

THE LAW OF PATENTS.

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THE

LAW OF PATENTS

FOR

USEFUL INVENTIONS.

BY

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IN THREE VOLUMES.

VOL. I.

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TO MY COLLEAGUES

IN THE

FACULTY OF THE YALE LAW SCHOOL,

FRANCIS WAYLAND, SIMEON E. CALDWIN, JOHNSON T. PLATT,
AND WILLIAM K. TOWNSEND,

I DEDICATE THIS TREATISE,

IN COMMEMORATION OF THE INTIMATE PERSONAL FRIENDSHIP
WHICH, FOR SO MANY YEARS, HAS INSPIRED AND
LIGHTENED OUR UNITED EFFORTS TO
ADVANCE THE LEARNING
OF THE LAW.

TO THE READER.

THE present work was undertaken in the conviction that a period had at last been reached when the Law of Patents could be successfully treated as a department of jurisprudence whose doctrines were derived by logical processes from established principles, and not as a mere body of legislative enactments verbally interpreted by the decisions of the courts. Patent Law governs those rights and obligations which are connected with the temporary monopoly in an invention. The fundamental principles on which it rests are in part rules of law, and in part facts in nature and the arts. These legal rules are identical with those applied from time immemorial in courts of law and equity, and have always been within the knowledge of persons learned in the law. Some of these facts have also long been known, while others, especially those relating to the essential attributes of an invention and the intrinsic character of the inventive act, have never, till a recent date, been fully understood. Ignorance concerning these formerly rendered the solution of many of the difficulties of Patent Law by any scientific method impossible, and led to nearly all the mistakes and perplexities which then arose in the administration of the law. But during the present generation a deeper research and a more exact discrimination have dispelled this ignorance, and though obscurities of detail still remain, yet whenever questions of Patent Law are now presented to our courts the factors of the problem lie before them, certain and intelligible, requiring only careful distinctions and accurate reasonings to attain impregnable results.

Acting upon this conviction the author commenced his labors by reading the various treatises on Patent Law, and all the English and American statutes and decisions bearing on the subject which had been published prior to the year 1882, extracting from them whatever statements, discussions, and explanations appeared to him of special value, and reducing the remainder to separate propositions of law or fact, — thus accumulating a wealth of material which for extensive knowledge, profound thought, and lucid explication can find no parallel in any other department of the law. The classification and collation of this material placed before him everything that has been said, decided, or conjectured concerning any question of Patent Law, and enabled him to formulate its doctrines with a completeness and correctness limited only by his own powers of comprehension and expression, while the material itself, enriched by the addition of the cases published during the progress of the work, and arranged in notes accompanying the formulated doctrine, now serves to explain, confirm, or perhaps to modify, the assertions and conclusions of the text.

This study of the Law of Patents in its sources demonstrated to the author that the fundamental principles on which it rests are these: —

I. That under our existing civilization public policy requires the state to encourage the exercise of inventive skill by conferring upon inventors a temporary monopoly in their inventions, and by securing to them its enjoyment.

II. That the grant and acceptance of this monopoly creates a contract between the inventor and the state, obliging the former to an immediate and complete disclosure of his invention to the public, and the latter to the legal protection and vindication of the monopoly in the invention thus disclosed.

III. That this contract is to be interpreted and enforced by the same rules of common law and equity which are applied to other contracts.

IV. That the terms "invention," "inventor" and "monopoly" express definite and permanent ideas of objects, persons, and relations which cannot be departed from in construing and protecting the rights of the respective parties to the contract.

V. That the mind and purpose of the legislature in enacting patent laws, and of the court in administering them, must be assumed to have been governed and directed by the four preceding principles; and hence that every statute and decision is to be read in their light and regarded as a correct enunciation of the law only when their distinctions and logical consequences are properly observed.

It is upon the basis of these principles that the system of Patent Law developed in the following pages has been erected. To these, as to infallible criteria of truth, have been brought the statements of text-writers, the provisions of statutes, the judgments, definitions, and discussions of the courts, and whenever one has been found inconsistent with these principles, its errors have been pointed out and its authority has been denied. It may surprise the reader, as it has excited the wonder and admiration of the author, to discover in how few out of all the abstruse and puzzling cases submitted to our courts any substantial divergence from these principles has occurred, and with what fidelity to duty our judges have receded from their unsound positions wherever a more mature consideration has convinced them of their error.

It is obvious from what has been already stated that the author does not regard the decisions of the courts in patent cases as simple judgments on the issues presented by the pleadings. On the contrary, they are, in numerous instances, elaborate essays, sometimes almost treatises, either on the whole body of the law or on a special topic, emanating from the minds of learned jurists, after long investigation and a close analysis of the conflicting arguments of acute lawyers and skilful experts, and announcing with carefulness of diction and thoroughness of statement the conclusions of law or

fact at which the writers have arrived. Such opinions are of priceless value to the author of a treatise and his readers. Although for the most part perhaps *obiter dicta*, so far as the controversy at bar was concerned, they are the true treasure-house of Patent Law to which student and teacher, counsel and court, must alike continually recur for the definition, confirmation, and exposition of the doctrines which they endeavor to comprehend and apply. Illustrious in the eyes of their professional brethren at large as are the judges from whom these opinions have proceeded, their highest honors are and ever have been won from those who are familiar with their efforts to develop and elucidate what one of the greatest of their number long ago aptly called "the metaphysics of the law." The author feels that he need offer no apology for his profuse citations from decisions of this character, and that not one will be found superfluous by any reader who desires to understand the subject he considers.

While thus declaring his appreciation of the value of these decisions the author recognizes that his readers may need a word of caution in reference to their use. One of the most common sources of error in all human affairs is the partial statement of a truth. Such a statement is correct as far as it goes, but if adopted and repeated by the hearer as embodying the whole truth, it scatters the seeds of many subsequent mistakes. Some of these decisions are open to this criticism. They are not and they do not purport to be exhaustive discussions of the topics which they treat, but merely the presentation of them in such aspects, and to such an extent, as may be important or appropriate for the determination of the questions actually decided. When such opinions are regarded by later courts as covering the entire subject, and the limitations, extensions, or modifications which in the case then pending may be essential to bring them within the principles of the law are overlooked, error is of course inevitable. Instances of this as well as other forms of misuse of authorities are pointed out and corrected in the notes.

The notes which form so large a portion of these volumes consist mainly of monographs on subjects treated more briefly or from a different standpoint in the text, of the extracts just referred to, and of the propositions of law or fact gathered from statutes and decisions in the manner heretofore described. To these propositional notes the author has devoted particular attention. In a treatise like the present, where the text sets forth only the conclusions resulting from a study of the notes, the ordinary method of citation by page and volume would have been comparatively useless, and it was therefore deemed expedient to frame the notes in digest form that the reader might at one view have the entire topic at his command. To ensure their correctness the author has revised all such notes since they were in print and believes they can now be depended upon as exact statements of the doctrine of the cited cases. No notice is taken of one case as overruling another, for the reason that the direct reversal of the whole decision in a patent case rarely if ever occurs, and because any discrepancy between the cases must be apparent to the reader who examines all.

With one or two exceptions the details of the work require no explanation. The first volume is occupied with the consideration of the nature of the patent-monopoly, the invention which it protects, and the inventor on whom it is conferred. The second treats of the letters-patent, their grant, repeal, construction, and transfer. The grant of letters-patent, being regulated partly by statute and partly by Patent Office rules and customs, involves matters of transitory as well as permanent obligation. It has been the endeavor of the author to separate between these, and confine his discussions to the settled law and practice of the Office. This separation, however, is not and cannot be complete, and as the rules are changed from time to time by the Commissioner, there is no other method open to the reader than to make himself acquainted with the current official rules and judgments and be guided by them where they disagree with those set forth

in the author's pages. The third volume contains an examination of the wrongs against inventors, patentees, etc., and their remedies. These are considered at length except as to those rules of procedure in the courts of law and equity which are common to all controversies, and which are mentioned here only in order to preserve the continuity of the subject and enable matters peculiar to infringement suits to be discussed in their proper place.

The Index covers the notes as well as the text. This was necessary to render them available for purposes of reference, but had each note been indexed under all its appropriate headings the space occupied would have been equivalent to another volume. Usually, therefore, a note appears in the index but once, and if not found under the heading first consulted can be discovered by turning to the other headings cited at the conclusion of the first.

It was the intention of the author in citing cases to mention in every instance all the reports in common use in which the case appears. Generally this has been done, but in the handling of so large a mass of materials omissions have occurred which it is one object of the Table of Cases to supply. In referring to the Table the reader should remember that a case often goes by different names, most of which are abbreviations of the longer and correct title given in the Table itself.

In the Appendix are collected and digested the cases published since the work went to press in the spring of 1888. So far as was possible these were inserted in the notes, but as no complete statement of their propositions could thus be made it seemed advisable to add them in this manner by themselves. It is the present design of the author, in cooperation with his son, George W. Robinson, of the New Haven Bar, who has been associated with him during the past five years of his labors on this treatise, to issue similar digests of cases involving questions of Patent Law, with suitable annotations, at such intervals as the profession

may require until the work itself may need enlargement or revision.

In conclusion the author begs the indulgence of his brethren toward those errors which are to be expected in a treatise of such extent and character. Commenced at a late period of his own life, he did not feel at liberty to publish a tentative volume, trusting to the labor of future years to fill up to its due proportions the outline thus presented; and the difficulties of a writer who undertakes to cover the whole field of research and deduction at a single effort, however earnest and prolonged, can be learned only by experience. If length of days to which he has no natural right are given him, he hopes to bring his literary offspring to a higher degree of development and usefulness. If not, he leaves it in the hands of men and scholars through whose additions and corrections he is confident that it will not suffer loss.

WILLIAM C. ROBINSON.

YALE UNIVERSITY,
August, 1890.

NOTE. — A collection of the Acts of Congress concerning patents for inventions, chronologically arranged and annotated from the cases prior to 1861, may be found at the end of Law's Patent Digest, edition of 1877.

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INTRODUCTION.

**OF THE ORIGIN AND NATURE OF THE MONOPOLY SECURED
TO INVENTORS BY THEIR LETTERS PATENT,**

AND OF

**THE HISTORY AND DEVELOPMENT OF THE PATENT SYSTEM
OF THE UNITED STATES.**

VOL. 1. — 1

TREATISE

ON

THE LAW OF PATENTS.

INTRODUCTION.

CHAPTER I.

OF THE ORIGIN OF THE MONOPOLY SECURED TO AN INVENTOR BY LETTERS-PATENT.

§ 1. Monopolies in General.

Historically, the patent systems both of England and America had their origin in those royal grants by which monopolies in trade or manufacture were conferred on a few favored subjects of the British crown. A monopoly is a franchise created by the Government, and vesting in an individual or corporation the exclusive privilege of practising a certain art, or of making, using, or selling a certain article, which, but for such monopoly, all other individuals and corporations would be at liberty to practise, or to make and use and sell.¹ In the infancy of European commerce, when all mercantile enterprises were attended with great hazard either of life or capital, these exclusive privileges were bestowed by different

§ 1. ¹ "Monopoly" (from the Greek *μόνος*, *alone*, and *πωλέομαι*, *to sell*) signifies "the exclusive right to sell." Such rights were claimed and exercised both among the Greek and Roman merchants, but without the authority of their governments (Godson, 2). Under the English kings these rights were granted by public letters, authenticated by the Great Seal, addressed to the people at large. From the Latin name of these letters,

"*literæ patentēs*," is derived the word "patent;" a title now applied to many other forms of public grant, as well as to that of the exclusive right to practise an invention. The bestowal of a monopoly by the government, under this system, not merely creates an exclusive privilege, but enables its possessor to protect and defend the rights which it confers. Phillips, 1; 2 Bl. Com. 346.

monarchs upon particular cities in order to induce them to embark in those important undertakings. When trade increased, other monopolies were obtained by the same cities as rewards for service rendered or money furnished to the State; and in this manner nearly all commercial operations eventually became restricted to these incorporated bodies, and were carried on under the protection of these exclusive grants. Associations of trading cities, for their mutual advancement and defence, were also formed, in some instances assuming such proportions and exercising such political authority as to become formidable rivals of the sovereign power.²

§ 2. **Continental Monopolies : The Hanseatic League.**

The most famous of these ancient civic combinations was that of the Hanse towns, now generally known as the Hanseatic League.¹ This association was organized about the middle of the thirteenth century, by the trading towns of Northern Germany, for the protection of their commerce from the rapacity of princes and from the depredations of marauders, whether on land or sea. At one period it embraced eighty-five cities, grouped in four great societies, whose respective heads were Lubec, Dantzic, Brunswick, and Cologne. It possessed a regularly constituted government, and an established system of finance and administration. Its affairs were managed by a diet, in which each town was represented by its deputies, and which assembled once in every three years. Such were its resources that in A. D. 1428 it equipped a fleet of two hundred and forty-eight ships, carrying a force of twelve thousand soldiers, against Eric of Denmark. It maintained factories at London, Bruges, Novogorod, and Bergen, and was allied by treaty with the principal trading cities of Holland, France, Italy, and Spain. It created centres of industry and civilization in various parts of Northern Europe, opened new channels of communication by its highways and canals, and often rendered signal services to the monarchs in whose realms its agencies had been established. In return

² Godson, 2-5.

§ 2. ¹ Hallam, Middle Ages, chap. ix. part ii. ; Encyclopædias, *in loc.*

for these services its factories were endowed, by royal grant, with special privileges, in which every merchant belonging to a Hanseatic town participated. During the fifteenth century, however, it became involved in controversies with different sovereigns, by whom the privileges theretofore enjoyed by it were transferred to the trading cities in their several dominions; and its merchants were compelled to reside within their native towns in order that their own governments might receive the benefit accruing from their capital and skill. From this time its importance gradually declined, until in A. D. 1630 the greater number of the cities withdrew from its allegiance.

§ 3. Early English Monopolies: the Guilds.

In England trade became an object of royal solicitude at a very early period. By a law of Athelstan (925-941) every merchant who had made three voyages beyond sea was entitled to the dignity of "thane." The formation and development of towns, as the centres of domestic traffic, were encouraged by the grant of special privileges; and from the time of William Rufus there was no reign in which political immunities or commercial franchises were not bestowed upon them.¹ The guilds, which had originally been clubs for religious, charitable, or social purposes, and were common throughout the kingdom, allied themselves together in the towns, and forming a body, known as the "merchant guild," applied themselves to commerce, procured numerous monopolies from the crown by purchase or otherwise, and finally engrossed the local trade. As this "merchant guild" increased in wealth and influence, it devoted itself to the more extensive and lucrative enterprises, while the lesser tradesmen associated themselves in "craft guilds," and obtained royal charters conferring upon them the power to regulate apprenticeships, to fix the hours of labor and the rate of wages, to exclude competition, and to confine to their own bodies certain industrial pursuits as well as the minor branches of commerce. In the struggle which sprang up between the merchant guilds and

§ 3. ¹ Hallam, Middle Ages, chap. viii., part iii.

craft guilds, and which continued during several centuries, the latter slowly encroached upon the privileges of the former, and becoming larger partakers of the royal favor gradually secured the control of trade.²

§ 4. **English Monopolies from A. D. 1261 to A. D. 1551.**

Until the reign of Edward VI. (A. D. 1551) the foreign commerce of England was almost entirely in the hands of strangers. These were principally citizens of the Hanse towns, who had been encouraged to settle in London by Henry III. (A. D. 1261), and had by him been erected into a corporation, endowed with many privileges, and exempted from various obligations imposed on other aliens. During three centuries these "merchants of the Steel-Yard," by loans of money and other services, maintained themselves under the favor and protection of the crown, and virtually monopolized the maritime trade of the whole country. In A. D. 1551 their privileges began to be recalled, and from thenceforward foreign commerce came more and more under the control of the English merchant companies, on whom monopolies of the same character were liberally bestowed.¹

§ 5. **English Monopolies : the Growth of Abuses.**

At the same period a change appears to have taken place in the terms on which, and the purposes for which, these monopolies were granted. Anciently, a monopoly was conferred directly on the merchant or trading corporation by whom it was to be enjoyed ; and the motive of the grant, in theory at least, was to induce the grantee to engage in trade. This theory of the motive of the grant soon became so far modified as to permit the consideration of the franchise to consist, wholly or in part, of money paid or service rendered to the sovereign. But now monopolies were given by the crown to individuals, who had no intention to employ them otherwise than by selling them to others at as high a price as possible. Rulers rewarded their favorites with these gifts, which, though costing

² Green's History of the English People, bk. iii., chap. i.

§ 4. ¹ Hume, chap. xxxv.

the giver nothing, were of great value in the market, and bestowed on their purchaser the power to impose the severest burdens on his fellow-subjects. By this process the last remains of free competition, both in domestic and foreign commerce, were speedily destroyed, and English trade, in almost all commodities, was confined to a few citizens, who fixed whatever price they pleased upon the exports and imports of the nation.

§ 6. Monopolies under Elizabeth: Resistance against Abuses.

This evil reached its height under the reign of Elizabeth. It was the policy of that illustrious monarch never to call upon her people for supplies unless necessity compelled it; and as a means of raising money for herself, as well as of bestowing favors on her courtiers and servants, these exclusive privileges were multiplied by her until the most common articles of consumption, such as salt, iron, powder, vinegar, bottles, saltpetre, oil, starch, and paper, were brought under the control of the monopolists. The advance in the prices of all these commodities was enormous, — salt, for instance, which had sold at sixteen pence a bushel, being held at fourteen or fifteen shillings. At the same time, to protect monopolists in the enjoyment of their privileges, they were endowed with arbitrary powers of searching the stores and habitations of those who were suspected of infringing upon their rights, and of collecting heavy penalties from them when found guilty. Against these grievous burdens Parliament rebelled in A. D. 1601, and a bill abolishing monopolies was introduced and advocated in the House of Commons. In the midst of the discussion a message was received from the queen, in which she promised to withdraw the most oppressive of these privileges, and the proposed legislation on the subject was abandoned.¹

§ 7. Monopolies under James I.: their Abolition in A. D. 1623 by Stat. 21 Jac. I.

The slight relief thus extorted from Elizabeth was followed in the reign of James I. by the complete deliverance of the

§ 6. ¹ Hume, chap. xlv.

English people from this tyrannical dominion of monopolists. Upon his accession in A. D. 1603 this prince had voluntarily rescinded all the exclusive privileges by which his predecessor had attempted to restrict domestic commerce. The foreign trade, however, still remained under the control of the great merchant companies, comprising in all about two hundred citizens of London, who by combining among themselves raised or lowered the prices of all exported and imported articles at their pleasure. From time to time, during the ensuing twenty years, efforts were made to remedy these remaining evils by legislative action, but without success until, in A. D. 1623, the famous Statute ~~against~~ ^{against} Monopolies (21 Jac. I. ch. 3) was enacted by Parliament and received the sanction of the king.¹ By this statute all past monopolies were abolished, and the power of the crown to grant them in the future was explicitly denied, except in cases where such grants had been or should be made to the inventors of new manufactures, conferring upon them the exclusive privilege of practising such inventions for a limited period of time.²

§ 8. English Monopolies since the Stat. 21 Jac. I.

Notwithstanding this statute, the English sovereigns did not immediately relinquish their claim to the free exercise of this branch of their prerogative. In A. D. 1631 Charles I. under the pressure of financial difficulties again asserted the ancient powers of the crown, and granted monopolies as a means of replenishing the royal treasury. But such was the effect of the victories already gained, and such the temper of the people, that the exclusive privileges thus conferred were generally disregarded, and all endeavors to enforce them failed. The pecuniary result to the king was also most discouraging, and from that time onward all pretence of any right in the crown to erect monopolies, contrary to the provisions of this statute, has been practically abandoned.¹

§ 7. ¹ Hume, chaps. xlv., xlix.

² For succinct accounts of the history of monopolies in England prior to

the passage of this statute, see Coryton, 1-9; Godson, 5-15; Collier, chap. ii.

§ 8. ¹ Hume, chap. lii.

§ 9. Two Classes of Monopolies, Legal and Illegal.

The monopolies created by the British crown before the statute of James I. may be divided into two great classes, which differ from each other both in their legal and in their intrinsic character. To the first class belong all those which were conferred on the inventors of a new manufacture or the introducers of a new trade into the realm, and which secured to them the exclusive privilege of carrying on such trade or manufacture for a certain period of time. The second class embraces those by which the exercise of some well-known branch of industry or commerce was restricted to particular individuals or corporations, and the liberty of other subjects to employ themselves in these pursuits was correspondingly abridged.¹ The earliest monopolies were of the former class, and were bestowed as a reward and an encouragement on those who, at their own expense or by their personal efforts, were engaged in advancing the mechanical knowledge or the commercial resources of the public.² Such monopolies were always sustained by the courts, and their creation was regarded as a legitimate exercise of royal power. The crown was properly considered as the patron of deserving artisans

§ 9. ¹ The various definitions of monopoly given by different writers are to be reconciled only by remembering that some have endeavored to define monopoly in general, while others have confined themselves to a description of illegal or criminal monopolies. Thus Comyn (Dig. Tit. Trade D. 4), "A monopoly is when the sale of any merchandise or commodity is restrained to one or a certain number."

Bouvier, "A monopoly is also an institution or allowance by a grant from the sovereign power of a State by commission, letters-patent, or otherwise, to any person or corporation, by which the exclusive right of buying, selling, making, working, or using anything is given."

On the other hand, Blackstone (4 Com. 159) defines monopoly as "a

license or privilege allowed by the king, for the sole buying and selling, making, working, or using of anything whatsoever; whereby the subject in general is restrained from that liberty of manufacturing or trading *which he had before.*"

Hawkins (P. C. chap. 79, § 1), "A monopoly is an allowance by the king, to any person or persons, of the sole buying, selling, making, working, or using of anything whereby any person is sought to be restrained from any freedom *which he had before or hindered from his lawful trade.*"

To the same effect are other authorities, both earlier and later, whose statements that monopolies are unlawful, void, or oppressive are to be understood as referring only to monopolies of the second class.

² Coryton, 1, 5.

and merchants; and the development of trade and commerce, through their enterprises and inventions, was recognized as a sufficient reason for temporarily restricting the freedom of the people.³ But as monopolies became more numerous, and were bestowed as a return for service or pecuniary aid rather than as a recompense for benefits conferred upon the public, the character of the monopoly itself was less and less regarded, and the oppressive privileges of the second class were freely granted. These were, however, always treated by the courts as contrary to common right and void at common law; but since no power existed by which the king could be prevented from creating them, the judges could apply no remedy except by punishing the monopolist for procuring and asserting them.⁴ In one case under Elizabeth in A. D. 1602, and another under James I. in A. D. 1614, this difference in the character and legality of these two classes of monopolies was clearly stated, and the nature of the controversy on this subject, between the courts and people upon one side and the crown upon the other, was accurately defined.⁵ The statute of James I. simply enacted into a law,

³ Hawkins (P. C. chap. 79, § 6), "It seemeth clear that the king may, for a reasonable time, make a good grant to any one of the sole use of any art invented or first brought into the realm by the grantee."

Bac. Abr. (Tit. Prerogative, F. 4), "It is agreed that the king may, for a reasonable time, grant to a person the sole use of any art first invented by him, and this it seems the king might do at common law."

See also Godson, 10.

⁴ Bac. Abr. (Tit. Prerogative, F. 4), "The king's grant of a monopoly, as of the sole buying, selling, working, making, or using of any commodity, is not only void by the common law, but the persons procuring such grants are said to be punishable by fine and imprisonment."

Comyn (Dig. Tit. Trade, D. 4), "All monopolies are contrary to Magna Charta."

See also Godson, 12, citing case of John Peachie, who was convicted and punished, in the reign of Edward III., for obtaining a monopoly of the trade in sweet wines.

⁵ Darcy v. Allin, Noy, Rep. 173. This was an action on the case brought by Edward Darcy against Thomas Allin for the infringement of a patent granted in the 30 Eliz., to one Ralph Bowes and his assigns, for the exclusive making and importing and sale of playing-cards during twelve years, and renewed for an additional twelve years to the plaintiff, evidently an assignee of Bowes.

The defendant pleaded that, as a citizen of London, he had a free right to trade in all merchantable things; and to this plea the plaintiff demurred. The argument against the validity of the patent, given at length in the report, is interesting and very forcible.

which bound the sovereign, the doctrines that the courts had always maintained, and reiterated those principles of Magna

It insists that the crown has no power to grant such a patent, and refers to cases in which monopolies of office, toll, etc., had been held void by the courts. It also denounces the patent as contrary to common right, destroying trade and labor, raising prices, and filling the market with inferior goods. It then states the distinction between lawful and unlawful monopolies, and gives instances thereof as follows: (182) "Now, therefore, I will show you how the judges have heretofore allowed of monopoly patents; which is, that where any man by his own charge and industry, or by his own wit or invention, doth bring any new trade into the realm, or any engine tending to the furtherance of a trade, that never was used before, — and that for the good of the realm, — that in such cases the king may grant to him a monopoly patent for some reasonable time, until the subjects may learn the same, in consideration of the good that he doth bring by his invention to the Commonwealth; otherwise not.

"In the 9th Eliz. there was a patent granted to Mr. Hastings of the court: That in consideration that he brought in the skill of making of Frisadoes as they were made in Harlem and Amsterdam beyond the seas, being not used in England, — that, therefore, he should have the sole trade of the making and selling thereof for divers years; charging all other subjects not to make any Frisadoes in England during that time, upon pain to forfeit the same Frisadoes by them made, and to forfeit also £100, the one moiety thereof to the Queen's Majesty, the other to Mr. Hastings; upon which patent Mr. Hastings, about 20 years past, exhibited an information in the Exchequer against

certain clothiers of Coxall for making of Frisadoes, contrary to the intent of this patent. To which information, for that it was against law to have such penalties of the goods and £100 to be forfeited by force of a letter-patent, therefore did demur upon the information, and moved the court, and the opinion of the court being clear against him, he never went further in his information, but exhibited his English bill in the Exchequer chamber against them, where, upon the examination of the cause, it appeared that the same clothiers did make baize very like to Mr. Hastings's Frisadoes, and that they used to make them before Mr. Hastings's patent, for which cause they were neither punished nor restrained from making their baize like to his Frisadoes.

"Another monopoly patent was granted to Mr. Matthey, a cutler at Fleetbridge, in the beginning of this Queen's time, which I have here in court to show, by which patent it was granted unto him the sole making of knives with bone hafts and plates of lattan; because, as the patent suggested, he brought the first use thereof from beyond seas; yet, nevertheless, when the wardens of the company of cutlers did show, before some of the counsel and some learned in the law, that they did use to make knives before, though not with such hafts, that such a light difference or invention should be no cause to restrain them; whereupon he could never have benefit of this patent, although he labored very greatly therein.

"Lastly, the monopoly patent granted to one Humphrey of the Tower, for the sole and only use of a sieve, or instrument for melting of lead, supposing that it was of his own

Charta which declared that the liberties of the citizen were to remain forever unrestrained by royal usurpation.⁶

invention, and therefore prohibited all others to use the same for a time; and because others used the like instrument in Darbyshire, contrary to the intent of his patent, therefore he did sue them in the Exchequer chamber by English bill; in which court the question was whether it was newly invented by him, whereby he might have the sole privilege, or else used before at Mendiff in the West Country, which if it were there before used, then the court was of opinion he should not have the sole use thereof."

The same case, but without the argument of counsel, is reported in 11 Coke, R. 84 b., Trinity Term, 44 Eliz., where it appears that the cause itself was decided in favor of the defendant. 1 Abb. P. C. 1.

In the case of "The Clothworkers of Ipswich," Godbolt, 252, decided at Easter Term, 12 James I., in which similar questions were presented: (253) "it was agreed by the court that the king might make corporations, and grant to them that they may make ordinances for the ordering and government of any trade; but thereby they cannot make a monopoly, for that is to take away free trade which is the birth-right of every subject. . . . (254) But if a man hath brought in a new invention and a new trade within the kingdom, in peril of his life and consumption of his estate or stock, etc., or if a man hath made a new discovery of anything; in such cases the king, of his grace and favor, in recompense of his costs and travail, may grant by charter unto him, that he only shall use such a trade or traffic for a certain time, because at first the

people of the kingdom are ignorant and have not the knowledge or skill to use it. But when that patent is expired, the king cannot make a new grant thereof; for when the trade is become common, and others have been bound apprentices to the same trade, there is no reason that such should be forbidden to use it." 1 Abb. P. C. 6.

⁶ Magna Charta, 9 Henry III., chap. xxxvii. A. D. 1225, "Escuage from henceforth shall be taken like as it was wont to be in the time of King Henry our grandfather; reserving to all Archbishops, Bishops, Abbots, Priors, Templars, Hospitallers, Earls, Barons, and all persons as well spiritual as temporal, all their free liberties and free customs which they have had in time passed. And all these customs and liberties aforesaid, which we have granted to be holden within this our realm, as much as appertaineth to us and our heirs we shall observe; and all men of this our realm, as well spiritual as temporal (as much as in them is), shall observe the same against all persons in like wise. And for this our gift and grant of these liberties and of other contained in our Charter of Liberties of our Forest, the Archbishops, Bishops, Abbots, Priors, Earls, Barons, Knights, Freeholders, and other our subjects have given unto us the fifteenth part of all their moveables. And we have granted unto them, on the other part, that neither we nor our heirs shall procure or do anything whereby the liberties in this charter contained shall be infringed or broken; and if anything be procured by any person contrary to the premises it shall be had of no force nor effect." 1 Stat. at Large, 13.

§ 10. Relation of the Stat. 21 Jac. I. to English and American Patent Law.

The statute of James I. was thus declaratory of the common law.¹ It created no new right either in the crown or

§ 10. ¹ The statute 21 James I., chap. 3, was, in substance, as follows, the passages in quotation marks being in the language of the act itself:—

“An Act concerning monopolies and dispensations of penal laws and the forfeiture thereof.”

I. Whereas your majesty, in the year 1610, published a book declaring that all grants of monopolies, and of the benefit of penal laws, and of the power of dispensing with law, and of compounding penalties, are contrary to law; and whereas your majesty then expressly commanded that no suitor should ever apply for such grants; and whereas, nevertheless, such grants have been applied for and allowed: Therefore to make void all these, and to prevent the like in time to come, may it please your majesty that it be declared and enacted by authority of this present parliament “that all monopolies, and all commissions, grants, licenses, charters, and letters-patent, heretofore made or granted, or hereafter to be made or granted, to any person or persons, bodies politic or corporate whatsoever, of or for the sole buying, selling, making, working, or using of anything, within this realm or the dominion of Wales, or of any other monopolies,” and all licenses to do anything contrary to law, or to confer authority on others so to do, and all grants of the power to compound or receive the benefit of any penalty before judgment thereon had, and all warrants or other process for the erection or promotion of the same “are altogether contrary to the laws of this realm, and so are and shall be utterly void, and of none effect, and in no wise to be put in use or execution.”

II. “That all monopolies and all such commissions, grants, licenses, charters, letters-patent,” and all other matters and things tending as aforesaid, “and the force and validity of them and of every of them, ought to be and shall be forever hereafter examined, heard, tried, and determined by and according to the common laws of this realm and not otherwise.”

III. “That all person and persons, bodies politic and corporate whatsoever, which now are or hereafter shall be, shall stand and be disabled and incapable to have, use, exercise, or put in use any monopoly or any such commission, grant, license, charter, letters-patent,” or other matter or thing tending as aforesaid, or any power grounded or pretended to be grounded on them.

IV. That at the end of forty days after this present session of parliament, any person who may be aggrieved “by occasion or pretext of any monopoly,” or other matter or thing tending as aforesaid, may recover in the king's courts, in an action on this statute, treble damages; and such suits shall not be hindered or delayed by any order or injunction issuing out of any other court than that before which such suit is pending, except a writ of error, under penalty of a *premunire*.

V. “Provided, nevertheless, and be it declared and enacted: That any declaration before mentioned shall not extend to any letters-patent and grants of privilege, for the term of one and twenty years or under, heretofore made of the sole working or making of any manner of new manufacture, within this realm, to the first and true inventor or inventors of such manufactures, which others,

in the people. It limited the royal prerogative to certain definite channels and specified the boundaries within which

at the time of the making of such letters-patent and grants did not use, so they be not contrary to the law, nor mischievous to the state, by raising of the price of commodities at home, or hurt of trade, or generally inconvenient, but that the same shall be of such force as they were, or should be, if this act had not been made and of none other. And if the same were made for more than one and twenty years, that then the same, for the term of one and twenty years only, to be accounted from the date of the first letters-patent and grants thereof made, shall be of such force as they were, or should have been, if the same had been made but for the term of one and twenty years only, and as if this act had never been had or made, and of none other."

VI. "Provided also, and be it declared and enacted: That any declaration before mentioned shall not extend to any letters-patent and grants of privilege, for the term of fourteen years or under, hereafter to be made, of the sole working or making of any manner of new manufactures, within this realm, to the true and first inventor and inventors of such manufactures, which others, at the time of making such letters-patent and grant, shall not use, so as also they be not contrary to the law, nor mischievous to the state, by raising prices of commodities at home, or hurt of trade, or generally inconvenient: The said fourteen years to be accounted from the date of the first letters-patent or grant of such privilege, hereafter to be made; but that the same shall be of such force as they should be, if this act had never been made and of none other."

VII. Provided, that this act shall not extend to or interfere with any

grant heretofore made or confirmed by act of parliament.

VIII. Provided, that this act shall not affect any warrant directed to any justice of the king's courts.

IX. Provided, that this act shall not prejudice any cities, boroughs, or incorporated towns, in the right to any customs heretofore used by them; or any company or corporation or fellowship of any trade, or society of merchants, in any of their immunities or privileges.

X. Provided, that this act shall not affect any patent heretofore made, or hereafter to be made, concerning printing, or the making of saltpetre or of gunpowder, or of ordnance or shot for ordnance, nor any grant of any office.

XI. Provided, that this act shall not affect any privilege heretofore granted, or hereafter to be granted, concerning the making of alum or the working of alum mines.

XII. Provided, that this act shall not prejudice any usage or privilege heretofore claimed and enjoyed by the guild of hoast-men of Newcastle-upon-Tyne, concerning the carrying or trading in coal; nor any grant of any licenses to taverners and retail dealers in wine to be drank on their own premises, where the fees for such licenses accrue directly to the use of the king.

XIII. Provided, that this act shall not affect the patent granted in A. D. 1623 to Sir Robert Mansel for the making of glass; or the patent granted in A. D. 1615 to James Maxwell for the transportation of calves' skins.

XIV. Provided, that this act shall not interfere with the patent granted in A. D. 1618 to Abraham Baker for the making of smalt; nor that granted in A. D. 1621 to Edward, Lord Dudley, for

it might lawfully be exercised. The grant of a monopoly still remained a voluntary concession on the part of the sovereign, to be bestowed by him according to his pleasure and on such terms as he might deem appropriate.² It became subject to judicial criticism only upon the questions whether the monopolist himself had complied with the conditions of the grant and was entitled, under the provisions of the statute, to receive it. If he were the true and first inventor of any manner of new manufacture within the realm, which others at the date of his grant did not use, and which was neither contrary to law nor hurtful to the state; if his monopoly, as granted, consisted only in the exclusive privilege of making or using such invention for the proper period of time; and if he had fulfilled the duties imposed on him by the crown,—his grant was valid, but otherwise was void. The decisions of the courts upon these provisions of the statute constitute the body of the present English Patent Law; while in the same statute, thus interpreted, are found the sources of the Patent Law of the United States.³

melting iron ore and making the same into bars with coal.

² Godson, 47; Attorney-General, *ex rel.* Hecker *v.* Rumford Chemical Works (1876), 9 O. G. 1062.

³ The disposition to regard the rights and remedies of inventors as resting entirely upon the Constitution and the Acts of Congress, which is apparent in the narrow construction given to the statutes in some recent cases, and is specifically expressed in *United States v. American Bell Telephone Co.* (1887), 41 O. G. 123, is thus evidently improper. These rights and remedies were recognized by the common law before the Stat. Jac. I. was enacted. They were acknowledged and enforced by the individual states before the adoption of

the Federal Constitution. Our patent acts have always depended upon common-law principles for their construction, and until recently have been uniformly treated as a part of that great body of theoretical and practical jurisprudence. Patent law is as truly, though not so extensively, a matter of historical development as the law of real property, and can no more be beneficially administered as a mere statutory system, inoperative except where verbally declared, than any other of those ancient branches of the law which we have inherited from our Anglo-Saxon ancestors. See Appendix to 3 Wheat. note 2: Briefs of counsel in *United States v. American Bell Telephone Co.* (1887), 32 Fed. Rep. 591.

CHAPTER II.

OF THE NATURE OF THE MONOPOLY SECURED TO AN INVENTOR
BY LETTERS-PATENT.

§ 11. Patent Privilege a Monopoly : Diversity of Opinions.

Certain modern writers upon Patent Law have asserted that the exclusive privilege conferred on an inventor is not a monopoly. Certain judges of the courts of the United States, in their decisions upon patent cases, have expressed the same opinion.¹ Other authors and jurists have declared

§ 11. ¹ To this effect is Curtis on Patents, Prelim. Obs. xix. : "A patent for a useful invention is not under our law, or the law of England, a grant of a monopoly, in the sense of the old common law." Also, xxii., "A patent right, under the modern law of England and America, differs essentially from one of the old English Monopolies. In those grants of the crown, the subject-matter of the exclusive privilege was quite as often a commodity of which the public were and long had been in possession, as it was anything invented, discovered, or even imported by the patentee."

There is no uniformity in the language used in reference to this matter by the American courts. Thus, for example, in *Brooks v. Jenkins* (1844), 3 McLean, 437, the judge remarks: "This law gives a monopoly, but not in an odious sense. It takes nothing from the community at large, but secures to them the greatest benefits." In *Parker v. Haworth* (1848), 4 McLean, 372; 2 Robb. 725, the same court declares: "It is not a monopoly the inventor receives. Instead of taking anything from the

public, he confers on it the greatest benefits." In *Bloomer v. Stolly* (1850), 5 McLean, 162, he states: "It is said monopolies are odious; but a patent right that shall compensate the inventor is not a monopoly in the general sense of that term. The inventor takes nothing from society." And in *Allen v. Hunter* (1855), 6 McLean, 305, he says: "Patentees are not monopolists. This objection is often made and it has its effect upon society. The imputation is unjust and impolitic. A monopolist is one who by the exercise of the sovereign power takes from the public that which belongs to it and gives to the grantee and his assigns an exclusive use. On this ground monopolies are justly odious. It enables a favored individual to tax the community for his exclusive benefit, for the use of that to which every other person in the community, abstractly, has an equal right with himself. Under the patent law this can never be done. No exclusive right can be granted for anything which the patentee has not invented or discovered. If he claims anything which was before

that the exclusive right of the inventor is not only a true monopoly, but, as is apparent from the historical sketch already given, that it is the primeval and ideal monopoly, out of the abuse of which all odious and illegal monopolies have grown.² The latter is the view taken of the subject by the earlier writers, and is the doctrine generally adhered to by the British courts.³

known his patent is void. So that the law repudiates a monopoly. The right of the patentee entirely rests on his invention or discovery of that which is useful and which was not known before. And the law gives him the exclusive use of the thing invented or discovered for a few years as a compensation for his ingenuity, labor, and expense in producing it. This, then, in no sense partakes of the character of a monopoly." Thus within a period of eleven years the same court declares of a patent privilege that it "is a monopoly but not in an odious sense;" that "it is not a monopoly," and that "it is not a monopoly in the general sense of that term."

² Stat. James I., § 1: "Be it declared and enacted, by authority of this present parliament; That all Monopolies, and all Commissions, Grants, Licences, Charters, and Letters Patent, heretofore made or granted, or hereafter to be made or granted, to any person or persons, bodies politic or corporate whatsoever, of or for the sole buying, selling, making, working, or using of anything within this realm, or the dominion of Wales, or of any other Monopolies," &c. Out of these the 6th section excepts the privileges granted to first inventors, thereby showing that the patent privilege was then regarded as one form of monopoly. Says Coryton: (5) "The earliest form of these privileges was that of conducting exclusively new trades, or dealing exclusively in objects of commerce hitherto unknown, as a reward and encouragement to the parties introducing them.

By degrees, however, the powers confided to the executive were perverted from their proper purpose; and under the pretence of the better government of trade, the prerogative of the crown was employed in sanctioning, in return for pecuniary aid, individuals and corporations in very oppressive monopolies."

³ To this effect is Godson: (43) "One species of monopolies, it has been shown, are those, which, although founded on grants, are allowed by statute law. From that source the Law of Patents for Inventions springs. . . . For although they are monopolies, yet they are very limited ones."

So also Phillips: (2) "A patent is a grant by the state of the exclusive privilege of making, using, and vending, and authorizing others to make, use, and vend an invention. It is a monopoly of the invention. The monopoly may be unrestricted in geographical extent, and so be coextensive with the authority of the state or government granting it, or may be confined to a certain territory; so in respect to duration, it may be for an indefinite or a limited period; and again in its nature or character it may be either absolute, or subject to certain qualifications and conditions. . . . (23) Patent rights are a surviving branch of the great system of monopolies," &c.

In Coryton: (2) "The exclusive use of new inventions, although the origin and the supporting principle of the whole, plays but an insignificant part in the great system of monopolies," &c.

Other writers applying the same term

§ 12. Patent Privilege a Monopoly: Effect of this Doctrine on Legislatures and Courts.

The question whether a patent privilege is a monopoly is not a mere question of words. It is the point of departure for

to the patent privilege are Norman, 2; 1 Web. 5, n.

The language of the English courts from the earliest period has been of the same character. Thus, in *Darcy v. Allin* (1602), Noy, 173 : (182) "Now, therefore, I will show you how the judges have heretofore allowed of monopoly patents; which is, that where any man by his own charge and industry, or by his own wit or invention, doth bring any new trade into the realm, or any engine tending to the furtherance of a trade that never was used before, and that for the good of the realm, that in such cases the king may grant to him a monopoly patent," &c.

In *Liardet v. Johnson* (1778), 1 Web. 53, Lord Mansfield says : (54, note c) "The law relative to patents requires, as a price the individual should pay the people for his monopoly," &c. Bull. N. P. 76.

In *Rex v. Arkwright* (1785), 1 Web. 64, Buller, J. : (66) "It is clearly settled at law that a man, to entitle himself to the benefit of a patent for a monopoly, must disclose his secret," &c. 1 Abb. P. C. 29 (31).

In *Turner v. Winter* (1787), 1 Web. 77, Ashhurst, J. : (80) "As every patent is calculated to give a monopoly to the patentee, it is so far against the principles of law," &c. 1 Abb. P. C. 43(47).

In *Huddart v. Grimshaw* (1803), 1 Web. 85, Lord Ellenborough : (86) "A patent entitling the plaintiff, for a limited period of time, to the monopoly of an invention," &c. 1 Abb. P. C. 128 (145).

In *Crossley v. Beverly* (1830), 1 Web. 112, Lord Tenterden : (116) "That would have been less beneficial to the public, because it would have prolonged

the time of the monopoly." 1 Abb. P. C. 437 (442).

In *Morgan v. Seaward* (1836), 1 Web. 170, Alderson, B. : (173) "That is the fair premium which the patentee pays for the monopoly he receives." Parke, B. : (194) "If the inventor could sell his invention, keeping the secret to himself, and when it was likely to be discovered by another, take out a patent, he might have, practically, a monopoly for a much longer period than fourteen years. . . . (197) A grant of a monopoly for an invention which is altogether useless," &c. 2 Abb. P. C., 262 (319), 419 (428, 431).

In *Crane v. Price* (1842), 1 Web. 393, Tindal, C. J. : (411) "The king may grant him a monopoly of a patent for a reasonable time."

In *Walton v. Bateman* (1842), 1 Web. 613, Cresswell, J., speaking of the statute of James I., says it was passed (614) "to enact that all parties should be disabled from using monopolies, except in certain instances."

In *Househill Co. v. Neilson* (1843), 1 Web. 673, Lord Brougham : (712) "The patent act contains two exceptions—the proviso under which the monopoly is allowed to be granted. . . . In cases of inventions, the patent right, or monopoly, may be granted," &c.

In *re Morgan's Patent* (1843), 1 Web. 737, Lord Brougham : (737) "a patent term, that is to say, a monopoly."

In *re Porter's Patent* (1855), 2 Web. 201, the Privy Council, in describing the object of the confirmation of a void patent, say that it is (211) "to give force and validity, by a quasi legislative authority, to a grant of monopoly actually void," &c.

In *Smith v. Davidson* (1857), 19 C. S.

two distinct theories, under whose influence courts and legislatures may be led to widely different conclusions as to the dividing line between the rights to be conceded to inventors and those to be reserved to the public. Every grant of a monopoly is, in appearance at least, in derogation of the common right.¹ The bestowal of an exclusive privilege on one man forbids its exercise by any other, and thus appropriates to him the benefits which otherwise would have remained, or might have become, the property of all. Like other apparent restrictions upon common right, the law regards such grants with disfavor, and so construes them as to permit no further limitation of the liberties of others than the language of the grant itself requires.² In legislative bodies, which recognize a patent-right as a monopoly, the interests of the public will naturally be preferred to those of the inventor; legislation on the subject will be cautious and conservative; and the powers conferred upon the patentee will be subordinated to the free enjoyment by all other citizens of every privilege that is not inconsistent with the protection to which his inventive skill and genius are entitled. In courts where the same theory prevails such rules will be followed as

697, the Lord President: "A monopoly of it is given to him as being his invention, because he is the party who has given to the public that invention. He has given it to the public under the condition that he shall obtain a monopoly. . . . The consequence is that his monopoly must be protected," &c.

In re Hill's Patent (1863), 1 Moore, P. C. C., N. S. 258, Coleridge, J.: (264) "A monopoly limited to a certain time is properly the reward which the law assigns to the patentee for the invention and disclosure to the public of his mode of proceeding." These authorities show the uniformity with which the English courts regard the inventor's privilege as a true monopoly.

§ 12. ¹ Any grant to have the sole right to exercise a trade is "against the common law and the benefit and liberty of the subject." 11 Coke Rep. 86.

Coryton: (4) "Freedom of trade, in so far as regards the employment of industry and skill was a jealously guarded maxim of common law, . . . (4) By the common law, however, the crown . . . had power to grant many privileges, 'although prima facie,' as it was said, 'they appear to be against common right.' The consideration was the invention of a new manufacture or the introduction of a new trade."

² 2 Bl. Com. 347.

"Crown grants have at all times been construed most favorably for the king," &c. Chitty, Prerog. 391-2.

"The taking away of rights is not favored by the law. Therefore statutes in derogation of common right are in the construction kept within their express provisions." Bishop on Written Laws, § 119.

tend to limit the monopoly of the inventor to the exact letter of his grant, and hold him to a strict compliance with all its conditions as an essential requisite to its validity.

§ 13. Patent Privilege a Monopoly: Effect of Departure from this Doctrine on Legislatures and Courts.

Upon the other hand, a grant, not made in derogation of the common right, is favored by the law. Being intended principally, if not entirely, for the benefit of the grantee, and conflicting with no public interest either actual or possible, the law construes it liberally in order to secure to the grantee all the advantage which the grantor might have purposed to bestow upon him.¹ And hence, where legislatures and the courts adopt this theory of the exclusive privilege created by a patent, and lose sight of its true character as a monopoly, legislative acts in favor of the inventor will be sweeping and extravagant, and the decisions of the courts will sustain him in claims which seriously abridge the rights of others, and will afford him a protection and redress far beyond that which justice and the public interest demand.

§ 14. Patent Privilege a Monopoly: Effect of this Doctrine upon earlier English Law.

The truth, as well as the importance, of this distinction will become apparent on an examination of the changes in the attitude of courts and legislatures toward inventors since the passage of the statute of James I. This statute was enacted at a period when the English people were suffering under grievous burdens, resulting from the multiplication of odious monopolies. The temper of the judges and of Parliament was hostile to exclusive privileges of every kind. In the two cases previously cited,¹ the former had cautiously allowed that a monopoly of a new trade or manufacture might lawfully be conferred on the inventor until the public had become accustomed to its use; and in this statute Parliament, with equal jealousy for the common right, confined this privilege to a

§ 13. ¹ Bishop on Written Laws, 173; 1 Abb. P. C. 1; Clothworkers of § 192: Bac. Abr. (Statutes, I. 7, 9). Ipswich (1615), Godbolt, 252; 1 Abb.

§ 14. ¹ Darcy v. Allin (1602), Noy. P. C. 6.

small class of individuals, and permitted it to them during no longer time than was considered necessary for the learning of the new trade and teaching it to others. The decisions under this statute within the next one hundred and eighty years were for the most part characterized by the same spirit. The inventor was looked upon as a monopolist, dependent for his exclusive rights upon the royal bounty; and his privileges were rigidly confined within the literal meaning of the words by which they were described in his patent.² If these were capable of two constructions, that was adopted which would enure most fully to the public benefit. Even where one of two constructions would defeat the grant while the other would support it, the latter was followed chiefly on the ground that the king's honor was more to be regarded than his profit, and that it, therefore, could not be admitted that the patent was intended to be void.³ With equal strictness was

² Coryton: (38) "Previously to the time of Lord Eldon, the patentee was as purely a creature of royal bounty as the monopolist of the Elizabethan age, and language was employed by judges in the application of the doctrine which would at the present day be considered highly unconstitutional. . . . The nature of the patentee's privileges drove him frequently into courts of law, and during this early period almost constantly to his disadvantage. To him alone no margin was conceded for possible error. . . . (39) Judges either covertly evaded or openly overruled such portions of the statute as opposed their opinions, and patent trials by degrees degenerated into dialectic discussions and verbal criticism."

³ Norman: (4) "It is laid down that the king's letters-patent are records of a high nature; they have in all times been construed most favorably for the king, contrary to the grants of common persons, which are construed in favor of the grantee and most strongly against the grantor. If they can be taken to enure to a double intent, they shall be

taken to the intent that makes most to the king's benefit. . . . But where it is capable of two constructions, by the one of which it will be valid and by the other void, that construction shall be put on it which shall make it valid, for that will be more for the benefit of the subject and the honor of the king, which ought to be more regarded than his profit, for it was not the king's intent to make a void grant."

See also *Bac. Abr.* (Prerogative, F.); *Comyn* (Dig. Grant. G. 12); *Bewley's Case*, 9 Rep. 131 *a.*; *Churchwardens of St. Saviour's*, 10 Rep. 67 *a.*

In *Rex v. Mussary* (1738), 1 Web. 41, the following general rules were laid down respecting patents by Lee, C. J.:

"1. Every false recital, in a thing not material, will not vitiate the grant, if the king's intention is manifest and apparent;

"2. If the king is not deceived in his grant by the false suggestion of the party, but from his own mistake upon the surmise and information of the party, it shall not vitiate or avoid the grant;

it required that the patentee should have fulfilled all the conditions of his grant. Any mistake in the description of his invention, any excess in his claims as to its novelty or usefulness, any disclosure of his secret to others before the issue of the patent, was treated as a fraud upon the crown, and on proof of any one of these his patent was declared to be invalid.⁴

“3. Although the king is mistaken in point of law or matter of fact, if that is not part of the consideration of the grant it will not avoid it ;

“4. Where the king grants *ex certa scientia et mero motu* those words occasion the grant to be taken in the most liberal and beneficial sense, according to the king's intent and meaning expressed in his grant ;

“5. Although in some cases the general words of a grant may be qualified by the recital, yet if the king's intent is plainly expressed in the body of the grant the intent shall prevail and take place.” 1 Abb. P. C. 8 (9).

These rules have been recognized in many patent cases. The distinction between a false suggestion of the patentee and a mistake of the king was very important ; the former avoiding a patent, the latter not. But as almost any excess or deficiency in the description of the invention was held to constitute a false suggestion, and as every mistake of the king in reference to the same matter went to the consideration of the grant, the consequences to the patentee were equally disastrous. Under these rules, which appear to have been intended for the benefit of the patentee, it was therefore held that a patent which suggests that certain inventions are improvements when one of them was not so, or which covers two or more inventions when one is not new, or which describes something as a necessary part of the invention that in reality is not so, or which calls the invention by one name when another is more appropriate, or which claims for the invention cer-

tain uses to one of which it is not applicable, was void. Moreover, according to these rules, if the king's grant did not contain the phrase, *ex certa scientia et mero motu*, it was still subject to the strict construction which formerly prevailed. *Feather v. Reg.* (1865), 6 B. & S. 257.

⁴ Coryton: (38) “An unapt title to his invention, an ill-judged word in its description, an incautious experiment, the least disclosure of his secret before letters sealed, and his privileges were at an end. Technical rules, framed with other objects and unsuited to the case, were rigorously applied by those who saw in it only the relation between the sovereign and the subject, and adjudicated on the maxims of the common law as applicable to royal franchises and grants, while the merits of the invention, or its effect on public policy, rarely engaged attention.”

In *Turner v. Winter* (1787), 1 Web. 77, Buller, J. : (81) “Many cases upon patents have arisen within our memory, most of which have been decided against the patentees upon the ground of their not having made a full and fair discovery of their inventions.” 1 Abb. P. C. 43 (48).

In *Liardet v. Johnson* (1778), 1 Web. 53, Lord Mansfield is said to have ruled (54, note *c*) that “the law relative to patents requires, as a price the individual should pay the people for his monopoly, that he should enroll, to the very best of his knowledge and judgment, the fullest and most sufficient description of all the particulars on which the effect depended that he was, at the time,

It was not until the generations which had suffered from the ancient grievances had passed away, and the traditions of those grievances themselves grew dim, that the judges, yielding to the pressure of industrial enterprise, laid aside the extreme doctrines and the rigid rules with which their predecessors had fought the battle of the people against odious monopolies, and began to recognize inventors as public benefactors, whose personal services and sacrifices merited the privileges which they received, and demanded for them a liberal consideration from the courts. In the latter part of the last century this change in judicial sentiment manifested itself in several notable expressions, in which, for the first time, the grant of letters-patent to an inventor was held to be a matter of right and not of favor, and the patentee was declared to be entitled to the approval and enforcement of his privilege whenever he had fairly given to the public the knowledge of the discovery that he had made.⁵

§ 15. Patent Privilege a Monopoly: Contract Theory Introduced: Effect on Later English Law.

During the present century the development of this liberal spirit in Great Britain has been marked and rapid. The right of the inventor to his exclusive privilege, in return for the benefit conferred by him upon the public, being once conceded, the idea that his letters-patent created a contract between him and the people naturally followed. This idea

able to do, . . . that no omission or defect in this instrument (specification) could admit of an apology while it was in the power of the patentee to have avoided it," &c.

Even as late as *Hornblower v. Boulton* (1799), 8 T. R. 95, Lord Kenyon observed: (98) "I am not one of those who greatly favor patents; for though, in many instances, . . . the public are benefited by them, yet on striking the balance upon this subject, I think that great oppression is practised on inferior mechanics by those who are more opulent." 1 Abb. P. C. 98 (99).

⁵ In *Arkwright v. Nightingale*

(1785), 1 Web. 60, Lord Loughborough: (61) "There is no matter of favor can enter into consideration in a question of this nature. The law has established the right of patents for new inventions; that law is extremely wise and just." 1 Abb. P. C. 24 (25).

In *Turner v. Winter* (1787), 1 Web. 77, Buller, J.: (81) "Whenever it appears that the patentee has made a fair disclosure, I have always had a strong bias in his favor, because, in that case, he is entitled to the protection which the law gives him." 1 Abb. P. C. 43 (48).

seems to have been first suggested by Lord Eldon who, in a case decided in A. D. 1800, stated that a patent was a bargain with the public and was to be construed on the same principles of good faith by which all other contracts were controlled.¹ Under the influence of this idea the attitude of the courts toward the patentee has gradually become more favorable, and the strictness of the old rules has relaxed, until he is now treated as if he were a party to a contract, and when he has substantially fulfilled his duty he is protected in the enjoyment of those benefits which his patent, liberally and reasonably construed, bestows upon him.²

§ 15. ¹ In *Cartwright v. Arnott*, Easter Term, 1800, cited in *Harmer v. Playne*, (1809), 11 East, 101, Lord Eldon: (107) "That they were to be considered as bargains between the inventors and the public, to be judged of on the principle of keeping good faith, by making a fair disclosure of the invention, and to be construed as other bargains." 1 Abb. P. C. 171 (174).

In *Harmer v. Playne* (1807), 14 Vesey, 130, Lord Eldon: (132) "Where the crown, on behalf of the public, grants letters-patent, the grantee entering into a contract with the crown, the benefit of which contract the public are to have," &c. 1 Abb. P. C. 166 (167).

In *Neilson v. Harford* (1841), 1 Web. 331, Alderson, B.: (341) "Lord Eldon lays down the principle so long ago as 1800. He says patents are to be considered as bargains between the inventor and the public, to be judged of on the principles of good faith, by making a fair disclosure of the invention, and to be construed as other bargains. That is the principle which must be taken to be the sound principle."

² In *Morgan v. Seaward* (1836), 1 Web. 170, Alderson, B.: (173) "It is the duty of a party who takes out a patent to specify what his invention really is, and although it is the bounden duty of a jury to protect him in the fair exer-

cise of his patent right, it is of great importance to the public, and by law it is absolutely necessary, that the patentee should state in his specification, not only the nature of his invention, but how that invention may be carried into effect. . . . That is the fair premium which the patentee pays for the monopoly he receives." 2 Abb. P. C. 262 (318.)

In *Walton v. Potter* (1841), 1 Web. 585, Tindal, C. J.: (595) "The object of the specification is, that it is the price which the party who obtains the patent pays for it," &c.

In *Gibson v. Campbell* (1841), 1 Web. 627, Tindal, C. J.: (629) "The specification . . . is the price that the man who takes out his patent pays to the public. . . . Therefore, every man who is an honest man, is bound to pay that price justly and fairly," &c.

In *Stevens v. Keating* (1847), 2 Web. 181, Pollock, C. B.: (187) "I take the rule to be that you are not to intend anything in favor of a specification or patent, and certainly not to intend anything against it; you are to deal with it just as you find it; you are to put the true and right and fair construction upon every allegation and every fact connected with it, and you are to find what is the true and fair and just result. You are not to lean in favor of the pub-

§ 16. Patent Privilege a Monopoly : Effect of Departure from this Doctrine on Later English Law : Amendments of Patents.

A similar alteration is exhibited in the spirit of the people, as it has been expressed in parliamentary enactments. Notwithstanding the disposition of the judges to construe a patent liberally in favor of the inventor, they had no power, under the statute of James I., to change its terms. However inaccurately it described the real invention, this description was the measure of his privilege, and by his patent, as originally granted, he must stand or fall.¹ Clerical errors might indeed be corrected upon application to the crown.² But a material defect, whether arising from inadvertence or design, could not be remedied ; and as the contract created by the patent was entire and indivisible, such a defect rendered the patent void. Thus if a patentee mistakenly embraced within his privilege anything that was not new, or claimed two or more inventions one of which was not entitled to protection, or attributed to his invention a wider sphere of usefulness than actual experience would justify, the whole patent was invalid.³ In this condition the law remained until

lic against the patent, which, it is to be regretted, was many years ago rather the fashion of courts of justice, under the notion that it was a monopoly, that all monopolies were odious, and that, therefore, you were to intend everything against them ; although, on the other hand, in modern times, it is said the leaning is the other way, I do not think there ought to be any leaning one way or the other."

But in *Feather v. Reg.* (1865), 6 B. & S. 257, Cockburn, C. J., holds that a patent is not truly a contract by the crown with the patentee on valuable consideration, and so entitled to the most liberal construction, but is a prerogative grant upon condition that full publication be made.

§ 16. ¹ Godson : (159) "The patent and specification must, in fact, stand or

fall by themselves ; and no extraneous matter can be introduced to explain them and establish their legality. If they are bad in themselves nothing whatever can make them legal instruments."

² Norman, 107 ; Coryton, 180. *In re Sharp's Patent* (1840), 1 Web. 641.

³ In *Turner v. Winter* (1787), 1 Web. 77, Buller, J. : (82) "If the patentee says that by one process he can produce three things, and he fails in any one, the consideration of his merit, and for which the patent was granted, fails, and the crown has been deceived in the grant. Slight defects in the specification will be sufficient to vacate the patent." 1 Abb. P. C. 43 (50).

In *Bainbridge v. Wigley* (1810), 1 Carp. 270, the patent claimed improvements by which new notes could be sounded on a musical instrument. The

A. D. 1835. In that year Parliament bestowed upon inventors the right to amend the claims and descriptions in their patents, subject only to the limitation that no such amendment should extend the exclusive rights already granted.⁴ The power thus conferred was practically of the most important character. It enabled the patentee, at any time, to disclaim any matter whose presence in his patent would have made it void. It permitted him to change the published description of his invention by adding new words or excluding old. Under this act he might, at the first issue of his patent, claim anything he chose and enjoy its exclusive use, as if it were his own invention, until the public ascertained that he had claimed too much, and then, by this disclaimer, make his patent good. He might communicate his secret in imperfect language, never admitting the public into full possession of the invention unless his patent were attacked on that account, and when attacked might save himself from the consequences of his own ignorance or carelessness, by properly correcting it.⁵ Or if the progress of the art disclosed to him that advantages could be obtained by broadening his privilege, he might by skilful alterations in his claims embrace within

evidence showed that only *one* new note could be produced. *Ellenborough, C. J.*, held the patent void. 1 Abb. P. C. 181.

In *Rex v. Metcalf* (1817), 1 Web. 141 (note *a*), the patent was for making a "tapering" brush. The specification described it as a brush having bristles of unequal lengths. Lord Ellenborough held this patent invalid on account of the discrepancy. 1 Abb. P. C. 297.

In *Campion v. Benyon* (1821), 6 Moore, 71, *Dallas, C. J.*: (81) "If, therefore, there be any ambiguity, either in the patent itself, or in the specification, in any material point, it is of itself a ground for rendering the patent absolutely void." 1 Abb. P. C. 345 (355); see also *Rex v. Arkwright* (1785), 1 Web. 64; 1 Abb. P. C. 29; *Huddart v. Grimshaw* (1803), 1 Web. 85; 1 Abb. P. C. 128; *Bovill v. Moore* (1816), *Dav. P. C.* 361; 1 Abb. P. C. 231; *Hill v. Thomp-*

son (1817), 1 Web. 235; 1 Abb. P. C. 299; *Morgan v. Seaward* (1837), 1 Web. 187; 2 Abb. P. C. 419.

⁴ 5 & 6 Will. IV., chap. 83, § 1, authorizing any person "who as grantee, assignee, or otherwise, hath obtained, or who shall hereafter obtain letters-patent," by leave of certain officials, to enter with the clerk of patents "a memorandum of any alteration in the said title or specification, not being such disclaimer or such alteration as shall extend the exclusive right granted by the said letters-patent," &c.

⁵ A disclaimer may be made after the judgment of a court of law, or the verdict of a jury, adverse to the validity of a patent, in order to preserve the new and useful parts of the invention. *In re Derosne's Patent* (1835), 1 Web. 166 n.; *Morgan v. Seaward* (1838), 2 *Carp.* 104.

them matters which at first he did not ask to have protected, and thus create a patent-right materially different in its effect from that originally bestowed upon him.⁶ Necessary and proper as the law in substance may have been, the age had become so permeated with the spirit of industrial enterprise, and had conceived such exalted ideas of the value of inventive skill, that no sufficient safeguards were thrown around the power thus bestowed, and the inventor, no longer a mere contracting party, whose granted privileges depended on his own fulfilment of his bargain with the public, was raised to a position where he could receive and enjoy his grant without ever giving for it the consideration which the law demands.⁷

⁶ Coryton : (185) "The extent of the alterations in its description gives, as we have seen, a very inadequate idea of the extent of the alteration in the results of a manufacture. The real effect of any alteration in a specification may, therefore, be to create a patent-right materially different from that intended to be conferred by the original letters-patent."

In re Sharp's Patent (1840), 1 Web. 641, the petitioner claimed that by a memorandum of alteration, filed under this statute, the patent of the respondent had been extended to embrace matters not originally protected, and prayed the Master of the Rolls to expunge it as unlawful. Lord Langdale, M. R. refused, on the ground that he had no authority so to do, and said : (643) "You have a plain and easy remedy elsewhere. If the memorandum goes beyond the act, as you say, it is void, and could not be given in evidence or made any use of," — thereby recognizing as valid every memorandum that might be filed, until the same were declared invalid in a court of law. In a note to this case Mr. Webster says : (642, note e) "According to the practice of the law officers of the crown, memoranda of alterations of a very extensive kind have been allowed. . . . The va-

lidity of any memorandum of alteration, when enrolled, is matter of law and of fact, to be decided in the same manner as questions arising on the validity of the original specification." With a disposition to allow "alterations of a very extensive kind" to be filed, and a decision which makes such alterations valid parts of the original specification until a contrary judgment is rendered on a trial of the patent itself, the power conferred upon a patentee by this statute could hardly escape serious abuses.

⁷ Coryton : (178) "A consideration of amendment and disclaimer . . . produces a strong conviction on the mind that the theory proceeded on is false, and the practice, beyond a doubt, highly prejudicial to public interests. Good policy requires that the invention, at the period of the grant, should be complete, and the proceedings connected with it such as to discourage all laxity in the patentee. The very contrary appears to be at the foundation of the practice as at present established, as the terms of the patent privilege, carelessly conceded in the first instance, may, with as little supervision, at any period of their continuance, be varied almost arbitrarily by the patentee."

Lund : (197) "The privilege has been

§ 17. Patent Privilege a Monopoly: Effect of Departure from this Doctrine on later English Law: Validating void Patents.

Parliament did not content itself even with this concession. In another section of the same act it conferred upon the crown the power to confirm and validate patents which had been granted contrary to the express language of the law. According to the statute of James I., a monopoly could be bestowed on no one except the first and true inventor of some manufacture which others, at the date of the letters-patent, did not use.¹ In construing this provision the courts distinguished between a use in secret by which the people could obtain no knowledge of the invention, and a use in public by which such knowledge might have been communicated; and decided that any use of the latter kind, whether by one person or many, would defeat a patent.² This was the law for upwards of two hundred years. But now it was enacted that the patentee, though not the first inventor, and though the actual invention protected by his patent had been used by others before he discovered it, might have his void patent

greatly abused in a large majority of cases, and it has almost become a custom to choose a very distributive title, and to divide or break up the specification into as many minute divisions and heads as possible, with the sole object of enabling the patentee to detach any of these several members whenever he may find it convenient. This very much increases the difficulty of understanding or applying what remains, and a specification drawn up on such a principle can never be that carefully and minutely digested document which will alone stand an argument in a court of law, and protect either the public from imposition or an inventor from the embarrassment and anxiety attendant upon a badly defined right."

§ 17. ¹ Stat. Jac. I., § 6.

² In Dollond's Case (1766), 1 Web. 43, it was held that a prior inventor, confining his discovery to his closet so that the public were not ac-

quainted with it, did not prevent a later inventor and patentee from obtaining a monopoly of the invention. 1 Abb. P. C. 9.

In Tennant's Case (1802), 1 Web. 125, note *c*, Lord Ellenborough, C. J., held that a prior use by five persons, though connected in the same business, was such a use as would defeat a patent. 1 Abb. P. C. 115.

Lund: (69) "Throughout the preceding cases this principle is kept steadily in view: that the private or secret use of an invention, or trials, or experiments, by one person, do not prevent another from obtaining a patent for the same invention; if he be the first to publish the invention (the first who comes to the crown), he is accounted the first inventor. This was distinctly laid down in the early case of Dollond's Patent and has since been invariably followed."

made good against all persons whatsoever, including the original inventor, on proof that at the date of his patent he believed himself the first inventor, and that the thing invented had not then been publicly and generally used.³

§ 18. Patent Privilege a Monopoly : Effect of Departure from this Doctrine on later English Law : Extending Patents.

Nor did the liberality of Parliament stop here. The statute of James I. had limited the period of the inventor's privilege to fourteen years. This period had always been considered long enough to enable any patentee, who used due diligence in bringing his invention to the knowledge of the public, to gain an ample recompense for the cost and labor of inventing it. But such was the appreciation in which these modern

³ 5 & 6 Will. IV., chap. 83, § 2. This statute provides that if, in any action, it be found that the patentee was not the first inventor of the supposed invention "by reason of some other person or persons having invented or used the same or some part thereof, before the date of such letters-patent;" or, if the patentee discovers that some other person had, unknown to him, "invented or used the same or some part thereof before the date of such letters-patent," he may apply to the king in council to confirm his patent; and upon hearing before the judicial committee of the privy council, if such committee are "satisfied that such patentee believed himself to be the first and original inventor," and are "satisfied that such invention or part thereof, had not been publicly and generally used before the date of such first letters-patent," may report to the king, and the king may grant the application, and the said patentee shall then have "the sole right of using, making, and vending such invention as against all persons whatsoever, any law, usage, or custom to the contrary thereof notwithstanding."

In re Stead's Patent (1846), 2 Web.

143, Lushington, J. : (146) "We apprehend that this section must necessarily be construed to confer the power of giving to the patentee that which he did not possess before the passing of the statute, or, in other words, of curing that which, before the statute, would have constituted an invalidity. If the patent were valid by the law as it existed before the passing of the statute, it could hardly be necessary to confirm it. The case to be remedied was not that of a patentee discovering a prior invention, wholly unused and wholly unknown up to the date of the letters-patent, but it was applicable to the case of a patentee discovering a prior invention so known that the patent might be invalidated on that ground, though not publicly and generally used."

In re Horniball's Patent (1855), 2 Web. 201, Leigh, J. : (210) "It is not very easy to define what is the exact meaning of the expression 'publicly and generally used,' . . . but certainly we cannot consider the use of the invention on board a single ship, however public or for whatever length of time, as a general use."

lawgivers held the services of the inventor that power was now conferred upon the crown to continue his monopoly for an additional period of seven years, and this was increased in A. D. 1844 to fourteen years.¹

§ 19. Patent Privilege a Monopoly: Effect of Departure from this Doctrine upon Patentee and Public under later English Law.

The change which these three statutory concessions wrought in the position of the patentee was very great. His patent, which once accurately and permanently defined the boundary between his rights and those of the public, had now become an elastic instrument which, by disclaimer or amendment, might be adapted to his varying fortunes in the courts and to the requirements of advancing art. To have been the first applicant for letters-patent constituted the basis of his privilege rather than to have been the first inventor, or even to have first brought the invention into actual use. Instead of being now, as formerly, compelled to push his new manufacture into public notice with energy and promptness in order to make sure of his reward, it became possible for him to secure additional periods of protection, in some cases even doubling the monopoly originally granted to him for making and disclosing his invention. Each one of these statutory concessions was a direct limitation of the public right. Each was a bestowal on the inventor of important powers never embraced in any grant of a monopoly under the statute of James I. and never contemplated by the common law. Neither of them could have been allowed by Parliament, nor would the attempt to grant them have been tolerated by the people, had not the theory of the nature of a patent privilege, and of the reciprocal relations of the inventor and the public, been very different from that which had prevailed two centuries before.

§ 18. ¹ 5 & 6 Will. IV., chap. 83, § 4; 7 & 8 Vict., chap. 69.

§ 20. Patent Privilege a Monopoly: Effect of Departure from this Doctrine on the American Courts: Contract Theory: Reward Theory.

In this country that extreme jealousy of the inventor's privilege, which characterized the earlier English judges, never has been manifested. Our courts did not approach this subject until after the ancient doctrines had been widely modified in favor of the patentee, and the true interest of the public had been recognized as best promoted by securing to him an immediate and liberal reward. In the earliest case in which those questions were considered at any length (A. D. 1831), the court adopted these three fundamental principles, which have been followed in all subsequent decisions: (1) That a patent creates a contract between the inventor and the public, and that each party is bound to exercise good faith toward the other; (2) That a patent is not granted to the inventor as a favor, but is a matter of right on his compliance with the conditions prescribed by law; (3) That being intended for his benefit, both the patent and the law are to be construed in favor of the patentee.¹ The progressive spirit

§ 20. ¹ In *Whitney v. Emmett* (1831), Baldwin, 303, Baldwin, J.: (319) "A patent is a bargain with the public, in which the same rules of good faith prevail as in other contracts. . . . (318) In England a patent is granted as a favor on such terms as the King thinks proper to impose; here a patent is a matter of right, on complying with the conditions prescribed by the law. . . . (322) Intended for their protection and security, the law should be construed favorably and benignly in favor of patentees in the spirit of the proviso in patents in England." 1 Robb, 567 (589, 587, 593).

In *Ames v. Howard* (1833), 1 Sumner, 482, Story, J.: (485) "Patents for inventions are not to be treated as mere monopolies, odious in the eyes of the law, and therefore not to be favored; nor are they to be construed with the utmost rigor, as *strictissimi juris*. The

Constitution of the United States, in giving authority to Congress to grant such patents for a limited period, declares the object to be to promote the progress of science and useful arts; an object as truly national and meritorious and well-founded in public policy as any which can possibly be within the scope of national protection. Hence it has always been the course of the American courts (and it has latterly become that of the English courts also) to construe these patents fairly and liberally, and not to subject them to any over-nice and critical refinements." 1 Robb, 689 (692).

In *Blanchard v. Sprague* (1839), 3 Sumner, 535, Story, J.: (539) "Formerly, in England, courts of law were disposed to indulge in a very close and strict construction of the specifications accompanying patents and expressing the nature and extent of the inven-

of this court appears in the further doctrine then announced : that the grant of an exclusive privilege to the inventor is intended to advance the interest of the public, not by securing to it the knowledge and the use of that particular invention, but by rewarding the inventor and thus stimulating him as well as others to new efforts,² — a doctrine which, if pushed to its legitimate conclusions, would justify the legislative grant of any privilege however extensive in scope or in duration, and which seems to have influenced the language, if not the ideas, of many later judges in their interpretation of the powers and remedies bestowed by Congress on the patentee.³

tions. This construction seems to have been adopted upon the notion that patent-rights were in the nature of monopolies, and, therefore, were to be narrowly watched, and construed with a rigid adherence to their terms, as being in derogation of the general rights of the community. At present, a far more liberal and expanded view of the subject is taken. Patents for inventions are now treated as a just reward to ingenious men, and as highly beneficial to the public, not only by holding out suitable encouragements to genius and talents and enterprise, but as ultimately securing to the whole community great advantages from the free communication of secrets and processes and machinery, which may be most important to all the great interests of society, — to agriculture, to commerce, and to manufactures, as well as to the cause of science and art. In America this liberal view of the subject has always been taken, and indeed it is a natural, if not a necessary result from the very language and intent of the power given to Congress by the Constitution on this subject. Congress (says the Constitution) shall have power to promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right of their respective

writings and discoveries. Patents, then, are clearly entitled to a liberal construction, since they are not granted as restrictions upon the rights of the community, but are granted to promote science and useful arts." 1 Robb, 734 (739).

² In *Whitney v. Emmett* (1831), Baldwin, 303, Baldwin, J. : (321) "With the Constitution, the English Statute, and the adjudication upon it before them, Congress have declared the intention of the law to be to promote the progress of the useful arts by the benefits granted to inventors, not by those accruing to the public after the patent had expired, as in England." 1 Robb, 567 (591).

³ In *Brooks v. Jenkins* (1844), 3 McLean, 432, McLean, J. : (437) "When we consider the inestimable advantages which result to the world from the labor, ingenuity, and expense of inventors, so far from classing them with monopolizers, they should be regarded as public benefactors. And in order to secure to them the remuneration, which the law provides, a liberal construction should be given to it."

See also *Parker v. Haworth* (1848), 4 McLean, 370 ; 2 Robb, 725 ; *Bloomer v. Stolly* (1850), 5 McLean, 158 ; *Allen v. Hunter* (1855), 6 McLean, 303.

§ 21. Patent Privilege a Monopoly: Effect of Departure from this Doctrine on the American Courts: Amending Patents: Damages and Profits.

The opinion that a defective patent is amendable was also first authoritatively expressed in the courts of the United States. In A. D. 1832 it was decided that the practice of correcting such defects is within the spirit and intention of the general law which authorizes the granting of a patent, and is necessary to secure to the inventor that full compensation which it is the interest of the public to bestow upon him.¹ The subsequent act of Congress establishing this practice has been construed with even greater liberality, — the court in one case holding that in his amended patent the inventor may

The distinction taken by the learned judge in this early case of *Whitney v. Emmett* seems to serve almost as a line of demarcation between the two great classes into which the later authorities may be divided. That the purpose of the patent law is to benefit the inventor is one principle. That the purpose of the law is to secure to the public the advantages of the invention, by compensating the inventor for its disclosure, is an entirely different principle. Some decisions of the courts are evidently controlled by the first principle; others are as evidently delivered under the inspiration of the second. By remembering this, many seeming diversities in the opinions of the judges may be accounted for and reconciled; and in reading and collating these opinions it is essential that the lawyer or the writer should be on his guard and not be misled by the language of the court into a doubt as to the soundness of its doctrine.

The influence of the idea that the benefit of the inventor is the object sought by the law also manifests itself in the extreme importance given by our present rules to priority of invention as distinguished from priority of

publication, in the facility with which reissues and extensions have been granted, and in the extravagant compensation often awarded by the courts to patentees whose exclusive rights have been infringed.

§ 21. ¹ In *Grant v. Raymond* (1832), 6 Pet. 218, Marshall, C. J. : (243) "It has been said that this permission to issue a new patent on a reformed specification, when the first was defective through the mistake of the patentee, would change the whole character of the Act of Congress. We are not convinced of this. The great object and intention of the act is to secure to the public the advantages to be derived from the discoveries of individuals; and the means it employs are the compensation made to those individuals, for the time and labor devoted to these discoveries, by the exclusive right to make, use, and sell the things discovered for a limited time. That which gives complete effect to this object and intention by employing the same means for the correction of inadvertent error, which are directed in the first instance, cannot, we think, be a departure from the spirit and character of the act." 1 Robb, 604 (635).

include not only what was well described before, but whatever else was suggested, either in the first patent or in the specification, drawings, or model by which it was accompanied.² In reference to the damages to be recovered in an action for infringement, the courts have been equally solicitous for the interests of the patentee, allowing him, as compensation for the injuries he has sustained, not only all he might have realized from his invention, if undisturbed, but all that the superior industry or capital of the infringer have enabled him to save or make by using the invention.³

§ 22. Patent Privilege a Monopoly: Effect of Departure from this Doctrine on American Legislation: Amending Patents: Extensions.

The legislative bodies whose attention has been directed to this subject have exhibited a still more marked regard for the welfare of the patentee. The Constitution of the United

² In *Seymour v. Osborne* (1870), 11 Wall. 516, Clifford, J. : (544) "Power is unquestionably conferred upon the Commissioner to allow the specification to be amended if the patent is inoperative or invalid, and in that event to issue the patent in proper form ; and he may doubtless, under that authority, allow the patentee to redescribe his invention and to include in the description and claims of the patent not only what was well described before, but whatever else was suggested, or substantially indicated in the specification or drawings, which properly belonged to the invention as actually made and perfected."

³ In *Mowry v. Whitney* (1871), 14 Wall. 620, Strong, J. : (651) "The question to be determined in this case is what advantage did the defendant derive from using the complainant's invention over what he had in using other processes then open to the public and adequate to enable him to obtain an equally beneficial result ? The fruits of that advantage are his profits."

In *Mers v. Conover* (1876), 11 O. G. 1111, Strong, J. : (1112) "In the ascertainment of profits made by an infringer of a patented invention, the rule is a plain one. The profits are not all he made in the business in which he used the invention, but they are the worth of the advantage he obtained by such use ; or, in other words, they are the fruits of that advantage. . . . It is urged, however, that the Green machine, in which the defendant used the plaintiff's invention, was old and defective, and that no profits were actually received from such an use. But if such be the fact, if the defendant was a loser by splitting wood with the Green machine, his loss was less, to the extent of seventy-five cents on each cord split, than it would have been had he not used the patented invention. Such a result was equivalent to an equal gain, and it was rightly estimated as a part of the profits for which the infringer was responsible."

States declares that the progress of science and art is promoted by securing to inventors these exclusive privileges, and empowers Congress to enact such laws as will carry this idea into practical effect.¹ In the discharge of this duty, Congress conferred upon inventors the right to an exclusive privilege in such inventions as were not known or used *before their alleged discovery by the patentee*,—a right of far greater practical value than that conferred by the statute of James I., which permitted grants of the exclusive privilege only for inventions not known or used *at the date of the grant*.² It also provided for the surrender of an invalid or inoperative patent, and the issue of a new one based on a restricted or enlarged description; by which proceeding a patentee could claim and protect matters that were unclaimed and unprotected by his original patent.³ In A. D. 1836 it established a system by which the trouble and expense of obtaining patents were reduced to the lowest possible degree, and the security of the inventor against the subsequent loss of his privilege by

§ 22. ¹ Const. U.S. Art. 1, § 8: "Congress shall have power . . . to promote the progress of science and useful arts by securing, for limited times, to authors and inventors the exclusive right to their respective writings and discoveries."

² Phillips: (169) "But there is a material difference in the effect of an oral publication, in England or France and the United States, where the invention has been reduced to practice in consequence of such a publication; for, as we have seen, in England and France, the novelty of the discovery is tested in reference to the date of the patent, whereas in the United States it is tested in reference to the date of the discovery. We perceive how prejudicial the rule, adopted in England and France, must be to the interests of the inventor, and to the beneficial operation of the patent law, by depriving the inventor of all the advantage of communication with others on the subject of his invention previous to taking out his patent; for if he

so makes it known, it may give others an opportunity to defeat his patent by piracy."

In *Cornish v. Keene* (1835), 1 Web. 501, Tindal, C. J.: (508) "If this (invention) was, at the time these letters-patent were granted, in any degree of general use, . . . then the letters-patent are void." 2 Abb. P. C. 139 (171).

The act of 1790, § 1, provided that a patent might issue for an invention "not before known or used." The act of 1793, § 1, prescribes that the invention must not have been "known or used before the application" for a patent. In the act of 1836, § 7, it was made the duty of the Commissioner to issue a patent if upon examination it did not appear that the invention had been known or used "prior to the alleged invention or discovery thereof by the applicant." See also Curtis, §§ 83, 84.

³ Act of 1832, § 3.

an adverse decision in the courts was rendered almost impregnable.⁴ In A. D. 1837 it gave to any person interested in a patent, which was void by reason of excessive claim, permission to cure the difficulty, as far as his interest in the patent was concerned, by simply filing in the Patent Office a written disclaimer of the excess.⁵ In A. D. 1839 it bestowed upon the inventor the further privilege of using his invention for two years before applying for a patent.⁶ It also freely exercised its powers in granting to patentees an extension of the period of their monopoly, at first by special acts and later under general laws, until the act of 1861 which prohibited extensions and increased the ordinary period to seventeen years.⁷ Thus although, at the outset, our patent laws were in some most important aspects more favorable to the inventor than those of England, the development of the theory that an inventor is necessarily a public benefactor, and that the means adopted for his protection and encouragement are in themselves promotive of the public good, has here as well as there produced its legitimate results in the constant increase of his exclusive privileges and the corresponding limitation of the public rights.

§ 23. Patent Privilege a Monopoly: Necessity for a Permanent and Correct Doctrine on this Point.

Experience having thus demonstrated that the dividing line, as drawn by courts and legislatures, between the rights of the inventor and the public is determined by the current theory concerning the nature of a patent privilege, it is evidently a matter of the first importance that this theory should be correct, and that once having been adopted it should always be consistently maintained.¹ Continual concessions to the pat-

⁴ Act of 1836, § 7. But see § 50, note 2, *post*.

⁵ Act of 1837, § 7.

⁶ Act of 1839, § 7.

⁷ Act of 1836, § 18; act of 1861, § 16.

§ 23. ¹ Not merely the importance but the absolute necessity of a correct theory upon this subject is demonstrated

by the remarkable changes in the attitude of our courts toward patentees during the past few years. From an extreme liberality, in which the rights of the public were too often disregarded, a tendency to an equally extreme strictness has been manifested, particularly in reference to the doctrines governing reissue and abandonment. Under the

entee are as unjust, and ultimately as disastrous, as continual restrictions of his powers; for they constantly give rise to new grounds of litigation, and are sure to produce, at some time, a reaction in public sentiment under whose impulse the entire system of exclusive privileges may disappear. That the correct theory can be ascertained by examining the relations of the inventor and the public to the invention both before and after the patent privilege is granted, and discovering what the grant has taken from the one and given to the other, cannot be disputed. Such an investigation will disclose not only that a patent privilege is a true monopoly, but that it approaches very nearly to an odious monopoly in its restriction of the pre-existing public right.

§ 24. Patent Privilege a Monopoly: Rights of Inventor under Natural Law.

In pursuing this investigation the relations of an inventor and the public to an unpatented invention first demand attention. In its earliest stage this invention is a mere addition to the stock of ideas possessed by the inventor. He has imagined or discovered something which to himself, and presumably to all the world, is new, and has conceived a method by which his idea may be so applied as to produce a tangible and valuable result. In this stage he has a natural exclusive right to his invention. No one can compel him to disclose his secret. He may reduce it to actual practice, or preserve it as a matter of subjective contemplation. The law can take no other notice of it than it does of his moral sentiments or his personal recollections. If, however, he endeavors to avail himself of this idea in his exterior life, his position in regard to it is somewhat changed. The material forms in which he then embodies it are his, but the idea itself is not to be imprisoned within their narrow bounds. Every one who examines and can understand them immediately conceives the same idea, whether he will or not, and thencefor-

influence of this tendency fundamental legal recognition, have been brought in principles, bottomed in the unchange- question, and uncertainty introduced able relations of an inventor to his into some of the most stable and essen- invention, and sanctioned by uniform tial provisions of the law.

ward that idea remains as much a part of the observer's fund of knowledge as it ever was of that of the inventor. In order, therefore, to retain exclusive ownership of his idea, he must withhold its material embodiment from observation; and as long as he can do this, the invention is as truly his by natural right as if it never had been thus externally expressed.¹ But with his submission of the tangible result of his idea to the inspection of others, in such a manner that the idea itself becomes apparent, his control over it is gone. An idea once communicated can no longer be exclusively appropriated and enjoyed. Every one who receives it possesses it in the same degree as if he alone had apprehended it, and its inventor has no power to restrain him from its practical and useful application. Under the laws of nature the exclusive public use of an invention is thus impossible, and hence there is no natural right to such a use. The inventor, who voluntarily discloses his invention to the public, necessarily and freely dedicates it to the public; and that which formerly was his alone by virtue of his sole possession becomes by universal possession the common property of all mankind.²

§ 24. ¹ Curtis : (xx) "Whether we regard the knowledge, remaining for the present in the exclusive control of him whose intellectual production it is, as property, or as a possession of ideas, to which some other term might be more appropriate, it is still a possession, of which the owner cannot by any rule of natural justice be deprived without his consent. In this view it may, as it seems to me, justly be termed property."

² Coryton : (45) "So far as natural right is concerned, the application of a law of nature, a philosophical or abstract principle, is capable of exclusive appropriation only so long as the secret of such application is within the inventor's breast. Once passed, it becomes the property of all mankind."

Norman : (2) "Independently of an express restriction by the sovereign authority in a state, there is no such

thing as exclusive property in an invention. The subject-matters of human inquiry are free to all men. An addition once made to the stock of knowledge is common property forever, nor is it less the property of the discoverer because others possess it as well as himself. It is in its nature infinite and incapable of appropriation. The first builder of a house could claim as his own the substantial and tangible materials, the logs and wood of which he constructed it; but the idea of such an erection became instantly the property of all mankind. The abstract natural right of the inventor is only to exercise his own invention freely."

In *The Attorney-General ex rel. Hecker v. The Rumford Chemical Works* (1876), 9 O. G. 1062, Shepley, J. : (1064)

"So long as such writings and discoveries were not communicated to the public, authors and inventors had a possession

§ 25. Patent Privilege a Monopoly: Rights of Public under Natural Law.

The natural right of the public to appropriate all new ideas that may be voluntarily disclosed is no less evident than that of the inventor to conceal them.¹ It is a law of nature that men should profit by the discoveries and inventions of each other. This is the law which binds society together, and in obedience to which lies all the possibility of moral, intellectual, and material advancement. No man lives, or can live, for himself alone. Every improvement he can make in his appearance, habits, manners, or affairs becomes a guide and stimulus to others, by following which they also can improve themselves in person or estate. To benefit by the discoveries of his fellow-men is thus not only a natural right, it is also the natural duty which every man owes to himself and to society; and the mutual, universal progress thence resulting is the fulfilment of the earthly destiny of the human race.² It is by virtue of this natural right, and in pursuance of this natural duty, that the public receive

of, which was equivalent to a property in, their writings and discoveries. When communicated to the public, by the common law that property was lost."

§ 25. ¹ In *Jordan v. Overseers* (1831), 4 Ham. 294, Lane, J.: (309) "Although the inventor had, at all times, the right to enjoy the fruits of his own ingenuity, in every lawful form of which its use was susceptible, yet, before the enactment of the statute, he had not the power of preventing others from participating in that enjoyment, to the same extent with himself; so that however the world might derive benefit from his labours, no profits ensued to himself."

² Perhaps no recognition of this inherent public right is clearer and more positive than that contained in the very law by which the patent privilege is created. It has always been a fundamental doctrine of that law that if the public once became possessed of the inventor's secret their right to use it could

never thereafter be restrained. What should amount to such possession has, it is true, at different times been differently determined. In the earlier English cases it was held that any knowledge of the invention by the public before the granting of the patent vested it inalienably in them. *Wood v. Zimmer* (1815), 1 Web. 44, note; *Cornish v. Keene* (1835), 1 Web. 501. Modern legislation in the United States, on the other hand, permits the inventor to publicly use and sell his invention for two years before applying for a patent without thereby delivering it into their possession. But the principle remains the same, and in every aspect of it is enforced by the courts, that whenever the inventor permits the invention to pass beyond the legally defined limits of his exclusive possession, his right to it ceases and the right of all mankind to it begins. See also Phillips, 422; Curtis, §§ 101, 102.

and profit by the ideas of the inventor, as he, in turn, receives and profits by the ideas of others, each being recompensed for his private contribution to the general good by that which he appropriates to his own use out of the vast fund of human knowledge which has been formed by the continuous contributions of all races and all ages since the world began. This natural right and duty of the public come into existence where the natural right of the inventor ends, the same act which determines his exclusive possession and control delivering the invention to the universal knowledge and service of mankind.

§ 26. Patent Privilege a Monopoly : Restricts the Natural Right of the Public to use the Invention when disclosed.

Into the midst of this harmonious system of mutual rights and duties the patent privilege intrudes itself as a disturbing element. It obliterates the dividing line, drawn by the law of nature, between the relations of the inventor and the public to the new invention. It establishes an arbitrary line, based on no fixed principle, suggested by no natural analogy, and shifting toward or from the true line according to the changing theories of successive generations. It temporarily deprives the human race of its right to profit by the labors and discoveries of the individual, except upon such terms as he may see fit to impose. It locks up, under the control of the inventor, the physical fact or law which he applies, and gives him as complete dominion over it as if he and not Almighty God were its creator, and as if his advantage and not that of mankind in general were the object for which this attribute or element itself was made.¹ Regarded, therefore, in its sim-

§ 26. ¹ Many erroneous ideas, concerning the rights of inventors and the benefits conferred by them upon the public, seem to result from a failure to discriminate between different classes of inventors, as well as between the relations which authors and inventors occupy toward their respective writings and discoveries. Some jurists regard authors and inventors as having the

same rights to their various productions. Thus Curtis : (xix) "Inventors, in this respect, stand upon the same broad ground with authors. Both of these classes of persons have created something intellectual in its nature, &c." To the same effect are *dicta* of the judges scattered through the various reports. Other jurists, on the contrary, consider authors and inventors as occu-

plest and most abstract form, the patent privilege is a true restriction of pre-existing public rights. It may not, and or-

pying totally different positions. Thus Hindmarch, *Def. Pat. Laws, &c.* : (23) "A work of the imagination whether in literature or the fine arts, such as a poem, a piece of music, a painting, or a piece of sculpture, is actually created by its author, and he gives to the world that which in all probability never would be produced by any other mind. But he who invents a new practical manufacturing art, although the art may be of greater utility than any product of the imagination, does but find out that which had previous existence in the same way as travellers discover new countries or places. Inventions in the useful arts are based upon physical laws, which are immutable ; every investigation of those laws, in any given direction, must end in the same result ; and the consequence is that it frequently happens that several persons unknown to each other make almost precisely the same invention. . . . The merit of an inventor, which entitles him to the consideration of the public, in truth consists in his being the first to *communicate* a knowledge of the art, which he has discovered, to the public, and his merit with the public is the same whether any one has before *secretly* discovered the same art or not ; but he no more creates that art than Sir Isaac Newton did the law of gravitation, which he discovered."

Neither of these assertions is entirely correct. The habit among American writers of classing authors with inventors has probably arisen from the fact that the Constitution of the United States mentions them in the same clause, as alike entitled to protection. But their exclusive privileges rest, historically as well as theoretically, upon different foundations. The common law, as we have seen, never recognized any

exclusive right in the inventor to his invention, after he had once publicly disclosed it. His privilege was based on a royal grant, which was justified only on the ground of the benefit accruing to the public from such disclosure. The property of an author in his writings, on the other hand, was acknowledged as existing at common law even after his voluntary publication of them (*Millar v. Taylor* (1769), 4 Burr. 2303) ; and though this natural right has been merged into that defined and limited by the statute 8 Anne, chap. 19, § 1 (1710), (*Becket v. Donaldsons*, 4 Burr. 2408), which is the foundation of our modern copyright law, its origin and nature are entirely different from that which left the inventor dependent on the bounty of the sovereign for whatever protection his invention might receive.

The character of the exclusive privileges secured to authors and inventors by existing laws is also widely different. His copyright vests in the author no exclusive right to his ideas, apart from the language in which they are expressed, and any other writer may create them or adopt them, and clothe them in his own words, at his pleasure. But the exclusive privilege of the inventor extends to the idea which is embodied in his invention as well as to the form in which that idea is presented to the eye, and no other person is permitted to conceive and use or copy that idea in any mechanism or production of his own.

But notwithstanding these historical and legal diversities, the distinction between authors and inventors is not as great or as well-defined as Mr. Hindmarch has asserted. It is not true that every author is a creator as distinguished from a discoverer, nor that every inventor is a discoverer as distinguished from a creator. In fact, there are two

dinarily it does not, take away from the people the actual enjoyment of any benefit which they already had in their

classes of authors ; one which creates ideas as well as represents them; the other which collects ideas or facts already in existence and whose method of presenting them alone is new. To the first class belong the real authors, properly so called, — the pioneers in poetry, romance, and philosophy, and those who in succession have substantially added to, or developed the primeval thought. To the latter class belong the compilers, abridgers, and all others who bring nothing of their own into their works except their mode of selection, expression, and arrangement. In the same way there are also two classes of inventors : one which grasps at laws or facts in nature hitherto uncomprehended or unknown, and by applying them to practical uses, opens new fields of activity to the industrial arts ; the other which, on these fundamental inventions, builds its humble superstructures, by the combination, rearrangement, or new application of the facts or elements or principles which the great inventors have made known. To rank these two together as equal in accomplishment and merit is unwarrantable. The great inventor is no less a creator than the great author ; and the idea by which he links the physical law or fact to its accomplished object in the arts, that idea which is embodied in his actual invention, is as truly his creation as the nebular hypothesis was the creation of Laplace, or "Samson Agonistes" that of Milton. These are the inventors who deserve the name, the honors, and the rewards of public benefactors. They confer upon mankind, not only during their own generation, but for all time, benefits which, without them, might have never been enjoyed. But the second class of authors and inventors are entitled to no

such encomiums and to no such rewards. They achieve nothing which other men of ordinary ability and skill could not perform, and give nothing to the world that some one else would not be sure to give, as soon as the necessity for it was realized and the attention of the artisan or chemist turned in that direction.

With these differences in view it is evident that authors and inventors can neither be classed together nor entirely separated from each other ; and it is also evident that neither the existing copyright nor patent laws give to these different classes of authors and inventors a protection commensurate with their respective merits. The copyright law apparently ignores the existence of the first class of authors, as a distinct and more meritorious class, and gives to them no higher protection than it accords to the mere echoer of their original ideas. The patent law, on the other hand, secures to the first class of inventors an adequate recompense, in kind if not in duration, but bestows the same reward upon inventors of the second class, no matter how small may be the intellectual value of their achievements. The practical difficulties attending any attempt to measure recompense by merit, in either case, may be insurmountable. But there is no occasion for rendering the questions involved in the conflicting claims of inventors and the public any more obscure by putting all classes of inventors on the same level with the first class of authors, as has sometimes been done, or by denying to the first class of inventors the same degree of intellectual merit and accomplishment which is justly attributed to the highest class of writers. Patent law ought to rest on its own theories and antecedents, and deal with its own problems accord-

possession, but it does prohibit their immediate exercise of that perpetual and natural right by virtue of which every new discovery, when openly practised or proclaimed, becomes at once the possession and the property of all.

§ 27. Patent Privilege a Monopoly: Restricts the Natural Right of the Public in favor of a Limited Class of Inventors.

The extent to which the patent privilege invades these natural rights and duties appears still more clearly on considering the fact that such privileges are granted only to a very small class of inventors. In some degree probably every sane person of mature age is an inventor. By accident or by the efforts of his genius he discovers something new in one or more of the innumerable departments of human affairs, by which his own condition, as well as that of other men, is substantially improved. Not only the scholar in his closet, the explorer in the ocean or the wilderness, and the artisan in his work-shop, but every other man whose faculties are occupied with any form of labor, or with any kind of rational amusement, makes some addition to the common stock of useful knowledge, and aids in the advancement of his race. If each of these were privileged to appropriate to himself, for the time being, the entire advantage of his own discovery, the relation of the individual inventor to the whole body of inventors would correspond more closely with the principles of natural justice. But, on the contrary, the field of patentable invention is comparatively narrow.¹ By far the greater and the most useful portion of human discoveries lie outside the domain of these exclusive privileges. The general phenom-

ing to its own principles, without being led astray, either in its enactments or interpretations, by false analogies or by attempts to follow systems which, in nature as well as origin, are unlike its own.

§ 27. ¹ Under the statute of James I. a patent privilege is grantable only to protect a "new manner of manufacture." The courts interpreted this phrase as including: (1) New substances or compo-

sitions of substances; (2) new mechanisms or combinations of mechanisms; (3) new methods or processes of operating, whereby substantial or mechanical results were produced. *Boulton v. Bull* (1795), 2 H. Bl. 463 (492). Under the acts of Congress only an art, machine, manufacture, composition of matter, or design, or some improvement therein, can be thus privileged.

ena and laws of matter, the methods of agriculture and commerce, the metaphysical and moral truths, and all other inventions which do not relate to the industrial arts, belong at once, upon their publication, to all mankind. Of every one of these the privileged inventor may avail himself as freely as their first discoverer. But because his invention chances to fall within the protected field he can enjoy it in its full extent, and yet withhold it from the general fund of knowledge. He can do even more. He can select from the discoveries of others some truth which lies beyond the privileged domain, bring it within the privilege by devising a method for its application in the arts, and then appropriate the whole to his exclusive use. He can thus embody in tangible materials the results of the long years of research of the engineer, the chemist, or the electrician, and then forbid even these pioneers of science to employ in their own service the laws and facts which they themselves made known.² The whole world of activity is in this manner laid at the inventor's feet. Not only is the natural right of the public to benefit by every new discovery devested in his favor, but the natural right of every discoverer to enjoy the fruit of his own genius or good fortune, in common with the public, may be also lost as soon as the inventor has contrived the means of putting it to practical employment.

² While it is true that no physical law or fact, merely as such, can be exclusively appropriated by any person, even with the aid of the patent privilege, yet if there be but one method by which that law or fact can be practically applied to useful purposes, the person who discovers and patents that one method thereby obtains complete control over the uses of such fact or law. In this manner the discovery of any scientist, if published to the world, may be brought into actual employment in the arts by some other person, under

such circumstances as entirely to deprive the original discoverer of the right to apply it to any use whatever. Thus in the case of Neilson's Patent (1829), 1 Web. 273, if another than Neilson had discovered that smelting-furnaces driven by hot blast were more profitable than those driven by cold, and Neilson's method of employing the hot blast were the only practicable one, his patent would have excluded the very person who discovered the utility of the hot blast from availing himself, in any way, of his own discovery.

§ 28. Patent Privilege a Monopoly: Restricts the Natural Right of the Public to Discover and Employ the same Invention.

But the limitations created by the patent privilege extend to deeper and more fundamental rights than these. Every man has the natural right to discover for himself, and to apply to his own uses, any physical fact or law. That another may have already discovered the same law or fact, and the same method of its application, in no manner abridges this inherent right.¹ To all men the entire universe of truth is open, and no one can infringe upon another's rights therein unless by fraud or force he obtains possession of some secret which that other has alone discerned. This natural right is an essential and invaluable one. The indomitable activity of the human mind, directed by the pressure of exterior necessities to the subjugation of the material world, inevitably and constantly results in new discoveries and in their adaptation to the satisfaction of its wants. The maintenance of life as well as the development of character and civilization has always been, and always must be, dependent on the untrammelled exercise of these inventive powers; and no man can totally relinquish or be hindered from their use without losing his proper place among the thinkers and workers of his age, and being degraded to the condition of a pauper or a slave. Against this onward rushing tide of inventive energy the patent privilege arrays itself. To one who has conceived and practically applied a new idea it gives the power, not only to prohibit other men from copying after him, but from inventing and applying the same idea for themselves. It rec-

§ 28. ¹ In *Am. H. & L. S. & D. Mach. Co. v. Am. T. & M. Co.* (1870), 4 Fisher, 284, Shepley, J. (294): "An inventor has no right to his invention at common law. He has no right of property in it originally. . . . If to-day you should invent an art, a process, or a machine, you have no right at common law, nor any absolute natural right, to hold that for seven, ten, fourteen, or any given number of years, against one

who should invent it to-morrow, without any knowledge of your invention, and thus cut me and everybody else off from the right to do to-morrow what you have done to-day. There is no absolute right, or natural right at common law, that I, being the original and first inventor to-day, have to prevent you and everybody else from inventing and using to-morrow or next day the same thing." Holmes, 503 (509).

ognizes no difference between the piracy of an invention by the wilful injurer and its entirely independent generation by a true inventor. It so appropriates to one a truth originally free to all, that no other has any longer the right to know it, for any practical and useful purpose, until the patent privilege expires.² Every new patent thus closes up another avenue of research against all the world, thwarts the endeavors of the human mind in that direction, and to benefit one individual deprives all others of the right to profit in the same way by their own inventive powers.

§ 29. Patent Privilege a Monopoly: Restricts the Natural Rights of Simultaneous Inventors.

It is no answer to this thought to say that the privileged inventor is generally the sole inventor, and that but for him the idea and its application would remain unknown. The contrary is true. With very few exceptions, every invention is the result of the inventive genius of the age, working under the demand of its immediate wants, rather than the product of the individual mind. The inventors who have stepped forward into the outer darkness, and inaugurated a new era in the industrial progress of mankind, are probably less in number than the centuries of human history. The vast majority of inventions consist of slight advances in existing arts, and lie within the scope of the activities of many of the laborers in the common field. The one who first, through his superior abilities or more fortunate surroundings, attains the goal, only does that which many others, without aid from him, would very soon accomplish as effectually as he; and

² Lund : (4) "Supposing the originator of an idea also provides a mode or way of usefully applying it; or even suppose he usefully applies an idea or thought suggested by another person, or one long and well known but not as yet usefully applied: in either of these cases he will be entitled to forbid all other similar applications of the idea to the same object or purpose; although the utility which he produces is comparatively trifling, and the forbidden appli-

cation is admitted to be a great improvement upon the subject-matter of patent."

In *Andrews v. Carman* (1876), 9 O. G. 1011, Benedict, J.: (1013) "The idea when made available by a method, whereby it is put to practical use, is patentable as a process, and is thus secured to the person who has conceived the idea and invented the method." 13 Blatch. 307 (312); 2 Bann. & A. 277 (282).

the true measure of his merit is, therefore, not the value of his actual discovery, but the value of his temporary precedence of them.¹ Quite often also is the same discovery simultaneously made by several inventors. Men of the same genius, recognizing the same wants, skilled in the same arts, and familiar with the same defects in present methods of supply, might naturally be expected to arrive, at nearly the same time, at the same means of answering the public need; and experience amply justifies this expectation.² But with the granting of a patent privilege to any one of these inventors, the discoveries of the others, whether simultaneous or successive, become useless. Their patient research, their earnest meditation, their unwearied struggles are now all in vain. The patent privilege appropriates to the patentee the whole discovery, deprives them of the right to use the results they have themselves attained, and by rewarding him for his mere priority of publication or invention defeats the hopes and efforts of the rest.³

§ 29. ¹ Coryton: (16, 17) "The extension of the condemnation of monopolies of trades and articles in common use to that of patents, is based on the restraints upon the public during the continuance of the privileges. In some cases the mere abstinence amounts to serious self-denial. The tide of manufacturing industry and inventive skill, notwithstanding its apparent irregularities, rolls onward in a settled direction, indicated by the expressed wants of society, and within an almost calculable time is certain to achieve some means of satisfying those wants. Some discoveries are made by the pioneers of science, men like Watt, far before their age; to them a monopoly of their invention is but an inadequate reward; while of others the whole body of society is in earnest search; the appropriation therefore by individuals may be looked on almost as an invasion of a right."

In *Clark P. S. & F. R. Co. v. Copeland* (1862), 2 Fisher, 221, Shipman, J.: (227) "It not unfrequently happens,

in the progress of the mechanic arts, that the time arrives when the whole atmosphere of inventive thought is quickened with the life of an approaching discovery, that many lines of investigation and experiment, converging for a long time toward the point, almost, but not quite, reach it; when, at last, some mind, by a happy thought, supplies some new element, or instrument, or mode of organization, and instantly gives birth to the organized idea."

² Accurate statistics as to simultaneous inventions are unattainable. In the greater proportion of such cases, the grant of a patent to the first applicant probably leads to the silent abandonment of the enterprise by others. But those which come under the notice of the Patent Office, in interference proceedings and otherwise, are quite numerous, amounting sometimes to several hundred in a year. Argument before Com. on Patents, 1878, 336.

³ Godson: (54) "If two persons severally discover the same thing, the one

§ 30. Patent Privilege a Monopoly: Restricts the Natural Right of the Public to Improve upon Existing Inventions.

Nor is this all. The patent privilege reaches out into the future, and restricts the right to exercise inventive skill in fields which the thought of the privileged inventor never entered. Every real invention gives a fresh impulse to the progress of the age, and affords it a new vantage ground from which to press on toward still greater triumphs over the material world. Ideas which the inventor could not have conceived are suggested by his invention to the minds of others,—ideas which, if applied in practice, would result in benefit to all mankind. The right of one man in this manner to avail himself of the discoveries of others is also a natural right. It is the right which every generation exercises over the inventions of its predecessors; and were it denied, every inventor, instead of aiding in the progress of the race, would be a barrier in its path, unless his own invention were so perfect as to exhaust all possibility of advancement in the same direction. Yet even this right is invaded by the patent privilege. It debars other men, not only from applying the discovery to the uses for which it was designed by its inventor, but from employing it as a basis on which to build up new inventions of their own. To the patentee belongs, not merely the exclusive right to what he has invented, but also the right to prevent others from using their own inventions, however valuable they may be, if they embrace a single one of his original ideas.¹ Nor is his right affected by the fact that whatever

who obtains a patent for it, before the other has made the matter public, will be adjudged to be the true and first inventor and be entitled to hold the grant."

In *Smith v. Davidson* (1857), 19 C. S. 697, which was a case of contemporaneous invention by both plaintiff and defendant, it was adjudged that the defendant could not use his own invention after the grant of a patent to the plaintiff. The lord president said: "His monopoly must be protected, and although there may be others who have

made the same discovery, but who have not brought it to the same perfection, and have not made their bargain with the public in regard to it, they cannot disturb the integrity of the monopoly of the party who first makes his bargain with the public." See also *Forsyth v. Riviere* (1819), 1 Carp. 401; 1 Abb. P. C. 325. For American cases to the same effect, see *Cox v. Griggs* (1861), 2 Fisher, 174; 1 Bissell, 362.

§ 30. ¹ Lund, speaking of the effect of a patent privilege on the rights of others to develop the same idea, says: (5) "This

they adopt of his invention was independently discovered. His patent privilege once thrown around a new idea, that idea, no matter by whom conceived or how improved upon by others, is his alone. So far as he is able he may develop and extend it, and may erect new structures upon its foundation; but to all others it remains forbidden ground.² And hence, where

characteristic of a patent right may undoubtedly very often hinder the profitable employment of a certain amount of ingenuity, as well as prevent great improvements in some patented inventions. It is well known that the degree and character of the ingenuity, required to perfect or vary the practical details of an invention, is common in comparison either with the genius or good fortune, which leads to the useful application of a mere thought or abstract idea; and, therefore, as soon as such an application is made, some improvements in matters of detail would, in almost every case, be immediately produced. Now to allow these to be put in practice without the consent of the patentee, during the continuance of his grant, would amount to its repeal — for instance by the sale of a cheaper or better article. Whatever question there may be, as to the right of the public to the immediate enjoyment of any such improvements, there can be no doubt that the improver is not entitled to profit at the expense of the patentee; as the improvements were the fruits of his usefully applied thought.”

In *Converse v. Cannon* (1873), 9 O. G. 105, Woods, J.: (107) “It makes no matter what additions to, or modifications of, a patentee’s invention a defendant may have made; if he has taken what belonged to the patentee he has infringed, although with his improvement the original machine or device may be much more useful.” 2 Woods, 7 (12).

² Curtis: (§ 320) “These cases show

that when a party has invented some mode of carrying into effect a law of natural science, or a rule of practice, it is the application of that law or rule which constitutes the peculiar feature of his invention; that he is entitled to protect himself from all other modes of making the same application; and, consequently, that every question of infringement will present the question whether the different mode, be it better or worse, is in substance an application of the same principle. . . . If the mode of carrying the same principle into effect, adopted by the defendant, still shows only that the principle admits of the same application in a variety of forms, or by a variety of apparatus, the jury will be authorized to treat such mode as a piracy of the original invention.”

In *Jupe v. Pratt* (1837), 1 Web. 145, Alderson, B.: (146) “You may take out a patent for a principle coupled with the mode of carrying the principle into effect, provided you have not only discovered the principle, but invented some mode of carrying it into effect. But then you must start with having invented some mode of carrying the principle into effect; if you have done that, then you are entitled to protect yourself from all other modes of carrying the same principle into effect, that being treated by the jury as piracy of your original invention.” 2 Abb. P. C. 464 (467).

In *Ex parte Kent* (1880), 17 O. G. 686, Doolittle, Acting Com.: (686) “It is true that a discoverer of a genus in mechanics is entitled to a claim in a

his exclusive rights are rigidly respected or enforced, and his own skill and enterprise are not sufficient to produce the improvements of which his discovery is capable or to which it leads, the public may be deprived of every benefit of the invention, except those which it confers upon them at the moment when it leaves the first inventor's hands.

§ 31. Patent Privilege a Monopoly : Deprives the Public of the entire Use of the Invention at the Option of the Patentee.

Finally, the patent privilege is not merely restrictive of these public rights, it is capable of being turned, at the will of the inventor, to their complete destruction. A patentee has not only the exclusive right to use his own discovery and to impose whatever terms he chooses on its use by others, but he also has the right to refuse to use it or permit its use. His patent places him under no obligation to the public during the existence of his privilege. If poverty or other inability compels him to retain it unemployed, or his unwarranted estimate of its pecuniary value places it beyond the reach of others, the people are without redress. The fact or law which he has discovered and applied is his own property, and can be withheld from or bestowed upon mankind at his pleasure. He has become an absolute monarch over that part of nature's vast domain, and can determine whether it shall be at once a fruitful field, or remain during his ownership an uncultivated waste.¹ Fortunately, this evil is less formidable in practice than in possibility. The obstinacy or carelessness of the inventor does not often keep from public use a really valuable invention. Those who appreciate its true importance adopt it

patent co-extensive with the genus, and to which all subsequent claims for species of that genus must be subordinate."

§ 31. ¹ In *Pitts v. Wemple* (1855), 2 Fisher, 10, Drummond, J. : (15) "A man may obtain a patent for an invention and let it lie in the Patent Office without use, and no one else would have the right to use such invention because it is his property." 1 Bissell, 87 (93).

This position has been recently qualified by a decision that the patentee must use the invention himself, or permit others to use it on reasonable terms, or the court will not grant him an injunction against infringers, but will order them to give bonds to account for its use. See *Hoe v. Knap* (1886), 27 Fed. Rep. 204 ; 36 O. G. 1244.

in defiance of his rights, and at the risk of their own ultimate loss confer upon the public the benefit of his discovery. And though the courts condemn these bold infringers, the world may owe to them the entire advantage it derives from the invention, which but for them would have lain unemployed for years, if not forever.

§ 32. Patent Privilege a true Monopoly: how Distinguished from an Odious Monopoly.

The nature of the patent privilege, as thus disclosed by its effects on the relations of the inventor and the public toward the invention, proves that it possesses both the characteristics of a true monopoly: (1) It confers on the inventor an exclusive right to which he is not naturally entitled, and which he could neither claim nor enforce except through the arbitrary interposition of the law; (2) It restricts the public in its enjoyment of three invaluable natural rights, without the exercise of which, in some form, all progress in the industrial arts would be impossible. It differs from an odious monopoly in this: that in the odious monopoly the public are deprived of some existing method of enjoying these rights, while the patent privilege prevents their exercise only in the new direction marked out by the discovery of the inventor.¹ But in both cases the rights restricted are the same, and the effect on their enjoyment after the monopoly is granted is identical.² That a patent privilege is a true monopoly, derogatory to common right, is, therefore, the correct theory concerning it considered in itself. If courts and legislatures, by abandoning this theory, have drifted into lax and dangerous modes of dealing with the public interests when opposed to those of the inventor,

§ 32. ¹ In *Mitchell v. Reynolds* (1711), 1 P. Williams, 181, Parker, C. J., held that the grant of the sole use of a trade is void, but a grant of a trade newly invented, and for a time, is good; for the public has an advantage in the invention of a useful trade which, after a limited time, is to be public. See also *Darcy v. Allin* (1602), Noy. 173; 1 Abb. P. C. 1.

² Phillips: (5) "The rights taken from the members of the community generally are, first, that of discovering or inventing the same thing, independently of the prior invention, and that of using and vending it for a limited time; and second, the right of profiting by the prior invention or discovery of another, for a limited time."

it is apparent that the future safety of the entire patent system, and the protection of the people from unreasonable and oppressive patent privileges, can only be secured by such a return to this theory as shall result in the adoption of a just and permanent dividing line between these constantly conflicting rights.

§ 33. Patent Privilege, though a Monopoly, is Justifiable on grounds of Public Policy.

The creation of a monopoly embracing these extraordinary privileges, with their corresponding limitations of the common right, could not be justified unless the ultimate results of its bestowal were, upon the whole, highly advantageous to the public. That this is true, experience has fully demonstrated.¹ The granting of a patent privilege at once accomplishes three important objects: it rewards the inventor for his skill and labor in conceiving and perfecting his invention; it stimulates him, as well as others, to still further efforts in the same or different fields; it secures to the public an immediate knowledge of the character and scope of the invention, and an unrestricted right to use it after the patent has expired. Each of these objects, with its consequences, is a public good, and tends directly to the advancement of the industrial arts. Any system of law which attains these results, without the

§ 33. ¹ Curtis: (xxxiv) "It is now too late in the history of civilization to question the policy of this protection, which forms a prominent feature in the domestic polity of every nation which has reached any considerable stage of progress in the arts of civilized life."

In *Ames v. Howard* (1833), 1 Sumner, 482, Story, J.: (485) "The Constitution of the United States, in giving authority to Congress to grant such patents for a limited period, declares the object to be to promote the progress of science and useful arts, an object as truly national, and meritorious, and well-founded in public policy, as any which can possibly be within the scope of national protection." 1 Robb, 689 (692).

J. J. Storow, Esq., Argument before Com. on Patents (1878): (334) "I look upon it as a mark of the highest civilization that a country shall recognize by its fundamental law the utilitarian effects of pure brain power; as a mark both of the highest civilization and of the highest reaches of the law that a nation recognizes, as property to be protected, because helpful to the state and to all its people, the pure creations of the intellect."

See also, for an able presentation of the policy and advantages of this method of reward and encouragement, the address of Hon. J. M. Thacher before the Patent Congress at Vienna in 1873, 4 O. G. 419.

undue restriction of natural rights, is evidently consonant with reason, justice, and sound public policy.

§ 34. Patent Privilege a Justifiable Monopoly: Inventors Entitled to Reward. .

To reward the inventor for his skill and labor in making his invention has always been recognized as a proper reason for granting him an exclusive privilege.¹ Every discoverer of any new and useful thing becomes thereby a benefactor to his race. Even if he preserves his secret, employing his invention only in his own affairs, the improvement which he makes in them is an addition to the sum of human prosperity, and so far an advantage to the public. If he reveals it, permitting but a limited enjoyment and on terms involving compensation to himself, he has conferred still greater favors on mankind. And if he freely publishes it, allowing all to practise it who so desire, and conveying to them whatever knowledge he may have as to its most profitable use, he has bestowed upon the world the highest benefits. Regarded as a mere inventor, not protected by a patent, he is thus always serviceable to the state, and whenever the value of his invention to the public exceeds the fair measure of that contribution, which is due from every man to the common stock of useful knowledge, he is entitled to some adequate reward.

§ 34. ¹ Phillips: (12) "It would be considered paltry to maintain that a general, who had achieved a victory, was sufficiently compensated by his pay, during the time he gave to the achievement. He is considered a benefactor to his country, and, as such, entitled not merely to his pay, but to a *reward*. So is the inventor of a useful art a benefactor to his country, and to the whole civilized world, and as such entitled to a *reward*. It is a debt due to him; not one that he can demand by virtue of the law of nature, and independently of all civil institutions, but one which it ought to be the early

care of the positive laws to acknowledge and satisfy."

Curtis: (xx) "The intellectual conception of an inventor, or a writer, constitutes a valuable possession, capable of being appreciated as a consideration, when it passes by his voluntary grant into the possession of another. If, by the same voluntary grant, this possession is bestowed upon the public, the logical justice of compensation, in some form, will appear at once, by supposing the benefit to have been conferred exclusively upon any one of the mass of individuals who form in the aggregate the moral entity termed the public."

§ 35. Patent Privilege a Justifiable Monopoly : a Proper Reward for the Inventor.

Of all conceivable methods of recompensing an inventor, that of conferring upon him a temporary monopoly of his invention is undoubtedly the best, both for himself and for the public. It places the invention in the hands of him who generally is most fitted to develop and apply it, and compels him to render it beneficial to the public in order that he may reap his own reward. It encourages the inventor to bring his invention to the highest possible condition of practical utility by constantly inventing improvements on it, in order to keep pace with the public wants and to control the trade from which his compensation is derived. It secures the direction of inventive genius toward fields of labor which are of practical importance to the public, and in which the prospect of a due remuneration is most immediate and certain. It makes the reward of the inventor commensurate with the value of his invention to the public. It lays no burden on the people except that of remaining for a while without that which they never yet enjoyed. It is in all respects, if judiciously bestowed and so construed as to protect the precise thing invented and only that, the nearest approach to a perfect apportionment of recompense to services that the law has ever known.¹

§ 35. ¹ Bentham, *Rationale of Rewards* : (92) "It is an instance of reward peculiarly adapted to the nature of the service, and adapts itself with the utmost nicety to those rules of proportion to which it is most difficult for reward, artificially instituted by the legislature, to conform. If confined, as it ought to be, to the precise point in which the originality of the invention consists, it is conferred with the least possible waste of expense. It causes a service to be rendered, which, without it, a man would not have a motive for rendering ; and that only by forbidding others from doing that which, were it not for that service,

it would not have been possible for them to have done. Even with regard to such inventions, for such there will be, where others besides him who possesses the reward have scent of the invention, it is still of use by stimulating all parties and setting them to strive which shall first bring the discovery to bear. With all this it unites every property that can be wished for in a reward. It is variable, equable, commensurable, characteristic, exemplary, frugal, promotive of perseverance, subservient to compensation, popular and reasonable." See also Coryton, 21.

§ 36. Patent Privilege a Justifiable Monopoly: Public Interest Promoted by Stimulating Inventive Genius.

To stimulate inventive skill and energy is one of the most effective methods of advancing national prosperity, and in modern times especially attracts the attention of all enlightened governments. While it is certain that the human mind, independently of external impulses, is constantly engaged in pushing its investigations into new fields and in achieving new results, it by no means follows that practical inventions in the industrial arts would rapidly be multiplied without the inducement offered by the prospect of pecuniary reward. Such inventions necessitate not only the conception of a new idea by the mind, but the reduction of that idea to practice in some tangible and useful form. This latter process cannot be accomplished by speculation only, but involves experiments, often protracted and expensive, and a degree of physical skill and labor which otherwise applied might secure to the inventor a considerable recompense in money. To lead an able and prudent man to engage in such enterprises as these, some reasonable hope of profiting by his own labors must be aroused within him; and this can be effected only by a promise on the part of the public that if he succeeds in his invention he shall be suitably rewarded.¹ Experience teaches that this is true; the progress of inventive triumphs, in all civilized nations, being directly in proportion to the encouragement offered to inventors by the state.²

§ 36. ¹ Coryton: (22) "Inventors, as a class, are singularly deficient in the qualifications for prosecuting a new trade with a probability of success, if exposed to unlimited competition. Without the encouragement of a patent, how is any man to engage in a novel and expensive process, if the moment he succeeds, at the cost of all this outlay, he must be sure that his neighbors, who were cautious enough to shun all chances of loss, will come into competition with him and make his remuneration impossible?"

Chauncey Smith, Esq., Argument before Com. on Patents (1878): (426) "The suggestion is made, indeed, that

inventors are so possessed with the spirit of invention that they would make inventions whether rewarded for it or not. But I am satisfied, from my observation of the inventors with whom I have come in contact, that those who make this assertion know but little of inventors. I have met many of them, but I have never yet seen one, who did not labor constantly and zealously in view of the reward which he hoped to reap as the result of his labor."

² Hon. Elisha Foote, Argument before Com. on Patents (1878): (416) "Some gentlemen have urged here that inventions do not need the protec-

§ 37. Patent Privilege a Justifiable Monopoly: Stimulates Inventive Genius.

For this purpose also the bestowal of the patent privilege on the inventor is admirably adapted. The reward which it offers is certain, and is limited in amount only by the value of his invention to the public and by his energy and judgment in developing it. It furnishes him with the strongest motive to pursue his researches and experiments by securing to him the profitable result of the very enterprise in which he is engaged. It gives him a contingent property in the invention from the moment when he first conceives the idea, to become absolute when the patent privilege is granted, on which he can, as on the pledge of any other property, raise means to prosecute his inquiries and bring them to complete success.¹ And where the field of art covered by his patent is capable of further cultivation, it enables him to devote himself to its improvement with the assurance that every increase in its utility to the public will be followed by an increase in his own reward.

tion of patents; that they come as a matter of course, from the natural promptings of the human mind, and will be made without reference to profits or personal advantages. Such persons, I apprehend, have never investigated the subject. It is within my remembrance when most of the women were employed in spinning and weaving just as they were in the times of Homer. . . . Indeed since the practical operation of patent laws, there has been more advance in all the practical arts of life than was made before in all preceding ages of the world taken together."

§ 37. ¹ Chauncey Smith, Esq., Argument before Com. on Patents (1878): (427) "Those who expect and, perhaps, believe that inventors would make inventions without the hope of reward as well as with, assume, I think, that invention consists wholly in mental labor — in the intellectual exercise of conceiving and devising new things, which

may be described in words and represented by drawings, if the subject is of a nature to admit of drawings. But in almost all cases a good invention involves a great deal more than this. It involves experiments and trials, a large amount of physical labor, and the expenditure for materials of more or less money, according to the nature of the invention. . . . It is this practical part of invention which few men could or would undertake unless the product of the labor and expense should become their own. Most of our inventors are men who live by their daily labor, and they are frequently compelled to sell a share of their proposed inventions in advance of their reduction to practice, in order to obtain the means to reduce them to practice. Contracts of this kind are common, but they could not be made if the law did not protect the invention in the hands of the inventor when completed."

§ 38. Patent Privilege a Justifiable Monopoly: Public Interest promoted by Disclosure of Inventions.

The duty which the state owes to the people to obtain for them, at the earliest moment, the practical use of every valuable invention in the industrial arts is, however, a higher and more imperative duty than any which it owes to the inventor. Upon the amelioration of their physical condition depends, to a great extent, the mental and moral progress of its citizens, and the influence of inventions in effecting this amelioration cannot well be overestimated. Such a delay in bringing a single invention into use as might result from an attempt by the inventor to conceal it may deprive an entire generation of advantages which would redound to its incalculable benefit. To secure the publication of the invention as soon as it is brought to such perfection as to be capable of practical employment, and to remove, as early as the accomplishment of this first object will permit, all restrictions to its free use by the people is, therefore, the main purpose of every concession made to the inventor by the state.¹

§ 39. Patent Privilege a Justifiable Monopoly: Secures the early Disclosure of Inventions to the Public.

The patent privilege, if wisely guarded, effects this purpose. It removes from the inventor all inducement to conceal his

§ 38. ¹ Coryton: (20) "Nothing but principles of justice or public policy can justify the crown, as the steward of public rights, in sanctioning such privileges as those awarded to patentees. The reward of the inventor for the benefit he has conferred on trade, and the obtaining from him for public use the full benefit of the improvement he has effected, are objects which the Executive, as representative of the community, should endeavor to effect with the least possible disturbance of public rights."

In *Blanchard v. Sprague* (1839), 3 Sumner, 535, Story, J.: (539) "Patents for inventions are now treated as a just reward to ingenious men, and as

highly beneficial to the public, not only by holding out suitable encouragements to genius and talents and enterprise; but as ultimately securing to the whole community great advantages from the free communication of secrets, and processes, and machinery, which may be most important to all the great interests of society." 1 Robb, 734 (739).

In *Kendall v. Winsor* (1858), 21 How. 322, Daniel, J.: (327) "It is undeniably true, that the limited and temporary monopoly granted to inventors was never designed for their exclusive profit or advantage; the benefit to the public or community at large was another and doubtless the primary object in granting or securing that monopoly."

discovery, by affording him the same protection that could be obtained by the most rigid secrecy. It encourages him to make known his results, as the method of securing for himself the largest recompense. It compels him to acquaint the public, thoroughly and at the outset, with all the details of his invention and with the various modes of benefiting by its use. It appropriates to the whole people, after a short period of exclusive ownership by the inventor, the entire invention as a portion of that common property in which all men may exercise an equal right.¹ Wherein any grant of the patent privilege fails to accomplish this object it is the fault, not of the inherent nature of the privilege itself, but of the legislature which devised it or the courts by whom it is construed.

§ 40. Patent Privilege a Monopoly : its Threefold Aspect, as a Reward, a Stimulus, and a Contract for the Disclosure of the Invention.

Regarded as a method of attaining these three objects, the concession of the patent privilege by the state is an act having a threefold character. As a reward bestowed on the inventor for his past inventions, it is an act of justice. As an inducement to future efforts, it is an act of sound public policy. As a grant of temporary protection in the exclusive use of a particular invention, on condition of its immediate publication and eventual surrender to the people, it is an act of compromise between the inventor and the public, wherein each concedes something to the other in return for that which is conceded to itself.¹ In this latter character it is a true

§ 39. ¹ In *Grant v. Raymond* (1832), 6 Pet. 218, Marshall, C. J. : (243) "The great object and intention of the act is to secure to the public the advantages to be derived from the discoveries of individuals." 1 Robb, 604 (635).

For a very instructive and interesting discussion of the effects produced by the patent laws upon the inventive genius, the public convenience, wealth and happiness, and the intellectual progress of the countries where such laws prevail, see the arguments of Messrs: Chauncey

Smith, J. J. Storrow, and other gentlemen, in the Report of the hearing before the Congressional Committee on Patents in 1877-78.

§ 40. ¹ Coryton: (41) "The clearest insight, however, into the peculiarities of this property [a patent privilege] is from considering it as the result of a contract entered into by the executive, as representative of the public, with the patentee. The parties meet on the understanding that the one has a secret to communicate, the other a favor to confer in return."

contract, to the stipulations in which each party is bound with the same strictness as in any other contract, and which is to be interpreted in the same manner as other legal obligations.² That portion of the contract by which the public grant protection to the inventor, being intended for his benefit, should be liberally construed, in order to secure to him, in its fullest extent, the protection to which he is entitled. That portion of the contract by which the inventor communicates his invention to the public, being intended for the public benefit, ought, for the same reason, to be construed in favor of the public, in order to secure to them that knowledge and use of the invention to which they are entitled. To construe both parts of the contract in favor of the public, as in the earlier English cases, or to construe both in favor of the inventor, as seems to be the tendency of certain modern courts, is an abandonment of the correct theory of the patent privilege itself, and of the common rules by which all mutual obligations are controlled.³

Phillips : (22) "All laws of this description, therefore, give only a temporary monopoly. They offer a compromise between the inventor and the rest of the community, by which each party surrenders something, and it is proposed that each shall receive an equivalent."

² Curtis : (xxiii) "But it should always be remembered that in the grant of a patent privilege, as now understood, a contract takes place between the public and the patentee, to be supported upon the ground of mutual considerations, and to be construed, in all its essential features of a bargain, like other contracts to which there are two parties, each having rights and interests involved in its stipulations."

³ Curtis : (xxxv) "The truth is, a patent should be construed as, what it really is, in substance, namely, a contract or bargain between the patentee and the public, upon those points which involve the rights and interests of either party. These points relate to the extent of the claim, and to the intelligi-

bility of the description for the purposes of practice." See also 2 Pars. Cont. 257 z.

That any confusion or doubt should attend the truth or application of so plain a rule as that stated in the text would seem impossible, did not experience prove the contrary. So far as the relation between the public and the patentee can be regarded as a contract relation, the rights and obligations of both parties to the contract are perfectly clear and simple. The right of the public is to be put into immediate possession of a complete knowledge of the invention, and it is the duty of the patentee to give this knowledge. The right of the patentee is to enjoy unmolested the exclusive use of his invention during the life of his patent, and it is the duty of the public to secure him in this right by the ordinary forms of legal protection and redress. These reciprocal rights and obligations are to be assured to the respective parties only by imposing upon each the necessity of fully,

§ 41. Patent Privilege a Monopoly: its Contract Aspect alone Involved in the Construction and Administration of Patent Law: Two Fundamental Principles.

The acts of legislatures which prescribe the limits and conditions of the patent privilege, and the decisions of the courts in interpreting and applying such legislative acts, relate to its contract character alone. Considerations of public policy and of justice to inventors are proper for the constitutional convention, when determining whether or not these privileges shall be granted, and for the legislature when about to define the scope of the inventor's rights and the service which he must render to the public in return. But the legis-

literally, and immediately discharging its legal duty to the other; in other words, by interpreting each side of the contract against its promisor and in favor of its promisee.

The cause of this confusion and doubt one need not go far to discover. In the first place, the courts have for many years habitually employed sweeping language to the effect that patents were to be construed liberally in favor of the patentee, — language which is correct enough if the patent is to be regarded merely as the grant of the privilege (which it was until a recent period), but which is incorrect when the patent is considered as embracing also the communication of his discovery by the inventor to the public. As a matter of fact the specification and drawings attached to a patent now perform two distinct functions, and thus become portions of each of the two different parts of the contract. Used to define the limits of the granted privilege, they are the contract of the public, and to be interpreted in favor of the patentee. Used to describe the invention to the public, they are the contract of the inventor and to be construed in favor of the public. General language in this instance has worked such mischief as it usually does.

Moreover, this confusion is increased

by the fact that the interpretation of these two parts of the contract is practically confided to two different tribunals. The question as to the meaning of the patent, specification, and drawings, considered as a grant of privilege, is a question of law for the court. The question as to their meaning and sufficiency, considered as a communication of the discovery to the public, is a question for the jury under the direction of the court. The rule which is to guide the court in its interpretation is the rule of favor to the patentee; that which is to guide the jury is the rule of full protection to the public. That the courts, in hurriedly prepared instructions to the jury, should sometimes fail to distinguish between these two rules, and direct them generally that the patent is to be construed in favor of the patentee, is perhaps not surprising; but that their language, embodied in the reports and followed by later judges, should come to be regarded as embracing the entire law on that subject was as unnecessary as it is unfortunate. That this confusion has worked practical injustice to the public may not be capable of proof; but the obscuration of the law itself by those whose duty it is to develop and elucidate it is, by no means, the least of evils.

lature having acted in the premises, the language of the statute, regarded, as all statutes must be, as intended to promote the common good, becomes the measure of the rights and duties of the inventor and the public, and fixes the relations which they are to occupy toward each other. It is the office of the courts to interpret the language of the statute, and apply it to particular cases, in such a manner as to effect the intention of the legislature, by preserving these rights and enforcing these duties, as they are prescribed by the statute and specified in the patent actually granted.¹ Patent Law as such, consisting of these statutes and decisions, therefore relates only to the contract character of the patent privilege and forms one branch of the Law of Contracts.² It deals with a single form of obligation, and with but two classes of parties whose relations to each other are always substantially the same. The principles on which it rests are simple, though often difficult of application on account of the abstruse or intricate character of the invention concerning which the controverted questions rise. These principles may be finally reduced to two, as fundamental grounds on which all others rest:—

I. That the inventor, having made such an invention as is entitled to the patent privilege, must communicate it to the public by publishing an accurate description of its character and uses ;

II. That the public, having received from the inventor this communication, must thenceforth, during the period for which his privilege is granted, protect him in the exclusive use of the invention so described.

§ 41. ¹ Bishop, Written Laws : (§ 70)
 “Laws are expounded and enforced, not made, by the courts. The makers are entitled to have their real meaning, if it can be ascertained, carried out. Hence the primary object of all rules for interpreting statutes is to ascertain the legislative intent ; or, exactly, the meaning which the subject is authorized to understand the legislature intended.”

² 2 Pars. Cont. : (257 *y*) “The rules and principles of the common law, as to contract, construction, evidence and remedy, are applied to the law of patents. . . . (257 *z*) [The patentee] is a party to a fair and equal contract, and should be dealt with by the law rationally and impartially.”

§ 42. Patent Privilege a Monopoly : its Contract Aspect: Obligations assumed by the Inventor.

According to the first of these principles the obligation of the inventor to the public is twofold : (1) The result of his inventive skill must be of such a nature that a patent may lawfully be granted to protect it ; (2) The invention itself must be fully communicated to the public. Of these two obligations the latter is practically the most important. Invention without publication is of comparatively little value to the state, and to reward the inventor, at the public loss, for a discovery which he endeavors for his own advantage to conceal, would be contrary to the entire purpose of the patent privilege.¹ It is the publication, rather than the invention, which promotes the interests of the people ; and although invention by some one must necessarily precede publication by any, it has always been the policy of the law to treat the publication as the meritorious act which entitles the inventor to his patent. Thus by the decisions under the statute of James I. it was established that the first importer into the realm was entitled to the same privilege as a first inventor ; the mere act of invention adding nothing to the merit of the latter, and its absence not diminishing the service rendered to the public by the former.² The earlier patents also contained a clause, requiring the inventor to take apprentices and teach them the knowledge and mystery of the new invention.³ In the reign of Anne (A. D. 1712) it was made a condition of the grant that the patentee should file in Chan-

§ 42. ¹ In *Kendall v. Winsor* (1858), 21 How. 322, Daniel, J. : (328) "The inventor who designedly, and with a view of applying it indefinitely and exclusively for his own profit, withholds his invention from the public, comes not within the policy or objects of the Constitution or Acts of Congress. He does not promote, and if aided in his design, would impede, the progress of science and the useful arts. And with a very bad grace could he appeal for favor or protection to that society which, if he had not injured, he certainly had neither benefited nor intended to benefit."

² In *Edgebury v. Stephens* (1691), 1 Web. 35, Holt and Pollexfen, JJ. : "A grant of a monopoly may be to the first inventor by the 21 Jac. I., and if the invention be new in England, a patent may be granted though the thing was practised beyond sea before ; for the statute speaks of new manufactures within this realm ; so that if it be new here, it is within the statute ; for the act intended to encourage new devices useful to the kingdom, and whether learned by travel or by study it is the same thing." 1 Abb. P. C. 8.

³ Coryton, 123.

cery a written specification, describing his invention and the proper mode of its employment.⁴ And in this country it has always been a condition precedent to the issue of a patent that the inventor should place upon the public records a full and accurate statement of the character of his discovery and of the methods in which it could be practically used.⁵ As between rival inventors, also, the one who has first published the invention, by his application for a patent, is presumed to be entitled to the privilege until the contrary is shown.⁶ Of simultaneous inventors, the first publisher by specification becomes the only patentee.⁷ Through the whole body of the law runs the same principle, that the real consideration given to the public for the patent privilege is not the skill of the inventor in inventing, but his honesty and thoroughness in making his discovery known.⁸ The inventor, therefore, who does not

⁴ Godson, 46 ; Coryton, 123. This requirement was introduced into the patent, not by legal enactment, but on the authority of the law officers of the crown, — the date of the first patent containing this condition being April 1, 1712.

⁵ In the act of 1790, § 2, it is provided that, at the time the patent is granted, the patentee shall file, to be kept on public record, a written specification so describing the invention as to enable any person skilled in the art to which it belongs to make and use it. The same act, § 3, makes it the duty of the government official, in charge of such record, to furnish copies of it to any one who may desire them. These provisions, in substance, are found in all later statutes.

⁶ In *Booth v. Lyman* (1880), 17 O. G. 393, Paine, Com. : (394) “ Priority of invention . . . is determined *prima facie* as between two original applications by the dates of filing the respective applications : as between an original pending application and one or more patents by the dates of filing the pending application and the applications on which the patents were granted ; as between a pend-

ing reissue application and one or more unexpired patents by the dates of filing the original application for the patent of which a reissue is asked and the applications on which the other patents were granted.”

⁷ In *Cox v. Griggs* (1861), 2 Fisher, 174, Drummond, J. : (177) “ If they were jointly experimenting and equally meritorious, a doubt should be solved in favor of him who first obtains a patent.” 1 Bissell, 362 (365).

⁸ Curtis: (xxi) “ This secret the inventor undertakes to impart to the public, when he enters into the compact which the grant of a patent privilege embraces. In that compact he promises, after the lapse of a certain period, to surrender to the public completely the right of practising his invention ; and, as a guaranty against his concealment of the process by which it is to be practised, and to prevent the loss of this knowledge, he is required to deposit in the archives of the government a full and exact description in writing of the whole process, so framed that others can practise the invention from the description itself. The public, on the other

fully disclose his invention, at the time and in the manner required by law, does not fulfil his contract with the public and is not entitled to the privilege which he receives.⁹ If this occurs without his fault, reason and the public interest both require that he should be permitted to protect himself and afford proper information to the public by amending his description.¹⁰ But such permission, unless restricted to evident mistakes and never suffered to result in an extension of the privilege already granted, is fraught with many dangers, and leads to flagrant violations of the public rights.¹¹

§ 43. Patent Privilege a Monopoly: its Contract Aspect: Obligations assumed by the Public.

According to the second of these two principles, the obligation of the public to the inventor, upon the discovery and

hand, through the agency of the government, in consideration of this undertaking of the inventor, grants and secures to him the exclusive right of practising his invention for a term of years."

In *Carr v. Rice* (1856), 1 Fisher, 198, Betts, J. : (200) "It is dealt with by the courts, as a grant by the legislature, in exchange for the equivalent to be received by the public, in the free enjoyment of the patented discovery, after the inventor's exclusive privilege expires."

In *Page v. Ferry* (1857), 1 Fisher, 298, Wilkins, J. (306) : "The patent may be considered in the light of a deed from the government, the consideration of which is the invention specified; and the patentee is bound to communicate it, by so full, clear, and exact a description, with drawings and models, that it shall be within the comprehension of the public at the expiration of the patent, for at that period his invention becomes public property."

⁹ Curtis: (§ 256) "If anything be omitted which gives an advantageous operation to the thing invented, it will vitiate the patent."

¹⁰ In *French v. Rogers* (1851), 1 Fisher,

133, Kane, J. : (137) "If it be true, as we have supposed . . . that the patent is granted to the inventor in consideration of some benefit to be derived by the public from his disclosures, and that the reissue is in consideration of some more full or more accurate disclosure than that which he had made in his original specification, or some renunciation on his part of an apparently secured right — it is for the public interest that the surrender and reissue should be allowed to follow each other, just as often as the patentee is content to be more specific or more modest in his claims."

¹¹ In *Meyer v. Maxheimer* (1881), 20 O. G. 1162, Wheeler, J. : (1162) "There is no safe or just rule but that which confines a reissue patent to the same invention which was described or indicated in the original." 20 Blatch. 15 (17); 9 Fed. Rep. 99 (100).

In *Smith v. Merriam* (1881), 19 O. G. 601, Lowell, J. : (602) "The law is extremely liberal, perhaps too much so, and has been much abused." 6 Fed. Rep. 713 (717).

See also *Miller v. Brass Co.* (1882), 104 U. S. 350, 21 O. G. 201.

publication of his invention, is also twofold: (1) It must give to his exclusive right a legal sanction by the act of granting him the patent; (2) It must afford him adequate protection and redress in cases where his rights are violated or endangered. To the inventor himself the former is undoubtedly the most valuable part of this obligation. A patent being once obtained, the public generally acquiesce in the inventor's claims as far as he has clearly stated and defined them, and he proceeds to gather his reward without denial or interference on the part of others.¹ But the latter part is practically the most important; for it is this which gives vitality and force to the former, and it is in the proceedings which this involves that the limits of the patent privilege are finally determined and the rules governing it are settled and applied. The principle which underlies these rules, namely, that the inventor is entitled to complete protection in the exclusive use of what he has invented and has covered by his patent, assumes that he will bring his invention into actual use, and that the injury to which he is subject consists in such a use by others as amounts to an infringement of his own.² It is true that his patent privilege as now interpreted permits him to withhold his patented invention from the public, and that this course of action does not justify its unauthorized employment.³ Nevertheless, it is apparent that one great object of the patent privilege is to secure to the public an immediate,

§ 43. ¹ Although there are numerous infringements, which are never brought to the attention of the courts, and of suits actually instituted but a small part find their way into the reports, yet, in view of all the facts, it appears probable that less than two per cent of the patents actually granted are so far infringed as to impair the enjoyment of his exclusive use by the inventor.

² The property of a patentee in his invention consists entirely in his right to its exclusive use (*Brush v. Naugatuck R. R. Co.* (1885), 32 O. G. 894, 24 Fed. Rep. 371; 23 Blatch. 277), and the whole body of the law protect-

ing this property, with the single exception of the equity doctrine concerning his right to the infringer's profits, proceeds on the assumption that the invention will be put to practical use, so far as it is in the inventor's power.

³ In *Pitts v. Wemple* (1855), 2 Fisher, 10, Drummond, J. : (15) "A man may obtain a patent for an invention and let it lie in the Patent Office without use, and no one else would have the right to use such invention, because it is his property." 1 Bissell, 87 (93); but see *Hoe v. Knap* (1886), 27 Fed. Rep. 204; 36 O. G. 1244, cited in note 1, § 31.

if not gratuitous, enjoyment of the new discovery, and that the inventor does not fulfil the spirit of his contract unless he introduces his invention into actual use and puts its benefits within the reach of others.⁴ It is for this very reason that his reward for his disclosure is given him in this form of a monopoly of his invention, and that the amount of his compensation is thus made dependent on the diligence with which he presses it upon the public. Correctly speaking, it is, therefore, the infringement of the use, and not of the ownership of an invention, that the public have contracted to prevent or to redress; and the degree of injury committed by the infringer is to be estimated by his interference with that use as already made, or likely to be made, by the inventor. To give to one who, having patented a valuable invention, practically suppresses it the same redress, in quantity as well as kind, which justly could be claimed by one who was engaged in its employment, is a perversion of the true idea of the relation of the inventor to the public, and sanctions his neglect of a duty impliedly imposed upon him by his grant.⁵ No such encouragement should be given to him to speculate upon wrong-doing. He should be compelled to exercise the exclusive right conferred upon him by his patent, and thereupon the state should vindicate that right by obliging those who violate it to make him ample compensation for the loss they have occasioned.

⁴ In *Magic Ruffle Co. v. Douglass* (1863), 2 Fisher, 330, Shipman, J. : (333) "The public who thus, through the law, secure to the inventor the exclusive property in his invention for a limited period, receive in return either new, more valuable, or cheaper productions during the lifetime of the patent, and from its expiration the free enjoyment of any benefits which may flow from it forever thereafter."

⁵ This is the consequence, however, of the rule adopted by the courts that in equity the infringer is to be so far treated like a trustee for the owner of the infringed patent, as to be held accountable to him for all the benefits that

may accrue from the infringement. In view of that rule, all question as to the actual injury done to the patentee is avoided. It is assumed that, by the infringement, he has been deprived of all the profit which the defendant has made, and this whether he has ever attempted to avail himself of his invention or not. Indeed, if his invention be of that class which can be enjoyed by licensing others to use it, and he has thus enjoyed it, his compensation for the infringement is likely to be far less in amount than if he had neglected it, since in the former case his habitual license fee, and not the profits, becomes the measure of his recovery.

§ 44. Patent Privilege a Monopoly: Summary of Fundamental Principles.

This discussion of the nature of the patent privilege leads to the following conclusions:—

I. That the patent privilege is a true monopoly, granted in derogation of the common right;

II. That this monopoly is, however, properly bestowed on the inventor, because, upon the whole, it is conducive to the public good;

III. That when bestowed, it becomes a consideration paid to the inventor for the immediate and full disclosure of his invention, and for its ultimate entire surrender to the public;

IV. That unless the inventor, at or before the issue of his patent, makes this disclosure, and thereby puts the public into complete possession of his secret, his own part of the contract remains unfulfilled, and he is not entitled to the privilege;

V. That so much of the letters-patent as constitutes the grant of the inventor's privilege is to be construed liberally in his favor; while so much as constitutes his disclosure of the invention is to be construed in favor of the public;

VI. That having duly published his invention, and received his patent, the inventor is entitled to enjoy his exclusive use without interference, and to recover in suitable proceedings full compensation for all injuries thereto.

CHAPTER III.

OF THE PATENT SYSTEM OF THE UNITED STATES.

§ 45. Patent Privilege in America usually Conferred only by Federal Government: Power of State Governments to Grant Patents.

IN the United States the patent privilege is now conferred by the national government alone. That the individual States possess the power to grant these rights, as part of their inherent sovereignty, is generally conceded, and has been formally recognized both by Congress and the courts.¹ Previous to the establishment of the patent system of the United States many of the States had exercised this power, but as its opera-

§45. ¹ The act of 1793, §7, provides: "That where any State, before its adoption of the present form of government, shall have granted an exclusive right to any invention, the party, claiming that right, shall not be capable of obtaining an exclusive right under this act, but on relinquishing his right under such particular State; and of such relinquishment, his obtaining an exclusive right under this act shall be sufficient evidence."

Among the most notable examples of these State grants is the one out of which grew the case of *Livingston and Fulton v. Van Ingen* (1812), 9 Johns. 507. On Mar. 19, 1787, the legislature of the State of New York granted to one John Fitch the sole and exclusive right and privilege of making and using boats, propelled by fire or steam, within the waters of that State for the period of fourteen years. Fitch failed to ex-

ercise this right, and on Mar. 27, 1798, his patent was repealed, and the same privileges were conferred on Robert R. Livingston for the ensuing twenty years. Livingston's efforts were also fruitless, but Robert Fulton having at last succeeded in constructing a boat that could be moved by steam, the Livingston patent was extended on April 5, 1803, to embrace Fulton also, and its duration fixed conditionally at twenty years from the date of the extending act. While the steamboats of these patentees were in operation, James Van Ingen and others engaged in a similar enterprise, and against these a bill for an injunction was filed by Livingston and Fulton in 1811. The chancellor denied the prayer of the bill, but on appeal to the Court of Errors this judgment was reversed, and a perpetual injunction ordered. Kent, C. J., delivering his opinion in reference to the power of in-

tion was necessarily limited to the territory of the State, the practical protection afforded to the inventor by such grants was comparatively worthless.² And since it became possible, by one act emanating from the central government, to secure these exclusive privileges throughout the entire nation, inventors have, with scarcely an exception, sought and received their patents from the Federal authority.

**§ 46. Patent Privilege Authorized by Federal Constitution:
Powers of Congress.**

The power of the United States to clothe inventors with their exclusive privileges is derived from the following clause in the eighth section of the first article of the Constitution: "The Congress shall have power . . . to promote the progress of Science and useful Arts, by securing, for limited Times, to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." The authority thus conferred on Congress is unrestricted as to the method of its exercise. The subject of the exclusive right must be a writing or discovery of the person to whom the right is granted, and the period during which the right may be enjoyed must be determined by the letter of the grant.¹ As to all other matters Congress

dividual States to grant such patents, says: (581) "If the grant is not inconsistent with the power of Congress to regulate commerce, there is as little pretence to hold it repugnant to the power to grant patents. That power only secures, for a limited time, to authors and inventors, the exclusive privilege to their writings and discoveries; and as it is not granted, by exclusive words, to the United States, nor prohibited to the individual States, it is a concurrent power which may be exercised by the States, in a variety of cases, without any infringement of the Congressional power. A State cannot take away from an individual his patent right, and render it common to all the citizens. This would contravene the Act of Congress, and would be, therefore, unlawful.

But if an author or inventor, instead of resorting to the Act of Congress, should apply to the legislature of this State for an exclusive right to his production, I see nothing to hinder the State from granting it, and the operation of the grant would, of course, be confined to the limits of this State. Within our own jurisdiction, it would be complete and perfect. So a patentee under the Act of Congress may have the time of his monopoly extended by the legislature of any State, beyond the term of fourteen or twenty-eight years allowed by that law."

² Law. Dig. (States, 11).

§ 46. ¹ In *Graham v. Johnston* (1884), 21 Fed. Rep. 40, Morris, J. : (42) "The theory of the encouragement given to inventors is, that by disclosing under the

is supreme. It may refuse all privileges whatsoever. It may bestow them with or without conditions. It may establish such a period for their duration as it deems expedient. It may exhaust its powers by special grants to individual authors and inventors, or by a general law award to all a uniform protection. Its action may be retrospective or prospective, as long as vested rights are not impaired.² The effect of its

regulations of law their discoveries they benefit the public, and the constitutional power of Congress for securing to them the exclusive right to their inventions has only one restriction, viz. : that it shall be for limited times. With regard to the terms upon which the exclusive right shall be granted, the time when the application for the original grant or for any renewal or extension of it shall be made, it has been frequently held that the regulations in these matters are merely self-imposed restrictions on the constitutional power of Congress, which it can at pleasure disregard in any particular case. Walker Pat., § 255."

In *Livingston and Fulton v. Van Ingen* (1812), 9 Johns. 507, Kent, C. J. : (583) "It seems to be admitted that Congress are authorized to grant patents only to the *inventor* of the useful art. . . . There cannot, then, be any aid or encouragement, by means of an exclusive right under the law of the United States, to importers from abroad of any useful invention or improvement."

In *Blanchard v. Sprague* (1839), 3 Sumner, 535, Story, J. : (541) "The power is general, to grant to inventors ; and it rests in the sound discretion of Congress to say, when and for what length of time and under what circumstances the patent for an invention shall be granted. . . . All that is required is, that the patentee should be the inventor." 1 Robb, 734 (741).

² In *Graham v. Johnston* (1884), 21 Fed. Rep. 40, Morris, J. : (42) "Special

acts for the relief of particular inventors have often been passed by Congress. *Evans v. Eaton*, 3 Wheat. 454. In the case of *Agawam Co. v. Jordan*, 7 Wall. 583, the Supreme Court sustained a patent which had been extended in pursuance of a special act of Congress, passed more than twenty years after the original patent had expired, and the invention had been free to the public. . . . In *Blanchard v. Sprague*, 2 Story, 170, Mr. Justice Story, speaking of the right of Congress to grant a patent to an inventor whose invention had, at the time of the passage of the act, gone into public use, says that the question is set at rest by *Evans v. Eaton*, and that he had never doubted the constitutional authority of Congress to make such a grant. The right which the public has acquired to use the thing invented, by reason of the applicant for a patent failing to do something prescribed by Congress, and the necessity for which Congress might, by previous legislation, have dispensed with, has never been held to be a vested right."

In *Bloomer v. Stolley* (1850), 5 McLean, 158, McLean, J. : (161) "There would seem to be no doubt that the constitutional power in question might have been fully exercised by Congress in making special grants ; . . . but this would be a question of expediency and not of constitutional power. . . . (162) The machinery through which this right is ordinarily applied for, and obtained, may be dispensed with, and the title may be conferred by a legislative grant ;

enactments is co-extensive with the territory of the United States,³ and no State can disturb or modify either the privileges

and this may be done in regard to the extension of an exclusive right by Congress, the same as in originally granting it."

In *McClurg v. Kingsland* (1843), 1 How. 202, Baldwin, J., speaking of the patent laws: (206) "Though they may be retrospective in their operation, that is not a sound objection to their validity; the power of Congress to legislate upon the subject of patents is plenary by the terms of the Constitution, and as there are no restraints on its exercise, there can be no limitation of their right to modify them at their pleasure, so that they do not take away the rights of property in existing patents." 2 Robb, 105 (110).

For examples of the exercise of its more extraordinary powers on this subject, see the following cases:—

The grant of a patent, or a renewal, for an invention already in public use, *Evans v. Jordan* (1813), 1 Brock. 248; 1 Robb, 20; *Evans v. Jordan* (1815), 9 Cranch, 199; 1 Robb, 57; *Blanchard v. Sprague* (1839), 3 Sumner, 535; 1 Robb, 734; *Jordan v. Dobson* (1870), 4 Fisher, 232.

The grant of special extensions, *Blanchard's Gun-Stock Turning Factory v. Warner* (1848), 1 Blatch. 258; *Bloomer v. Stolley* (1850), 5 McLean, 158; *Bloomer v. McQuewan* (1852), 14 How. 539.

That all the rights and remedies of inventors rest on the Constitution and the acts of Congress, and where these are silent no right or remedy exists, see *United States v. American Bell Telephone Co.* (1887), 41 O. G. 123; 32 Fed. Rep. 591. But see § 10 and notes.

That the powers of Congress are unlimited except as to time of grant, see *Graham v. Johnston* (1884), 21 Fed. Rep. 40.

That special acts of Congress are valid though privative of common right, see

Graham v. Johnston (1884), 21 Fed. Rep. 40.

³ In *Brown v. Duchesne* (1856), 19 How. 183, Taney, C. J., speaking of the power of Congress to confer patents for inventions: (195) "The power thus granted is domestic in its character, and necessarily confined within the limits of the United States. It confers no power on Congress to regulate commerce, or the vehicles of commerce, which belong to a foreign nation, and occasionally visit our ports in their commercial pursuits. . . . Nor is there anything in the patent laws that should lead to a different conclusion. They are all manifestly intended to carry into execution this particular power. They secure to the inventor a just remuneration from those who derive a profit or advantage, within the United States, from his genius and mental labors. . . . But these acts of Congress do not, and were not intended to, operate beyond the limits of the United States; and as the patentee's right of property and exclusive use is derived from them, they cannot extend beyond the limits to which the law itself is confined." In pursuance of this rule it was held in this case that the use, on a foreign vessel in an American port, of an invention patented in the United States, is no infringement of the patentee's rights.

In *Gardiner v. Howe* (1865), 2 Clifford, 462, the limits of the United States, for this purpose, were regarded as including American vessels on the high seas. Clifford, J.: (464) "The patent laws of the United States afford no protection to inventions beyond or outside of the jurisdiction of the United States; but this jurisdiction extends to the decks of American vessels on the high seas, as much as it does to all the territory of the country."

which it creates or their enjoyment by the persons on whom they are bestowed.⁴

⁴ In *People v. Russell* (1883), 25 O. G. 504, Cooley, J., speaking of an ordinance imposing a license fee on peddlers, says: (504) "It is objected to the ordinance that if applied to the sale of patented articles it is an interference with the power of Congress to grant exclusive rights to patentees to make and sell their inventions, and an encroachment upon the rights which the patent assures to the patentees. We agree that if this is the case the ordinance can have no such application. The power of Congress to grant the exclusive right to make and sell the articles which from their originality and value have been found deserving, is exclusive, and any State legislation which undertakes to limit or restrict in any manner the privileges which the letters-patent confer is an invasion of the sphere of national authority, and therefore void. This was shown in *Cranson v. Smith*, 37 Mich. 309, and what is said there need not be repeated. But the ordinance in question does not assume to interfere with or in any way to abridge the exclusive rights which the patentee may lay claim to under his patent. The ordinance is a police regulation, made under the general police authority of the State, and taking no notice of this or any other patent, or of the way in which any salable commodity may have come into existence. It is one of the customary regulations for a business. It is well settled now, if it was ever doubted, that any ordinary exercise of Congressional authority does not take from the State any portion of its general power of police. *Pervear v. Commonwealth*, 5 Wall. 475. The acts of Congress assume the existence of State regulations, and in many respects would prove inoperative and confusing if it were other-

wise. The patent laws are as forcible for illustration as any other; they give exclusive rights, but they do not determine personal capacity to contract or prescribe the requisites for sales of patented articles or impose the customary restrictions which are supposed to be important to the protection of public morals. All these matters are left to the State law. The patentee must observe the Sunday law as much as any other vendor; he must put his contracts in writing under the same circumstances which require writings of others, and he must obey all other regulations of police which are made for general observance. *Patterson v. Kentucky*, 97 U. S. 501. Invidious regulations applicable to patentees exclusively might be void; but there is no question of that nature here. We have no doubt that it was competent for the State to confer upon the city the power to pass such an ordinance. That the regulating of hawkers and peddlers is important, if not absolutely essential, may be taken as established by the concurring practice of civilized states. They are a class of persons who travel from place to place among strangers, and the business may easily be made a pretence or a convenience to those whose real purpose is theft or fraud. The requirement of a license gives opportunity for inquiry into antecedents and character and the payment of a fee affords some evidence that the business is not a mere pretence." 49 Mich. 617 (618).

In *Palmer v. State* (1883), 39 Ohio State, 236, Upson, J.: (238) "The patent laws of the United States give to inventors the exclusive right to their inventions, but do not give to them the right to disregard laws enacted to promote the welfare of the whole people.

§ 47. Patent Privilege Conferred by General or Special Acts of Congress.

The acts of Congress, in pursuance of this authority, have been of two classes: (1) Special acts, bestowing upon in-

The State cannot discriminate against patented articles by imposing upon their sale conditions and restrictions not placed upon the sale of other similar articles; but the sale of all articles like those now under consideration, whether patented or not, may be restricted, regulated or forbidden, whenever the public good requires such restriction, regulation, or prohibition."

In *State v. Telephone Co.* (1880), 36 Ohio State, 296, McIlvaine, C. J.: (311) "While it is true, that letters patent secure a monopoly in the thing patented, so that the right to make, vend, or use the same is vested exclusively in the patentee, his heirs and assigns, for a limited period; it is not true, that a right to make, vend, or use the same in a manner which would be unlawful except for the letters patent, thereby becomes lawful, under the act of Congress, and beyond the power of the States to regulate or control. This doctrine is fully discussed and settled in *Jordan v. Overseers of Dayton* (4 Ohio, 295), and *Patterson v. Kentucky* (97 U. S. 501). The doctrine of these cases may be stated thus: the right to enjoy a new and useful invention may be secured to the inventor and protected by national authority against all interference; but the use of tangible property which comes into existence by the application of the discovery is not beyond the control of State legislation, simply because the patentee acquires a monopoly in his discovery."

In *Patterson v. Commonwealth* (1875), 11 Bush, 311, Pryor, J.: (314) "There is a manifest distinction between the right of property in the patent, which carries with it the power on the part of the patentee to assign

it, and the right to sell the property resulting from the invention or patent. A State has no power to say through its legislature that the patentee shall not sell his patent, or that its use shall be common to all of its citizens; for this would be in direct conflict with the law of Congress; and that portion of the opinion referred to, giving the patentee an unrestricted power to sell, has allusion alone to his right of property in the patent right, as that was the only question involved in the case. The discovery or invention is made property by reason of the patent, and this right of property the patentee can dispose of under the law of Congress, and no State legislation can deprive him of this right; but when the fruits of the invention or the article made by reason of the application of the principle discovered is attempted to be sold or used within the jurisdiction of a State, it is subject to its laws, like other property; and such has been the uniform decision of all the courts, State and Federal, upon this question."

In *Ex parte Robinson* (1870), 4 Fisher, 186, Davis, J.: (188) "The property in inventions exists by virtue of the laws of Congress, and no State has a right to interfere with its enjoyment, or to annex conditions to the grant. If the patentee complies with the law of Congress on the subject he has a right to go into the open market anywhere within the United States and sell his property." 2 Bissell, 309 (314). In this case a law of Indiana regulating the sale of patent-rights within that State was held unconstitutional and void.

In support of the same principle see *Hollida v. Hunt* (1873), 70 Ill. 109;

dividual inventors some new or more extensive privilege;
(2) General acts, providing for the issue of grants of privi-

Helm v. First National Bank of Huntington (1873), 43 Ind. 167.

In *Jordan v. Overseers* (1831), 4 Ham. (Ohio) 294, Lane, J. : (309) "The sole operation of the statute, is to enable him to prevent others from using the products of his labours, except with his consent. But his own right of using is not enlarged or affected. There remains in him, as in every other citizen, the power to manage his property, or give direction to his labours, at his pleasure, subject only to the paramount claims of society, which require that his enjoyment may be modified by the exigencies of the community to which he belongs, and regulated by laws, which render it subservient to the general welfare, if held subject to State controul."

That a State statute is not to be so construed as to interfere with the enjoyment of a patent privilege or annex conditions to its grant, see *Grover & Baker Sewing Mach. Co. v. Butler* (1876), 53 Ind. 454.

That a State law imposing unusual burdens on the vendors of patent-rights is unconstitutional, see *Wilch v. Phelps* (1883), 14 Brown (Neb.), 134 ; 25 O. G. 981.

That a State has no power to require the vendor of *patent-rights* to procure a State license to do so, see *State v. Butler* (1879), 3 Lea, 222.

That a State has power to protect its citizens against fraud in the sale of patent-rights by requiring the vendor to file and record his patent and statement of his title in the county where it is offered for sale, see *New v. Walker*, (1886), 108 Ind. 365; *Brechbill v. Randall* (1885), 102 Ind. 528.

That a foreign corporation cannot be compelled to comply with certain State provisions as a condition of its power to sell or license under its patents within

such States, see *Shook v. Singer Mfg. Co.* (1878), 61 Ind. 520; *Grover & Baker Sewing Mach. Co. v. Butler* (1876), 53 Ind. 454; *Wood Mowing & Reaping Mach. Co. v. Caldwell* (1876), 54 Ind. 270.

That a State cannot pass laws regulating the sale of patent-rights, see *People v. Russell* (1883), 49 Mich. 617; 25 O. G. 504; *Crittenden v. White* (1876), 23 Minn. 24; *Patterson v. Com.* (1875), 11 Bush (Ky.), 311; *Hollida v. Hunt* (1873), 70 Ill. 109.

That a State cannot discriminate against notes taken for patent-rights, see *Hollida v. Hunt* (1873), 70 Ill. 109.

That a State may pass a law requiring notes or bonds given for a patent-right to state that fact on the face of the instrument, see *New v. Walker* (1886), 108 Ind. 365; *Herdie v. Roessler* (1886), 39 Hun, 198; *Tod v. Wick Bros.* (1881), 36 Ohio St. 370; *Haskell v. Jones* (1878), 86 Pa. St. 173. *Contra*, *Castle v. Hutchinson* (1885), 25 Fed. Rep. 394; *Cranson v. Smith* (1877), 37 Mich. 309; *Helm v. First National Bank of Huntington* (1873), 43 Ind. 167.

That where a State law requires that a note or bond given for a patent-right shall disclose that fact on its face, a note not disclosing it is open to all defences which could be made if it had contained such disclosure, see *New v. Walker* (1886), 108 Ind. 365; *Tod v. Wick Bros.* (1881), 36 Ohio St. 370.

That a State has power to regulate the transfer of notes which were originally given for an interest in a patent, see *Domestic Sewing Mach. Co. v. Hatfield* (1877), 58 Ind. 187.

That the States cannot be deprived of their police powers by any ordinary act of Congress, see *People v. Russell* (1883), 49 Mich. 617 ; 25 O. G. 504.

That the patent laws confer rights

lege by some department of the government to any person who might be found to be entitled to them. Each of the former is independent of all others of its class, but is considered as engrafted on the general acts, and is construed in harmony with them as far as its own language will permit.¹ The latter

but do not determine contracting powers or prescribe requisites for sales, see *People v. Russell* (1883), 49 Mich. 617 ; 25 O. G. 504.

That a patentee's right to use and sell his invention is subject to State law, see *In re Brosnahan* (1883), 4 McCrary, 1 ; 18 Fed. Rep. 62.

That a State has power to regulate the sale of the patented article and of the products of patented processes, see *Patterson v. Com.* (1875), 11 Bush (Ky.), 311.

That a State may require a pedler to take out a license though the articles he sells are patented and he is the patentee, see *People v. Russell* (1883), 49 Mich. 617 ; 25 O. G. 504 ; *Webber v. Virginia* (1881), 103 U. S. 344 ; 20 O. G. 369.

That a State may protect its citizens against unwholesome food by requiring that a label stating its ingredients be placed on each package, and to such a requirement a patent for the composition of matter is no defence, see *Palmer v. State* (1883), 39 Ohio St. 236.

That the States have power to regulate the use of the invention, see *State v. Telephone Co.* (1880), 36 Ohio St. 296.

That where the use of an invention requires an exercise of the right of eminent domain, the State may impose such conditions on the right as it deems necessary, see *State v. Telephone Co.* (1880), 36 Ohio St. 296.

That a State may regulate the use of property resulting from the enjoyment of the invention, see *Halkett v. State* (1885), 105 Ind. 250.

That a State may fix a maximum

charge for the use of patented inventions, see *Central Union Telephone Co. v. Bradbury* (1885), 106 Ind. 1.

That a patent for a medicine does not authorize any person to administer it without obtaining the State license required by law, see *Thompson v. Staats* (1836), 15 Wend. 395 ; *Jordan v. Overseers* (1831), 4 Ham. (Ohio) 294.

That a State law prohibiting lotteries cannot be violated under pretence of exercising a right under the patent laws, see *Vannini v. Paine* (1833), 1 Harr. (Del.) 65.

The summation of the law on this somewhat involved topic seems to be: (1) That the monopoly conferred by the United States upon the patentee is entirely distinct, in law, from his property in the art or instrument protected by the patent, *Bloomer v. McQuewan* (1852), 14 How. 539 ; (2) That States have no power to interfere with the enjoyment or disposition of the monopoly created by the issue of letters-patent ; (3) That States have power to regulate the manufacture, use, and sale of the invention protected by the patent so far as public policy may require ; (4) That States have no power to discriminate against patented inventions on the ground that they are patented ; (5) That contracts between the patentee and others in reference to the invention are governed by State laws.

See also *Wilson v. Sandford* (1850), 10 How. 99 ; § 1242 and notes, *post*.

§ 47. ¹ In *Evans v. Eaton* (1818), 3 Wheaton, 454, as to one of these special acts, Marshall, C. J., said (518) that it is "engrafted on the general act for the promotion of useful arts, and that the

were intended to establish and develop a permanent patent-system, by which the reciprocal rights of the inventor and the public might be carefully determined and thoroughly secured. These, and the decisions of the courts upon them, constitute the body of the American Patent Law.

§ 48. Patent Privilege under General Acts of Congress: History of the Patent System of the United States.

Congress inaugurated the patent system of the United States by an act passed in A. D. 1790.¹ By this act it im-

patent is issued in pursuance of both." 1 Robb, 243 (286).

In *Bloomer v. McQuewan* (1852), 14 How. 539, Taney, J.: (548) "We must take into consideration not only the special act under which the appellant now claims a monopoly, but also the general laws of Congress in relation to patents for useful improvements. . . . They are statutes *in pari materia*; and all relate to the same subject and must be construed together."

§ 48. ¹ The following epitome of the various general acts of Congress, relating to patents for inventions, will show at once the scope of legislation, and the development of positive patent law:—

Act of 1790:—

Sec. 1. Patent to issue to inventor for fourteen years, on application; record to be made thereof.

Sec. 2. Patentee to file a full description, with drawings and model, when applicable.

Sec. 3. Copies of specification, &c., furnished to all persons.

Sec. 4. Penalty for infringement.

Sec. 5. Proceedings to repeal unlawful patents.

Sec. 6. Patents and specifications *prim. facie* evidence of patentee's right to patent; but statements of specification may be disputed by defendant; and, if it be excessive or defective, defendant to prevail.

Sec. 7. Fees for issue of patents.

Act of 1793:—

Sec. 1. Patent to issue to inventor for fourteen years, on application; record to be made thereof.

Sec. 2. Patentee of an improvement not entitled to use original invention, or *vice versa*; changes of form or proportions not invention.

Sec. 3. Patentee to make oath that he believes himself the true inventor, and to file a full specification, with drawings and model when applicable.

Sec. 4. Interest in patent privilege assignable; record of assignment, &c.

Sec. 5. Penalty for infringement.

Sec. 6. Defendant may attack patent on ground of fraudulent excess or defect in specification, or prior use, or publication, or piracy by patentee from prior inventor.

Sec. 7. State patents to be relinquished by patentees of United States.

Sec. 8. Saving existing applications for patents.

Sec. 9. Proceedings in case of interfering applications.

Sec. 10. Proceedings to repeal unlawful patents.

Sec. 11. Fees for issue of patents.

Sec. 12. Repeal of act of 1790, saving existing rights.

Act of 1794:—

Sec. 1. Saving suits commenced under act of 1790 from defeat by its repeal in 1793.

posed upon the Secretary of State, the Secretary of War, and the Attorney-General, or any two of them, the duty of grant-

Act of 1800 :—

Sec. 1. Extends privileges of act of 1793 to resident aliens ; oath to be made by every applicant that to the best of his knowledge the invention was never before known or used in this or any foreign country ; such use to avoid patent if obtained.

Sec. 2. Representatives of deceased inventor may obtain patent in trust for heirs or devisees.

Sec. 3. Penalty for infringement.

Sec. 4. Repeals fifth section of act of 1793.

Act of 1819 :—

Sec. 1. Circuit courts of United States to have original cognizance, at law and equity, of actions under patent laws, with writ of error or appeal to Supreme Court.

Act of 1832, ch. 162 :—

Sec. 1. Annual publication of list of patents for preceding year.

Sec. 2. Proceedings before Congress for an extension.

Sec. 3. Proceedings for reissue of patent on account of defect in original.

Act of 1832, ch. 203 :—

Sec. 1. Extending privilege of alien patentees ; requires actual use in United States within one year after date of patent.

Act of 1836 :—

Sec. 1. Establishes Patent Office under commissioner ; duties of commissioner.

Sec. 2. Duties of chief clerk and other clerks.

Sec. 3. Oath and official bond of commissioner, &c.

Sec. 4. Seal of Office ; copies of records.

Sec. 5. Form of patent.

Sec. 6. Patent to issue to inventor of new and useful art, machine, manu-

facture, or composition of matter, or an improvement thereon, not before known or used by others, or in public use or on sale at time of application, provided full specification, drawings, and model be filed ; oath required that patentee believes himself the first inventor, and does not know of its prior use or knowledge.

Sec. 7. Commissioner to have examination made as to novelty of the invention, and inform applicant of result thereof ; fees to be paid ; appeal from this finding regulated.

Sec. 8. Proceedings when application interferes with an existing patent ; foreign patent to same applicant no bar to one in the United States within six months after issue of former ; when patent may be dated.

Sec. 9. Fees for patents.

Sec. 10. Representatives of deceased inventor may take out patent in trust for heirs or devisees.

Sec. 11. Patents to be assignable ; record thereof.

Sec. 12. Proceedings as to *caveat* ; effect of and proceedings under same ; judgment in Patent Office not binding on courts on question of validity of patents.

Sec. 13. Proceedings as to reissues ; improvements subsequently invented may be annexed to existing patents.

Sec. 14. Penalty for infringement.

Sec. 15. Notice of special defences ; fraudulent specification ; patentee not first inventor ; prior publication ; prior public use or sale ; piracy of the invention by patentee from another ; failure of alien patentee to introduce the invention into public use in the United States in due time ; provides that if prior use or knowledge abroad is without the cognizance of patentee, the patent shall be good.

ing to every inventor, whose discovery they deemed sufficiently useful and important, a patent securing to him the exclusive

Sec. 16. Proceedings to repeal interfering patent by rival patentee or applicant; and to obtain patent when interfering application rejected by Patent Office.

Sec. 17. Original jurisdiction of all actions, under the patent laws, to be in circuit courts of the United States with writ of error or appeal to Supreme Court.

Sec. 18. Proceedings in Patent Office for an extension.

Sec. 19. Provides for Patent Office Library.

Sec. 20. Models and specimens to be classified and arranged for public inspection.

Sec. 21. Repeals all former patent laws; saving pending actions and applications.

Act of 1837, passed in part to remedy evils caused by destruction of Patent Office by fire Dec. 15, 1836:—

Sec. 1. Patents issued before Dec. 15, 1836, and assignments thereof, to be recorded in Patent Office without charge; drawings may be reproduced; clerks of courts to furnish copies to Patent Office of all such patents, &c., in their possession.

Sec. 2. Copies of such record to be *prima facie* evidence; originals not to be evidence unless recorded.

Sec. 3. New patent to issue on deposit of a duplicate, as near as may be, of the model, drawings, and specifications of the old; copies and new patents made evidence.

Sec. 4. Models destroyed to be duplicated where important.

Sec. 5. Provides for reissue of several patents for the different inventions embraced in the original; models and drawings to be deposited if former ones were destroyed.

Sec. 6. Patent may issue to assignee

at request of, and on application by, inventor.

Sec. 7. Proceedings in disclaimer.

Sec. 8. Application for reissue, or to annex an improvement to an existing patent, to be subject to same examination as original.

Sec. 9. Patent not invalid for what is properly claimed, by reason of excessive claim; costs and disclaimer.

Sec. 10. Agents to receive and forward models, &c., to Patent Office.

Sec. 11. Additional clerks.

Sec. 12. If application of foreigner rejected, fees, in part, refunded.

Sec. 13. Oath and affirmation of patentee.

Sec. 14. Funds of Patent Office; annual list of patents to be published, &c.

Act of 1839:—

Secs. 1 and 2. Additional examiners and clerks.

Sec. 3. Publication of classified and alphabetical list of all patents heretofore granted.

Secs. 4. and 5. Appropriations.

Sec. 6. Foreign patent for same invention within previous six months not to defeat an application, if there has been no public use in the United States; in such cases domestic patent to run fourteen years from date of foreign patent.

Sec. 7. Owner of an invention, before application by the inventor for a patent, may continue its use or sale after patent granted; no patent invalid by reason of such prior ownership, use, or sale, unless invention were abandoned by inventor, or were in use or sale more than two years before his application.

Sec. 8. Assignments, &c., recorded without charge.

Sec. 9. Appropriation for agricultural purposes.

benefits of his invention for a period not exceeding fourteen years. The same act prescribed the mode in which the

Sec. 10. Bill in equity for a patent, when application is refused by Patent Office.

Sec. 11. Appeal from commissioner to Chief-Justice of District Court for District of Columbia.

Sec. 12. Commissioner to make rules for taking evidence in cases in the Patent Office.

Sec. 13. Appropriation.

Act of 1842 :—

Sec. 1. Fees paid by mistake refunded.

Sec. 2. Act of 1837, sec. 3, extended to patents issued prior to Dec. 15, 1836, but subsequently lost.

Sec. 3. Patents may be granted for new designs for seven years.

Sec. 4. Before whom patentee may make oath.

Sec. 5. Penalty for marking "patented," &c., on unpatented articles, or for imitating the mark of a patentee.

Sec. 6. Patented articles to be marked with date of patent.

Act of 1846 :—

Sec. 1. Payment and deposit of funds for Patent Office.

Act of 1848 :—

Sec. 1. Additional examiners ; power to extend patents vested in commissioner.

Sec. 2. Recording fee of assignments, &c.

Sec. 3. Additional clerks.

Sec. 4. Commissioner to have freedom of mails for distributing annual reports.

Act of 1849, chap. 108 :—

Sec. 2. Patent Office removed to the Interior Department.

Act of 1852 :—

Sec. 1. Appeals, now made to Chief-Justice of District Court of United States for the District of Columbia, may be also taken to either of the assistant-

judges of the Circuit Court for said district.

Sec. 2. Compensation of such judges.

Sec. 3. Repeals sec. 13, act of 1839.

Act of 1861, chap. 37 :—

Sec. 1. Writ of error or appeal from Circuit Court to Supreme Court in patent cases, at instance of either party.

Act of 1861, chap. 88 :—

Sec. 1. Proceedings in taking testimony for use in Patent Office.

Sec. 2. Examiners-in-chief "of legal knowledge and scientific ability," appointed to revise decisions of examiners when necessary, &c.

Sec. 3. Except in interference cases no appeal allowed to examiners-in-chief till application has been twice rejected by examiners, &c.

Sec. 4. Salaries.

Sec. 5. Models may be restored to rejected applicants.

Sec. 6. Sec. 10, act of 1837 repealed.

Sec. 7. Commissioner may appoint new examiners.

Sec. 8. Commissioner may require illegible applications, &c., to be printed ; may refuse to recognize any person as a patent solicitor, subject to approval of President.

Sec. 9. No fees to be refunded.

Sec. 10. Revision of fee-table.

Sec. 11. Inventors of new designs may patent the same for three and a half years, seven years, or fourteen years as they desire ; fees established ; existing design patents may be extended.

Sec. 12. Applications for patents to be regarded as abandoned when not completed and prepared for examination within two years after filing, unless cause shown ; time of filing applications for extensions.

Sec. 13. Patented articles to be so marked on article or package ; otherwise

application for a patent should be made, the conditions on which it should be granted, the proceedings by which it might be annulled, and the remedies for its violation by infringement. In A. D. 1793 the duty of issuing these patents was confided to the Secretary of State, subject to the approval of the Attorney-General. In A. D. 1836, the necessities of inventors having outgrown the capacity of the State Department as then constituted, a sub-department was created, known as the Patent Office, to which the powers and duties of the Secretary, in reference to patents, were transferred. At the same time the entire system was reconstructed, many new and valuable elements were added, and the rights and obligations of inventors were established very nearly as they now exist. In A. D. 1849 the Patent Office was removed to the Department of the Interior, a division of which it has ever since remained. In A. D. 1870 a further improvement of the law took place, which was confirmed and re-enacted in the Revision of 1874. Besides these acts, others of minor importance have from time to time been passed, amending or extending the subordinate provisions of the law.

infringer not liable to pay damages unless he knew of his infringement; sec. 6, act of 1842 repealed.

Sec. 14. Printing and disposal of ten copies of each patent, specification, and drawings.

Sec. 15. Printed copies of patent, duly sealed and certified by the commissioner to be legal evidence.

Sec. 16. Term of patents to be seventeen years; and no extension of such patents.

Sec. 17. Repeal of inconsistent acts.

Act of 1863:—

Sec. 1. Renewal of oath on appeal as required by sec. 7, act of 1836, unnecessary.

Sec. 2. Compensation of examiners, &c.

Sec. 3. Every patent to be dated not later than six months after notice of its allowance to patentee or his agent; if

final fees not paid within the six months, the invention to become public property.

Act of 1865:—

Sec. 1. When final fee unpaid in due time, a new application may be filed within two years from date of allowance of original application.

Act of 1868:—

Chap. 227. Examiner-in-chief of longest official experience to act as commissioner in case of absence or disability of commissioner.

Act of 1870:—

This act — as amended in act of 1871, chaps. 5 and 132, and joint resolution of 1871, No. 5 — is still in force, and forms part of the Revision of 1874.

The foregoing summary does not include acts whose sole purpose was the appointment of officials or the granting of appropriations.

§ 49. Condition of the Patent System of the United States before the Act of 1836: Patents Granted without Examination.

The principal features of the present patent system had their origin in the act of 1836. This act marked a new epoch in patent legislation in this country, and has been of inestimable benefit both to inventors and the public. Under the English law patents were granted upon the simple application of the inventor, and without investigation as to the novelty or utility of his invention.¹ The same practice prevailed in the United States until the act in question, the patentee receiving his grant entirely at his own risk of its subsequent defeat by the proof of any use or knowledge of the invention prior to his own, and yet having no method of ascertaining whether such use existed, except the tedious, expensive, and uncertain one of private inquiry.² A patent thus situated was necessarily of small commercial value. Few men would risk their capital on the chance of its validity; and if, as often was the case, the patentee was without means to develop his invention, it became either wholly useless to himself as well as to the public, or gave him his reward after long years of suffering and discouragement.

§ 49. ¹ Simonds : (222) "No examination is made as to novelty, or utility, and the patent issues as a matter of course, unless some private person enters an opposition and shows good reason why a patent should not be granted."

² Under the act of 1790, the patent was to issue upon the simple application of the inventor, alleging and describing his discovery, if the Secretary of State, Secretary of War, and the Attorney-General, or any two of them, deemed it sufficiently useful and important.

Under the act of 1793, the patent issued on application and publication, with oath of the inventor as to novelty.

On complying with these conditions the applicant was entitled to his patent as matter of right.

In *Grant v. Raymond* (1832), 6 Peters, 218, Marshall, C. J. : (241) "The Secretary of State may be considered, in issuing patents, as a ministerial officer. If the prerequisites of the law be complied with, he can exercise no judgment on the question whether the patent shall be issued." 1 Robb, 604 (632). See also *Pennock v. Dialogue* (1829), 2 Peters, 1; 1 Robb, 542; *Whitney v. Emmett* (1831), Baldwin, 303; 1 Robb, 567.

§ 50. Changes introduced by the Act of 1836: Patents granted only after due Examination.

By the act of 1836 Congress undertook to relieve inventors from this difficulty, as far as possible, by providing a tribunal before which the right of the inventor to his patent might be examined and determined prior to its issue, and at a minimum of trouble and expense. For this purpose it established a bureau, or department of the government, having both executive and judicial powers, and imposed on it the duty of thoroughly investigating all the questions on which the validity of the proposed patent might depend, and of granting it to the inventor only when such investigation disclosed no probability of its defeat by subsequent litigation.¹ A patent thus granted could, of course, be reasonably trusted. The capitalist might venture his fortune in developing the inventions which it protects, with as much security as attends ordinary commercial operations. The meritorious inventor was no longer condemned to interminable waiting and unrewarded self-sacrifice. The discoverer of anything pronounced by the Patent Office to be new and useful acquired thereby a property which had market value, and to which he could give a title as reliable as that to any other form of personal estate.²

§ 50. ¹ Act of 1836, § 7. On the filing of the application and description "the Commissioner shall make or cause to be made an examination of the alleged new invention or discovery; and if on any such examination it shall not appear to the Commissioner that the same had been invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant, or that it had been patented or described in any printed publication in this or any foreign country, or had been in public use or on sale with the applicant's consent or allowance prior to the application, if the Commissioner shall deem it to be sufficiently useful and important, it shall be his duty to issue a patent therefor. But whenever, on such examination it shall appear to the Commissioner that the ap-

plicant was not the original and first inventor or discoverer thereof, or that any part of that which is claimed as new had before been invented or discovered, or patented or described in any printed publication in this or any foreign country, as aforesaid, or that the description is defective and insufficient, he shall notify the applicant thereof, giving him, briefly, such information and references as may be useful in judging of the propriety of renewing his application, or of altering his specification to embrace only that part of the invention or discovery which is new."

² The confidence hitherto engendered by the supposed reliability of patents which have sustained the scrutiny of the Patent Office is not likely to be long preserved, if certain positions now asserted receive permanent indorsement in

§ 51. Organization of the Patent Office: Its Officers and their Duties.

The organization of the Patent Office consists of a Commissioner of patents, an assistant-commissioner, a board of examiners-in-chief, and a large staff of subordinate clerks, examiners, draughtsmen, and attendants. It is the duty of the Commissioner, acting personally or through the assistant, to superintend or perform all operations concerning the issuing of patents as directed by law, and to have charge of all the records, apparatus, and other property belonging to the Office.¹

the courts. If every decision of the Commissioner which involves a question of law is open to review; if every reissue is liable to be declared invalid because the court before which it is attacked cannot find in the original a claim for the invention embraced in the reissue; if the public use of an invention by a rival but later inventor, without the knowledge of the first and true inventor, more than two years before the latter's application for a patent, is *ipso facto* a bar to the issue of such patent, though no fault of omission or commission can be imputed to the true inventor; if the opinion of a judge upon the bench, who however skilled in law must seldom be profoundly versed in the chemical or mechanic arts, can outweigh the deliberate judgment of trained experts in the Patent Office on the question of the presence of inventive as distinguished from mechanical skill, and that upon his mere inspection without evidence, as certain cases hold, — the value of a patent is too precarious to warrant large investments on the faith of its validity. Not even multitudinous decisions in its favor can much increase the confidence of capitalists, since it may often happen that after every meritorious defence has been exploded, some obscure event, whose sole importance is dependent on a technical construction of the statutes, will become a pebble in the judicial sling to smite a gigantic but

beneficent monopoly into the dust. See *Andrews v. Hovey* (1887), 123 U. S. 267; 42 O. G. 1284.

§ 51. ¹ Rev. Stat. 1874, sec. 475. "There shall be in the Department of the Interior an office known as the Patent Office, where all records, books, models, drawings, specifications, and other papers and things pertaining to patents shall be safely kept and preserved."

Sec. 476. "There shall be in the Patent Office a Commissioner of Patents, one Assistant Commissioner, and three examiners-in-chief, who shall be appointed by the President by and with the advice and consent of the Senate. All other officers, clerks, and employees authorized by law for the Office shall be appointed by the Secretary of the Interior, upon the nomination of the Commissioner of Patents."

Sec. 481. "The Commissioner of Patents under the direction of the Secretary of the Interior shall superintend or perform all duties respecting the granting and issuing of patents directed by law; and he shall have charge of all books, records, papers, models, machines, and other things belonging to the Patent Office."

Under § 178, in the absence of the Commissioner from any cause, his assistant, deputy, or chief clerk becomes the "Acting Commissioner." Patents certified and signed by the "Acting Commissioner" are of the same force as

He has power to establish such regulations, not inconsistent with law, as he may, from time to time, deem proper for the conduct of proceedings in his department.² He is the final judge, so far as the Patent Office is concerned, of all controverted questions arising in the Office, and in granting or withholding patents he is not bound by the decisions of his inferiors.³ The examiners-in-chief are by law required to be persons of competent legal knowledge and scientific ability. It is their duty, on the written application of the inventor, to revise and determine upon the correctness of such decisions of the subordinate examiners as may be alleged to be erroneous,

if issued by the Commissioner himself, and the presumption is that the officer so certifying is the "Acting Commissioner," and that sufficient reason existed for his appointment as such. *Wilson v. Rousseau* (1846), 4 How. 646; 2 Robb, 372; *Woodworth v. Hall* (1846), 1 W. & M. 389; 2 Robb, 517; *York & Mary. R. R. Co. v. Winans* (1854), 17 How. 30; *Dorsey Co. v. Marsh* (1873), 6 Fisher, 387.

² Rev. Stat. 1874, § 483. "The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office."

The rules established by the Commissioner are, until abrogated, as binding as the law itself, not only upon him and his inferior officers, but also upon parties doing business with his department. If they contravene a statute, however, the statute prevails. Law Dig. (Rules of Patent Office); *Stone v. Greaves* (1879), 17 O. G. 260; *Brown v. La Dow* (1880), 18 O. G. 1049.

³ Rev. Stat. 1874, § 4893. "On the filing of any such application and the payment of the fees required by law, the Commissioner of Patents shall cause an examination to be made of the alleged new invention or discovery;

and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the Commissioner shall issue a patent therefor."

In *Wilder v. McCormick* (1846), 2 Blatch. 31, Betts, J. (34): "The grant of the patent is itself sufficient evidence that all the preliminary steps required by law were properly taken. . . . (35) The question of the regularity of the proceedings in petitioning for and obtaining the patent, and that of the correctness of the judgment of the officer in awarding it . . . cannot be inquired into."

In *Stone v. Greaves* (1880), 17 O. G. 397, Doolittle, A. C. (398): "It has been inferred from the language of section 4893 that the Commissioner can simply direct an examination of an application, and that when by that examination it shall appear to the subordinate person or tribunal who has made the examination that the claimant is justly entitled to a patent under the law, the Commissioner, *nolens volens*, shall issue the patent. This is a strained construction of the section and one opposed to the language of the other sections cited. The power to direct an examination under the section in question is incidental to the general powers conferred upon the Commissioner by

and to perform such other similar labors as the Commissioner may assign to them.⁴ The qualifications and duties of the remaining clerks, examiners, and other officers of the department are left to the discretion of the appointing power and the Commissioner.

§ 52. Functions of Patent Office: Examination of Inventions claimed to be Patentable.

The principal functions of the Patent Office, in addition to the formal issuing of letters-patent, are three: (1) To determine whether an alleged invention is in itself patentable; (2) To settle the disputes arising between rival claimants of the same invention; (3) To disseminate among the public the best and most exhaustive information concerning the

section 481 concerning 'all duties respecting the granting and issuing of patents directed by law.' The section does not state whom the Commissioner shall cause to make the examination, nor does it require that it shall be made to appear to the examiner, or other person than the Commissioner, that the claimant is justly entitled to a patent; and in this absence of control or exercise of final judgment expressly given any other officer of the question of patentability, it is both reasonable and necessary to conclude that such control and judgment should be exercised by the officer causing the examination to be made, who alone is permitted to issue the patent, and . . . that the Commissioner can and should stay the grant or issuance of a patent at any time before its delivery if convinced that such issuance would be contrary to any requirement of law."

See also *Hull v. Com.* (1875), 2 McArthur, 90; 7 O. G. 559; *Ex parte Neale* (1879), 15 O. G. 511; *Hoe v. Cottrell* (1880), 18 O. G. 59; 17 Blatch. 546; 1 Fed. Rep. 597; 5 Bann. & A. 256; *McKay, Tr. v. Dibert* (1881), 19 O. G. 1351; 5 Fed. Rep. 587.

⁴ Rev. Stat. 1874, § 482. "The examiners-in-chief shall be persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the appellant, to revise and determine upon the validity of the adverse decisions of examiners upon applications for patents, and for reissues of patents, and in interference cases; and, when required by the Commissioner, they shall hear and report upon claims for extensions, and perform such other like duties as he may assign them."

§ 4910. "If such party is dissatisfied with the decision of the examiners-in-chief, he may, on payment of the fee prescribed, appeal to the Commissioner in person."

In *Snowden v. Pierce* (1861), cited Law Dig. (Examiners, 6-9), it was held that before the act of 1861 all judicial acts done in the Patent Office were in intendment of law done by the Commissioner. But under the act of 1861 the examiners-in-chief became judicial officers, independent of the Commissioner, to whom their proceedings may be brought for review by appeal.

existing state of the industrial arts. Of these three functions the former is at once the most onerous and the most important. The number of applications yearly filed exceeds twenty thousand. The inventions described in them belong to every division and subdivision of human employments. The patentable difference between any one of these and preceding inventions may be difficult of detection and yet really exist. Its discovery may involve the examination of every article of the same species used in this country, or patented or described in any printed publication at home or abroad. Such an investigation requires not only the services of a large body of skilled examiners, but also the most thorough systemization of their labor.

§ 53. Functions of Patent Office : Mode of Examining Inventions.

To secure the necessary accuracy and expedition in this work all known industries are divided into classes, embracing almost every species of material products. These classes are again grouped into divisions, cognate classes being kept as far as possible in the same division, and each division is assigned to certain examiners who are familiar with the classes of products of which it consists. On the receipt of a new application it is referred to the appropriate examiner, and the result of his investigation is reported to the applicant. If the invention is found patentable, and no rival claims to be the first inventor, the patent is allowed; if found not patentable, a further hearing can be had upon appeal. This examination results in the final rejection of about one third of all the applications filed. On the assumption that these rejections are on sufficient grounds, the public are thus saved from the infliction of several thousand worthless patents every year, while the applicants and their business associates escape the losses and disappointment which the issue of such patents, and their subsequent destruction by judicial action, would involve.¹

§ 53. ¹ It would appear from the 1887 that about 14,000 applications Annual Report of the Commissioner for were in that year rejected.

§ 54. Functions of Patent Office: Adjudicating between Rival Inventors: Interferences.

The disputes arising in the Patent Office between rival claimants of the same invention are determined by a proceeding known as an interference.¹ Such interference is declared whenever two or more applications are filed covering the same invention, or when an applicant, whose petition is rejected on the ground of an outstanding patent in another, asserts that he is nevertheless the first inventor. In the former case each of the several applicants, and in the latter the applicant and the patentee, are notified to file in the Office within a given time written statements, under oath, and duly sealed from observation, specifying the dates at which the invention was conceived and perfected by them. At the time appointed these statements are opened, and if from them it appears who has priority the patent is awarded to him; if not, such further hearing will be had as may be necessary to ascertain the fact. Where the contestants are all merely applicants, the issue of a patent to one of them is a denial of it to the others. Where one of the contestants is already a patentee, this proceeding does not affect his patent, but if the other party proves his own priority he receives a patent also, and they are both left to pursue the controversy in the courts.

§ 54. ¹ Rev. Stat. 1874, § 4904.
 "Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than twenty days, as the Commissioner shall prescribe."

See also Rules of Patent Office: Interferences.

In *Nicholson v. Bennett* (1879), 16 O. G. 631, Paine, Com. : (631) "Interferences between patents cannot be adjudicated in the Patent Office; but interferences between one or more applications and two or more patents can be adjudicated here, and priority awarded to one of the patents or to an application, according to the facts. Such adjudication is conclusive upon all parties so far as the interference in the Patent Office is concerned, but it is not conclusive as to the relative rights of the patentees outside of the Patent Office."

§ 55. Functions of Patent Office: Disseminating Information concerning Patented Inventions.

The duty of disseminating information to the public concerning the current progress of the industrial arts has always been recognized and prescribed by Congress. The act of 1790 directed the Secretary of State to furnish copies of the description, model, and drawings of any invention to every person who would pay the cost of making them. The act of 1836 provided that the models and specimens of existing inventions, duly classified, should be arranged in suitable galleries and kept open for the inspection of the public. In A. D. 1837 the annual publication of a list of the patents granted during the preceding year was ordered. In A. D. 1839 a classified and alphabetical list of all patents theretofore granted was prepared and issued. In A. D. 1871 complete copies of the specifications and drawings of each patent subsequently issued were directed to be placed at the Capitol of every State and Territory, in the Clerk's office in each Judicial District, in the Congressional Library, and in every other public library which would pay the cost of binding and transportation, and secure freedom of access to them for the public. In A. D. 1872 was commenced the publication of the "Official Gazette," a weekly journal containing a list of all patents issued during the preceding week, with abstracts of their specifications, copies of their drawings, transcripts of their claims, and the names and residences of the patentees. Decisions of the Commissioner on questions of practice, and of the United States Courts on matters of Patent Law are also given, making annually about two thousand pages, with some thirteen thousand illustrations, two hundred reported cases, an index of patentees and patents, and an excellent digest of decisions. The extensive circulation of this journal now puts into the hands of every inventor, manufacturer, and capitalist interested in industrial pursuits, full information in regard to all that is accomplished in the numerous fields of inventive effort, and suggests to alert and thoughtful minds many of those ideas which are finally embodied in actual improvements in mechanics and the arts.

§ 56. Functions of Patent Office : Caveats : Disclaimers : Reissues.

In furtherance of the advantages thus offered by the patent system to inventors, there are three collateral proceedings, designed to meet peculiar exigencies in the history of an invention. Where an inventor, who is still engaged in reducing his discovery to practice, fears that another, laboring in the same direction, may first obtain a patent, he can file a caveat in the Office and thereby protect himself during the residue of his experiments, and secure a hearing on the question of priority before a patent issues to any one for the invention.¹ If a patent, as already granted, is defective on account of its excessive claims, the error may be cured by simply filing a disclaimer.² When, through the inadvertence

§ 56. ¹ Rev. Stat. 1874, § 4902. "Any citizen of the United States who makes any new invention or discovery, and desires further time to mature the same, may, on payment of the fees required by law, file in the Patent Office a caveat setting forth the design thereof, and of its distinguishing characteristics, and praying protection of his right until he shall have matured his invention. Such caveat shall be filed in the confidential archives of the Office and preserved in secrecy, and shall be operative for the term of one year from the filing thereof; and if application is made within the year by any other person for a patent with which such caveat would in any manner interfere, the Commissioner shall deposit the description, specification, drawings, and model of such application in like manner in the confidential archives of the Office, and give notice thereof, by mail, to the person by whom the caveat was filed. If such person desires to avail himself of his caveat, he shall file his description, specifications, drawings, and model within three months from the time of placing the notice in the post-office in Washington, with the usual time required for transmitting it to the caveator

added thereto; which time shall be endorsed on the notice. An alien shall have the privilege herein granted, if he has resided in the United States one year next preceding the filing of his caveat, and has made oath of his intention to become a citizen."

See also Rules of Patent Office : Caveats.

² Rev. Stat. 1874, § 4917. "Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or of any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office; and it

or mistake of the inventor, his patent fails to cover any part of his invention, as he attempted to describe and publish it in his specification, the patent may be surrendered and a new one, remedying the deficiency, may be procured.³

shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it."

See also Rules of Patent Office : Disclaimer.

³ Rev. Stat. 1874, § 4916. "Whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the Commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued to the patentee, or, in case of his death or of an assignment of the whole or any undivided part of the original patent, then to his executors, administrators, or assigns, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the amended patent. The Commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters patent. The specifications and claim in every such case shall be subject to revision and restriction in the same manner as

original applications are. Every patent so reissued, together with the corrected specification, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form ; but no new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except each by the other ; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the Commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid."

See also Rules of Patent Office : Reissues.

In *Smith v. Merriam* (1881), 19 O. G. 601, Lowell, J. : (602) "The most natural construction of this law would perhaps be that, if a patent should be inoperative by reason of a defective specification or invalid for claiming too much, the defect might be supplied or the excessive claim be reduced by reissue ; but the courts have given a different interpretation, much wider in most respects and narrower in only one. They do not permit a defective specification to be supplied excepting from the drawings or model ; but they do permit the claim to be varied, provided the same invention is described in both patents, and hold that the decision of the Office that the occasion had arisen for granting a reissue is final. 'The law is extremely liberal, perhaps too much so, and has been much abused.'" 6 Fed. Rep. 713 (716).

§ 57. Patent Privilege Conferred only on Inventors.

The Constitution of the United States authorizes the grant of patents only to inventors. Under the construction given to the word "inventors" by the English courts, it comprehended not only those who by their ingenuity had discovered, and by their labors or expenditures had reduced to practice, some new art or manufacture, but all those who had introduced into the realm any new trade or industry from foreign lands.¹ This construction was never recognized in the United States. An inventor, in the meaning of the Constitution, is one who has himself conceived the fundamental idea of the invention, and has embodied it in tangible materials. To him and to him only can a patent lawfully be granted.²

§ 58. Patent Privilege Conferred only on the First and Original Inventor.

To what inventors and for what inventions patents may be issued, is determined by the acts of Congress. For any one invention but one valid patent can exist; and of several distinct inventors of the same invention, one only is entitled to receive a grant of the exclusive right. This one is the original and first inventor.¹ An original inventor is a creator,

§ 57. ¹ In the case of *Edgebury v. Stephens* (1691), 2 Salk. 447, it was held that "if the invention be new in England a patent may be granted, though the thing was practiced beyond sea before; for the statute speaks of new manufactures within this realm; so that if it be new here, it is within the statute; for the act intended to encourage new devices useful to the kingdom, and whether learned by travel or by study, it is the same thing." 1 Web. 35; 1 Abb. P. C. 8.

² In *Livingston v. Van Ingen* (1812), 9 Johns. 507, Kent, C. J. : (583) "It seems to be admitted that Congress are authorized to grant patents only to the *inventor* of the useful art. . . . There cannot, then, be any aid or encouragement, by means of an exclusive right

under the law of the United States, to importers from abroad of any useful invention or improvement."

In *Pitts v. Hall* (1851), 2 Blatch. 229, Nelson, J. : (234) "A person, to be entitled to the character of an inventor, within the meaning of the Act of Congress, must himself have conceived the idea embodied in his improvement. It must be the product of his own mind and genius, and not of another's."

See also *Washburn v. Gould* (1844), 3 Story, 122; 2 Robb, 206; *Sparkman v. Higgins* (1846), 1 Blatch. 205.

§ 58. ¹ Rev. Stat. 1874, §§ 4886, 4920. In *Bedford v. Hunt* (1817), 1 Mason, 302, Story, J. : (304) "The first inventor, who has put the invention in practice, and he only, is

not a borrower or copyist, of the invention.² The first inventor is that original inventor whose inventive act, in point of time, preceded the inventive acts of others.³ According to the earlier statutes, a first inventor must have been such as to all the world.⁴ However meritorious an applicant might

entitled to a patent. Every subsequent patentee, although an original inventor, may be defeated of his patent right upon proof of such prior inventions being put into use. The law in such case cannot give the whole patent right to each inventor, even if each be equally entitled to the merit of being an original and independent inventor; and it therefore adopts the maxim, *qui prior est in tempore, potior est in jure.*" 1 Robb, 148 (150).

See also *Lowell v. Lewis* (1817), 1 Mason, 182; 1 Robb, 131; *Thomas v. Weeks* (1827), 2 Paine, 92; *Reed v. Cutter* (1841), 1 Story, 590; 2 Robb, 81; *Allen v. Blunt* (1846), 2 W. & M. 121; 2 Robb, 530.

² The term "original inventor," is sometimes used by the courts as synonymous with "first inventor." See *Odiorne v. Winkley* (1814), 2 Gallison, 51; 1 Robb, 52; *Thomas v. Weeks* (1827), 2 Paine, 92; *Allen v. Blunt* (1846), 2 W. & M. 121; 2 Robb, 530.

In other cases the judges make a distinction between the "original" and the "first" inventor, giving the former title to every true inventor, and the latter only to the foremost among true inventors. See *Lowell v. Lewis* (1817), 1 Mason, 182; 1 Robb, 131; *Bedford v. Hunt* (1817), 1 Mason, 302; 1 Robb, 148; *Pennock v. Dialogue* (1829), 2 Peters, 1; 1 Robb, 542; *Reed v. Cutter* (1841), 1 Story, 590; 2 Robb, 81; *Roemer v. Simm* (1874), 5 O. G. 555.

³ In *Pennock v. Dialogue* (1829), 2 Peters, 1, Story, J. : (23) "It gives the right to the first and true inventor and to him only; if known or used before his supposed discovery he is not

the first, although he may be a true inventor." 1 Robb, 542 (566).

In *Reed v. Cutter* (1841), 1 Story, 590, Story, J. : (599) "He is the first inventor in the sense of the Act, and entitled to a patent for his invention, who has first perfected and adapted the same to use; and until the invention is so perfected and adapted to use, it is not patentable. . . . In a race of diligence between two independent inventors, he, who first reduces his invention to a fixed, positive, and practical form, would seem to be entitled to a priority of right to a patent therefor. The clause of the fifteenth section (Act of 1836; Rev. Stat. 1874, § 4920), now under consideration, seems to qualify that right, by providing that, in such cases, he who invents first shall have the prior right, if he is using reasonable diligence in adapting and perfecting the same, although the second inventor has, in fact, first perfected the same, and reduced the same to practice in a positive form. It thus gives full effect to the well known maxim, that he has the better right, who is prior in point of time, namely, in making the discovery or invention." 2 Robb, 81 (90, 91).

⁴ In the act of 1790, the invention to be patentable, must have been one "not before known or used;" no limit to the time or place of user being mentioned. In the act of 1793, it must have been one "not known or used before the application;" no limit of place being here established. In pursuance of these acts, the courts held that the inventor must be the first inventor as to all the world, in order to be entitled to a patent.

be, he could obtain no valid patent for the fruits of his own ingenuity, if his discovery had been anywhere anticipated, even without his knowledge. The act of 1836 removed this hardship, and provided that he who first conceived and reduced to practice an invention which was not before known or used in the United States, and nowhere had been patented or described in any printed publication, should be regarded as its first as well as an original inventor.⁵

§ 59. Patent Privilege Conferred only for Certain Classes of Inventions.

Not everything that in itself is new is an invention, nor is every invention patentable under the existing law. Invention implies something more than change of form, or of arrangement, or of mode of use. It is the result of inventive as distinguished from mechanical skill. An operation of the intellect, not following the beaten track but striking out into some new direction and achieving some new triumph over matter, is involved in its production. It is perhaps incapable of exact definition, and the line between it and what the

In *Reutgen v. Kanowrs* (1804), 1 Wash. 168, Washington, J. : (170) "If it appears that the plaintiff was not the original inventor, in reference to other parts of the world as well as America, he is not entitled to a patent." 1 Robb, 1 (4).

In *Dawson v. Follen* (1808), 2 Wash. 311, Washington, J. : (311) "To entitle the plaintiff to recover [the jury] must be satisfied that he was the original inventor, not only in relation to the United States, but to other parts of the world." 1 Robb, 9 (9).

"If a patentee is not the first or original inventor, in reference to all the world, he is not entitled to a patent even although he had no knowledge of the previous use or previous description." Law Dig. (Inventor, B. 32). See also *Whitney v. Emmett* (1831), Baldwin, 303 ; 1 Robb, 567.

⁵ Act of 1836, §§ 7, 15. By § 7,

the applicant for a patent was entitled to receive it unless, on due examination, it appeared that the same invention had been previously invented or discovered by some other person *in this country*. And § 15 provided that a patent should not be void on account of the invention or any part thereof having been before known or used in any foreign country. See also Rev. Stat. 1874, § 4886.

"The provision of § 6 and § 15 of the act of 1836 introduced an important modification into the law of patents, designed to protect the American inventor against the injustice of being thrown out of the fruits of his ingenuity, by the existence of a secret invention or discovery abroad, — that is, a discovery not patented, and not described in any printed publication." Law Dig. (Inventor, B. 33), citing 5 Opin. 21 (1848).

Patent Law regards as a mere imitation is often very difficult to draw.¹ Among recognized inventions, however, only certain classes are entitled to protection. These lie almost entirely within the domain of the industrial arts. The act of 1790 enumerated them as "any useful art, manufacture, engine, machine, or device, or any improvement therein."² The act of 1793 describes them as "any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement" on the same.³ To these the act of 1842 added "any new and original design" for a manufacture or to be worked into or imprinted on a manufacture.⁴ Beyond these narrow limits no discovery, whatever its utility or novelty, is patentable.⁵

§ 60. Form of Letters-Patent.

The form of letters-patent in the United States has undergone but little change. Under the acts of 1790 and 1793 they were simple grants of the exclusive right to the invention, for a term not exceeding fourteen years, and contained recital of the petition and a full description of the discovery

§ 59. ¹ In *Ransom v. Mayor of New York* (1856), 1 Fisher, 252, Hall, J. : (265) "Invention, in the sense of the patent law, is the finding out, contriving, devising, or creating something new and useful, which did not exist before, by an operation of the intellect."

In *Clark Patent S. & F. R. Co. v. Copeland* (1862), 2 Fisher, 221, Shipman, J. : (227) "With regard to the degree of mental labor and inventive skill required in the work of invention, the law has no nice or rigid standard. There must be some inventive skill exercised, but the degree of that skill is not material."

In *Woodman v. Stimpson* (1866), 3 Fisher, 98, Lowell, J. : (103) "The difficulty is in drawing the line and showing what is invention and what is mere construction."

In *Kirby v. Beardsley* (1867), 3 Fisher, 265, Shipman, J. : (278) "I am well aware that it is often no easy task to draw the true line of distinction between invention, the product of original thought, and mere obvious manual changes following the beaten track of mechanical experience." 5 Blatch. 438, (453).

² Act of 1790, § 1.

³ Act of 1793, § 1.

⁴ Act of 1842, § 3.

⁵ Rev. Stat. 1874, § 4886. In *Singer v. Walmsley* (1860), 1 Fisher, 558, Giles, J. : (562) "It seems, then, that whatever may be the extent of the terms of the grant under the Constitution, the only power that Congress has exercised is the power to give a patent for a 'new and useful art, machine, manufacture, or composition of matter.'"

of the inventor.¹ The act of 1836 substituted for this full description in the patent a short description or title of the invention, and required the annexation to the patent of a complete copy of the description and the claims, as contained in the application.² The act of 1837 directed that a copy of the drawings, if any existed, should also be appended to the patent.³ In A. D. 1861 the term of patents was extended to seventeen years.⁴ A patent, as now issued, thus contains a grant of the exclusive right to the patented invention during seventeen years, a short description or title of the art or thing invented, and a copy of the description, claims, and drawings which form the basis of the grant.

§ 61. Rights Embraced in Patent Privilege.

The patent privilege, in the United States, includes the exclusive right to make, use, or sell the patented invention and the exclusive right to empower others to make and use and sell it.¹ These rights are separable from each other and may

§ 60. ¹ Act of 1790, § 1; Act of 1793, § 1.

Under these statutes the patent itself gave substantial notice of the character of the invention. The applicant, in his petition, was compelled to set forth the fact and nature of his discovery, and the allegations and suggestions of the petition were recited in the patent. If the specification and petition were filed at the same time, the former was regarded as part of the latter, and by reference was made a portion of the description given in the patent. See *Evans v. Chambers* (1807), 2 Wash. 125; 1 Robb, 7; *Hogg v. Emerson* (1847), 6 How. 437; 2 Robb, 655.

² Act of 1836, § 5.

This change in the language of the statutes, describing the requisites of the patent, was adopted in order to make the law itself conform to the usage, which had grown up under the prior acts, of inserting the whole descriptive

portion of the petition in the patent, and which sometimes led to misconstructions. See *Hogg v. Emerson* (1847), 6 How. 457; 2 Robb, 655.

³ Act of 1837, § 6.

⁴ Act of 1861, § 16.

§ 61. ¹ Rev. Stat. 1874, § 4884.

In *Gayler v. Wilder* (1850), 10 How. 477, Taney, C. J. : (494) "Now the monopoly granted to the patentee is for one entire thing; it is the exclusive right of making, using, and vending to others to be used, the improvement he has invented, and for which the patent is granted."

In *Bloomer v. McQuewan* (1852), 14 How. 539, Taney, C. J. : (549) "The franchise which the patent grants, consists altogether in the right to exclude every one from making, using, or vending the thing patented, without the permission of the patentee. This is all that he obtains by the patent."

be transferred, either singly or together, by the patentee.² They constitute his property in the invention, and are the measure of the reward conferred upon him for the service he has rendered to the public.³

§ 62. Remedies for Infringement.

The law provides two methods by which the injuries to these rights of patentees may be redressed: (1) An action on the case; (2) A bill in equity for an injunction, an account, and damages.¹ The former was once the ordinary method, but in recent times has been almost wholly superseded by the latter. Original jurisdiction over these proceedings resides exclusively in the Circuit Courts of the United States, subject to an appeal or writ of error to the Supreme Court.²

² Rev. Stat. 1874, § 4898.

In *Blanchard v. Eldridge* (1849), 1 Wall. Jr. 337, Grier, J. : (339) "As the grants of the crown were, at common law, construed with the greatest strictness, the privileges granted by a patent for a monopoly, would probably not have been treated as capable of assignment, unless made so by the letter of the grant. . . . But the Act of Congress of 1836 has regulated the assignment of patents. . . . (340) This statute also renders the monopoly capable of subdivision in the category of its locality, but in no other way. The patentee is not allowed to carve out his monopoly, which is an unity, into a hundred or more, all acting in the same place, and liable to come into conflict." 2 Robb, 737 (739, 740). See also *Gayler v. Wilder* (1850), 10 How. 477; *Suydam v. Day* (1846), 2 Blatch. 20.

³ In *Brown v. Duchesne* (1856), 19 How. 183, Taney, C. J. : (195) "The right of property which a patentee has in his invention, and his right to its exclusive use, is derived altogether from these statutory provisions; and this court have always held that an inventor has no right of property in his

invention, upon which he can maintain a suit, unless he obtains a patent for it, according to the acts of Congress; and that his rights are to be regulated and measured by these laws, and cannot go beyond them."

In *Blandy v. Griffith* (1869) 3 Fisher, 609, Swayne, J. : (620) "The rights secured by a patent for an invention or discovery are as much property as anything else, real or incorporeal."

In *Densmore v. Scofield* (1880), 102 U. S. 375, Swayne, J. : (378) "Patents rightfully issued are property, and are surrounded by the same rights and sanctions which attend all other property." 19 O. G. 289 (289).

That an inventor's property consists in his exclusive right to practise the invention, see *Brush v. Naugatuck R. R. Co.* (1885), 32 O. G. 894; 24 Fed. Rep. 371; 23 Blatch. 277.

§ 62. ¹ Rev. Stat. 1874, §§ 4919, 4921.

² Rev. Stat. 1874, §§ 629, 699, 711.

State courts, however, can entertain questions arising under the patent laws of the United States when collaterally drawn into discussion in cases within their jurisdiction. See *Sherman v.*

§ 63. Increase of Inventions under the Patent System of the United States.

The patent system of the United States completed the ninety-eighth year of its existence on the tenth day of April, A. D. 1888. During this period the number of patents issued has been over three hundred and eighty thousand; an average of more than ten per day. Under the stimulus afforded by the protection given to the inventor, and by the vast fortunes realized by successful patentees, the inventive genius of the nation has been rapidly developed, and is increasing at an almost incredible rate.¹ Before A. D. 1837 the whole number of patents granted was about ten thousand; less than two hundred and twenty per year. The following table shows the rate of issue since that date, given in decades including 1876:

1837	to	1846	5,019
1847	"	1856	12,572
1857	"	1866	50,094
1867	"	1876	130,240

That this increase has been out of all proportion to the increase of population is evident from the following table, in which appears the population at each census year in the preceding decades, the number of patents granted in that year, and the ratio of patents to population:—

Census Year.	Population.	Patents.	Ratio.
1840	17,069,453	473	1 to 36,088
1850	23,191,876	993	1 " 23,308
1860	31,443,321	4,778	1 " 6,525
1870	38,558,371	13,333	1 " 2,894

In other words, the rate of the development of inventive genius in the United States, as exhibited by the operations of the Patent Office from 1840 to 1850 was six times, from 1850 to 1860 was nine times, and from 1860 to 1870 was thirteen times as great as the rate of increase in population.

Champlain Trans. Co. (1858), 31 Vt. 162; Rich v. Atwater (1844), 16 Conn. 409; and §§ 854-866, 1256, 1257 and notes, *post*. § 63. ¹ See statement of the Progress of the Patent System of the United States in Commissioner's Report for 1887, 42 O. G. 616.

§ 64. Increase of Inventions due to Patent System.

Whatever other influences have contributed to this extraordinary increase in the efforts and triumphs of inventors, a powerful and permanent cause has undoubtedly existed in the patent system itself. A system which constantly calls the attention of the public to the progress of the industrial arts, and as constantly suggests new wants and new fields for investigation; which secures the inventor against the issue of a patent to another claimant until he has been heard as to his prior rights; and which affords him a thorough examination as to the novelty and usefulness of his invention by skilled and learned experts at an expense scarcely exceeding the week's wages of a laborer, may fairly be credited with a large proportion of that benefit which the nation has received from the inventions and discoveries of its citizens. History does not present a better illustration of the vast results which may flow from a few acts of wise and far-sighted legislation.

§ 65. Subdivisions of Patent Law.

In examining the details of this patent system, and attempting to define and classify the principles and rules of law by which its several departments are controlled, the following division of the subject will be pursued:—

- I. OF PATENTABLE INVENTIONS.
- II. OF INVENTORS AND PATENTEES.
- III. OF LETTERS-PATENT.
- IV. OF WRONGS AND REMEDIES.

To each of which a separate Book will be devoted.

REGISTERED PATENT
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NEW YORK

BOOK I.

OF PATENTABLE INVENTIONS.

BOOK I.
OF PATENTABLE INVENTIONS.

PRELIMINARY ANALYSIS.

§ 66. Patents Grantable only to the Persons and for the Objects Prescribed by Law.

THE right of an inventor to a patent depends entirely upon the provisions of positive law.¹ However valuable his discovery, however meritorious the service he has thereby rendered to the public, unless his invention falls within the scope of these provisions, it becomes, immediately upon its disclosure, the property of all mankind. That in peculiar cases great apparent hardship results from an adherence to this rule is no doubt true;² but such exceptional evils necessarily

§ 66. ¹ This proposition is as correct in reference to the English patent system as in reference to our own. Whatever considerations of private justice or of public policy may have sustained the grant of letters-patent at common law, the statute of James I. abolished all such grants except in certain special cases. The effect of this exception in the statute was to place the excepted cases on the same footing as if no right existed, unless created by express statute; for though the statute has been uniformly regarded as declaratory of the common law, it has nevertheless been interpreted in this respect as a negative statute, excluding from this privilege every invention on which the privilege itself was not in terms conferred. The same severe interpretation has been properly applied to our

own statutes, which rest entirely upon the positive provisions of the Constitution of the United States. This proposition, however, has no reference to rights *under* a patent, which are determined, in part at least, by the inherent nature of the subject and the fundamental principles of the common law. See § 10 and notes.

² Rarely in any case, within the history of the Patent Law, has the rigor of this rule been more apparent than in that of *Morton v. The N. Y. Eye Infirmary* (1862), 5 Blatch. 116. The plaintiff had discovered a method of rendering patients insensible to pain during surgical operations, and had thereby conferred inestimable benefits upon the whole race of man. Having procured a patent for his method, and attempted to enforce his apparent rights

attend all regulations which depart from the great principles of natural law, and seek by arbitrary measures to promote the common good.

§ 67. Patents Grantable only to Inventors: and to them only for Certain Inventions.

In this country the positive law, from which this right of the inventor is derived, is contained in the Constitution of the United States and in the Acts of Congress, as interpreted by the decisions of the Federal Courts. According to the Constitution, Congress has no power to grant a patent to any one but an inventor, and to him only for his own invention.¹ Even this limited power has been exercised by Congress only in respect to certain classes of inventions, and the privilege of the inventor is thus practically confined to particular results of his inventive skill.² Under our laws, therefore, as

against the defendant, the validity of his patent was disputed, *inter alia*, on the ground that such a discovery could not be protected under any existing provision of the law. In rendering a decision against the plaintiff upon this point, Shipman, J., said: (127) "But the beneficent and imposing character of the discovery cannot change the legal principles upon which the law of patents is founded, nor abrogate the rules by which judicial construction must be governed. These principles and rules are fixed, and uninfluenced by shades and degrees of comparative merit. They secure to the inventor a monopoly in the manufacture, use, and sale of very humble contrivances, of limited usefulness, the fruits of indifferent skill and trifling ingenuity, as well as of those grander products of his genius which confer renown on himself and extensive and lasting benefits on society. But they are inadequate to the protection of every discovery, by securing its exclusive control to the explorer to whose eye it may be first disclosed. A discovery may be brilliant

and useful, and not patentable. No matter through what long, solitary vigils, or by what importunate efforts, the secret may have been wrung from the bosom of nature, or to what useful purposes it may be applied. Something more is necessary. The new force or principle brought to light must be embodied and set to work, and can be patented only in connection or combination with the means by which, or the medium through which, it operates." 2 Fisher, 320 (329).

See also the opinion of the Attorney-General (1856), 8 Op. Atty. Gen. 269.

Further, that an inventor has no exclusive right at common law but only by statute, see *Comstock v. White* (1860), 18 How. Pr. 421; *Dudley v. Mayhew* (1849), 3 Comst. 9; *Higgins v. Strong* (1836), 4 Blackf. (Ind.) 182.

§ 67. ¹ Const. U. S. art. 1, § 8.

² Act 1790, § 1, "art, manufacture, engine, machine, or device, or any improvement therein." Act 1793, § 1, "art, machine, manufacture, or composition of matter," or an improvement therein. Act 1836, § 6, "art, machine,

they now exist and always have existed, the grantee of a patent must be an inventor, and its subject-matter must be one of those inventions which are specifically mentioned in the Acts of Congress.

§ 68. No Object can be an Invention unless it Results from an Inventive Act: no Person an Inventor unless he has Performed an Inventive Act.

An invention is the result of an inventive act; and an inventor is a person by whom an inventive act has been performed. The terms "invention" and "inventor" had acquired a definite legal meaning before our Constitution was adopted. It was in favor of "inventors" that the exception in the statute of James I. was made. In several early cases it was held that this name included only those who either by their own ingenuity and study had created, or by their researches in foreign countries had discovered and had then imported, something worthy of protection by the law.¹ The reason for thus

manufacture, or composition of matter," or improvement therein. Act 1870, § 24; Rev. Stat. 1874, § 4886.

§ 68. ¹ At common law the importer and the inventor were regarded as of equal merit, since each gave to the public some useful manufacture which they did not before possess. Thus in *Darcy v. Allin* (1602), Noy, 173, the law is thus stated: (182) "Where any man by his own charge and industry, or by his own wit or invention, doth bring any new trade into the realm, or any engine tending to the furtherance of a trade, that never was used before, . . . the king may grant to him a monopoly patent . . . in consideration of the good he doth bring by his invention to the commonwealth, &c;" instancing Hastings's patent granted in 1567 "in consideration that he brought in the skill of making frisadoes as they were made in Harlem and Amsterdam," &c; also Matthey's patent, granted still earlier, for the sole making of knives with bone hafts, &c., "because . . . he brought the first use

thereof from beyond seas." 1 Web. 5 (6); 1 Abb. P. C. 1.

The Smalt patents, granted 1606, were in consideration that the patentees had undertaken to manufacture in England "a blue stuff called smalt," which should be "as good, perfect, and merchantable as the same or like stuff called smalt, made, wrought and compounded in the parts beyond the seas and brought into this realm," &c.

Dudley's patent, granted 1622, was in consideration that Dudley had "at his great travail and industry and after many chargeable experiments found out the mystery, art, way, and means of melting iron ore . . . with sea coals or pit coals in furnaces with bellows, of as good condition as hath been heretofore made of charcoal," &c.

Mansell's patent, granted 1624, was in consideration of his having expended his whole fortune in developing the invention of one Percival for making glass with coal instead of wood.

Then came the stat. Jac. I., 1624,

placing an importer on the same plane of merit with a creator, if it ever was sufficient, ceased to be so when intimate commercial intercourse made the improvements of one nation the immediate property of others; but in the English law this classification has not changed, and the importer is still entitled to a patent. In the United States, however, the importation, by one man, of that which is accessible to all, has never been regarded as meriting the right to its exclusive public use, and hence the word "inventors" is in our law em-

authorizing a patent to the "first and true inventor or inventors of such manufactures," but excepting alike from the repealing clause of the statute, the Smalt patents, the Dudley and the Mansell patents, as being on the same ground of merit. This phrase in the statute received its construction in *Edgebury v. Stephens* (1691), 1 Web. 35; 2 Salk. 447, Holt and Pollexfen, JJ., saying: "The act intended to encourage new devices useful to the kingdom and whether learned by travel or by study it is the same thing." 1 Abb. P. C. 8. Following this ruling, Lombe's patent, granted 1719, was in consideration that he "did with the utmost difficulty and hazard, and at a very great expense, discover the arts of making and working the three capital engines made use of by the Italians to make their organzine silk, and did introduce those arts and inventions into this kingdom," &c.

This doctrine was constantly admitted in the courts by counsel and recognized in practice. In later cases it has also been affirmed. Thus in *Walton v. Bateman*, (1842), 1 Web. 613, Cresswell, J.: (615) "The party obtaining the patent must be the true and first inventor in this country. If he import from a foreign country that 'which others at the time of making of such letters-patent and grants did not use,' it will suffice." So, also, in *Lamenaude's Patent* (1850), 2 Web.

164, Lord Brougham: (169) "You may have a patent as the importer of a foreign invention, because that is the construction that the courts have put upon the statute that you are the *quasi* inventor, if you import it for the first time." See *Lewis v. Marling* (1829), 1 Web. 493; 1 Abb. P. C. 421; *Minter v. Wells* (1834), 1 Carp. 622; 2 Abb. P. C. 26; *Stead v. Williams* (1843), 2 Web. 126; *Beard v. Egerton* (1846), 3 C. B. 97; *Nickels v. Ross* (1849), 8 C. B. 679.

The extent to which this doctrine has been carried may be gathered from the decision in *Wirth's patent* (1879), L. R. 12 Ch. 303, where it was held that an alien resident abroad may take a patent in England for an invention communicated to him by another alien resident abroad; though one who learns the invention in England from another is neither an inventor nor an importer. See *Marsden v. Saville Co.* (1878), L. R. 3 Ex. D. 203.

At the same time, the actual difference between the merit of the inventor and importer is in some cases recognized, especially in reference to the extension of the patent privilege beyond the first life of the patent; the claims of an inventor being in such cases regarded as entitled to greater consideration. See *Soames' Patent* (1843), 1 Web. 729.

See also *Coryton*, chap. iii.; *Norman*, chap. vi.

ployed in its first meaning only, and is confined to those by whom creative skill and genius have been exercised.² It is the exercise of this creative skill alone which is here recognized as an inventive act, and only the result of such an act, so far perfected as to be available for public use, is an invention. In every question whether or not a given person is an inventor, or a given thing an invention, the test is, therefore, found in the nature of the act performed by the one, or resulting in the other. If the act is what the law regards as an inventive act, the actor is an inventor and the result is an invention. If the act is not in law an inventive act, neither the actor nor his production are entitled to the protection afforded by a patent.

§ 69. No Invention Patentable unless Embraced within one of the Prescribed Classes.

Before our patent system was established, the line was also clearly drawn between those results of the inventive act which constitute the proper subject-matter of a patent, and those to which the law gives no protection. The English statute

² In this exclusion of the importer from the privilege of a patent Congress inaugurated that departure from the fundamental idea of the English courts, concerning the true relation between the inventor and the public, which has exercised such an important influence over many of our subsequent ideas. Under the English theory the merit of the inventor was not in the exercise of his inventive genius creating new manufactures, but in the rendering of new manufactures, by whomsoever created, accessible to the public. The consideration, therefore, for the issue of the patent was simply publication, not creation; and this principle colors the decisions of the courts on all questions of prior use, prior knowledge, abandonment, etc., as well as those of novelty. But, in this country, a different principle has been established. The act of 1790 authorized a patent

to inventors only for something "not before known or used," and this phrase being regarded by the courts as including knowledge or use at any time or in any country, no mere importer could receive a patent, since the invention must have been at some time and somewhere "before known and used." The privilege was thus restricted to inventors proper; that is, to those who had created that which did not before exist, and the merit of creation was thus substituted in the American theory for that of publication, though not, as we shall see hereafter, to the total exclusion of the latter. The effect of this change of theory is manifest in our doctrines of prior use and publication, of novelty in the thing invented, and of priority of right as between rival inventors. See Phillip: 59; Godson, 54-56.

groups the former under the general name of "manufacture," but this was early held to include not merely a vendible product of inventive skill, but also a method of applying physical forces to the production of physical effects.¹ Congress adopted the same ideas in its description of the inventions for which patents might be granted. It enumerates them as an art, a machine, a manufacture, a composition of matter, a

§ 69. ¹ In *Boulton v. Bull* (1795), 2 H. Bl. 463, Eyre, C. J. : (492) "It was admitted in the argument at the bar, that the word '*manufacture*' in the statute (21 Jac. I., c. 3), was of extensive signification, that it applied not only to things made, but to the practice of making, to principles carried into practice in a new manner, to new results of principles carried into practice. Let us pursue this admission. Under things made, we may class in the first place, new compositions of things, such as manufactures in the most ordinary sense of the word; secondly, all mechanical inventions, whether made to produce old or new effects, for a new piece of mechanism is certainly a thing made. Under the practice of making we may class all new artificial manners of operating with the hand, or with instruments in common use, new processes in any art, producing effects useful to the public." 1 Abb. P. C. 59 (87).

This classification of C. J. Eyre evidently includes an art, machine, manufacture, and composition of matter. That a design is an invention relating to the industrial arts, and consequently the proper subject-matter of a patent, was a subsequent conception both in the American and English law. The patentability of an improvement upon an existing invention was, in the earlier history of the law, denied. Lord Coke, who was chairman of the Committee on the passage of the stat. Jac. I., commenting upon that statute in 3

Inst. 184, says: "The privilege must not be contrary to law; such a privilege as is consonant to law must be substantially and essentially newly invented, but if the substance was *in esse* before, and a new addition thereunto, though that addition make the former more profitable, yet it is not a new manufacture in law; and so was it resolved in the Exchequer Chamber, Pasch. 15 Eliz. in *Bircot's* case, for a privilege concerning the preparing and melting, &c., of lead ore, for there it was said that it was but to put a new button to an old coat, and it is much easier to add than to invent; and it was there also resolved, that if the new manufacture be substantially invented according to law, yet no old manufacture in use before can be prohibited." This position was controverted by Lord Mansfield in *Morris v. Bransom* (1776), Bull. N. P. 76 c.; 1 Web. 51; 1 Abb. P. C. 21; and by Buller, J., in *Boulton v. Bull* (1795), 2 H. Bl. 463 (488); 1 Abb. P. C. 59 (83), and the error attributed to the ignorance of the age concerning the true nature of an invention, since which decision the patentability of an improvement as well as an original invention has been generally recognized.

For further classifications of patentable inventions under the English law, see Godson, 58; Holroyd, 33; Web. Law and Prac. Supp. 1, &c.; Coryton, 57; Norman, 7; Lund, 6; *Morgan v. Seaward* (1837), 1 Web. 187; 2 Abb. P. C. 419.

design, and an improvement upon some art, machine, manufacture, composition of matter, or design.² All other discoveries and inventions, however valuable and important, are subject to the operation of the natural law.

§ 70. No Invention Patentable unless New and Useful.

A further limitation on the patentability of inventions is found in the provision of the statute of James I. that a manufacture is entitled to protection only when it is "new,"¹ and

² The admirable classification contained in the present American statute was not reached without previous futile endeavors to enumerate the objects covered by the spirit and purpose of the law. In the act of 1790 they were described as an "art, manufacture, engine, machine, or device, or any improvement thereon." The terms here employed were evidently chosen without reference to their exact meaning, and have a remarkable correspondence to some of those then current in the English courts. The words "engine" and "device" convey no idea not embraced in "manufacture" and "machine," and no phrase is introduced which clearly covers a substance formed by the intermixture of ingredients, though this could have been here, as it was in England, included under "manufacture." During the interval between this act and that of 1793, the matter was sufficiently elucidated to enable Congress in the latter act to specify the great classes of inventions, according to their radical distinctions, and to arrange their statement in an order expressing their scientific relations to each other, — a classification unsurpassed by that of any other patent system, and probably, in the very nature of things, incapable of improvement. See *Ex parte Blythe* (1884), 30 O. G. 1321.

§ 70. ¹ Under the stat. Jac. I., the patentable subject-matter was the "sole

working or making of any manner of new manufacture within this realm." Whether the phrase "within this realm" was intended to qualify the "working or making" and thus define the territorial limits of the patent privilege, or to make patentable any manufacture which was new within the realm, is not apparent from the language of the statute. The courts, assuming that the former rule needed no expression, adopted the latter interpretation, and regarded every manufacture not already known in the kingdom as new, however well known it might be in other lands. This doctrine required a wider extension of the term "inventor" than is embraced within its ordinary meaning, and a limitation of the further provision "which others at the time of the making of such letters-patents and grants did not use" to the people of the realm, although no words to that effect appear in the statute. If the courts had held the phrase "within the realm" as referring to the scope of the monopoly instead of the locality within which the invention must be new, and consistently with this view had insisted that the manufacture must not have been before in use by any person in any country, and that the patentee must have been its actual inventor, in the sense of its creator, the English statute would have substantially represented our own law as it stood until the act of 1836.

neither "contrary to the law, nor mischievous to the state, by raising prices of commodities at home, or hurt of trade, or generally inconvenient."² Our statute has expressed the same idea in the phrase "new and useful,"³ making the novelty and utility of the result of the inventive act additional conditions of its patentability. The language of our courts might sometimes lead the incautious reader to imagine that the novelty and utility here required were to be taken as the tests by which the presence or the absence of the inventive act could always be determined.⁴ Yet such is not the case.

² The language of the stat. Jac. I., in reference to this requisite of a patentable invention is particularly significant. It was designed to exclude from protection not only every illegal manufacture, and those which tended to raise the price of commodities or to injure trade, but all those which on any ground were generally inconvenient. Lord Coke, in commenting on this requirement in 3 Inst. 184, instances an invention of labor-saving machinery, whereby persons hitherto employed were deprived of work, as falling within the prohibition, because "it was holden inconvenient to turn so many laboring men to idleness." Unreasonable as this may now appear, it illustrates the fundamental theory of the law, that the patent privilege exists for the public benefit and not for that of the inventor, and that whatever merit his discovery may possess in itself, if the community are not advantaged by its use, the government is not justified in encouraging the inventor to disclose it by offering him the protection of a patent.

³ In the act of 1790 the word "new" is not applied adjectively to the invention, the idea being represented by the verbs "invented or discovered," and the qualifying phrase "not before known or used." It appears, however, in the act of 1793 and

in all subsequent statutes. That the invention must be "useful" has always been expressly stated.

⁴ Where the advantage derived by the public from an invention is considered as the only or the chief reason for the allowance of the patent privilege, the presence of inventive skill is either not regarded or is inferred from the utility and novelty of the invention. In England, therefore, it is generally presumed when the art or article is found to possess the statutory requisites for patentability. In this country, until recently, the same position has been maintained. In the learned work of Mr. Curtis (edition of 1867), § 32, the view then entertained of this subject is stated in the following sentences: "It may be doubted, whether all the different forms of stating or investigating the question of sufficiency of invention are anything more than different modes of conducting the inquiry, whether the particular subject of a patent possesses the statute requisites of *novelty* and *utility*, both of which qualities must be found uniting in it. . . . While the law does not look to the mental process by which the invention has been reached, but to the character of the result itself, it may still require that the result should be such as not to exclude the possibility of some skill or ingenuity having been exercised. It

Inventive skill may be involved in the production of an object which, though hitherto unknown to the inventor, is already in possession of the public; and even greater genius may be manifested in devising mischievous and destructive agencies than in creating those which aid in the advancement of mankind. But in order to entitle an inventor to a patent the inventive act must not merely be performed; it must be performed in such a manner and for such a purpose as to benefit the public by bestowing something on them which they do not before possess, and which when they receive it will tend to their advantage; or, in the briefer phrase, the result of the inventive act must be both "new and useful."

§ 71. No Invention Patentable if already Abandoned to the Public.

Finally, the patent privilege undergoes another limitation in the provision that no invention, which has already passed from the control of the inventor into the possession of the public, is entitled to protection. The English statute expresses this condition in the declaration that the "manufacture" must be such as "others, at the time of making such letters-patent

requires this, because it requires that the subject-matter of a patent shall be something that has not substantially existed before, and is useful in contradistinction to being frivolous."

The later American cases, however, have drawn the line sharply, as will be shown hereafter (§§ 78-86 and *notes*), between those new and useful productions which could have resulted from the exercise of mechanical or constructive skill and those to which the employment of the inventive faculties is necessary. Thus it is no longer the rule that where the nature of the invention does not exclude the exercise of the creative powers its origin in them will be presumed (Curt. §§ 32, 34, 36, 40). On the contrary, it must affirmatively appear that the inventive faculties alone could have produced the

art or article, and for this purpose its novelty and utility may be considered, not as direct evidence, but as the minor premiss of a syllogism whose major asserts that if mechanical genius could provide an instrument or operation of such value and importance in the arts it would have long before been in existence and subjected to the use of man.

The distinction between "intrinsic novelty" and "legal novelty" drawn in § 113 *post*, is here important. The confusion of the two is evident in the last portion of the citation from Curtis, *ante*. The "statute requisite of novelty" is not the same as that novelty which consists in the fact that the invention "has not substantially existed before."

and grants, shall not use.”¹ The Acts of Congress, though varying from time to time the terms of this requirement² as well as their description of the conduct by which the abandonment of the invention to the public may be indicated, have uniformly recognized this rule, and made the inventor’s retention of control over his own discovery an essential element in his right to its protection. The reason of this rule is evident, since if the inventor has already dedicated his invention to the public, he cannot afterwards bestow it upon

§ 71. ¹ The doctrine that the “abandonment” of an invention, or its dedication to the public, is fatal to the claim of the inventor for a patent is as well recognized in the English law as in our own, although the technical language of our statutes gives greater prominence to the rule. The stat. Jac. I., by excluding from the privilege all inventions except those “which *others* at the time of the making of such letters-patents and grants *did not use*,” can scarcely have been intended to repeat the previous requirement, that a patentable manufacture must be “new.” But as an invention, however new at the date of its conception or importation, might easily have passed into use by others, and thus have become public property, before the patent had been granted, it was essential to provide that no issue of a patent should deprive the public of the advantage they already had attained, by making it a condition of the grant that no such use should have occurred. This view of the provision has uniformly been enforced in the British courts. *Wood v. Zimmer* (1815), Holt, N. P. 160; 1 Abb. P. C. 202; *Househill Co. v. Neilson* (1843), 1 Web. 673. In the latter case Lord Brougham says: “The statute excludes from a patent the true inventor who shall have made the invention so public that others, at the time of granting the patent, shall use the invention” (note 719).

² Act of 1790, “not before known or used.”

Act of 1793, “not known or used before the application.” In several cases this phrase has been treated as relating to the question of novelty rather than that of abandonment, and as in effect a repetition of the adjective “new,” already stated in the act to be an essential condition of patentability. *Morris v. Huntington* (1824), 1 Paine, 348; 1 Robb, 448; *Mellus v. Silsbee* (1825), 4 Mason, 108; 1 Robb, 506; *Treadwell v. Bladen* (1827), 4 Wash. 703; 1 Robb, 531, &c. In others its relation to the doctrine of abandonment more definitely appears. *Whitney v. Emmet* (1831), Baldwin, 303; 1 Robb, 567; *Shaw v. Cooper* (1833), 7 Peters, 292; 1 Robb, 643, &c.

Act of 1836, “not, at the time of his application for a patent, in public use or on sale, with his consent or allowance.”

Act of 1839, “no patent shall be held to be invalid by reason of such purchase, sale, or use prior to the application, . . . except on proof of abandonment of such invention to the public; or that such purchase, sale, or prior use has been for more than two years prior to such application for a patent.”

Act of 1870, “not in public use or on sale for more than two years prior to his application, unless the same is proved to have been abandoned.”

them as a consideration for the grant to him of its exclusive use.⁸

§ 72. Essential Characteristics of a Patentable Invention.

The characteristics of a patentable invention, as they appear from this analysis of the provisions of the law, are these: (1) It must be the result of an inventive act, so far perfected as to become available for public use; (2) It must belong to one of those great classes of inventions, which Congress has declared to be the subjects-matter of a patent; (3) It must be new; (4) It must be useful; (5) It must not have been abandoned to the public by the inventor.¹ Hence in considering inventions in detail, and in examining the various principles and rules by which their patentability is to be determined, these topics will require attention:—

- I. Of the nature and result of the inventive act.
- II. Of the classes of inventions legally entitled to protection.
- III. Of novelty.
- IV. Of utility.
- V. Of the abandonment of the invention to the public.

⁸ 1 Web. (720, n.): “What has once been given to the public cannot be resumed; the public being in possession of any species of knowledge, there is no consideration for the exclusive privileges granted by subsequent letters-patent; there is no fresh knowledge to be communicated to the public through the medium of the specification, to constitute the consideration upon which the letters-patent are granted; such knowledge being the price and bargain for the grant, or that which the public get in return for the limited monopoly.”

The necessity for this rule is so evident, and the reasons on which it is based are so forcible, that in its application the courts have been inclined to restrict even the rights which grow out of priority of inventive act and of good faith on the part of the inventor, when they come in conflict with an already

acquired possession of the invention by the public. See § 357 and notes.

§ 72. ¹ In *Earle v. Sawyer* (1825), 4 Mason, 1, Story, J.: (6) “The thing to be patented is not a mere elementary principle, or intellectual discovery, but a principle put in practice, and applied to some art, machine, manufacture, or composition of matter. It must be *new*, and not *known* or *used* before the application; that is, the party must have found out, created, or constructed some art, machine, &c., or improvement on some art, machine, &c., which had not been previously found out, created, or constructed by any other person. . . . It must also be useful, that is, it must not be noxious or mischievous, but capable of being applied to good purposes; and perhaps it may also be a just interpretation of the law that it meant to exclude things absolutely frivolous and foolish.” 1 Robb, 490 (495).

§ 73. Difficulties of the Subject Caused by Failure to Apprehend the True Nature of an Invention.

In discussing these topics we shall encounter certain difficulties, inseparable from any system of positive law which attempts to regulate matters relating to imperfectly understood mental or physical facts. Such systems are not the development of evident and necessary truths, but are built up through the interpretations given by the courts to the terms in which the arbitrary will of the legislative body is expressed; terms not always carefully selected, nor accurately adapted to the subjects which they are intended to control.¹ In all such cases, the nature of the fact to which the law relates, as well as the reason of the law and the principles by which its application must be governed in order that the system may be permanent and beneficial to the state, are of gradual and late discovery; and the efforts of the courts to grasp and formulate them are characterized by many apparent

§ 73. ¹ In reference to no body of law can this proposition be more true than in regard to the English and American law of patents. The law itself was formulated at a period when the fact to which it relates was comparatively little understood, and though the language used was in itself sufficiently clear, the interpretations of it which became necessary, in order to carry out its spirit and intent, depended too much on the essential characteristics of its subject-matter not to suffer in precision and completeness from the general want of exact information in reference to the real nature of an invention. The law itself undertook to protect an invention in the hands of its inventor for a certain time, in consideration of its disclosure to the public; and all its terms and implications were, therefore, to be construed in such a manner as to accomplish this result. In every general interpretation of the law the questions presented were: What is an invention? What is an inventor? and What is a bestowal of the invention

on the public? In every special application of the law the courts were called upon to determine whether the object protected was an invention; whether the patentee was an inventor, and whether he had fulfilled his duty by rendering the invention accessible to the public. All of these are questions of fact, reducible in most instances to one; viz., Is that which the patentee has created or imported and published, an invention? To answer this question a thorough knowledge of the nature of an invention, as a fact in the arts, is of course essential. Whatever legal learning may accomplish in the effort to construe and apply the language of the law, it is evident that no reliable result can be attained without this knowledge. And an examination of the cases chronologically will satisfy the investigator that the development of this legal system has been dependent upon and determined by the development of knowledge concerning the true essential characteristics of the subject-matter to which the law relates.

contradictions, by much uncertainty of language, and by the frequent confusion of ideas which are, in themselves, essentially dissimilar. These difficulties are perhaps less formidable in the present system than in any other, owing partly to its narrow limits, partly to the fortunate expressions which are contained in both the American and English statutes, but they nevertheless exist; and hence, in the examination of the text-books and reported cases, the exercise of constant caution becomes necessary, lest by the overlapping and interlacing of propositions which are really distinct, or by the substitution of the rules governing one branch of the subject for those which properly control another, the reader should be needlessly misled. To remedy as far as possible these evils, our own examination of the system will begin with an endeavor to ascertain the nature and essential attributes of an invention.

CHAPTER I.

OF THE NATURE AND ESSENTIAL ATTRIBUTES OF AN INVENTION.

§ 74. **An Invention is an Unchangeable Fact to which the Law must Conform: Its Comprehension essential to a Comprehension of the Law.**

The one unchangeable factor in all legal questions relating to inventions is the invention itself. An invention is either a physical operation or a physical instrument, and as such its essential characteristics are determined by the laws of nature. No human legislation, no judicial interpretation, can increase, modify, or diminish its necessary attributes, and no legal doctrine concerning it can be correct which is based upon a partial or erroneous view of those inherent qualities that differentiate it from all other actual or possible inventions. What is thus true of individual inventions is true of all inventions, considered as a class of agencies employed by man for the production of physical effects. An invention, in that it is an invention, possesses certain attributes without which it could not be an invention, — attributes which the law cannot alter, and which it cannot ignore with any prospect of arriving at reliable conclusions upon any problem that relates to inventions. A clear and accurate apprehension of these necessary attributes is, therefore, the first step in any investigation of the principles and rules of Patent Law, as well as the only guide to the solution of those difficulties which the practical application of that law presents.

§ 75. **True Nature of an Invention but Recently Disclosed.**

It is not the least remarkable feature in the history of our Patent Law, that this fundamental conception has been the latest in definition and development of any connected with inventions. The earlier courts contented themselves with the

construction of the statutes, and with the decision of the individual cases presented to them, according to the crude notions of physical agencies which then prevailed. As new questions arose, not of law merely but of law as interpreted by the subject-matter to which it related, they were compelled to penetrate more and more deeply into the mysteries of nature and examine the inherent properties of the instruments and operations whose identity or diversity was to be determined, until within the past few years the essential characteristics of an invention itself have been elucidated and established as the foundation on which the entire structure of legislation and interpretation rests. To our own courts, and to certain of their able and experienced judges whose opinions will be freely cited in the following pages, is this great advancement toward a correct and exhaustive knowledge of the law of patents for inventions largely due.

§ 76. **Nature of an Invention Ascertained by Examining the Inventive Act from which it Results.**

No apprehension of an effect can be more perfect than that which is obtained through an examination of its cause. An invention is the effect of an inventive act, and it has been by passing from the study of the invention — the effect, to that of the inventive act — its cause, that the great progress in our modern understanding of the subject has been achieved. Every invention has its origin in man. It is his addition to the agencies already existing in nature, and owes to him its generation, its birth, its growth, and its application to the purposes for which it was designed. Beyond the brain which conceives and the hand which fashions it human investigation cannot penetrate. We must be satisfied to pause when we have discerned the mental processes and manual operations which result in an invention, and have learned from them the essential characteristics which every invention must possess. To the inventive act we therefore turn our attention, as furnishing to us a correct and definite apprehension of the attributes which must be found in every true invention.

§ 77. **Inventive Act Twofold: Mental and Physical.**

Every invention contains two elements: (1) An idea conceived by the inventor; (2) An application of that idea to the production of a practical result.¹ Neither of these elements is alone sufficient. An unapplied idea is not an invention. The application of an idea, not original with the person who applies it, is not an invention. Hence, the inventive act in reality consists of two acts; one mental, the conception of an idea; the other manual, the reduction of that idea to practice.² It is especially in the mental act that the questions which confront us find their answer.

SECTION I.

OF THE MENTAL PART OF THE INVENTIVE ACT.

§ 78. **Mental Part of Inventive Act Includes an Exercise of the Creative Faculties, Generating a new Idea.**

The mental faculties employed in the inventive act are the *creative* not the *imitative* faculties.¹ An invention is the

§ 77. ¹ In *Horton v. Mabon* (1862), 12 C. B. N. S. 437, Willes, J.: "The invention consists in the idea, and the mode in which the idea is made of practical utility." *Cited Higgins*, § 88.

² That the inventive act consists in conceiving an idea and reducing it to practice, see *Adams v. Edwards* (1848), 1 Fisher, 1; *Thomas v. Weeks* (1827), 2 Paine, 92.

§ 78. ¹ In *May v. County of Fond du Lac* (1886), 27 Fed. Rep. 691, Dyer, J.: (695) "To be patentable, a thing must not only be new and useful, but must amount to an invention or discovery."

In *Rosenwasser v. Berry* (1885), 22 Fed. Rep. 841, Colt, J.: (843) "Not every improvement is invention; but to entitle a thing to protection it must be the product of some exercise of the inventive faculties, and it must involve

something more than what is obvious to persons skilled in the art to which it relates."

In *Conover v. Roach* (1857), 4 Fisher, 12, Hall, J.: (16) "An invention in the sense of the patent law, as I understand it, means the finding out — the contriving, the creating . . . of something which did not exist, and was not known before, and which can be made useful and advantageous in the pursuits of life, or which can add to the enjoyment of mankind."

In *Ransom v. The Mayor of New York* (1856), 1 Fisher, 252, Hall, J.: (265) "Invention, in the sense of the patent law, is the finding out, contriving, devising, or creating something new and useful, which did not exist before, by an operation of the intellect."

That not every new thing is an in-

product of original thought. It involves the spontaneous conception of some idea not previously present to the mind of the inventor. Industry in exploring the discoveries and acquiring the ideas of others; wise judgment in selecting and combining them; mechanical skill in applying them to practical results; none of these are creation, none of these enter into the inventive act.² Only when the mind of

vention, see *Landesmann v. Jonasson* (1887), 32 Fed. Rep. 590.

² In *Hollister v. Benedict Mfg. Co.* (1884), 113 U. S. 59, Matthews, J. : (73) "As soon as the mischief became apparent, and the remedy was seriously and systematically studied by those competent to deal with the subject, the present regulation was promptly suggested and adopted, just as a skilled mechanic, witnessing the performance of a machine, inadequate, by reason of some defect, to accomplish the object for which it had been designed, by the application of his common knowledge and experience, perceives the reason of the failure, and supplies what is obviously wanting. It is but the display of the expected skill of the calling, and involves only the exercise of the ordinary faculties of reasoning upon the materials supplied by a special knowledge, and the facility of manipulation which results from its habitual and intelligent practice; and is in no sense the creative work of that inventive faculty which it is the purpose of the Constitution and the patent laws to encourage and reward."

In this opinion the same justice accurately defines inventive skill as "that intuitive faculty of the mind put forth in the search for new results, or new methods, creating what had not before existed, or bringing to light what had lain hidden from vision," as opposed to a "suggestion of that common experience which arose spontaneously and by a necessity of human reasoning in

the minds of those who had become acquainted with the circumstances with which they had to deal."

In *Atlantic Works v. Brady* (1883), 107 U. S. 192, Bradley, J. : (199) "The process of development in manufactures creates a constant demand for new appliances, which the skill of ordinary head-workmen and engineers is generally adequate to devise, and which, indeed, are the natural and proper outgrowth of such development. Each step forward prepares the way for the next, and each is usually taken by spontaneous trials and attempts in a hundred different places. To grant to a single party a monopoly of every slight advance made, except where the exercise of invention, somewhat above ordinary mechanical or engineering skill, is distinctly shown, is unjust in principle and injurious in its consequences. The design of the patent laws is to reward those who make some substantial discovery or invention, which adds to our knowledge and makes a step in advance in the useful arts. Such inventors are worthy of all favor. It was never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea, which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufactures." 23 O. G. 1330 (1332).

In *Smith v. Elliott* (1872), 1 O. G. 331, Woodruff, J. : (332) "The law, however, gives no monopoly to industry, to wise judgment, or to mere me-

the inventor originates an idea new to himself, if not to

mechanical skill in the use of known means, nor to the product of either if it be not new. These are within the proper field of competition, and open to all. In general they will in that competition be justly appreciated, and will command their proper remuneration if usefully employed. It is invention of what is new, and not comparative superiority or greater excellence in what was before known, which the law protects as exclusive property, and it is that alone which is secured by patent.

. . . (333) On that subject it should be observed that there are many changes which may be suggested by the judgment or taste of the manufacturer, or by the particular uses to which the article produced is to be applied, which are not invention; and many exhibitions of superior skill in producing an article of greater excellence, which are not invention. Thus, if a fabric be already known and in use, change of color, change of mere material, change in its degree of fineness, or in the fineness of the parts thereof, if these changes involve nothing new in construction, nor in the relations of its parts, nor in the office or function of either part, the whole do not constitute invention, although for many purposes these may constitute the greater excellence of the fabric." 9 Blatch. 400 (403); 5 Fisher, 315 (318).

In *Tatham v. Le Roy* (1852), 2 Blatch. 474, Nelson, J. : (488) "In order to ascertain and determine whether the change in the arrangement and construction of an existing machine is to be considered as a substantial change or not, you must ascertain and determine whether the change is the result of mechanical skill, worked out by mechanical devices — of a knowledge that belongs to that department of labor — or whether the change is the result

of mind, of genius, of invention, in which you discover something more than mere mechanical skill and ingenuity. A change in the arrangement and construction is not substantial, unless you find embodied in it, over and beyond the skill of the mechanic, that inventive element of the mind which is to be found in every machine or improvement that is the proper subject of a patent. If you find that, then the change is a substantial one, that entitles the party to a patent."

That the exercise of inventive as distinguished from mechanical skill is essential to constitute an inventive act, see *Leonard v. Lovell* (1886), 29 Fed. Rep. 310; *Celluloid Mfg. Co. v. Comstock & Cheney Co.* (1886), 27 Fed. Rep. 358; 36 O. G. 1356; *Aron v. Manhattan Ry. Co.* (1886), 26 Fed. Rep. 314; 34 O. G. 1508; *Hartford Woven Wire Mattress Co. v. Peerless Wire Mattress Co.* (1885), 23 Blatch. 227; *Washburn & Moen Mfg. Co. v. Grinnell Wire Co.* (1885), 24 Fed. Rep. 23; *Ames v. Carlton Spring Bed Co.* (1885), 24 Fed. Rep. 785; 32 O. G. 1238; *Kappes v. Hartung* (1885), 23 Fed. Rep. 187; 32 O. G. 652; 23 Blatch. 152; *Phillips v. Carroll* (1885), 23 Fed. Rep. 249; 31 O. G. 265; *Hollister v. Benedict Mfg. Co.* (1885), 113 U. S. 59; *Celluloid Mfg. Co. v. Chrolithion Collar & Cuff Co.* (1885), 23 Fed. Rep. 397; 31 O. G. 519; 23 Blatch. 205; *Rosenwasser v. Berry* (1885), 22 Fed. Rep. 841; *Mosler Safe & Lock Co. v. Mosler* (1885), 31 O. G. 1689; 22 Fed. Rep. 901; *Spill v. Celluloid Mfg. Co.* (1884), 21 Fed. Rep. 631; 22 Blatch. 441; *Nicodemus v. Frazier* (1884), 19 Fed. Rep. 260; *Thompson v. Boisselier* (1884), 114 U. S. 1; 31 O. G. 377; *Estey v. Burdett* (1884), 109 U. S. 633; 26 O. G. 637; *Morris v. McMillin* (1884), 112 U. S. 244; 29 O. G. 951; *Phillips v. Detroit*

all the world, does he call into exercise his own inventive

(1884), 111 U. S. 604; *Double Pointed Tack Co. v. Two Rivers Mfg. Co.* (1883), 109 U. S. 117; 25 O. G. 1075; *National Mfg. Co. v. Myers* (1883), 23 O. G. 1443; 15 Fed. Rep. 237; *Wood v. Packer* (1883), 17 Fed. Rep. 650; *Slawson v. Grand St. R. R. Co.* (1883), 107 U. S. 649; 24 O. G. 99; *Clark Pomace Holder Co. v. Ferguson* (1883), 21 Blatch. 376; 17 Fed. Rep. 79; 24 O. G. 1090; *Wallace v. Noyes* (1882), 23 O. G. 435; 21 Blatch. 83; 13 Fed. Rep. 172; *Mackay v. Jackman* (1882), 22 O. G. 85; 12 Fed. Rep. 615; 20 Blatch. 466; *Atlantic Works v. Brady* (1882), 107 U. S. 192; 23 O. G. 1330; *Bruce v. Marder* (1882), 22 O. G. 1039; 20 Blatch. 355; 10 Fed. Rep. 750; *Packing Co. Cases* (1881), 105 U. S. 566; 21 O. G. 1689; *Pratt v. Rosenfeld* (1880), 21 O. G. 866; 3 Fed. Rep. 335; 18 Blatch. 234; 5 Bann. & A. 488; *Pearce v. Mulford* (1880), 102 U. S. 112; 18 O. G. 1223; *Dunbar v. Myers* (1876), 94 U. S. 187; 11 O. G. 35; *Stimpson v. Woodman* (1869), 10 Wall. 117.

That inventive skill and mechanical skill are not easily distinguishable, though the former creates a new idea while the latter employs an old one, see *New York Belting & Packing Co. v. Magowan* (1886), 27 Fed. Rep. 362; 34 O. G. 1159.

That small discoveries may involve inventive skill, see *Hobbie v. Smith* (1886), 27 Fed. Rep. 656.

That study, effort, and experiment are not alone enough to constitute inventive skill, see *Butler v. Steckel* (1886), 27 Fed. Rep. 219; 36 O. G. 455.

That good judgment is not inventive skill, see *Estey v. Burdett* (1884), 109 U. S. 633; 26 O. G. 637.

That reasoning processes are not inventive processes, see *Watson v. Cincinnati, I., St. L. & C. R. R. Co.* (1885), 23 Fed. Rep. 443.

That to use well known materials in conjunction with each other, as mechanics usually do, may show judgment but is not invention, see *Welling v. Crane* (1882), 23 O. G. 189; 14 Fed. Rep. 571.

That to relieve an existing invention from long known and grievous defects is invention, see *Asmus v. Alden* (1886), 27 Fed. Rep. 684; 36 O. G. 231.

That a mere working caution or direction, though if followed it will improve existing modes of operation, is not an invention, see *Patterson v. Gas Light & Coke Co.* (1876), L. R. 2 Ch. 812.

That a mere mode of packing is not an invention, see *Forncrook v. Root* (1884), 29 O. G. 774; 21 Fed. Rep. 328; *King v. Gallun* (1883), 109 U. S. 99; 25 O. G. 980.

But that a mode of packing, producing useful results, may be an invention, see *Eppinger v. Richey* (1877), 14 Blatch. 307; 12 O. G. 714; 3 Bann. & A. 69.

That a mode of arranging and presenting for sale is not an invention, see *Pratt v. Rosenfeld* (1880), 5 Bann. & A. 488; 21 O. G. 866; 18 Blatch. 234; 3 Fed. Rep. 335; *King v. Frostel* (1879), 4 Bann. & A. 236; 8 Bissell, 510; 16 O. G. 956; *Reed v. Reed* (1875), 8 O. G. 193; 12 Blatch. 366; 1 Bann. & A. 515; *Langdon v. De Groot* (1822), 1 Paine, 203; 1 Robb, 433.

That the making of part of a known thing is not invention, see *Seligman v. Day* (1876), 2 Bann. & A. 467; 14 Blatch. 72.

That the mere casting in one piece what was formerly cast in two is not invention, see *Ormson v. Clarke* (1862), 13 C. B. N. s. 337.

That to employ the instinct of animals to apply force to existing machines is not an invention, see *Merrill v. Cousins* (1866), 26 U. C. Q. B. 49.

skill, and perform the mental portion of the inventive act.³

That the discovery of a method of arranging patterns on the material so as to cut it up for use without waste is not invention, see *Walker v. Rawson* (1879), 4 Bann. & A. 128.

That using the same thing on a larger scale is not invention, see *Brainard v. Evening Post Association* (1884), 22 Blatch. 61 ; 19 Fed. Rep. 422.

That to increase power by substituting compound for simple levers is not invention, see *Puetz v. Bransford* (1887), 31 Fed. Rep. 458.

³ In *Earle v. Sawyer* (1825), 4 Mason, 1, Story, J., apparently disputes the doctrine of intellectual creation, and refers the creative act to the actual machine or other instrument produced. Thus he says, speaking of the claims of the defendant, which he overrules: (5) "The whole argument, upon which this doctrine is attempted to be sustained, is, if I rightly comprehend it, to this effect. It is not sufficient, that a thing is new and useful, to entitle the author of it to a patent. He must do more. He must find it out by mental labor and intellectual creation. If the result of accident, it must be what would not occur to all persons skilled in the art, who wished to produce the same result. There must be some addition to the common stock of knowledge, and not merely the first use of what was known before. . . . An invention is the finding out by some effort of the understanding." He then denies this proposition as follows: "It did not appear to me at the trial, and does not appear to me now, that this mode of reasoning upon the metaphysical nature, or the abstract definition of an invention, can justly be applied to cases under the Patent Act. That Act proceeds upon the language of common sense and common life, and has

nothing mysterious or equivocal in it. . . . (6) The thing to be patented is not a mere elementary principle, or intellectual discovery, but a principle put in practice, and applied to some art, machine, manufacture, or composition of matter. It must be *new*, and not *known* or *used* before the application; that is, the party must have found out, created, or constructed some art, machine, &c., . . . which had not been previously found out, created, or constructed by any other person. It is of no consequence, whether the thing be simple or complicated; whether it be by accident, or by long, laborious thought, or by an instantaneous flash of the mind, that it is first done. The law looks to the fact, and not to the process by which it is accomplished. It gives the first inventor, or discoverer of the thing, the exclusive right, and asks nothing as to the mode or extent of the application of his genius to conceive or execute it." 1 Robb, 490 (494).

If the difference between the court and counsel were other than a mere verbal one, it is evident, in the light of later decisions, that the views of the learned judge were incorrect. The patent in question was for a combination of old elements. The defendants contended that the combination was so simple that it did not require inventive skill to make it. The court held that, being new and useful, it was patentable without reference to the intellectual processes involved in its production. The opinions of the court also seem somewhat colored by the then prevailing ideas in the English courts, that the law could take notice only of the concrete practical invention and not of the abstract ideas which lie behind it. Modern judges would probably have sustained the patent on the ground that, while

§ 79. **Mental Part of Inventive Act Includes a Conscious Perception of the Idea Generated by the Creative Faculties.**

Moreover, no exercise of the creative faculties can form a part of the inventive act, unless the idea resulting from such exercise is fully apprehended by the mind of the inventor. To create by accident without a recognition of the fact or nature of his own creation, and consequently without the power to repeat the same creative act, is not invention.¹

intellectual inventive skill is necessary, the novelty and usefulness of the invention were sufficient evidence of its employment. Be this, however, as it may, the necessity of inventive skill, as distinguished from every other "application of genius," is now thoroughly established.

See also the following cases. *Ed- ham v. Washburn* (1874), 4 Clifford, 254; 7 O. G. 649; 1 Bann. & A. 537; *Reed v. Reed* (1874), 12 Blatch. 366; 8 O. G. 193; 1 Bann. & A. 515; *Smith v. Elliott* (1872), 9 Blatch. 400; 5 Fisher, 315; 1 O. G. 331; *Spaulding v. Tucker* (1869), Deady, 649; *Blake v. Stafford* (1867), 3 Fisher, 294; *Woodman v. Stimpson* (1866), 3 Fisher, 98; *Wooster v. Crane* (1865), 2 Fisher, 583; 5 Blatch. 282; *Case v. Brown* (1864), 2 Wall. 320; *Forbes v. Barstow Stove Co.* (1864), 2 Clifford, 379; *Clark Patent Steam & Fire Regulator Co. v. Copeland* (1862), 2 Fisher, 221; *Ransom v. Mayor of N. Y.* (1856), 1 Fisher, 252; *Tatham v. Le Roy* (1852), 2 Blatch. 474.

That mechanical skill must be estimated as it existed at the date of the invention, see *Wilcox v. Bookwalter* (1887), 31 Fed. Rep. 224; 39 O. G. 1200.

That the standard of mechanical skill is being constantly raised and the field of invention narrowed, see *Wilcox v. Bookwalter* (1887), 39 O. G. 1200; 31 Fed. Rep. 224.

§ 79. ¹ In *Ransom v. The Mayor of*

New York (1856), 1 Fisher, 252, Hall, J. : (265) "If there was, at any time, or under any circumstances an accidental combination similar in character to that which the plaintiffs have patented — if that combination was made accidentally or otherwise, under such circumstances that the public obtained no knowledge of the invention — obtained no knowledge of the mode in which (it) could be made available, then the invention was not made by the parties who produced this combination. In other words, if the parties who made the combination, although seeing with the eye, perceived not, or hearing with the ear, understood not what would be the result of this combination, they added nothing to their own stock of knowledge; and the fact if observed by other men, (if they understood it not), added nothing to the knowledge of science upon that subject. Therefore the invention was not made until the parties contriving, or others observing, the existing combination, saw that it could be made available for the purpose of producing a result."

In *Househill Co. v. Neilson* (1843), 1 Web. 673, Hope, J. : (690) "It is not sufficient to show that others, in experiments or incidental trials, had hit upon the same idea, not having made public the principle and the application of it to the same processes. . . . I have to repeat, that the originality of the invention is not destroyed by proof, that, in the history of the arts and trades of

While previous intention to create in this especial form, or even to create at all, is not required, it is essential to the inventive act that the inventor should not only *conceive*, but should also *perceive* his original idea, and should do both so clearly as to make this idea an actual addition to his fund of knowledge, and to be able to communicate it to the public.

§ 80. Mental Part of Inventive Act Complete only when the Idea Generated is Sufficiently Developed for Practical Application.

Again, the idea in which this exercise of the creative faculties results must be complete and capable of practical application. To recognize a public want, to entertain vague notions of some mode in which that want may be supplied, to put forth efforts which approach, however nearly, to the solution of the problem and yet leave it unsolved, are not enough. Such operations never pass beyond the line of mere conjecture or of unsuccessful experiment. They *create* nothing; and though they tend to stimulate and aid creative genius, they are in themselves useless both to the inventor and the public.¹ To

this country, some one or two or even more persons may have apparently had some glimpse of the same conception, in occasional and insulated experiments, which were not prosecuted, nor made known, and from which, so far as the rest of the world were concerned, no result or change followed on former practice."

That unless the idea of the invention is fully present to the mind of the inventor, inventive skill has not been exercised, and no invention has been made, see *Andrews v. Hovey* (1883), 5 McCrary, 181; 26 O. G. 1011; 16 Fed. Rep. 387; *Boyd v. Cherry* (1883), 4 McCrary, 70.

That to make a thing by chance, without the ability to reproduce it, is not invention, see *Maxheimer v. Mayer* (1881), 20 Blatch. 17; 9 Fed. Rep. 460; 20 O. G. 1162; *Andrews v. Carman* (1876), 13 Blatch. 307; 9 O. G.

1011; 2 Bann. & A. 277; *Pelton v. Waters* (1874), 1 Bann. & A. 599; 7 O. G. 425; *Harrison v. Railway Co.* (1860), 6 Jur. N. S. 993; *Minter v. Mower* (1835), 1 Web. 138; 2 Abb. P. C. 178.

That to accidentally produce, without perceiving and comprehending the nature of the result or the mode of producing it, is not invention, see *Libbey v. Mt. Washington Glass Co.* (1886), 26 Fed. Rep. 757; 36 O. G. 572; *Boyd v. Cherry* (1883), 4 McCrary, 70.

That incidental ideas, not discerned by the inventor, are not within the scope of his conception, see *Boyd v. Cherry* (1883), 4 McCrary, 70.

§ 80. ¹ In *Winans v. The New York and Harlem R. R. Co.* (1855), 4 Fisher, 1, Nelson, J. : (9) "Now, the circumstance that a person has had an idea of an improvement in his head, or has sketched it upon paper — has drawn it,

him alone whose mind conceives the perfect, practical, operative idea, — that idea which, when embodied in tangible materials, will accomplish the desired result, — belongs the right of the inventor and the credit of performing the inventive act.²

and then gives it up — neglects it — does not, in judgment of law, constitute or have the effect to constitute him a first and original inventor. It is not the person who has only produced the idea, that is entitled to protection as an inventor, but the person who has embodied the idea into a practical machine, and reduced it to practical use. He who has first done that is the inventor who is entitled to protection. A kindred principle, also, it may be proper to state here, which is, that where a person engaged in producing some new and useful instrument or contrivance, and who has embodied it into a machine, and endeavored to reduce it to practice by experiments — if those trials fail — if he fail in success and abandon it, or give it up, that consideration affords no impediment to another person, who has taken up the same idea or class of ideas, and who has gone on perseveringly in his studies, trials, and experiments, until he has perfected the new idea, and brought it into practical and useful operation. He is the person — the meritorious inventor — who is entitled to the protection of the law.”

In *Goodyear v. Day* (1852), 2 Wall., Jr., 283, Grier, J. : (299) “It is usually the case, when any valuable discovery is made, or any new machine of great utility has been invented, that the attention of the public has been turned to that subject previously; and that many persons have been making researches and experiments. Philosophers and mechanics may have, in some measure, anticipated, in their speculation, the possibility or probability of such discovery or invention; many ex-

periments may have been unsuccessfully tried, coming very near, yet falling short of the desired result. They have produced nothing beneficial. The invention, when perfected, may truly be said to be the culminating point of many experiments, not only by the inventor, but by many others. He may have profited indirectly by the unsuccessful experiments and failures of others; but it gives them no right to claim a share of the honor or the profit of the successful inventor. It is when speculation has been reduced to practice, when experiment has resulted in discovery, and when that discovery has been perfected by patient and continued experiments — when some new compound, art, manufacture, or machine, has been thus produced, which is useful to the public, that the party making it becomes a public benefactor, and entitled to a patent.”

As it is evident that no idea can be embodied in a practical art or instrument until it is sufficiently developed in the mind of the inventor to be thus applied, the rule requiring reduction to practice necessitates the complete development of the idea.

That to have invented a person must not be merely experimenting in the direction of a result, but must have matured his conception into an operative means, see *Voelker v. Gray* (1885), 30 O. G. 1091.

² That to suggest that a given result may be obtained, without indicating the method of obtaining it, is not invention, see *Graham v. Gammon* (1877), 3 Bann. & A. 7; 7 Bissell, 490.

That any mere experiment, as distinguished from practical use, is not

§ 81. **Mental Part of Inventive Act Complete though the full Value of the Idea Generated is not Perceived.**

But while the idea of the invention must thus exist, complete and comprehended, in the mind of the inventor, it is not necessary that he should have fathomed all its possibilities.¹ An invention, though made only for one purpose, is sometimes capable of serving many. In the development of the industrial arts, every really valuable invention finds numerous applications outside the scope of that for which it was originally devised; and some of these are often vastly more important to the public, and more profitable to the inventor, than those which occupied his mind in the performance of the creative act. That these modes of employing his invention are unforeseen does not affect his position or his rights as an inventor, so far as his invention is concerned.² The law regards him as the owner of the invention for any and every purpose to which it can be applied, and thus secures to him the entire benefit of his original idea.³

invention, see *Many v. Sizer* (1849), 1 Fisher, 17.

That if an invention will not answer its purpose without further invention it is not patentable, and a patent for it is void, see *Burrall v. Jewett* (1830), 2 Paige (N. Y.), 134.

§ 81. ¹ That an inventor need not understand all the uses to which his invention may be applied, see *Stow v. Chicago* (1882), 104 U. S. 547; 21 O. G. 790; *Eagleton Mfg. Co. v. West, Bradley & Cary Mfg. Co.* (1880), 17 O. G. 1504; 18 Blatch. 218; 2 Fed. Rep. 774; *Woodbury Patent Planing Mach. Co. v. Keith* (1879), 4 Bann. & A. 100; *Welling v. Rubber Coated Harness Trimming Co.* (1874), 7 O. G. 606; 1 Bann. & A. 282; *Wells v. Jacques* (1874), 1 Bann. & A. 60; 5 O. G. 364.

² That an inventor is entitled to all the benefits of his invention, see *New Process Fermentation Co. v. Koch* (1884), 21 Fed. Rep. 580; 29 O. G.

535; *Union Stone Co. v. Allen* (1882), 15 Phila. 508; *Stow v. Chicago* (1882), 104 U. S. 547; 21 O. G. 790; *Burke v. Partridge* (1878), 58 N. H. 349.

³ The proposition stated in this paragraph must not be so extended as to conflict with two others, which are equally correct. These are: (1) That where the same concrete invention may serve as the embodiment of two distinct ideas, the use of such invention as the expression of one of those ideas is not the use of the invention as the expression of the other; (2) That when the new use of an existing invention involves the exercise of inventive skill, beyond that which was exercised in creating the invention, this new use is itself a new invention, and not included in the invention as originally created.

The scope of the doctrine of this paragraph is, therefore, limited to such benefits as the inventive skill of the inventor in question has actually conferred upon the public, and which are

§ 82. **Mental Part of Inventive Act Complete though the Scientific Principles Underlying the Idea are not Understood.**

Nor is it necessary, on the other hand, that he should comprehend the scientific principles on which the practical effectiveness of his invention rests.¹ The relations that subsist between his idea and the effect which it produces when embodied in an operative form, can be really understood by no one. Human knowledge goes no further than to recognize that when a given action is performed a given event follows; but the tie which binds the action and event together evermore escapes investigation; and when we speak of "laws of nature," or of "causes and effects," we use the language of convenience, not of necessary truth. No deeper insight is required of the inventor in regard to his original idea. If that idea, when practically applied, is followed by the desired result the law is satisfied, whether or not the inventor can explain, or whether any one can understand, the reason of its operation, or state the principle on which the correspondence of effect and cause depends.

thereby made accessible to them without any further exercise of the creative faculties. All these belong to him, whether or not he recognizes their existence, and though they may become apparent only after long use of his invention. A new inventor, conceiving an essentially different idea and expressing it through the same tangible embodiment, does not avail himself of the same invention. And though new inventors devising, by their creative genius, new uses for his old invention cannot employ it for these uses without his consent, the uses they have thus produced do not belong to him, but are their separate and complete inventions.

§ 82. ¹ In *Andrews v. Hovey* (1883), 5 McCrary, 181, Shiras, J. : (194) "Indeed, it is not necessary that the inventor, to be entitled to a patent, should himself understand the abstract principle which his invention brings into use. It is sufficient if he is the inventor of a

means whereby a new and useful application of the abstract principle is brought about." 16 Fed. Rep. 387 (396); 26 O. G. 1011 (1014).

That the inventor need not understand the scientific truths underlying his invention, see *Andrews v. Cross* (1881), 19 O. G. 1705; 8 Fed. Rep. 269; 19 Blatch. 294; *St. Louis Stamping Co. v. Quinby* (1879), 4 Bann. & A. 192; 16 O. G. 135; *Stow v. Chicago* (1877), 3 Bann. & A. 83; 8 Bissell, 47; *Piper v. Brown* (1870), Holmes, 20; 4 Fisher, 175; *Treadwell v. Parrott* (1866), 3 Fisher, 124; 5 Blatch. 369.

But that where his invention purports to be a process consisting in the application of the laws of nature to effect a certain object, the conception of the idea is impossible without a previous perception of the physical laws which it employs, see *Andrews v. Hovey* (1883), 16 Fed. Rep. 387; 26 O. G. 1011; 5 McCrary, 181.

§ 83. **Mental Part of Inventive Act Complete whether Prolonged or Instantaneous.**

The law draws no distinction between those operations of the creative faculties which manifest themselves in long-continued study and experiment, and those which reach their end by sudden intuition or apparent accident.¹ Here also is a

§ 83. ¹ In *Anilin v. Cochrane* (1879), 16 Blatch. 155, Wheeler, J. : (160) "An invention is not like a will, depending on intention. It is a fact, and, if the fact exists, it does not appear to be material whether it came by design, or accidentally without being bidden." 4 Bann. & A. 215 (221).

In *Blake v. Stafford* (1868), 6 Blatch. 195, Shipman, J. : (205) "If no inventive skill, but only mechanical dexterity, was necessary to produce it, then it is not patentable. Originality is the test of invention. If that is successfully exercised, its product is protected; and it is immaterial whether it is displayed in greater or less degree, or whether the new idea revealed itself to the inventor by a sudden flash of thought, or slowly dawned on his mind after groping his way through many and dubious experiments." 3 Fisher, 294 (305).

In *Middletown Tool Co. v. Judd* (1867), 3 Fisher, 141, Shipman, J. : (146) "Whenever a change or device is new, and accomplishes beneficial results, courts look with favor upon it. The law, in such cases, has no nice standard by which to gauge the degree of mental power or inventive genius brought into play in originating the new device. A lucky casual thought, involving a comparatively trifling change, often produces decided and useful results, and though it be the fruit of a very small amount of inventive skill, the patent law extends to it the same protection as if it had been brought forth after a lifetime devoted to the profoundest thought and the most ingenious experiment to attain it."

In *The Magic Ruffle Co. v. Douglass* (1863), 2 Fisher, 330, Shipman J. : (338) "A subject-matter to be patentable must require invention, but is not necessarily the result of long and painful study, or embodied alone in complex mechanism. A single flash of thought may reveal to the mind of the inventor the new idea, and a frail and simple contrivance may embody it. Some inventions are the result of long and weary years of study and labor, pursued in the face of abortive experiments and baffled attempts, and finally reached after the severest struggles, while others are the fruit of a single happy thought."

In *Crane v. Price* (1842), 1 Web. 393, Tindal, C. J. : (411) "In point of law, the labor of thought, or experiments, and the expenditure of money, are not the essential grounds of consideration on which the question, whether the invention is or is not the subject-matter of a patent ought to depend. For if the invention be new and useful to the public, it is not material whether it be the result of long experiments and profound research, or whether by some sudden and lucky thought, or mere accidental discovery." Utility to the public, and the fact that the public received the invention from the patentee, being in England the real basis of the patent, it was of course immaterial whether the patentee was an inventor or an importer, and if an inventor, whether his inventive act were sudden and easy or laborious and prolonged. Where, as in this country, the inventive act is regarded as also a ground,

region in which human knowledge is at fault. Indeed, it may well be doubted whether the creative act is over otherwise than instantaneous and intuitive, and whether research and reflection ever do more than clear the way for, and dispose the mind toward those sudden apprehensions of the truth to which in literature and the arts we give the names "invention" and "discovery." The law does not attempt to settle questions which thus lie beyond the reach of mental science. Wherever the creative faculties have evidently been at work, it inquires neither as to the method nor the duration of their exercise.² The patient labors of a lifetime, the unpremeditated flash of an original thought upon the mind, the revelation made to an appreciative intellect by some trivial accident,³ all stand upon an equal footing both in character and merit, and are entitled to the same reward.

§ 84. Mental Part of Inventive Act Complete though Aided by External Suggestions.

Nor does the law take notice of the aid which the inventor has derived from the suggestions, writings, or experiments of others, provided the creative act be truly his.¹ Unless the

perhaps the principal ground, of merit, the doctrine of this case can be maintained, as it has always been, only for the reason that the character of the inventive act is not dependent upon its difficulty or duration, but on its employment of the creative faculties of the human mind.

² That the degree of inventive skill is immaterial, see *Furbush v. Cook* (1857), 2 Fisher, 668; *Carr v. Rice* (1856), 1 Fisher, 198. (See also cases cited in § 85, note 2.)

³ Some valuable and remarkable inventions are said to have thus owed their origin to accident or the instantaneous conception of the mind. One of the most interesting cases upon this point is that of the "Water Tabbies." A workman, having spat on the floor, put his hot iron upon it, and observed

that it spread into a kind of flower. He afterwards tried the experiment upon linen and found it produced the same effect. He then obtained a patent, and lived to make a considerable fortune. 1 Web. 54, note.

§ 84. ¹ In *Hall v. Johnson* (1883), 23 O. G. 2411, Marble, Com. : (2412) "Mere suggestions, even if they point toward a result, are not sufficient to entitle one making them to be considered the inventor. In order that he may claim the benefit of what another does his suggestions must leave nothing for the mechanic to do but to work out what has been suggested."

In *The Union Paper Bag Machine Co. v. Pultz and Walkley Co.* (1878), 15 O. G. 423, Shipman, J. : (424) "Knowledge of prior experiments by another will not defeat the claim of the

idea which constitutes the spirit of his invention has been obtained by him from other persons, complete and capable of

patentee to an invention if it appears that, after those experiments were abandoned, he first perfected and adapted the invention to actual use; but he will not be an original inventor, and his claim to originality will be defeated if the knowledge or information which he derived from the abandoned models or experiments was sufficiently definite and clear to enable him to construct the improved thing which was the subject of his alleged invention. . . . (425) The patentee has a right to take up the improvement at the point where it was left by his predecessor, and if, by the exercise of his own inventive skill, he is successful in first perfecting and reducing to practice the invention which his predecessor undertook to make, is entitled to the merit of such improvement as an original inventor. . . . And if he is an original inventor of the improvement he is entitled to the benefit of unsubstantial variations and modifications in form of the principle of his invention, notwithstanding such modifications may run into and include the forms of mechanism shown in the abandoned experiments of which he had knowledge." 15 Blatch. 160 (165, 166); 3 Bann. & A. 403 (407, 408).

In *The United Nickel Co. v. Anthes* (1872), 1 O. G. 578, Shepley, J. : (581) "However suggestive the experiments of others may have been . . . they cannot be made available to defeat a patent granted to one who, after all the experimenters had failed to secure a practical and successful result beneficial to the community and a valuable contribution to the useful arts, first succeeded so as to be able to disclose to the public a practically useful and successful process, by him first brought

to perfection and first made capable of useful application." Holmes, 155 (160); 5 Fisher, 517 (523).

In *Judson v. Moore* (1859), 1 Fisher, 544, Leavitt, J. : (555) "Mere conversations about the practicability of an improvement, or suggestions as to the manner in which it might be carried out or accomplished, will not of themselves defeat the claims to originality of him who perfects the idea and secures a patent. Neither will experiments defeat, even if known to the patentee, if it appear that he prosecuted such experiments to final success; but any information to a patentee, sufficient to enable him to construct the thing itself, would destroy the originality of the invention. But that knowledge must be definite and tangible; it should be sufficient of itself to enable the party to whom it was imparted, to construct the improvement." 1 Bond, 285 (298).

In *O'Reilly v. Morse* (1853), 15 How. 62, Taney, C. J. : (111) "Neither can the inquiries he made, or the information or advice he received, from men of science in the course of his researches, impair his right to the character of an inventor. No invention can possibly be made, consisting of a combination of different elements of power, without a thorough knowledge of the properties of each of them, and the mode in which they operate on each other. And it can make no difference, in this respect, whether he derives his information from books, or from conversation with men skilled in the science. If it were otherwise, no patent, in which a combination of different elements is used, could ever be obtained. For no man ever made such an invention without having first obtained this information, unless it was

practical application, it is his own creation and not theirs, however closely their imperfect notions may approach to his.

discovered by some fortunate accident."

In *Pitts v. Hall* (1851), 2 Blatch. 229, Nelson, J. : (234) "Now, there is no doubt that a person, to be entitled to the character of an inventor, within the meaning of the Act of Congress, must himself have conceived the idea embodied in his improvement. It must be the product of his own mind and genius and not of another's. . . . At the same time, it is equally true that, in order to invalidate a patent on the ground that the patentee did not conceive the idea embodied in the improvement, it must appear that the suggestions, if any, made to him by others, would furnish *all* the information necessary to enable him to construct the improvement. . . . If they simply aided him in arriving at the useful result, but fell short of suggesting an arrangement that would constitute a complete machine, and if, after all the suggestions, there was something left for him to devise and work out by his own skill or ingenuity, in order to complete the arrangement, then he is, in contemplation of law, to be regarded as the first and original discoverer. On the other hand, the converse of the proposition is equally true. If the suggestions or communications of another go to make up a complete and perfect machine, embodying all that is embraced in the patent subsequently issued to the party to whom the suggestions were made, the patent is invalid, because the real discovery belongs to another." See also *International Tooth Crown Co. v. Richmond* (1887), 30 Fed. Rep. 775.

That an inventor may employ the mechanical skill of others and take their suggestions, see *Yoder v. Mills* (1885), 25 Fed. Rep. 821 ; 34 O. G. 1048.

That if the entire idea of the invention as a practical working means is derived from the suggestions of others, the alleged inventor is not entitled to a patent for it, see *Atlantic Works v. Brady* (1882), 107 U. S. 192 ; 23 O. G. 1330 ; *Spaulding v. Tucker* (1869), Deady, 649 ; *Thomas v. Weeks* (1827), 2 Paine, 92.

That mere suggestions of others do not show a want of inventive skill unless they suggest the entire invention, see *Butch v. Boyer* (1871), 8 Phila. 57 ; *Hubbell v. United States* (1869), 5 Court of Claims, 1 ; *Slemmer's Appeal* (1868), 58 Pa. St. 155.

That suggestions of part of the idea do not indicate want of inventive skill as to the whole, see *Celluloid Mfg. Co. v. Chrolithion Collar & Cuff Co.* (1885), 23 Fed. Rep. 397 ; 31 O. G. 519 ; 23 Blatch. 205 ; *Hall v. Johnson* (1883), 23 O. G. 2411 ; *Worden v. Fisher* (1882), 21 O. G. 1957 ; 11 Fed. Rep. 505 ; *National Feather Duster Co. v. Hibbard* (1881), 11 Bissell, 76 ; 21 O. G. 635 ; 9 Fed. Rep. 558.

That suggestions are not inconsistent with inventive skill unless they are so complete that it is unnecessary, see *Watson v. Belfield* (1886), 26 Fed. Rep. 536 ; 35 O. G. 1112.

That if, in addition to the ideas derived from such suggestions, inventive skill of his own was necessary in order to produce an operative means, he is the true inventor and entitled to a patent, see *Worden v. Fisher* (1882), 11 Fed. Rep. 505 ; 21 O. G. 1957 ; *National Feather Duster Co. v. Hibbard* (1881), 11 Bissell, 76 ; 9 Fed. Rep. 558 ; 21 O. G. 635 ; *Union Paper Bag Mach. Co. v. Pultz & Walkley Co.* (1878), 15 Blatch. 160 ; 15 O. G. 423 ; 3 Bann. & A. 403 ; *United Nickel Co.*

The law can draw no line between the ideas suggested to his mind by such external objects, and those which his mind generates from these suggestions. It can look only to the words and things from which his ideas may have been derived, and if it cannot find in them, apparent to the public view, the entire original idea as claimed by the inventor, it does not venture to dispute his right.

§ 85. Mental Part of Inventive Act Complete though the Idea Generated be of Small Value.

Lastly, the magnitude of the results which flow from the inventive act furnish no test by which its merits are determined. The advance made by the inventor may be slight, the benefit conferred upon the public may be small, but though these considerations influence the recompense which he eventually receives, they do not affect the intrinsic character of the

v. Anthes (1872), 5 Fisher, 517 ; 1 O. G. 578 ; *Holmes*, 155 ; *Waterbury Brass Co. v. Miller* (1871), 5 Fisher, 48 ; 9 Blatch. 77 ; *Matthews v. Skates* (1860), 1 Fisher, 602 ; *Bell v. Daniels* (1858), 1 Fisher, 372 ; 1 Bond, 212 ; *O'Reilly v. Morse* (1853), 15 How. 62 ; *Pitts v. Hall* (1851), 2 Blatch. 229 ; *Alden v. Dewey* (1840), 1 Story, 336 ; 2 Robb, 17.

That inventive skill may exist though the invention were suggested by the defective operation of previous devices, see *Heysinger v. Crawford* (1883), 16 Phila. 568.

That suggestions derived from the unsuccessful experiments of others do not exclude the exercise of inventive skill, see *Consolidated Valve Co. v. Crosby Valve Co.* (1885), 113 U. S. 157 ; 30 O. G. 991 ; *Whittlesey v. Ames* (1880), 18 O. G. 357 ; 9 Bissell, 225 ; 5 Bann. & A. 96 ; 13 Fed. Rep. 893 ; *Roberts v. Dickey* (1872), 4 Brews. (Pa.) 260 ; 1 O. G. 4 ; 4 Fisher, 532 ; *Spanlding v. Tucker* (1869), Deady, 649 ; *Hubbell v. United States* (1869),

5 Court of Claims, 1 ; *Agawam Co. v. Jordan* (1868), 7 Wall. 583 ; *Haselden v. Ogden* (1868), 3 Fisher, 378 ; *Matthews v. Skates* (1860), 1 Fisher, 602 ; *Bell v. Daniels* (1858), 1 Bond, 212 ; 1 Fisher, 372 ; *Pitts v. Hall* (1851), 2 Blatch. 229.

That the employment of ideas gathered from books is not inconsistent with inventive skill, see *O'Reilly v. Morse* (1853), 15 How. 62.

That the application of ideas suggested in prior patents, if not sufficiently explained therein to render the whole invention accessible to the public, does not exclude inventive skill, see *Baldwin v. Schultz* (1871), 5 Fisher, 75 ; 9 Blatch. 494 ; 2 O. G. 315 ; *Graham v. Mason* (1869), 5 Fisher, 1 ; 4 Clifford, 88.

That to reorganize an old invention, which is based on wrong principles, and render it successful is invention, see *Cammeyer v. Newton* (1874), 12 Blatch. 122 ; 5 O. G. 753 ; 1 Bann. & A. 294.

creative act.¹ The exercise of the inventive faculties in the production of a practical result having been once conceded, the degree and quantity of inventive skill which it involves are immaterial.² It falls within the purview of the law as an

§ 85. ¹ In *Pearl v. Ocean Mills* (1877), 2 Bann. & A. 469, Shepley, J. : (476) "No more difficult task is imposed upon the court in patent causes than that of determining what constitutes invention, and of drawing the line of distinction between the work of the inventor and the constructor. The change from the old structure to the new may be one which one inventor would devise with the expenditure of but little thought and labor, and another would fail to accomplish after long and patient effort. It may be one, which one whose mind is fertile in invention will suggest almost instantaneously, when the skilled hand of the constructor will fail to reach the apparently simple result by the long and toilsome process of experiment. It may be one which, viewed in the light of the accomplished result, may seem so simple as to be obvious almost to an unskilled operative, and yet the proof may show that this apparently simple and obvious change has produced a result which has for years baffled the skill of the mechanical expert, eluded the search of the discoverer, and set at defiance the speculations of inventive genius." 11 O. G. 2 (4).

In *Soames' Patent* (1843), 1 Web. 729, Brongham, J. : (735) "It is very fit their lordships should guard against the inference being drawn, from the small amount of any step made in improvement, that they are disposed to undervalue that in importance; if a new process is invented, if new machinery is invented, if a new principle is found out and applied so as to become the subject of a patent right, embodied in a manufacture, then, how-

ever small it may be in advance of the state of science or of art previous to the period of that step being made, that is no reason whatever for undervaluing the merits of the person who makes a discovery in science or an invention in art, because the whole history of science, from the greatest discoveries down to the most unimportant . . . is one continued illustration of the slow progress by which the human mind makes its advance in discovery; it is hardly perceptible, so little has been made by any one step in advance of the former state of things, because generally you find that just before there was something very nearly the same thing discovered or invented. Therefore it is no argument whatever in general, if there is a new principle, or a novel invention."

² That if inventive skill is actually exercised the degree of it is immaterial, see *Washburn & Moen Mfg. Co. v. Haish* (1880), 10 Bissell, 65; 4 Fed. Rep. 900; 19 O. G. 173; *Strobridge v. Lindsay* (1880), 18 O. G. 62; 5 Bann. & A. 411; 2 Fed. Rep. 692; *Pearl v. Ocean Mills* (1877), 2 Bann. & A. 469; 11 O. G. 2; *Potter v. Holland* (1858), 4 Blatch. 238; 1 Fisher, 382; *Many v. Sizer* (1849), 1 Fisher, 17; *Earle v. Sawyer* (1825), 4 Mason, 1; 1 Robb, 490.

That, on the contrary, the simplicity of the invention increases the merit of the inventive act, see *Yates v. Ry. Co.* (1877), 24 Grant Ch. (Can.) 495; *Summers v. Abell* (1869), 15 Grant Ch. (Can.) 532; *Powell v. Begley* (1867), 13 Grant Ch. (Can.) 381; *Muntz's Patent* (1846), 2 Web. 113.

invention, and is entitled to the same protection as if it were the most important of discoveries.

§ 86. **Mental Part of Inventive Act Defined.**

These characteristics of the mental part of the inventive act lead to the following as its definition: It is an exercise of the creative faculties, generating an idea which is clearly recognized and comprehended by the inventor, and is both complete in itself and capable of application to a practical result. Of the nature of the idea thus generated, and of the mode in which this exercise of the creative faculties is indicated, it next becomes our province to inquire.

SECTION II.

OF THE NATURE AND FACTORS OF THE IDEA GENERATED BY THE MENTAL PART OF THE INVENTIVE ACT.

§ 87. **The Generated Idea an Idea of Means, not an Idea of End.**

Two ideas are present to the mind of an inventor during his performance of the inventive act: (1) The idea of an end to be accomplished; (2) The idea of a means by which that end can be attained. The same ideas are manifest in the invention when reduced to practice and engaged in the production of its appropriate result.¹ In one or both of these ideas, therefore, resides the essence of the invention,—that characteristic principle on which its individuality depends, and by whose presence or absence its identity must be determined.² And here arise the fundamental questions upon

§ 87. ¹ In *Curtis v. Platt* (1863), cited in note to *Adie v. Clark* (1876) L. R. 3 Ch. 135, Wood, V. C. : (136) "In all discoveries of course there are two things—there is an object to be achieved and a means of achieving that object."

² In discussing an abstract as distinguished from a concrete invention, certain radical differences between them

must be remembered, or confusion will inevitably result. The abstract invention is the mental conception of the inventor. The concrete invention is that mental conception embodied in some operative art or instrument. In the abstract invention the end and means are inseparable from each other; the idea of means being unthinkable except in connection with the idea of

whose answer all other doctrines of the Patent Law are based : What is the essence of an invention ? What is the idea whose generation in the mind of the inventor constitutes the mental part of the inventive act ? Is it the idea of end, or is it the idea of means, or does it include both ? The rule, defined and analyzed in the last section, affords us a sufficient guide to the solution of this question. That rule excludes from the inventive act every mental operation which does not involve the exercise of the creative faculties. The application of this rule will demonstrate that the idea of means alone, and not the idea of end, is the result of the inventive act and, therefore, is the essence of the invention.

§ 88. **Idea of End Perceived but never Generated by the Inventor.**

The end to be accomplished by the invention is the satisfaction of a public want. This want is an existing fact. It grows inevitably out of the relations which man occupies to the external world. It can be satisfied only by such a change in those relations as will supply or terminate the want. The satisfaction of a want thus consists in a new condition of affairs, substituted for that in which the want originates.¹ Each of these two conditions is necessarily the antithesis or converse of the other, and hence whenever either is perceived the other is immediately suggested. Neither the idea of the want nor that of its satisfaction, therefore, is created or conceived by the inventor. As intellectual entities each has perpetual

that end to which it is a means. But the concrete invention does not usually express the idea of the end to be accomplished. It represents the idea of the means alone, the end coming into view only as the art or instrument is practically employed. Hence in speaking of the invention as it lies in the mind of the inventor, the end may properly be treated as a necessary subject for consideration as interpreting and defining the idea of means, although the latter is not yet embodied in tangible materials nor capable of producing

any practical results. But in discussing the concrete invention, the end must be regarded as unknown until by actual use of the invention the effect which it accomplishes can be ascertained.

§ 88. ¹ The word "satisfaction" admits of two significations : (1) The new condition of things, in which the want disappears ; (2) The method or operation by which the new condition is substituted for the old. In this sentence it is used in the former sense ; i. e., as *an effect produced*.

existence. To him may come the first perception of the want, and also the first idea of that condition of affairs in which the want will be extinguished, but thus far he has only seen what lies before the unconscious eyes of all mankind. Not until he endeavors to devise a means by which this change in his relations to the external world can be accomplished, and the new state of satisfaction be substituted for the state of want, do his creative faculties commence their operations. And this is true in reference to the satisfaction of his artificial wants, as well as in regard to those which are of common and continual recognition. These wants are all existing facts, suggesting their own satisfactions. However limited and special in itself, every artificial need is only one phase of a greater and once universal need which has been narrowed and divided by the successive triumphs of human ingenuity. Each new invention brings into clearer light the subordinate necessities which still remain, points out the new state of affairs in which the satisfaction of the want consists, and demands for its accomplishment a new exertion of inventive skill.² He who

² It is hardly possible to believe that a proposition so simple and self-evident as this could ever be forgotten or ignored. Yet many of the difficulties encountered in the development of Patent Law seem to have their origin just here. As we go forward it will be seen that an invention is a means, and a means only; and, therefore, that in determining the scope of any given invention it is, first of all, necessary to draw the line between such invention, as a means, and the effect which it produces. But in many cases the careful student will discover that this line has been missed, through a failure of the courts to recognize the truth that every want, and consequently every satisfaction of a want (i. e., every new condition in which a want disappears), is an existing fact; a fact to be perceived, not a thing or state to be conceived or created; and hence that judges have had recourse to doctrines not properly

applicable to the case at bar in order to support what evidently merited a patent, or to reject what certainly was not entitled to protection under the law. Instances of this are especially frequent in those cases which have been decided upon the doctrines of double use, or of the non-patentability of a principle. But it is evident that even the narrowest and most technical invention must have been devised to meet some want existing in the art to which the invention belongs, and that the invention is not itself the satisfaction but the means by which the satisfaction is produced. The want may never have been apparent until some previous invention, partially or imperfectly satisfying the more universal want, disclosed this subordinate and narrower need; but the need was nevertheless a fact, open to the observation of all men, and sure to be perceived by those skilled in the art and interested in its development.

perceives these new necessities and satisfactions, and devises means by which the state of satisfaction is substituted for the

Thus it was once impracticable for men to hold communication with each other at remote distances, without the aid of messengers, passing between one and the other. This universal want was limited in scope when blazing fires from lofty hilltops were adopted as signals mutually understood; thereby revealing the new, narrower want of some more certain, rapid, and intelligible mode by which information might be conveyed. In answer to this want the Semaphore, with its movable shutters, was devised, taking the place of the beacon-fire upon the hilltops, and affording sixty-three distinct messages, where but one or two had before been possible. This new device, however, only served to make still clearer the necessity for some mode of communication, by which the intermediate hill-top stations could be dispensed with, and the character of the messages be indefinitely varied; and the capabilities of the Semaphore being exhausted, attention was directed to the electric force as a means for the supply of this late-felt demand. The electric telegraph was not directed to the satisfaction of the old, original, universal want. That had ceased to exist in its fulness; for mankind were already in possession of the system of communicating by intelligible signals. The telegraph was a new method of forming such signals, having many advantages in efficacy and economy over the one then in use. With its introduction the want of communicating power at great distances without intermediate stations disappeared, and narrower wants became visible, relating to the more accurate and rapid operation of the instruments employed. Every successive improvement of the telegraph has substituted a better condition of affairs for a worse, but at the

same time has made evident the imperfections which remain to be removed, and has thus called for new exertions of inventive skill. In each case, as the end has become narrower and more special, the scope of the means devised to meet it has been correspondingly contracted; but wherever any want has become known it has been only as the subject of observation, the means by which its satisfaction was accomplished alone being the product of creative power. The same may be said of the development of every other great original invention, — the Steam-engine, the Smelting-furnace, the Sewing-machine, &c., — every advance in which has been made in obedience to some new need, disclosed by previous advances, and supplied by further triumphs of the inventive faculties. This truth is the foundation of the rule that all inventions must be studied in the light afforded by the state of the art, to which they belong, at the time the invention was made. By an examination of this art the exact want which the invention was intended to supply is ascertained, and in the attributes of the invention as adapted to that end, and in its operation while fulfilling it, the real character and purpose of the invention are disclosed. Regarded from this stand-point, the tests of novelty, utility, and the presence of inventive as distinguished from mechanical skill, may be applied to it with ease and accuracy, and the danger of erroneously awarding or denying the protection of the law to the invention is avoided.

That to perceive a hitherto unperceived quality in a known substance is not the invention of the substance nor of the quality, see *Ansonia Brass & Copper Co. v. Electrical Supply Co.* (1887), 32 Fed. Rep. 81; 42 O. G. 1168.

state of want, is a true inventor; but he who merely sees the want and its antithesis performs no part of the inventive act.

§ 89. **Idea of Means Necessarily Generated by some Inventor.**

The means by which man satisfies a want arising out of his relations to the external world is, on the contrary, invariably the result of the creative act. The idea which underlies it is necessarily *conceived* by one before it can be *perceived* by any. However great the want, however simple the method by which it is supplied, that method can originate only through the exercise of faculties which produce new operations or devices, and not merely discern and imitate the old. When man first came in contact with material nature, he found awaiting him the means of satisfying his most urgent if not all of his essential needs. Fruit offered itself to him for his food, water for drink, the caves and forests for his shelter. Beyond what nature thus spontaneously provided, he could not pass without employing his inventive skill, and every step in his material advancement has consisted in the creation of new means by which his constantly suggested wants could be supplied. The process by which he first generated artificial light or heat was thus as truly an invention as his last conquest over the difficulties of petroleum or electricity. The first rude car, on which he carried burdens previously borne upon his shoulders, embodied his creative act as fully as the ponderous engine whose glittering wheels transport the wealth of nations across continents with ceaseless energy and lightning speed.

§ 90. **Every Concrete Invention a Means, not an End.**

Judged by this test it is apparent that an invention, considered in itself, is neither an end nor a combination of both means and end, but is a means for the attainment of an end;¹

§ 90. ¹ In *Electric Railroad Signal Co. v. Hall Railway Signal Co.* (1885), 114 U. S. 87, Matthews, J. : (96) "The thing patented is the particular means devised by the inventor by which that

result is attained, leaving it open to any other inventor to accomplish the same result by other means." 31 O. G. 515 (517).

In *Fuller v. Yentzer* (1876), 94 U. S.

and though the idea of means cannot be contemplated by the mind apart from the idea of end, the end must be referred to only for the purpose of more fully comprehending the real nature of the means employed. An art or process, for example, is a means devised for the production of a given result. Its essence, the creative thought which it expresses, may be more clearly ascertained by studying the result accomplished than by examining the means itself in actual operation; but as an art or process it is complete, apart from any end which

288, Clifford, J. : (288) "The invention, if any, within the meaning of the patent act, consists in the means or apparatus by which the result is obtained." 11 O. G. 551 (551).

In *Corning v. Burden* (1853), 15 How. 252, Grier, J. : (268) "It is for the discovery or invention of some practicable method or means of producing a beneficial result or effect, that a patent is granted, and not for the result or effect itself."

In *O'Reilly v. Morse* (1853), 15 How. 62, Taney, C. J. : (119) "Whoever discovers that a certain useful result will be produced, in any art, machine, manufacture, or composition of matter, by the use of certain means, is entitled to a patent for it; provided he specifies the means he uses in a manner so full and exact, that any one skilled in the science to which it appertains, can, by using the means he specifies, without any addition to, or subtraction from them, produce precisely the result he describes. And if this cannot be done by the means he describes, the patent is void. And if it can be done, then the patent confers on him the exclusive right to use the means he specifies to produce the result or effect he describes, and nothing more."

In *Whittemore v. Cutter* (1813), 1 Gallison, 478, Story, J. : (480) "A patent can, in no case, be for an effect only, but for an effect produced in a given manner, or by a peculiar operation.

For instance, no patent can be obtained for the admeasurement of time, or the expansive operations of steam; but only for a new mode or new application of machinery, to produce these effects." 1 Robb, 40 (42).

In *Curtis v. Platt* (1863), cited in note to *Adie v. Clark* (1876), L. R. 3 Ch. 135, Wood, V. C. : (136) "In all discoveries of course there are two things — there is an object to be achieved and a means of achieving that object. . . . No novelty is required as to the object, the novelty may be in the means for effecting the object whether old or new."

Further, that the means, and not the end, is the invention, see *New American File Co. v. Nicholson File Co.* (1887), 31 Fed. Rep. 289; *Aron v. Manhattan Ry. Co.* (1886), 26 Fed. Rep. 314; 34 O. G. 1508; *New Process Fermentation Co. v. Maus* (1884), 20 Fed. Rep. 725; *Ex parte Blythe* (1884), 30 O. G. 1321; *McMillin v. Rees* (1880), 5 Bann. & A. 269; 1 Fed. Rep. 722; 17 O. G. 1222; *Henderson v. Cleveland Co-operative Stove Co.* (1877), 2 Bann. & A. 604; 12 O. G. 4; *Burr v. Cowperthwaite* (1858), 4 Blatch. 163; *American Pin Co. v. Oakville Co.* (1854), 3 Blatch. 190; *Holden v. Curtis* (1819), 2 N. H. 61.

That different means for the same end are different inventions, see *Hubbell v. United States* (1885), 20 Ct. of Claims, 354.

it achieves. The same is true of every other species of invention.² Each is a means designed to serve a purpose, to satisfy a want; and in its nature as a means, and a means only, reside those attributes on which its individuality and identity depend.

§ 91. Idea of Means Includes the Ideas of a Force, an Object, and a Mode of Application.

The idea resulting from the mental processes involved in the inventive act being thus purely an idea of means, the nature of this idea, as it lies in the mind of the inventor and is exhibited in his concrete invention, becomes a matter of the highest consequence. A moment's reflection will disclose that this idea must necessarily consist of three subordinate ideas: (1) The idea of an operating force; (2) The idea of an object operated on; (3) The idea of a mode of application through which the force is enabled to operate upon the object.¹

² That an art or process, in itself, satisfies no public want, but is . . . mere means of producing a state of things in which the want is satisfied, needs no argument. That a machine, though in operation, benefits no one unless it produces results in some physical substance, and that it is the result so produced which is really useful to the public, and not the machine or means itself, is also sufficiently apparent. In reference to manufactures and compositions of matter, however, the truth of this characterization is not, at first glance, quite so evident. Still the slightest examination shows that neither of those inventions is of any value to mankind until applied to some useful purpose as a means, and that even then the true benefit conferred by each is not in the manufacture or the compound, but in the effect which it produces upon the external substances to which it is applied. A dye-stuff or a leverage-chair, for example, satisfy no want while the one remains in the unbroken package or

the other in the storehouse of the manufacturer. If they could be employed for their respective purposes without affecting any other objects than themselves, they would still be utterly unprofitable to the human race. It is the substitution of one color for another effected by the one, and the ease and comfort to the human body afforded by the other, which constitute their real value to the public, — a value which no otherwise relates to them than as they are the means by which these changes of condition are produced. And it is as this means, and this means only, that they can be regarded as inventions and as embodying the efforts of creative power.

§ 91. ¹ In this and the succeeding paragraphs of this section, with the exception of § 105, the abstract invention is alone under discussion. As the idea of end is inseparable from the idea of means, the idea of the object which is to be acted on by the means in accomplishing its end, is necessarily present to the

For every change in material conditions is produced by the application of some physical force to some physical object; and the nature of this change depends upon the nature of the force, the method of its application, and the character of the object upon which it terminates. In conceiving his idea of the means, whereby such a change in material conditions is to be accomplished, the inventor must, therefore, contemplate some specific force, applied in a specific manner to a specific object and producing in the object the change proposed.

§ 92. Generation of Idea of Means does not Require the Generation of these Subordinate Ideas: The Force is a Fact Perceived, not Created, by the Inventor.

A closer examination will, moreover, demonstrate that the conception of an idea of means does not require that either the force, the mode of application, or the object, separately considered, should have been created by the inventor. A force is either natural or artificial. A natural force is a property of matter, as it exists and operates in nature independently of human aid, and though it may be discovered and employed by man, it cannot be the fruit of his inventive skill. An artificial force is a natural force, so transformed in character or energies by human power as to possess new capabilities of action. This transformation of a natural force into a force practically new involves a true inventive act. It is accomplished by applying to the natural force, as an object, some other force through some mode of application, and is

mind of the inventor whenever the idea of the means itself is entertained. As the concrete invention, however, embodies only the idea of means, it does not usually disclose to an observer the object upon which it is intended to exercise its functions until it is put in practical operation. In certain instruments even the idea of force is not apparent. A machine, for instance, as it stands unemployed, merely exhibits the idea of a mode of application, the

force which impels it and the object upon which it acts being neither expressed, nor perhaps suggested, by the concrete invention. But when the essential character of the invention is in question, and it becomes necessary to pass through the concrete embodiment to the idea of means, all these subordinate ideas must be presented to the mind, and be considered as the inherent and indispensable factors of which the idea of means is itself composed.

thus in itself an independent and complete invention, of which a later inventor may avail himself as the operative force to be employed by him in the conception of his own idea of means.¹ Hence, as the idea of means lies in the mind of the inventor, it is of no importance whether the force which forms the first factor of this idea is natural or artificial; or if artificial, whether it resulted from his own or from another's inventive act. In either case it is a completed fact in nature or the arts, whose capabilities are to be discovered and utilized by him as a subordinate element in the new means which he endeavors to create.

§ 93. The Object is a Fact Perceived, not Created, by the Inventor.

The second factor, the object to be acted on, stands in the same relation to the new idea of means. This object is also either natural or artificial. If natural, its existence, character, and susceptibilities are facts to be discovered, not invented. If artificial, the inventive act in which it had its origin is already past, the object has become a part of the material world, and occupies the same position, in reference to the invention now proposed, as if it had proceeded from the author of the universe himself.

§ 92. ¹ The doctrine of the "unity of inventions," hereafter to be more fully explained, rests upon the scientific fact that every means, however limited in operation or subordinate to other means, is necessarily a complete invention in itself, and is neither enlarged nor restricted by its employment in connection with other inventions. Hence when an inventor has transformed a natural force into a new artificial force, since this new force is a new means he has completed one inventive act. If he thereafter discovers in this new artificial force certain capabilities of action hitherto unknown, and unites them with any mode of application by which they can be made practically useful in the arts, this is an additional means, and the result of an

additional inventive act. If further discoveries reveal to him that certain objects possess susceptibilities which enable him to produce valuable results by subjecting them to the operation of his new force, this is still another means and is attained by a different inventive act. Thus any past invention may become the subject of discovery during the performance of a subsequent inventive act, and so form one of the factors of the new invention.

That a change in the condition of a natural force is an invention, and that the force in such changed condition is a new means and patentable when practically applied, see *Dolbear v. American Bell Telephone Co.* (1888), 43 O. G. 377.

§ 94. **The Mode of Application is a Fact Perceived, not Created, by the Inventor.**

The same truth may be predicated of the third factor, or the mode of application.¹ The action of a force upon an object depends not only upon their inherent qualities, but upon the relation which naturally or artificially exists between them. This relation may reside in simple contiguity, or it may result from the interposition of material agencies through which the force is brought to bear upon its object. The method by which this relation between the force and object is established is the mode of application. It may manifest itself by fugitive acts applying the force to the object, or by the employment of permanent instruments through which the force operates upon the object. But whatever may be its essential character it is either a natural or an artificial means, existing antecedently to the conception of the idea of which it forms a part, and consequently is not originated by the same mental process which results in this new idea of means.

§ 95. **Generation of Idea of Means Consists in Conceiving a New Union of the Force, Object, and Mode of Application.**

The creative genius of the inventor not being employed in the production of either one of the three factors of his idea of means, its sphere of operations must be limited to the union of these factors in that idea. This union consists in bringing the force into such relations with its object, through the mode of application, that the force will operate upon the object to produce the desired effect. Such union is rendered possible by the existence of certain capabilities in the force which enable it to act upon the object, of certain susceptibilities in the object which qualify it to receive the action of the force, and of certain availabilities in the mode of application which fit it for the direction of the force upon the object. All these

§ 94. ¹ What is here called the method in which the force is brought, "mode of application" is essentially *through the instrumentalities adopted by the inventor*, into connection with the object. See § 163, note 1, note to case The "mode of application" is the cited.

the inventor must perceive in order to effect this union. If this perception is derived from other persons his union of these factors requires no exercise of his creative faculties, since the direction of known capabilities upon known susceptibilities through known availabilities is a mere matter of industrial skill. But if his perception is the reflex of his own conception, if the capabilities of the force, or the susceptibilities of the object, or the availabilities of the mode of application have become known to him through his own original efforts, then the union of these factors, and the idea of means produced by such union, owe their existence to his creative faculties and are the fruit of his inventive skill.

§ 96. **Generation of Idea of Means Involves two Mental Processes : Discovery and Construction.**

It is thus evident that the conception of an idea of means by an inventor includes two mental processes: a process of discovery, and a process of construction. The process of discovery consists in the finding out, by his own endeavors, of those qualities in the force, the object, or the mode of application, which render their union possible. The process of construction consists in combining the three factors into the idea conceived. Without the former process, the latter would demand no exercise of the inventive faculties.¹ Without the

§ 96. ¹ That the act of discovery is an essential part of the inventive act has been recognized from the earliest history of Patent Law, and finds expression in numerous modes of statement, some direct, some circuitous. Among the most recent is that of Blatchford, J., in *Thompson v. Boisselier* (1885) 114 U. S. 1: (11) "The beneficiary must be an inventor, *and he must have made a discovery.*" Also in the same case (11) "So, it is not enough that a thing shall be new, in the sense that in the shape or form in which it is produced it shall not have been before known, and that it shall be useful, but it must, under the Constitution and the statute, amount to an in-

vention or discovery." 31 O. G. 377 (379).

In *Wooster v. Blake* (1881), 22 O. G. 1132, Blatchford, J.: (1133) "The invention consists primarily in finding out what mechanical operation is necessary to produce the practical result arrived at. When such operation is hit upon the mechanical work is easy. It is easy when the mechanical operation is seen to say that it was obvious that certain mechanical arrangements would effect it; but mechanical arrangements are tried and tried in vain to reach a practical result, because the mechanical operation which is to effect such a result is not yet seen. In looking at the completed thing the mechanical

latter, the former would result only in an addition to the inventor's knowledge of the properties of things, and not in the production of new operative means. Taken together they constitute the complete mental part of the inventive act, creating a new and original idea of means which requires only reduction to practice to make it useful in the arts.

§ 97. Discovery may Relate either to the Force, the Object, or the Mode of Application.

It is further evident that these mental processes are both performed whenever the qualities of either one of the three factors were hitherto unknown to the inventor. The constructive process is the same whether such qualities were originally discovered by the inventor or were communicated to him by others, and is, therefore, present in all efforts either of mechanical or of inventive skill. The process of discovery becomes necessary only when these qualities remain unknown, but is as necessary when those of a single factor are undiscovered as if those of the three were still to be revealed. Thus, where the capabilities of the force are as yet concealed, no conception of an idea of means in which it is united with an object and a mode of application is possible, although the susceptibilities of the object and the availabilities of the mode of application may be fully understood. Equally true is this when the susceptibilities of the object, or the availability of the mode of application are unknown. That which remains unknown must become known before the constructive process can begin; and this can be effected only by the process of discovery, whether its field of exploration cover the whole or merely one of these subordinate factors. Hence the conception of an idea of means may consist in the discovery of the capabilities of the force, and its union with an object whose susceptibilities are known, through a mode of

operation is there; but the inventor, though he knew all about cams and levers and other mechanical arrangements, did not have in advance before him the coveted mechanical operation."

That the process of discovery is essential to the inventive act, see *Gardner v. Herz* (1886), 118 U. S. 180; 35 O. G. 999.

⁹ Fed. Rep. 429 (432).

application whose availability is also known. Or it may consist in the discovery of the susceptibilities of the object, and its union with a force whose capabilities, and a mode of application whose availabilities, are already familiar to the inventor. Or it may consist in the discovery of the availability of a mode of application and its union with a force whose capabilities, and an object whose susceptibilities, he has long since ascertained. In each of these conceptions the creative faculties are exercised, and the mental part of the inventive act is truly and completely performed. If the field of discovery is wider, embracing the qualities of two or even of all these factors, the essential character of the mental processes involved, and consequently of the inventive act, remains unchanged.

§ 98. Creative Faculties Employed in Discovery on Seven Occasions.

From these considerations it appears that the creative faculties of the inventor may be exercised in the process of discovery on seven different occasions: (1) Where the capabilities of the force are discovered, the qualities of the other two elements being known; (2) Where the susceptibilities of the object are discovered, the qualities of the other two elements being known; (3) Where the availability of the mode of application is discovered, the qualities of the other two elements being known; (4) Where the capabilities of the force and the susceptibilities of the object are discovered, the availability of the mode of application being known; (5) Where the capabilities of the force and the availability of the mode of application are discovered, the susceptibilities of the object being known; (6) Where the susceptibilities of the object and the availability of the mode of application are discovered, the capabilities of the force being known; (7) Where the capabilities of the force, the susceptibilities of the object, and the availability of the mode of application are all the subject of discovery. In each of these cases, if the discovered factor or factors have been united by the discoverer with the known factors, (if any were already known), into an idea of a practically operative means, the mental part of the inventive act

has been performed and the invention is ready for concrete embodiment.

§ 99. **Process of Discovery Described : how Evidenced.**

The process of discovery consists in finding out what was before unknown. The method in which it is conducted is of no importance. Many discoveries are the result of study and research. Others are reached by experiment based on reasoning or conjecture. Others dawn on the mind apparently by accident, without previous attention to the subject. The fact of discovery can, in the nature of things, be ascertained only through its results. A matter hitherto unknown cannot become known without an act of discovery on the part of the person to whom it is first known ; and when the unknown is made known it is, therefore, certain that an act of discovery has been performed. The sole test of discovery, which any science can possess, thus formulates itself in the question : Has the unknown become known ? — a question which includes two others : What is the unknown ? When does the unknown become known ? In answering the first question the law escapes the uncertain speculations of philosophy by the adoption of a rule at once definite and practical. A thing is unknown when it is neither known in itself nor suggested to persons, who are acquainted with that class of things, by what is known. That individuals of unusual ability may reason from the known fact to the other does not make the latter also known ; but if the ordinary mind, being already familiar with a class of objects, can pass by an association of ideas from one of these to others not before perceived, the knowledge of the former embraces that of the latter and all alike are thus considered known. The unknown becomes known when its essential characteristics are comprehended by the mind. Hence in any given instance of alleged discovery, if the necessary attributes of some fact or object, heretofore unknown in itself to the alleged discoverer and not suggested to him by any known fact or object, have been brought within his comprehension by his own efforts, the allegation of discovery is true, and a substantial addition to his stock of knowledge has been made. Applying this test to the generation of an idea of means, the process of

discovery consists in the finding-out, by the inventor, of some force or capability of a force, or some object or susceptibility of an object, or some mode of application or availability in a mode of application, which was neither known to him before nor could have been suggested to him by anything that was known.¹ Wherever, therefore, either of the factors in the idea of means is new, in the sense of being hitherto wholly unknown to the mind of the inventor, and has not been communicated to him by others, the creative faculties must have been in operation and engaged in the process of discovery.

§ 100. Process of Construction Described: how Evidenced.

The process of construction consists in uniting the discovered force, or object, or mode of application, with the other two factors of the idea of means, in a conception whose embodiment in tangible materials will form a practically operative art or instrument. This process, though of a lower order than the process of discovery, is equally essential to the mental part of the inventive act.¹ The test of its performance is the accomplishment, by the embodied idea of means, of the end it was created to fulfil. For wherever a proper force is directed upon a proper object, by a proper mode of application,

§ 99. ¹ In order further to avoid any question as to the degree of personal knowledge possessed by the inventor, and thus the existence of the process of discovery, the law presumes that he has an acquaintance with all matters familiar to those who are skilled in the art to which his invention belongs. This subject is discussed in § 112, and the authorities are collected in its notes. If, therefore, the matter which he claims to have discovered was known to persons skilled in the art before the date of his alleged discovery, it is conclusively presumed that it was known to him, and hence that his assertion of discovery is false. On the contrary, if it were not known in the art until he made it known, its intrinsic

novelty is strong but not conclusive evidence that the act by which it became known to him was an act of true discovery. This position is the foundation of the theory that novelty indicates the exercise of inventive skill, a theory which is correct if the actual or intrinsic newness of the discovery be taken as the guide, but incorrect if the legal novelty (or patentable novelty, if it may be so called), of the concrete invention is regarded.

§ 100. ¹ That the discovery of hitherto unknown qualities or capabilities is not, by itself, invention, see *Ansonia Brass & Copper Co. v. Electrical Supply Co.* (1887), 32 Fed. Rep. 81; 42 O. G. 1168.

the result intended by the inventor must inevitably follow; and any failure in the result thus proves either that his discovered factor has not been joined with suitable associates, or that their union is still incomplete.

§ 102. **Essence of Idea of Means Depends on which of these Factors is the Subject of Discovery: Three Groups of Means: "A Force Applied:" "A Mode of Application:" "A Specific Treatment of Specific Objects."**

The idea of means being thus composed of three factors, at least one of which possesses attributes unknown to the inventor until discovered by his efforts, and all of which have been united by his constructive thought into a conception ready for practical and efficient expression in the arts, the ultimate and essential character of this idea must depend upon the factor in reference to which the process of discovery has been performed. The discovery of a new force or new capability of a known force, and its union with a mode of application through which it can act upon such objects as are naturally susceptible to its influence, constitutes an idea of *a force applied*.¹ The discovery of a new mode of application, or of a new availability in a mode already known, and its adaptation to employment as a method of connecting forces with their objects, constitutes an idea of *a mode of application*.² The discovery of a new object or of new susceptibilities in a known object, and its union, through an available mode of application, with a force capable of operating upon these susceptibilities with useful results, constitutes an idea of *subjecting a specific object to specific treatment*, thereby producing in the object certain definite effects.³ To one of these three groups all ideas of means necessarily belong; and in determining any question con-

§ 101. ¹ That the practical application of a newly discovered force or property of matter to any object, and by any mode of application, constitutes a new means and hence a new invention, see *Poillon v. Schmidt* (1869), 6 Blatch. 299; 3 Fisher, 476; *Smith v. Ely* (1849), 5 McLean, 76; *Parker v. Hulme* (1849), 1 Fisher, 44.

² That a new mode of applying a well-known force to its objects is a new means and a new invention, see *Hills v. London Gas Light Co.* (1860), 5 H. & N. 312.

³ That to discover new susceptibilities in an object and to render them available by subjecting it to well-known forces, applied in well-known methods,

cerning the essence of a concrete art or instrument, or its identity with any other art or instrument, the analysis of the idea of means, therein embodied, into its component factors, and its relegation to its proper group as indicated by the factor which has been the subject of discovery, affords the only scientific and reliable method of investigation.

§ 102. Essence of "A Force Applied."

The essence of an invention, in which is embodied the idea of a force applied, consists of the new force or capability acting through the selected mode of application. The process of discovery, it is true, has been employed only upon the force, but a force alone is not an operative means. To it must be added the intermediate agency, by which it is brought in contact with its object and so directed thereupon as to produce the end desired. The object, however, forms no part of the invention. It is, indeed, the substance upon which the means must act and in which it must accomplish its effects. Its presence is, therefore, indispensable to the useful operation of the means, and must have been contemplated by the inventor while selecting the mode of application by which his new force could be beneficially applied; but the existence of the means itself is independent of the object upon which it may be employed.

§ 103. Essence of "A Mode of Application."

The essence of an invention, in which is embodied the idea of a mode of application, consists of the new intermediate agency which the inventor has discovered, whereby a force may be united with its object. In discovering and comprehending such an agency, the mind must apprehend the force and object, and the relations which the new mode of application can establish between them; but when completely

is a new means and a new invention, see *Cary v. Wolff* (1885), 23 Blatch. 92; 32 O. G. 257; 24 Fed. Rep. 139; *Spill v. Celluloid Mfg. Co.* (1880), 5 Bann. & A. 405; 18 Blatch. 190; *Dalton v. Nelson* (1876), 2 Bann. & A. 225; 13 Blatch. 357; 9 O. G. 1112; *Union Paper Collar Co. v. White* (1875), 2 Bann. & A. 60; 7 O. G. 698, 877; *Young v. Fernie* (1864), 4 Giff. 577; *Steiner v. Heald* (1851), 6 Exch. 607; *Walton v. Potter* (1841), 1 Web. 597.

conceived and understood by the inventor, the mode of application stands alone, as a perfect and independent means, available for use with any force and any object to which it may be suitable, and reducible to practice in any form which establishes between them the connection necessary to the operation of the one upon the other in the mode proposed.

§ 104. **Essence of "A Specific Treatment of Specific Objects."**

The essence of an invention, in which is embodied the idea of treating a specific object in a specific manner in order to produce particular results, comprises the three factors of the idea,—the susceptibility of the object, the capability of the force, and the availability of the mode of application.¹ The susceptibility of the object is the only subject of discovery, but this is not a means. The capacity to receive impressions from external forces is a condition precedent to the operation of such forces, but is not a method by which those impressions may be produced. Yet the force, united with the mode of application, does not constitute the entire essence of the invention, since in reference to these factors there has been no process of discovery; and without that process exercised upon the object the specific treatment which results in the desired effect could not have been invented. Hence in inventions of this character, the three factors are inseparable, both in mental contemplation and in actual practice; the substitution of a different object or susceptibility, or of a different force or capability, or of a different mode of application or availability,

§ 104. ¹ This group of inventions is settled doctrine. Its gradual growth of comparatively late recognition in the law. The employment of an old force may be traced in the following cases: through an old mode of application upon a new object was long confounded with the "double use" of the old invention; and the proposition that an inventive act might consist in discovering new objects or new susceptibilities in an old object, and utilizing these by applying to them old forces through old modes of application, has been established only after long delay and much controversy. It is now, however, a

Walton v. Potter (1841), 1 Web. 597; Steiner v. Heald (1851), 6 Exch. 607; Young v. Fernie (1864), 4 Giff. 577; Union Paper Collar Co. v. White (1875), 2 Bann. & A. 60; 7 O. G. 698, 877; Dalton v. Nelson (1876), 2 Bann. & A. 225; 13 Blatch. 357; 9 O. G. 1112; Spill v. Celluloid Mfg. Co. (1880), 18 Blatch. 190; 5 Bann. & A. 405; Cary v. Wolff (1885), 23 Blatch. 92; 32 O. G. 257; 24 Fed. Rep. 139.

See also cases cited under § 266.

changing either the object treated or the method of treatment, and forming, therefore, a distinct invention.

§ 105. Essence of any Concrete Invention Ascertained by Relegating it to its Proper Group.

The concrete inventions falling within these fundamental groups do not necessarily belong to the same classes in the arts. Many processes, possibly some machines and manufactures, and probably all compositions of matter, are of the first group, representing the idea of a force applied. Processes which consist merely in the direction of known forces upon known objects, as well as most if not all machines and manufactures, are of the second group, embodying the idea of a mode of application. Processes which consist in the subjection of specific objects to specific modes of treatment, based upon the discovery of new susceptibilities in the objects treated, constitute the third group. The test, in any case of doubt, resides in the subject of discovery. Where the force alone has been discovered by the inventor, the other factors being known, the invention falls within the first group. Where only the mode of application has been discovered, the force and object being known, the invention belongs to the second group. Where the object furnished the sole field of discovery, the invention is embraced within the third group. The relegation of an invention to its proper group thus at once discloses its essential character, and renders its comparison with other inventions, for the purpose of determining their identity, accurate and practicable.

§ 106. Essence of Idea of Means not Changed though other Factors are Subjects of Discovery.

Were the process of discovery in all inventions confined to a single factor of the idea of means, the classification thus attained would need no further explanation. But it may occur that an inventor, having discovered one new factor, finds none within his knowledge which can be united with it into an operative means, and is compelled to prosecute his efforts of discovery until one or both of the remaining factors are obtained. Whether this method of achieving his results

changes the mental part of the inventive act, and the consequent character of the idea conceived, is a question of serious importance. That the constructive process of the mind is not varied by the necessity for additional discovery is evident, since the organization of factors into an operative whole involves the same mental energies whether or not the factors were hitherto unknown. The difference, if it exists, resides in the process of discovery and in the relation of the thing discovered to the idea of means. The process of discovery is the same except as to the field with which it has been occupied, involving the same faculties and proceeding by the same methods to the accomplishment of its results. The relation of the factors to each other and to the entire idea must, therefore, determine whether the discovery of more than one affects in any manner the nature of the inventive act and the idea of means which it evolves. But where an inventor has discovered a new force or a new object or a new mode of application, and either one of the remaining factors is unknown, it is obvious that the process of construction cannot be commenced and that no inventive act has been performed. And when he discovers the needed factor, and completes the idea of means through the constructive process, it is equally obvious that, so far as this idea of means is concerned, he has performed no more than the inventive act requires. Hence it is true that the essential character of the inventive act, which results in the production of any given idea of means, is not affected by the number of the factors which become the subjects of discovery. The discovery of the inventor in relation to the second or third factors may, however, have been more extensive than was necessary to complete this given idea of means. Thus, if the factor first discovered were the force or object, and the missing factor were the mode of application, that mode which he discovers may be available as the connecting agency between many other forces and their objects. Here it is evident, that while the idea of means into which the discovered force or object enters as a factor does not exhaust the availabilities of the discovered mode of application, yet neither the nature of the force applied, nor that of the object treated, nor that of the idea in which they are united,

is varied by the excess existing in the mode of application. The means is still the same means, operating on the same objects and accomplishing the same results, although one of its factors might have been employed for other independent purposes. The discovery of this additional availability may serve the inventor as a basis for constructing other ideas of means by uniting it with other forces or other objects, but cannot enlarge the scope or change the nature of the means of which the new discovered force or object is an essential factor. On the same principle, if the first discovery related to the mode of application, and the additional discovery to the force or object, the fact that in the mode of application availabilities reside, which are not required in the direction of this force upon its object, cannot extend the scope of the idea of that invention beyond the availabilities therein employed, although the additional availabilities may enter as essential factors into other means, whenever objects or forces which can be connected by them are discovered. The conclusion, therefore, seems inevitable that in a given invention it is immaterial whether one or more factors are the subject of discovery; that in all cases the same mental faculties are employed, the same processes are followed, and the same results attained; and that every invention, however conceived and constructed, must be either a force applied, a mode of application, or the subjection of a specific object to specific treatment for the purpose of producing in the object certain definite effects.

§ 107. Identity of Two Ideas Determined by Comparing their Essential Factors.

The identity or diversity of two ideas of means may be determined by resolving each idea into its component factors, and comparing those of one idea with the corresponding factors of the other. Where the force, the object, and the mode of application are the same in both ideas, the ideas are essentially identical. Where the force, the object, and the mode of application in one idea all differ from the corresponding factors of the other, the ideas are essentially diverse. Where one or two of the factors are the same in each idea, but the

remaining factor or factors are different, the ideas may be totally distinct, or they may be identical, or one may be included in the other. In such cases, to ascertain their true relation, each must be referred to its appropriate group, according to the factor which has been the subject of discovery. If the ideas fall into different groups they cannot be identical, though one may be included in the other. Thus an idea of means consisting in a mode of application may be embraced in an idea of a force applied, and both may be involved in that of treating a specific object in a specific manner, but neither of these ideas is identical with any of the others. But when the mode of application which constitutes the essence of one idea is not the same mode which the force applied employs, these two ideas have no common attribute, since the force in the first case, and the object in both cases forms no part of the essence of the means. In like manner, when one of the ideas is a mode of application or a force applied, and the other is a specific object subjected to specific treatment, the ideas must be wholly different, unless the force and mode of application in the latter are identical with those which constitute the former. If the two ideas fall within the same group, their identity or diversity depends upon the identity of their essential factors. When each is a force applied, the force and mode of application in each must be the same or they are totally diverse. When each is a mode of application, the availability employed by each must be the same or no identity of means exists. When each is the treatment of an object, the object, the mode of application, and the force in each must be identical, or the ideas are essentially distinct. In making these comparisons, accurate results would be impossible were the physical identity or diversity of forces, objects, and modes of application the facts to be decided, since for the most part these lie beyond the sphere of human knowledge. The law, therefore, being compelled to furnish some test of identity or leave these problems utterly unsolved, declares that, for its purposes, two forces, objects, or modes of application shall be regarded as the same, whenever, in connection with the other factors of the idea of means, they could be used as perfect substitutes for one another, and were

known as such in the arts when the idea of means was first conceived.¹ This rule rests on sound reason as well as on authority. No matter what their actual differences may be, two things must be the same, in reference to an invention, when, as employed in the invention, each would perform the functions of the other. If this interchangeability is known when the idea of means is conceived by the inventor, or is made known by his generation of the idea, his inventive act, in its processes of discovery and construction, embrace all alike, although in his concrete invention he may have chosen to employ but one. On the other hand if, after his idea has been completed, a new factor is discovered capable of filling the same place in the invention, and relations are established between it and the other factors of his idea, a new inventive act has been performed, including both the processes of discovery and construction, the results of which are not in law regarded as identical with his, however certain it may be that physically and industrially they are the same.

§ 108. General Statement of the Nature and Factors of the Idea Generated by the Mental Part of the Inventive Act.

The conclusions to which this examination of the nature and elements of the idea generated by the mental part of the

§ 107. ¹ The principle here involved is the same as that which, in reference to the concrete embodiment of the idea of means, finds expression in the doctrine of Equivalents. Whether in dealing with the art or instrument as practically employed, or with the ideas which form the essence of the invention, the law is compelled to furnish some standard by which, in the incurable deficiency of scientific knowledge, the identity of conceptions, as well as substances, may be determined. The one adopted serves all necessary purposes in either field, and though usually found, in its verbal statement, predicated of embodiment alone, is evidently as true and serviceable in ascertaining the identity of those factors upon whose

correspondence the identity of the concrete art or instrument depends.

Sec. iii., chap. iii., §§ 245-258 on Equivalents, with its notes, affords a wider and clearer discussion of the subject. Caution is requisite not to attribute to the identity of ideas the rule governing the date when equivalents in embodiment must have been known. An equivalent in embodiment must have been known when the act of embodiment was performed, which is *prima facie* at the date of the patent. An equivalent in idea must have been known when the idea was conceived by the inventor, which is at the date of his complete comprehension of his idea as an operative means.

inventive act conducts us, may be stated in the following propositions: —

I. The idea generated is an idea of means as distinguished from an idea of end;

II. The idea of means is composed of three factors, an idea of force; an idea of object; and an idea of a mode of application;

III. The generation of the idea consists not in the creation of either of these factors, but in the discovery that they are capable of union, and in uniting them in one idea of means;

IV. The idea of means is generated, and the mental part of the inventive act performed, whenever a new force, or new capability of a force, is discovered and applied to proper objects by some proper mode of application; or whenever a new object, or new susceptibility of an object, is discovered and is subjected to the action of any force through any suitable mode of application; or whenever a new mode of application, or new availability of a mode of application, is discovered and employed as the connecting agent between forces and their objects;

V. The ideas of means thus generated are divisible, according to the method of their generation and their essential attributes, into three classes: (1) A force applied, in which the force has been the subject of discovery, and the force and mode of application constitute the essence of the means; (2) A mode of application, in which the mode of application is the subject of discovery and the essence of the means; (3) A subjection of specific objects to specific treatment, in which the object is the subject of discovery but all the factors enter into the essence of the means;

VI. Whether the process of discovery extends to other factors than the one which characterizes an idea of means is unimportant; the idea itself is still the same, whatever other ideas may be constructed on the basis of the additional discovery;

VII. The identity or diversity of ideas of means is ascertained by resolving each into its component factors, and comparing every factor in one with the corresponding factor in the other;

VIII. Judged by this standard, ideas of means are iden-

tical where all the factors in each are identical with the corresponding factors in the other, or where both the inventions belong to the same group and the essential factors of each are the same as the essential factors of the other; they are diverse when all their corresponding factors are unlike, or when, belonging to different groups, the more complex does not embrace the essential factors of the other; one idea includes another when they belong to different groups and all the essential factors of the simpler means enter into the essence of the other.

The importance of these propositions, and of the principles upon which they rest, cannot be overestimated. They form the tests which, in the last resort, are decisive of every question relating to the exercise of inventive skill, or to the novelty or utility of its results. To them may be reduced most of those rules which, before the nature of the mental part of the inventive act was clearly understood, had obtained titles of their own, as if they were the ultimate verities of Patent Law. As we go forward they will solve for us all our apparent difficulties, and furnish us a basis for the classification of those decisions through which the courts have gradually wrought their way toward these essential and imperishable truths.

SECTION III.

OF THE FACTS WHICH INDICATE THAT THE MENTAL PART OF THE INVENTIVE ACT HAS BEEN PERFORMED.

§ 109. Whether an Inventive Act has been Performed is to be Determined from the Invention itself, not from the Assertions of the Inventor.

Whether or not the mental part of the inventive act has been performed is a question of fact, to be determined by the evidence presented.¹ For obvious reasons, this question is one of the most difficult of those arising in the administration

¹ That the existence of inventive skill is a question of fact, see *Rep. 142; Stimpson v. Woodman* (1869), 10 Wall. 117. *Butler v. Bainbridge* (1886), 29 Fed.

of Patent Law; and hence, wherever reasonable doubt exists, the same liberal spirit which characterizes both the enactment and the application of the law awards the benefit of the doubt to the inventor.² In the investigation of this question, the actual operations which have taken place in the mind of the inventor are not open to inquiry. Concerning these he alone has any personal knowledge, and even his impressions are often vague and unreliable. Of themselves they are of no importance to the public, provided the process of discovery and the process of construction have both been completed, and of these the nature and the elements of the idea embodied in the invention afford the only evidence. The invention must, therefore, speak for itself. As contemplated by the observer, apart from any claims of the inventor, it must present those indications which the law deems sufficient proof that it originated in an exercise of the inventive powers. If these exist, there is no occasion to determine by what intellectual operations the result was reached. If these are wanting, no allegations by the inventor can supply their place.

§ 110. Inventive Act Performed when the Generated Idea is an Idea of Means, and either of its Factors has been Discovered by the Inventor.

This question, when fairly apprehended, resolves itself into two subordinate inquiries: Whether the idea conceived by the

² In *Kirby v. Beardsley* (1867), 3 Fisher, 265, Shipman, J.: (278) "I am well aware that it is often no easy task to draw the true line of distinction between invention, the product of original thought, and mere obvious manual changes following the beaten track of mechanical experience. This difficulty, in connection with the general merit of inventors, as contributors to the material interest of society, has inclined courts to give a liberal construction to the law, so as to protect every contrivance that can be called new, which proves at all useful. Care has been taken to give the benefit of doubt, as to originality or creative thought, to

the inventor, so as to nourish inventive enterprise by lending encouragement to every degree of merit. This is the more important, as simple contrivances, the offspring of simple, even involuntary thoughts, often produce great and beneficial results, while complex and elaborate ones, the product of long and profound cogitation, not unfrequently prove comparatively or wholly abortive. But it is obvious that there is a limit beyond which mere changes cannot and ought not to receive this protection." 5 Blatch. 438 (453). See also *Butler v. Bainbridge* (1886), 29 Fed. Rep. 142.

alleged inventor is that of a practically operative means? and Whether either of the factors of the means conceived was previously unknown to the inventor? If the idea conceived is that of an operative means, it is at least certain that the constructive process has been performed, and that a force, an object, and a mode of application have been united in such a manner as to produce useful results. If, in addition to this, the inventor had no prior knowledge of that capability of the force, or that susceptibility of the object, or that availability of the mode of application, which renders possible their union in this idea of means, it is apparent that the process of discovery has taken place, and, therefore, that the mental part of the inventive act has been complete. The first inquiry is answered without difficulty by the tangible embodiment of the idea and its practical application in the arts, since if it there proves useful it is evidently an operative means. The second is the field of doubt and obscurity, in which the most exhaustive research sometimes fails to obtain a satisfactory reply.

§ 111. Discovery Present when either Factor of the Idea was before Unknown in the Arts.

Upon the subject of this second inquiry the inventor alone, of course, can speak with perfect accuracy. The conclusions of the law, however, are not allowed to rest on his unaided testimony, except when every other source of information fails. It has its own methods of ascertaining the state of his prior knowledge, and only when it has applied these, and has found them insufficient, does it permit his assertions to control its judgment. The fundamental test which it applies is the condition of human knowledge in general, in reference to those factors of the idea of means which the inventor claims to have discovered for himself. If these were utterly unknown before the date of their employment by the alleged inventor; in other words, if they were new in themselves; they must have been presented to his mind by the process of discovery. The actual novelty of any factor in the idea of means thus establishes beyond dispute the want of prior knowledge on the part of the producer of the means, and proves his exercise of his inventive powers.

§ 112. **Discovery Absent when every Factor of the Idea was Already Known in the Arts.**

The knowledge of mankind in general concerning any of the factors of the idea of means does not, however, demonstrate that the inventor shared such knowledge. Whatever information others may have possessed, the attributes of these factors may be new to him and have been ascertained by a true process of discovery. But the uncertainties attending the investigation of this fact are so great that the law cannot, with safety, give it serious attention. Except in cases where it could be proved that the inventor had derived his knowledge from external sources, his own assertion would be the only evidence obtainable, and though he were surrounded by those who were familiar with the factors he employed, his undisputed claim of personal ignorance would secure to him the credit of an inventive act. If the purpose of the law were to do honor or bestow rewards on all conceivers of ideas of means, this fact would be the proper point of inquiry. But as its only object is to confer exclusive privileges on the first inventor, it consistently refuses to regard any exhibition of inventive skill, the result of which could have been attained by applying the constructive process to the discoveries of others, and thus establishes the rule that every alleged inventor shall be conclusively presumed to have known, at the time of his conception of the idea of means, whatever was then generally known concerning any of its factors to persons skilled in the art to which the idea belongs.¹ Under this rule, the secret knowl-

§ 112. ¹ In *Crompton v. Knowles* (1881), 7 Fed. Rep. 199, Lowell, J. : (203) "It is a presumption of law that all mechanics interested in upholding or defeating a patent were fully acquainted with the state of their art when they took out their patent, or when they built their machine. This presumption is founded upon a policy like that which imputes to all persons charged with crime a knowledge of the law. It is necessary to the safe administration of justice. Each party may then be assumed to have borrowed from

the other whatever was actually first invented and used by that other."

In *Walton v. Potter* (1841), 1 Web. 585, Tindal, C. J. : (592) "The party is not entitled to his patent . . . unless he is the first and true inventor; therefore, if the subject-matter of the patent has been discovered—has been published in a dictionary, for example—though it has not been reduced into practice, if a man merely adopts it, the merit is so small that his patent for it would be worth nothing."

In a note to this case Mr. Webster

edge of single individuals is not considered. Such knowledge is not incompatible with general ignorance, and when it has been demonstrated that the knowledge was concealed, the want of knowledge on the part of other persons and the public is established. Wherever, therefore, an alleged inventor employs, in his idea of means, a factor whose attributes were unknown before his idea was conceived, or were known only to individuals who concealed their knowledge, his perception of those attributes must have resulted from his own process of discovery. On the other hand, whatever may have been the state of his own knowledge, if these attributes were already generally known to persons familiar with the art, it is presumed that he derived his information from external sources and that no inventive act has been performed.

§ 113. Discovery Indicated by the Intrinsic Novelty or Utility of the Concrete Invention.

When the performance of the process of discovery can be affirmed or contradicted in the foregoing manner, no further inquiry is necessary. But investigations of the attributes of forces, objects, or modes of application are not always satisfactory in the present state of scientific knowledge, and other methods of solving this question must, therefore, be employed.

says: (1 Web. 592) "The two issues of novelty, viz., whether the plaintiff is the true and first inventor, within the meaning of the statute, and whether the invention at the time of the grant be new as to public use and exercise, are, as in this case, generally involved together, because, if the latter be established in the negative, the former is involved in it; but they are, in point of law and of fact, distinct issues, for it may well be that the invention was never in public use and exercise, and yet that the grantee of the letters-patent is not the true and first inventor."

(1 Web. 44 n.) "If an account of an invention be contained in any published book in general circulation, the presumption is that the patentee learnt

it from such source, and in that case he would not be the true and first inventor."

Further, that an inventor is always presumed to have known all prior inventions that were identical with his, unless they had become "lost arts," see *Sinclair v. Backus* (1880), 5 Bann. & A. 81; 4 Fed. Rep. 539; 17 O. G. 1503.

That a matter of common knowledge and experience is not patentable, see *Preston v. Manard* (1886), 116 U. S. 661; 34 O. G. 1507.

That patents are public records, and a knowledge of them is presumed, see *Bate Refrigerating Co. v. Gillette* (1887), 40 O. G. 1029; 31 Fed. Rep. 809.

Among these the intrinsic novelty and utility of the concrete invention are the most important. In the concrete invention the idea of means is made practically operative by embodiment in tangible materials. An art or instrument is thereby produced which is capable of employment for a useful purpose. This art or instrument may possess legal novelty without intrinsic novelty. Legal novelty is a prerequisite to patentability, and exists whenever the invention has never been in use in the United States, nor patented nor described in a printed publication either here or abroad. Intrinsic novelty is predicable of the invention itself, and exists wherever the art or instrument was hitherto unknown in the arts, and was not suggested by anything already known. The latter novelty is very strong, and often conclusive, evidence that the alleged inventor of the art or instrument has discovered one or more of the factors of his idea of means, and consequently has performed the entire inventive act.¹ It may indeed be true that the constructive process, working upon factors all whose attributes are known, sometimes evolves concrete inventions which cannot be recognized as previously existing, and, therefore, are accepted as results of an inventive act, although no process of discovery has really occurred. The capability of the force, the susceptibility of the object, the availability of the mode of application, never before perceived and acted on by any one, may, nevertheless, have been suggested to the inventor's mind by other qualities of the same factor, and might have been suggested to the mind of any other person familiar with the art, provided his attention had been thereto directed. Where the suggestiveness of the known attribute is evident, and hence the process of discovery is excluded, the intrinsic novelty of the concrete invention cannot overcome the inevitable inference that no inventive act has been performed. But where the suggestiveness of the known

§ 113. ¹ That intrinsic novelty in the concrete invention indicates discovery, see *Celluloid Mfg. Co. v. Comstock & Cheney Co.* (1886), 27 Fed. Rep. 358; 36 O. G. 1356; *Hoe v. Cottrell* (1880), 17 Blatch. 546; 18 O. G. 59; 1 Fed. Rep. 597; 5 Bann. & A. 256.

That the novelty of the concrete invention is not conclusive evidence of discovery, see *Adams v. Bellaire Stamping Co.* (1886), 28 Fed. Rep. 360; 36 O. G. 567.

attribute is not apparent, and the inventor may thus have developed his idea through the process of discovery, the intrinsic novelty of the concrete invention is sufficient to remove the doubt and affirm the claim of the inventor to the merit of an entire inventive act. The intrinsic utility of the concrete invention is of similar significance.² Wherever any practically operative means proves itself singularly beneficial to mankind, the inference is almost inevitable that the idea which it embodies would long before have been perceived, had the constructive faculties of the human mind alone been able to produce it, and, therefore, that the process of dis-

² In *Hill v. Biddle* (1886), 27 Fed. Rep. 560, Butler, J. : (561) "While it is true that the utility of a machine, instrument, or contrivance, as shown by the general public demand for it when made known, is not conclusive evidence of novelty and invention, it is nevertheless highly persuasive in that direction, and, in the absence of pretty conclusive evidence to the contrary, will generally exercise controlling influence."

In *Asmus v. Alden* (1886), 27 Fed. Rep. 684, Butler, J. : (687) "What constitutes invention, in the legal sense, is difficult of exact definition, in terms. Where, however, an old device or machine in general use, with acknowledged serious defects, which have been long endured because no one has previously discovered a means of obviating them, is taken in hand, and, by changing its form or structure, they are removed, and a different and improved result obtained, it may safely be affirmed that the change required invention. Where the improvement, and consequent public benefit, is great, very little evidence of invention is required." 36 O. G. 231 (232).

That utility is evidence of the exercise of inventive skill, see *Sax v. Taylor Iron Works* (1887), 40 O. G. 118; *Wallace v. Noyes* (1882), 21 Blatch. 83;

23 O. G. 435; 13 Fed. Rep. 172; *Western Electric Light Co. v. Chicago Electric Light Mfg. Co.* (1882), 11 Bissell, 427; 14 Fed. Rep. 691; *Gottfried v. Crescent Brewing Co.* (1882), 22 O. G. 1447; 13 Fed. Rep. 479; *Bruce v. Marder* (1882), 22 O. G. 1039; 20 Blatch. 355; 10 Fed. Rep. 750.

That simplicity and evident fitness are no sign of an absence of inventive skill, see *McFarland v. Spencer* (1885), 23 Fed. Rep. 150; 32 O. G. 893; 23 Blatch. 155.

That a new arrangement and better result are not conclusive evidence of discovery, see *Calkins v. Oshkosh Carriage Co.* (1886), 27 Fed. Rep. 296; 36 O. G. 1149.

That cheapness may indicate inventive skill, see *Cornish v. Keene* (1835), 1 Web. 501.

That simplicity and cheapness do not necessarily indicate inventive skill, see *Evory v. Burt* (1883), 23 O. G. 2121; 15 Fed. Rep. 112; *Waterous v. Bishop* (1867), 20 Can. C. P. 29.

That merely overcoming former prejudices does not indicate discovery, see *Butler v. Steckel* (1886), 27 Fed. Rep. 219; 36 O. G. 455.

That when serious defects are remedied inventive skill is indicated, see *Osborn v. Glazier* (1887), 40 O. G. 1137.

See also § 344 and notes, *post*.

covery has been performed in reference to some one of the factors of which it is composed.

§ 114. Intrinsic Novelty of a Concrete Invention how Evidenced.

In examining an invention, for the purpose of determining its intrinsic novelty, it may be considered either directly in its own nature as an operative means, or indirectly through the end which it accomplishes. In many cases the former inquiry alone is necessary, its intrinsic novelty being apparent on the face of the invention, when contemplated in connection with the other processes or instruments heretofore employed in the same art. ¹But in by far the greater number recourse must be had also to the nature of the end attained, to the concrete results whose character is definite and comprehensible, however recondite may be the agencies by which they are achieved. Whenever the direct evidence of novelty is wanting or is insufficient, the courts, therefore, accept the indirect as ample ground for their conclusions, provided it conforms to certain well-established rules.

§ 115. Intrinsic Novelty of a Concrete Invention Evidenced by the Novelty of its Essential Factors.

The indications of intrinsic novelty afforded by an invention itself must be sought in its essential factors. If the invention is a force applied, whatever novelty the invention may possess resides in the force, or in the method of its application; no variation in the object, upon which the force may be directed, constituting any variation in the means employed. If the invention is a mode of application, the changes which may have been effected in the force and object are to be excluded, and novelty be sought in the intermediate agency through which they are connected with each other.¹ If the invention is the specific treatment of an object, all factors are essential, and novelty either in the object, the mode of application, or the force will make the whole invention intrinsically new.

§ 115. ¹ That a machine may itself *v. Sargent* (1886), 28 Fed. Rep. 185; show invention, see *Enterprise Mfg. Co.* 37 O. G. 891.

§ 116. **Intrinsic Novelty of a Concrete Invention Evidenced by the Novelty of its Mode of Operation: this Shown by its Comparative Utility.**

Further indications of the intrinsic novelty of the concrete invention are afforded by its operation while effecting its results. Although the essential factors of the idea of means remain the same, so far as human observation can detect, yet in the mode in which the operative means accomplishes its end such differences may exist as prove beyond all controversy that one or more of these essential factors has been changed, and, consequently, that the means itself is new. The question of utility, as indicating novelty, here becomes most important. The actual utility of an alleged invention sometimes, as we have seen, affords strong and direct evidence of inventive skill. But its comparative utility, the superiority of its operation over all existing methods of accomplishing the same result, may be so great as to furnish conclusive proof that the invention is radically different from all preceding arts or instruments, and that, though itself imperceptible, some new force, or new application, or new object must have been discovered by the inventor.¹ If, therefore, in

§ 116. ¹ In *Washburn & Moen Mfg. Co. v. Haish* (1880), 19 O. G. 173, Drummond and Blodgett, JJ. : (174) "There is no doubt that a device, in order to be patentable, must be the result of invention. The mere mechanical adaptation of old things to new uses is not usually invention, unless in combination; and yet it is extremely difficult in many cases to say just where the inventive faculty asserts itself as the controlling force. And the authorities furnish us no satisfactory test to apply and determine this question. . . . (175) In the absence of any other test, the courts have seemed to assume that the fact of the acceptance of a new device or combination by the public and putting it into extensive use was evidence that it was the product of invention; or, as one of the counsel for plaintiff expressed it, 'utility is sug-

gestive of originality.' In *Smith v. Goodyear Dental Vulcanite Company* (3 Otto, 486), Mr. Justice Strong said: 'Undoubtedly the result or consequences of a process or manufacture may in some cases be regarded as of importance when the inquiry is whether the process or manufacture exhibits invention, thought, and ingenuity.' Webster on the subject of patents, page 30, says: 'The utility of the change as ascertained by its consequences is the real practical test of the sufficiency of an invention, and since the one cannot exist without the other, the existence of the one may be presumed on proof of the existence of the other. Where the utility is proved to exist in any degree a sufficiency of invention to support the patent must be presumed.' We do not say the single fact that a device has gone into general use and has displaced other devices

its operation the concrete invention attains the desired end with greater economy of time, material, or labor; if it avoids

which had previously been employed for analogous uses establishes in all cases that the later device involves a patentable invention. It may, however, always be considered, and when the other facts in the case leave the question in doubt it is sufficient to turn the scale. So in *Eppinger v. Richey* (14 Blatchford, 307), Judge Shipman said: 'Two facts exist in this case. One is, that an important improvement has been attained. The second is, that the improvement is in a staple article which has been manufactured in this country for a long series of years. . . . The utility of the patented article has been evinced by its large sales. . . . The inventor evidently gave to the public an article which it wanted, and which it had not previously known. Without giving to the general use of the invention, as a test of its patentability, any greater importance than the Supreme Court in the case of *Smith v. Goodyear Dental Vulcanite Company* (above quoted) indicate should be given to this circumstance, I am of the opinion that the facts in the case fully establish the conclusions: (1) That however simple the change in the method of manufacture apparently may have been, yet it was a change which required invention for its accomplishment; (2) That the improvement resulting from the changed method of manufacture has been so great that the article which is produced is, within the meaning of the patent acts, a new and useful article of manufacture.' Mr. Justice Shepley said, in the case of *Isaacs v. Abrams*, 14 O. G. 862: 'A change in the form of a machine or instrument, though slight, if it works a successful result not before accomplished in a similar way in the art to which it is applied or in any other, is patentable.' Judge Shipman said, in *Stanley Works*

v. Sargent (8 Blatchford, 346): 'Utility is not an infallible test of originality. The patent law requires a thing to be new as well as useful in order to entitle it to the protection of the statute. To be new in the sense of the act it must be the product of original thought or inventive skill, and not a mere formal or mechanical change of what was old and well known; but the effect produced by the change is often an appropriate, though not a controlling, consideration in determining the character of the change itself.' " 4 Fed. Rep. 900 (906).

In *Roberts v. Dickey* (1871), 4 Fisher, 532, Strong, J.: (538) "There are many cases in which the materiality of an invention, whether it be a machine or a process, can be judged of only by its effect on the result, and this effect is tested by the actual improvement in the process of producing an article, or in the article itself introduced by the alleged invention. Curtis on Pat., § 9. 'In these cases,' says that author (§ 10), 'the subject of the invention is not the particular machinery, or apparatus by which the new application is made to be available, but it is the new application itself of certain known substances or agents, to produce a particular result, differing either in the process, or in the article produced from the former methods of producing the same thing, and thereby producing a better article, or producing it by superior and cheaper processes. It is obvious that the results in such cases furnish a complete test of the sufficiency of the inventions, because the importance of the result shows that, whether actually exercised or not, the possibility of the exercise of thought, design, ingenuity, and skill is not excluded.'" 1 O. G. 4 (5); 4 Brews. 260 (264).

In *Judson v. Cope* (1860), 1 Bond,

difficulties hitherto encountered, and thus becomes an agency more valuable and effective than any previously known, — the

327, Leavitt, J. : (337) “It will be obvious that, where there is doubt upon the question of novelty, and where the evidence of the witnesses leaves it uncertain whether the principle of the valves was identical, that evidence of the superior performance and utility of the patented improvement would have a direct bearing upon the question of novelty. In other words, if the jury are satisfied that the invention patented produces a result decidedly and clearly different from any which had been produced by the action of any prior valve, and that it was decidedly superior to any other in its operation, it would certainly afford a ground for the presumption that the thing itself had not been known before.” 1 Fisher, 615 (624).

In *Many v. Sizer* (1849), 1 Fisher, 17, Sprague, J. : (24) “If the changes made by the defendant have rendered his wheel one of greater utility than the plaintiff’s, such utility is evidence that some new principle, or mechanical power, or new mode of operation, producing a new kind of result, has been introduced. And the greater such utility, the stronger is such evidence. And if a manifest and very high degree of utility is obtained by such changes, it becomes full proof and conclusive, that a new principle, or mechanical power, or new mode of operation, producing a new kind or result, has been introduced. . . . (27) If the effect is a wheel of greater utility, that is evidence tending to show that some new principle, or mechanical power, or mode of operation, producing a new kind of result, has been introduced; and the higher the degree of utility, the stronger is such evidence. And it may arise to so high a degree as to become conclusive. From our inability to penetrate the secrets of nature, we may not

be able to detect the new principle, or power, otherwise than by its effects. But this utility must be derived from the changes introduced — not from the use of better material, or greater skill or care in the manufacture.”

In *Househill Co. v. Neilson* (1843), 1 Web. 673, Hope, J. : (690) “Great utility is an important element in the question of novelty. For if the process is of great, manifest, striking, and immediate utility, that is of the utmost importance to the point. Could this have been previously in public use and exercise without clear and abundant proof?”

In nearly all the foregoing extracts, the subject of *actual* utility, as indicating discovery or inventive skill, is confused with that of *comparative* utility, as indicating the intrinsic novelty of the concrete invention. Actual utility directly and immediately bears upon the question of inventive skill, because it may be safely assumed that an invention of great actual utility would be at once produced if mechanical skill were sufficient for its creation, and, therefore, that where a want has long existed unsupplied, and has at last been satisfied, inventive skill must have been employed. This evidence is as available and as conclusive where the invention is the first of its kind, as if it had found inferior competitors already in the field. Comparative utility bears only upon the question of intrinsic novelty, though through this question it indirectly influences the conclusion as to the existence of inventive skill. Comparative utility (that is, an increase in utility over that of any invention of the kind heretofore known) may show that a substantial difference must exist between the present and all prior inventions, and thus that the new art or instrument

degree of this increase in value and effectiveness may be, though it not always is, sufficient to demonstrate that the

could have originated only in some new discovery.

See § 344 and notes, *post*.

Further, that superior utility in the invention indicates intrinsic novelty in the invention and hence the exercise of inventive skill, see *Celluloid Mfg. Co. v. Comstock & Cheney Co.* (1886), 27 Fed. Rep. 358; 36 O. G. 1356; *Miller v. Pickering* (1883), 16 Fed. Rep. 540; 25 O. G. 89; *Hoe v. Cottrell* (1880), 17 Blatch. 546; 18 O. G. 59; 1 Fed. Rep. 597; 5 Bann. & A. 256; *U. S. Stamping Co. v. King* (1879), 17 Blatch. 55; 7 Fed. Rep. 860; 17 O. G. 1399; 4 Bann. & A. 469; *Dunbar v. Albert Field Tack Co.* (1879), 4 Fed. Rep. 543; 4 Bann. & A. 518; *Stilwell & Bierco Mfg. Co. v. Cincinnati Gas Light & Coke Co.* (1875), 1 Bann. & A. 610; 7 O. G. 829; *Monce v. Adams* (1874), 7 O. G. 177; 12 Blatch. 1; 1 Bann. & A. 126; *Birdsall v. McDonald* (1874), 1 Bann. & A. 165; 6 O. G. 682; *Smith v. Woodruff* (1873), 4 O. G. 635; 1 MacArthur, 459; 6 Fisher, 476; *Hitchcock v. Tremaine* (1872), 1 O. G. 633; *Sayles v. Chicago & Northwestern R. R. Co.* (1871), 3 Bissell, 52; 4 Fisher, 584; *Carter v. Baker* (1871), 1 Sawyer, 512; 4 Fisher, 404; *Woodman v. Stimpson* (1866), 3 Fisher, 98; *Singer v. Walmsley* (1860), 1 Fisher, 558; *Judson v. Moore* (1859), 1 Bond, 285; 1 Fisher, 544; *Morton v. Middleton* (1863), 1 Cr. S. 3d Series, 722; *Stevens v. Keating* (1847), 2 Web. 181.

That this superiority may manifest itself in rapidity or economy of action, or in the simplicity or efficiency of the invention, see *McFarland v. Spencer* (1885), 23 Blatch. 155; 23 Fed. Rep. 150; 32 O. G. 893; *Gottfried v. The Philip Best Brewing Co.* (1879), 17 O. G. 675; 5 Bann. & A. 4; *Dalton v. Nelson* (1876), 9 O. G. 1112; 13 Blatch.

357; 2 Bann. & A. 225; *Goodyear Dental Vulcanite Co. v. Willis* (1874), 7 O. G. 41; 1 Flippin, 388; 1 Bann. & A. 569; *Gallahue v. Butterfield* (1872), 2 O. G. 645; 10 Blatch. 232; 6 Fisher, 203; *Lister v. Leather* (1858), 8 El. & B. 1004; *Muntz's Patent* (1846), 2 Web. 113.

That success is evidence of novelty, see *Consolidated Valve Co. v. Crosby Valve Co.* (1885), 113 U. S. 157; 30 O. G. 991; *Wilson Packing Co. v. Chicago Packing & Provision Co.* (1881), 21 O. G. 411; 10 Bissell, 559; 9 Fed. Rep. 547.

That immediate general use indicates intrinsic novelty, see *Adams & Westlake Mfg. Co. v. Rathbone* (1886), 26 Fed. Rep. 262; *New York Belting & Packing Co. v. Magowan* (1886), 27 Fed. Rep. 362.

That success is not conclusive evidence of the existence of intrinsic novelty, see *Consolidated Fruit Jar Co. v. Bellaire Stamping Co.* (1886), 28 Fed. Rep. 91; 36 O. G. 121.

That superior utility is not conclusive evidence of novelty, see *Adams v. Bellaire Stamping Co.* (1886), 28 Fed. Rep. 360; 36 O. G. 567; *Wilson Packing Co. v. Chicago Packing & Provision Co.* (1881), 10 Bissell, 559; 21 O. G. 411; 9 Fed. Rep. 547; *Phillips v. Detroit* (1879), 4 Bann. & A. 347; 17 O. G. 191; *Monce v. Adams* (1875), 7 O. G. 177; 12 Blatch. 1; 1 Bann. & A. 126.

And that where the entire invention is clearly old in its essential character, no increase in the degree of its speed, economy, or efficiency, will indicate the exercise of inventive skill, see *Evory v. Burt* (1883), 15 Fed. Rep. 112; 23 O. G. 2121; *Guidet v. Brooklyn* (1882), 105 U. S. 550; 21 O. G. 1692; *Odiorne v. Denney* (1878), 13 O. G. 965; *Ex parte Greeley* (1873), 4 O. G. 612; 6 Fisher, 575; *Holmes*, 284; *Pitts v. Wemple* (1855), 2 Fisher, 10; 1 Bissell,

invention is new, and hence that some new factor must have been discovered, and the creative powers have been employed.

§ 117. **Intrinsic Novelty of a Concrete Invention Evidenced by the Novelty of the End Accomplished.**

The intrinsic novelty of an invention is also sometimes indicated by the nature of the end which it accomplishes, when practically employed in the arts. In all departments of physical science, a given end is usually attainable through many different means. Seldom, if ever, in the material world does any effect rest so exclusively upon a single cause that no other operation of natural or artificial forces could produce the same results. Identity of end is, therefore, no proof of identity of means. Though an alleged invention achieves no other ends than have already been obtained by using other arts or instruments, the idea of means which it embodies may still be new, and a true product of creative skill.¹ The converse

87; *Tatham v. Le Roy* (1852), 2 Blatch. 474; *Hotchkiss v. Greenwood* (1848), 4 McLean, 456; 2 Robb, 730; *Alden v. Dewey* (1840), 1 Story, 336; 2 Robb, 17.

See for this whole subject of utility as bearing on novelty &c., § 344, *post*.

§ 117. ¹ In *Pitts v. Wemple* (1855), 2 Fisher, 10, Drummond, J.: (19) "After a patent has been obtained for a particular thing by one person, another person without appropriating that patent may invent a new mode of accomplishing the same or a similar object, and the latter will be entitled to a patent for his discovery." 1 Bissell, 87 (97).

See, to the same point, *Coes v. Collins Co.* (1882), 9 Fed. Rep. 905; 20 Blatch. 221; 22 O. G. 417; *Toohy v. Harding* (1880), 1 Fed. Rep. 174; 4 Hughes, 253; *Buerk v. Valentine* (1872), 2 O. G. 295; 9 Blatch. 479; 5 Fisher, 366; *Burden v. Corning* (1864), 2 Fisher, 477; *O'Reilly v. Morse* (1853), 15 How. 62.

In *Curtis v. Platt* (1863), cited in note to *Adie v. Clark* (1876), L. R.

3 Ch. 134, Wood, V. C.: (136) "In all discoveries of course there are two things—there is an object to be achieved, and a means of achieving that object. Now the object to be achieved may be very old. Of course hundreds of patents have been taken out for achieving objects which in the history of mankind have been achieved by some means or other. No novelty is required as to the object, the novelty may be in the means for effecting the object whether old or new. . . . (139) If the invention be . . . nothing more than a particular means to attain to a given result which is perfectly well known, then you can no more say that the invention of one distinct set of means interferes with the invention of another than you could say originally that there ought not to be patents for the inventions of distinct means to an end. . . . They are the roads and means of attaining the end, and unless you can prove that one is a colorable imitation of the other, or bodily incorporates the other with merely an addition, it is impossible to

of this proposition, however, cannot be maintained. Diversity of ends never results from uniformity of means. In every cause perpetually resides every effect which it is able to produce, and as the nature of the effect depends entirely on the nature of the cause, no change can ever take place in the one without a corresponding alteration of the other. Thus, while identity of end is no proof of identity of means, diversity of end cannot exist without diversity of means, and every really new result furnishes in itself conclusive evidence that the cause by which it is produced is also new. Any invention, therefore, which accomplishes an end never before attained must be intrinsically new, and unless evidently a mere constructive union of known factors must, likewise, have originated in a new inventive act.² Caution is necessary, in this

say that they shall not be co-existent subjects of contemporaneous patents."

In *Walton v. Potter* (1841), 1 Web. 585, Tindal, C. J. : (590) "Now there can be no doubt whatever that, although one man has obtained a patent for a given object, there are many modes still open for other men of ingenuity to obtain a patent for the same object; there may be many roads leading to one place, and if a man has, by dint of his own genius and discovery after a patent has been obtained, been able to give to the public, without reference to the former one, or borrowing from the former one, a new and superior mode of arriving at the same end, there can be no objection to his taking out a patent for that purpose."

In *Huddart v. Grimshaw* (1803), 1 Web. 85, Ellenborough, C. J. : (92) "Now the object of this patent, and to be sure the objects of the two patents are substantially the same, . . . but it does not follow, that because the ends are materially the same, it is thereon open to the public. It has happened to me in the same morning to give, as far as I was concerned, my consent to the granting of three different patents for the same thing; but the modes of at-

taining it were all different." 1 Abb. P. C. 128 (153).

In a note to this case Webster says : (86) "It is important in this and similar cases, that the end or result, and the means by which such end or result is attained, should be carefully distinguished from each other; these means may, to all appearance, be trifling and insignificant, such as it would appear might have suggested themselves to any person. In all such cases the novelty or importance of the end attained may become a test as to the novelty of the means."

That there may be various patentable means to the same end, see also *Russell v. Cowley* (1835), 1 Web. 465.

² In *Stanley Works v. Sargent & Co.* (1871), 8 Blatch. 344, Shipman, J. : (346) "Utility is not an infallible test of originality. The patent law requires a thing to be new as well as useful, in order to entitle it to the protection of the statute. To be new, in the sense of the Act, it must be the product of original thought or inventive skill, and not a mere formal and mechanical change of what was old and well-known. But the effect produced by a change is often an appropriate, though not a con-

investigation of the end, not to confound ends never before perceived with ends which never before had been attained. A single means may accomplish many ends, and certain of

trolling, consideration in determining the character of the change itself." 4 Fisher, 443 (445).

In *Waterbury Brass Co. v. New York and Brooklyn Brass Co.* (1858), 3 Fisher, 43, Ingersoll, J. : (50) "It is a safe source of testimony, which can be relied upon with some degree of certainty, in order to ascertain whether the same means are used, ' look at the result produced by the means used. Like means, provided the machine is in perfect order, will, in a measure, produce like results. And if like results cannot be produced by two separate devices, it is good evidence for the jury to consider, in coming to a conclusion as to whether like means were used ; because, as a general rule, like results are produced by like means ; and if like results are not produced by two separate devices, it is fair for the jury to infer that the means may not be alike in kind or character."

In *Furbush v. Cook* (1857), 2 Fisher, 668, Curtis, J. : (672) "And it is decisive evidence, though not the only evidence, that a new mode of operation has been introduced, if the practical effect of the new combination is either a new effect or a materially better effect ; or as good an effect more economically attained by means of the change made in the combination of the patentee. A new or improved, or more economical effect, attributable to the change made by the patentee in the mode of operation of existing machinery, proves that the change has introduced a new mode of operation, which is the subject-matter of a patent ; and when this is ascertained, it is not a legitimate subject of inquiry, at what cost to the patentee it was made, nor does the validity of the patent depend on an opinion formed after

the event respecting the ease or difficulty of attaining it."

That novelty in the end indicates novelty of means, see *Enterprise Co. v. Sargent* (1886), 28 Fed. Rep. 185 ; 37 O. G. 891 ; *Sewing Mach. Co. v. Frame* (1884), 24 Fed. Rep. 596 ; 28 O. G. 96 ; *Reay v. Berlin & Jones Envelope Co.* (1884), 28 O. G. 370 ; 20 Fed. Rep. 506 ; *Barber v. Hallet* (1879), 20 O. G. 449 ; 10 Fed. Rep. 130 ; *Stewart v. Mahoney* (1879), 5 Fed. Rep. 302 ; 4 Bann. & A. 84 ; *Willimantic Linen Co. v. Clark Thread Co.* (1879), 4 Bann. & A. 133 ; *Pearl v. Ocean Mills Co.* (1877), 2 Bann. & A. 460 ; 11 O. G. 2 ; *Cornell v. Downer & Bemis Brewing Co.* (1877), 7 Bissell, 346 ; 11 O. G. 331 ; 2 Bann. & A. 514 ; *Stanley Works v. Sargent & Co.* (1871), 8 Blatch. 344 ; 4 Fisher, 443 ; *Turrill v. Illinois Central R. R. Co.* (1867), 3 Bissell, 66 ; 3 Fisher, 330 ; *Johnson v. Root* (1858), 1 Fisher, 351 ; *Sloat v. Patton* (1852), 1 Fisher, 154 ; *Hall v. Wiles* (1851), 2 Blatch. 194.

That an improvement in the result does not prove novelty in the means, see *Sax v. Taylor Iron Works* (1887), 40 O. G. 118.

That a change in existing devices causing them to produce new results indicates new means, see *Sewing Mach. Co. v. Frame* (1884), 24 Fed. Rep. 596 ; 28 O. G. 96.

That if the result is the same *in kind* it does not prove novelty in the means, however different it may be in mere degree, see *Ex parte Greeley* (1873), 4 O. G. 612 ; *Holmes*, 284 ; 6 Fisher, 575.

That an invention saves labor and expense, or produces better results, does not alone prove inventive skill, see *North v. Williams* (1870), 17 Grant Ch. (Can.) 179.

these ends may easily remain unknown until extensive application of the means develops and exhibits all its capabilities. Rarely does the most thoughtful of inventors discern the entire results of his discovery or understand the various uses to which, in the incessant progress of the arts, it may eventually be applied. But the perception of these ends does not produce them. It does not change their character nor indicate an alteration in the means by which they are attained. All owe their origin to that creative act which generated the idea of means and, whether known or unknown, they have existed ever since that act was first performed. This is the reason of the rule, already noticed, that all the uses of an idea of means belong to its conceiver, whether or not he at the time perceives them, while those who simply recognize them and apply to their attainment the means which he devised, are practising his invention, not their own, as truly as if all these ends had been discovered and disclosed by him. The ends which indicate a novelty of means must be themselves actually new; not the long dormant ends unconsciously achieved by prior arts or instruments, but new results produced for the first time by that invention concerning whose intrinsic novelty the inquiry is made.

§ 118. **Novelty of End, how Evidenced.**

Novelty of end is ascertained by an examination of its nature, and by a comparison of its utility with that of other ends. The end to be accomplished is the satisfaction of a public want. The satisfaction of this want consists in a changed condition of affairs, in which the want entirely disappears. This changed condition is the effect produced by the invention, and is the ultimate end to which the means embodied in the invention tends. Novelty of end is thus a new condition of the things or persons upon which the action of the means embraced in the invention terminates, and when in their condition novelty appears, a novelty of means may safely be presumed. This novelty of end exists whenever the change in the condition of affairs is a substantial, as distinguished from a formal, change; and the change is substantial when it removes a want hitherto wholly unsupplied or satisfies it by a change essentially distinct from any previously known.

§ 119. Novelty of End is Evident whenever any Want is for the First Time Supplied.

In cases where a change in the condition of affairs removes a want hitherto unsupplied, the character of the change itself becomes of little moment. No want, however trifling, is for the first time satisfied without the existence of a state of things which never has occurred before; and the production of this state of things requires the operation of a cause which, in itself or in its mode of operation, must be also new. This test of novelty of end is at once the simplest and the most reliable. Given a pre-existing want, and its removal, and the condition of affairs, on whose production the want ceases, must be new.¹

§ 120. Novelty of End is Evident whenever any Want is Supplied by a New Form of Satisfaction.

Where the same want may be removed by several different changes of condition, and one or more such changes have already been produced, the novelty of the present change is ascertained by a comparison between it and those previous changes of condition. Here the character of the change itself is of the greatest consequence. If the condition now developed so far departs from all the former as to become not merely a satisfaction or a better satisfaction of the want, but an essentially different satisfaction, it is a new condition, and not otherwise.¹ This can be true only where the distinc-

§ 119. ¹ That the satisfaction of a want hitherto unsatisfied requires new means, see *Judson v. Moore* (1859), 1 Fisher, 544; 1 Bond, 285.

That inventive skill is indicated when the new art or article satisfies a long-felt want and is accepted as such satisfaction by the public, see *Eames v. Andrews* (1887), 122 U. S. 40; 39 O. G. 1319; *Butler v. Bainbridge* (1886), 29 Fed. Rep. 142; *Consolidated Valve Co. v. Crosby Valve Co.* (1885), 113 U. S. 157; 30 O. G. 991; *United Nickel Co. v. California Electrical Works* (1885), 25 Fed. Rep. 475; 11 Sawyer, 250; *Washburn & Moen Mfg. Co. v. Grinnell Wire Co.*

(1885), 24 Fed. Rep. 23; *Hicks v. Otto* (1884), 29 O. G. 365; 22 Blatch. 94; 19 Fed. Rep. 749; *Brown Mfg. Co. v. Deere* (1884), 28 O. G. 1187; 21 Fed. Rep. 709; *Shuter v. Davis* (1883), 24 O. G. 303; 16 Fed. Rep. 564; *Lindsay v. Stein* (1882), 21 O. G. 1613, 10 Fed. Rep. 907; 20 Blatch. 370; *Bruce v. Marder* (1881), 22 O. G. 1039; 20 Blatch. 355; 10 Fed. Rep. 750.

§ 120. ¹ That difference in the character of the result may indicate a difference in means, see *Smith v. Woodruff* (1874), 6 Fisher, 476; 4 O. G. 635; 1 MacArthur, 459; *Singer v. Walmsley* (1860), 1 Fisher, 558.

tion in conditions is one of kind, not simply of degree. Though a condition be more perfectly attained, its character is still the same, and its increase in perfection may have been secured by a more careful or persistent application of the same means.² But when the last condition is distinct in kind, the end accomplished is a different end, affording a new form of satisfaction to the ancient want, and proceeding from the operation of a different means.

§ 121. Novelty of Form of Satisfaction is Indicated by its Comparative Utility.

When this difference between the old and new conditions is not evident upon their face, it may be inferred from their comparative utility.¹ Wherever any want, already partially

² That an improved operation and better result, if of the *same kind*, do not indicate a difference in means, see *Ex parte Greely* (1873), 4 O. G. 612; *Holmes*, 284; 6 *Fisher*, 575.

§ 121. ¹ In *Ex parte Pennock* (1874), 1 *MacArthur*, 531, *MacArthur, J.*: (537) "Inventions, like all other matters of inquiry, are subject to be judged of by practical results. A combination is not less an invention, although all the parts are well known, if the effect is a new or a better result, and it is the highest evidence possible of a patentable combination that it produces an article with a great economy of time and labor. In *Furbush v. Cook* (2 *Fisher*, 672), Judge Curtis remarked: 'And it is decisive evidence, though not the only evidence, that a new mode of operation has been introduced if the practical effect of the new combination is either a new effect or a materially better effect, or as good an effect more economically attained by means of the change made. A new improved or more economical effect attributable to the change made by the patentee in the mode of operating existing machinery proves that the change has introduced a new mode of operation which is the

subject-matter of a patent; and when this is ascertained, it is not a legitimate subject of inquiry at what cost to the patentee it was made, nor does the validity of the patent depend on an opinion formed after the event, respecting the ease or difficulty of attaining it.' . . . (539) Whether the inventive faculty has been exercised, is mostly a question of evidence, and is always to be considered in reference to the condition of the art, and the results accomplished, and where the combination is confessedly new and the benefit great, the presumption is strongly in its favor. It is not always safe to consider that there has been no invention because it appears obvious and simple, for simplicity is often the chief merit of a patent. . . . If the thought was original and can be employed with substantial advantage, it becomes a meritorious invention within the meaning of the patent law." 5 O. G. 668 (668, 669).

In *Smith v. Nichols* (1872), 2 O. G. 649, *Lowell, J.*: (650) "The fact that an article is better and more useful in the trade is evidence of novelty; but if the superiority is attained by the application of known means in a known way to produce a known result, though a

supplied, after some further change in the condition of affairs is fully satisfied and ceases to exist, the difference in the usefulness of the two forms of satisfaction is often treated as sufficient evidence of substantial difference in the conditions. (On the same principle a form of satisfaction, whose superiority to others is established by the fact that in its practical enjoyment by the public it has superseded every other, is usually regarded as a new condition, unless upon its face the contrary appears. If, on account of cheapness or any other greater ease of access by the public, it shows itself more useful than the old, this also, though of little consequence when other indications of novelty or similarity are present, may be sufficient to denote such a substantial variation as requires an actual difference in means.

§ 122. Discovery also Indicated by Prior Unsuccessful Efforts of Other Inventors.

Besides the evidence afforded by the nature of the end accomplished and its comparative utility, there is another fact

better one, the novelty required by the patent law is wanting." Holmes, 172, (175); 6 Fisher, 61 (64).

In *Roberts v. Dickey* (1872), 1 O. G. 4, Strong, J.: (5) "There are many cases in which the materiality of an invention, whether it be a machine or a process, can be judged of only by its effect on the result, and this effect is tested by the actual improvement in the process of producing an article, or in the article itself introduced by the alleged invention. Curtis, on Pat. § 9. 'In these cases,' says our author, (§ 10,) 'the subject of the invention is not the particular machinery or apparatus by which the new application is made to be available, but it is the new application itself of certain known substances or agents to produce a particular result, differing either in the process or in the article produced from the former methods of producing the same thing, and thereby producing a better article or producing it by superior and cheaper processes.

It is obvious that the results in such cases furnish a complete test of the sufficiency of the inventions, because the importance of the result shows that, whether actually exercised or not, the possibility of the exercise of thought, design, ingenuity, and skill is not excluded.' Similar observations may be found in Webster on the subject-matter of patents, page 30, where it is said: 'The utility, then, of the change, as ascertained by its consequences, is the real practical test of the sufficiency of an invention, and since the one cannot exist without the other, the existence of the one may be presumed on proof of the existence of the other. Whenever the utility is proved to exist in any great degree, a sufficiency of invention to support the patent must be presumed.' These remarks are very pertinent to the present case and they are obviously founded in good sense." 4 Fisher, 532 (538); 4 Brews. 260 (264).

Further, that an increase of utility in

which indicates not only the novelty of the end, but the necessity for inventive skill in the creation of the means whereby it is attained. This fact consists in the unsuccessful attempts of others to produce the same results.¹ The

the effect produced by an invention is evidence of novelty in such effect, and so of novelty and inventive skill in the invention itself, see *Roberts v. Schreiber* (1880), 5 Bann. & A. 491; 18 O. G. 125; 2 Fed. Rep. 855; *Hoe v. Cottrell* (1880), 18 O. G. 59; 17 Blatch. 546; 1 Fed. Rep. 597; 5 Bann. & A. 256; *Williams v. The Rome, Watertown, & Ogdensburgh R. R. Co.* (1878), 15 Blatch. 200; 15 O. G. 653; 3 Bann. & A. 413; *Eppinger v. Richey* (1877), 12 O. G. 714; 14 Blatch. 307; 3 Bann. & A. 69; *Smith v. Woodruff* (1873), 6 Fisher, 476; 4 O. G. 635; 1 MacArthur, 459; *Hitchcock v. Tremaine* (1872), 1 O. G. 633; 5 Fisher, 537; 9 Blatch. 550; *Howe v. Morton* (1860), 1 Fisher, 586; *Judson v. Moore* (1859), 1 Bond. 285; 1 Fisher, 544.

But that no improvement in the effect can show inventive skill in the means, when the means and effect remain substantially the same, see *Imlay v. Norwich & Worcester R. R. Co.* (1858), 4 Blatch. 227; 1 Fisher, 340.

That the success of the result of a process tends to show the novelty of the process, but is not conclusive, see *Wilson Packing Co. v. Chicago Packing & Provision Co.* (1881), 21 O. G. 411; 10 Bissell, 559; 9 Fed. Rep. 547.

See §§ 113, 116, *ante*, 344, *post*.

§ 122. ¹ In *Pearl v. Ocean Mills* (1877), 2 Bann. & A. 469, Shepley, J.: (476) "No more difficult task is imposed upon the court in patent causes than that of determining what constitutes invention, and of drawing the line of distinction between the work of the inventor and the constructor. The change from the old structure to the new may be one which one inventor

would devise with the expenditure of but little thought and labor, and another would fail to accomplish after long and patient effort. It may be one, which one whose mind is fertile in invention will suggest almost instantaneously, when the skilled hand of the constructor will fail to reach the apparently simple result by the long and toilsome process of experiment. It may be one which, viewed in the light of the accomplished result, may seem so simple as to be obvious almost to an unskilled operative, and yet the proof may show that this apparently simple and obvious change has produced a result which has for years baffled the skill of the mechanical expert, eluded the search of the discoverer, and set at defiance the speculations of inventive genius." 11 O. G. 2 (4).

That the unsuccessful efforts of others to accomplish the same result indicates that the means by which the present inventor accomplishes it are the fruit of inventive skill, see *Wilcox v. Bookwalter* (1887), 31 Fed. Rep. 224; *Celuloid Mfg. Co. v. American Zylonite Co.* (1886), 28 Fed. Rep. 195; 36 O. G. 1043; *Dudgeon v. Watson* (1886), 29 Fed. Rep. 248; *Davis v. Fredericks* (1884), 21 Blatch. 556; 19 Fed. Rep. 99; *Sewing Mach. Co. v. Frame* (1884), 24 Fed. Rep. 596; 28 O. G. 96; *Ward v. Grand Detour Plow Co.* (1883), 14 Fed. Rep. 696; *Bruce v. Marder* (1882), 20 Blatch. 355; 10 Fed. Rep. 750; 22 O. G. 1039; *Lindsay v. Stein* (1882), 20 Blatch. 370; 10 Fed. Rep. 907; 21 O. G. 1613; *Western Electric Light Co. v. Chicago Electric Light Mfg. Co.* (1882), 11 Bissell, 427; 14 Fed. Rep. 691; *Wallace v. Noyes* (1882), 18

courts assume that no such efforts would be made unless the want existed and were felt, while from the failure of all previous endeavors to supply it they draw the inference that nothing then existed in the arts from which the imitative faculties alone could have constructed a method of attaining to the satisfaction now enjoyed.

§ 123. Discovery Evidenced by Oath of Inventor and his Personal Experiments unless the Concrete Invention is Devoid of Legal Novelty.

Upon this question of the intrinsic novelty of the invention, its legal novelty has no especial bearing, since any art or instrument may be well known in some parts of the world and still have never been in use in the United States, nor have been patented, nor described in any printed publication. Legal novelty, however, is a proper matter for consideration, in certain cases, upon the question whether the invention, though not intrinsically new, could have been new to the inventor and thus the actual product of his own creative skill. Intrinsic novelty in an invention is not essential to its patentability, and hence, although such novelty affords the

Fed. Rep. 172 ; 21 Blatch. 83 ; 23 O. G. 435 ; Mallory Mfg. Co. v. Marks (1881), 20 Blatch. 32 ; 11 Fed. Rep. 887 ; 20 O. G. 1521 ; Yale Lock Mfg. Co. v. Norwich Nat. Bank (1881), 6 Fed. Rep. 377 ; 19 Blatch. 123 ; Washburn & Moen Mfg. Co. v. Haish (1880), 4 Fed. Rep. 900 ; 10 Bissell, 65 ; 19 O. G. 173 ; Hoe v. Cottrell (1880), 1 Fed. Rep. 597 ; 17 Blatch. 546 ; 18 O. G. 59 ; 5 Bann. & A. 256 ; Eastman v. Hinkel (1879), 5 Bann. & A. 1 ; Terry Clock Co. v. New Haven Clock Co. (1879), 4 Bann. & A. 121 ; 17 O. G. 909 ; Campbell v. James (1879), 18 O. G. 979 ; 17 Blatch. 42 ; 4 Bann. & A. 456 ; Williams v. The Rome, Watertown, & Ogdensburgh R. R. Co. (1878), 15 Blatch. 200 ; 15 O. G. 653 ; 3 Bann. & A. 412 ; Eppinger v. Richey (1877), 14 Blatch. 307 ; 12 O. G. 714 ; 3 Bann. & A. 69 ; Good-

year Dental Vulcanite Co. v. Willis (1874), 1 Bann. & A. 569 ; 7 O. G. 41 ; 1 Flippin, 388 ; Many v. Jagger (1848), 1 Blatch. 372.

That prior unsuccessful efforts of others indicate discovery of new factors by the successful inventor, see Adams & Westlake Mfg. Co. v. Rathbone (1886), 26 Fed. Rep. 262 ; Niles Tool Works v. Betts Mach. Co. (1886), 27 Fed. Rep. 301 ; Enterprise Mfg. Co. v. Sargent (1886), 28 Fed. Rep. 185 ; 37 O. G. 891 ; Celluloid Mfg. Co. v. Chrolithion Collar & Cuff Co. (1885), 23 Blatch. 205 ; 23 Fed. Rep. 397 ; 31 O. G. 519 ; Bogart v. Hinds (1885), 26 Fed. Rep. 149 ; 34 O. G. 1510.

That the mere fact that others failed where the present inventor succeeded is not conclusive evidence of discovery, see Butler v. Steckel (1886), 27 Fed. Rep. 219 ; 36 O. G. 455.

strongest evidence of the existence of the inventive act, its absence is not conclusive proof that no inventive act has been performed. The law contemplates the possibility that an inventor in this country may generate an idea of means by processes of discovery and construction, notwithstanding the conception of the same idea and its embodiment in operative arts or instruments abroad, and it intends to secure and does secure to such inventors the fruits of their creative skill. Thus while legal novelty raises no presumption of intrinsic novelty, nor of the generation of the idea of means by the alleged inventor, it is an essential condition of that recognition which the law concedes to the inventor's efforts, and in its absence no claim of the inventor that the idea of means is due to his discovery and construction can be entertained. But where legal novelty is present the law permits the alleged inventor to prove, if he can do so, that the invention has originated in his own inventive skill. For this his individual statement under oath, if not opposed by other evidence, may be sufficient. His long research and repeated trials may confirm, or his opportunity to imitate the arts or instruments of others may contradict, his statement.¹ The whole question is here open for the exhibition of any competent testimony; his own oath constituting *prima facie* proof, and in a case of doubt the presumption always being in his favor.²

§ 124. General Statement of Facts which Indicate that the Mental Part of the Inventive Act has been Performed.

The principles which govern the sufficiency and application of the evidence concerning the performance of the mental part of the inventive act, may be summed up as follows: —

I. To prove the mental part of the inventive act the evi-

§ 123. ¹ That an invention was reached by many steps and trials on the part of the inventor is evidence that it involved inventive skill, see *Campbell v. James* (1879), 18 O. G. 979; 17 Blatch. 42; 4 Bann. & A. 456; *Williams v. Rome, Watertown, & Ogdensburgh R. R. Co.* (1878), 15 Blatch. 200; 15 O. G. 653; 3 Bann. & A. 412.

² That discovery must be shown by independent evidence although legal novelty exists, see *Celluloid Mfg. Co. v. Comstock & Cheney Co.* (1886), 27 Fed. Rep. 358; 36 O. G. 1356.

dence must show that both the process of discovery and the process of construction have been performed by the alleged inventor;

II. Where the idea conceived is an idea of means it is certain that the constructive process was performed;

III. The performance of the process of discovery is demonstrated if either factor of the idea of means were hitherto unknown; it is rendered in the highest degree probable when the concrete invention is intrinsically new and is of great utility; it may be inferred from the unsuccessful efforts of others to achieve the same results; it may be proved by the oath of the inventor or other competent testimony when legal novelty exists in the invention; it is conclusively presumed against when legal novelty is wanting;

IV. Intrinsic novelty in the invention may manifest itself in its new essential attributes, or in its new mode of operation, or in its new effects; and novelty in mode of operation or effects may be inferred from their superior utility;

V. The legal novelty of the concrete invention does not prove its intrinsic novelty, nor the performance of the process of discovery by the alleged inventor;

VI. The inventor is presumed to have known all inventions and all factors which were familiar to persons skilled in the art to which his invention belongs; and none of these can he ever be permitted to claim as the result of his discoveries.

SECTION IV.

OF THE PHYSICAL PART OF THE INVENTIVE ACT: REDUCTION OF THE IDEA OF MEANS TO PRACTICE.

§ 125. Reduction to Practice Necessary to Complete the Inventive Act.

No mental operation, however definite and valuable may be its result, is a complete inventive act. That which rests in thought only, as a mere theory or intellectual conception, can never be a means producing physical effects. It is not "a

manufacture," in any sense in which that word has been applied in the industrial arts. It is neither "a thing made," nor "a manner of making." It improves no trade, confers no public benefit, and can be subject to no protection which the law is able to afford. An invention, therefore, does not exist until the generated idea has been reduced to practice.¹ It is not enough that as it lies in the inventor's mind, or can be explained to others, it is possible or even practicable. "Its possibility must become actuality." "Its practicability must be demonstrated by experience." The means which has been conceived must be made operative and useful in the arts. The spirit that has been created must be clothed with a body by which it is brought into contact with the exterior world, and through which its energies can act upon material substance.² In a word, the invention must be put into the

§ 125. ¹ In *Sawyer v. Edison* (1883), 25 O. G. 597, Marble, Com. : (601) "An invention is complete when the thought conceived is embodied in some practical and operative form."

In *Draper v. The Potomska Mills Co.* (1878), 13 O. G. 276, Shepley, J. : (276) "An imperfect and incomplete invention, resting in mere theory, or in intellectual motion, or in uncertain experiments, and not actually reduced to practice and embodied in some distinct machinery, apparatus, manufacture, or composition of matter, is not, and indeed cannot be, patentable under our patent acts, since it is impossible, under such circumstances, to comply with the fundamental requisites of those acts." 3 Bann. & A. 214 (215).

In *Andrews v. Carman* (1876), 9 O. G. 1011, Benedict, J. : (1013) "There can be no patent for a principle ; but 'for a principle so far embodied and connected with corporeal substances as to be in a condition to act and produce effects in any trade, mystery, or manual occupation there may be a patent.' The idea or principle of forcing water from the earth

into a well-pit by the use of artificial power is new, but is not by itself patentable. The idea, when made available by method whereby it is put to practical use, is patentable as a process, and is thus secured to the person who has conceived the idea and invented the method." 13 Blatch. 307 (312) ; 2 Bann. & A. 277 (281).

In *McComb v. Brodie* (1872), 2 O. G. 117, Woods, J. : (119) "A patent cannot be granted for a principle or an idea, or for any abstraction whatever ; for instance, for the naked idea of a slit, slot, or aperture, disconnected from any application. But when the idea is applied to a material thing, so as to produce a new and useful effect or result, it ceases to be abstract, and becomes a proper subject to be covered by a patent." 5 Fisher, 384 (391) ; 1 Woods, 153 (158).

² In *Morton v. The New York Eye Infirmary* (1862), 5 Blatch. 116, Shipman, J. : (121) "In its naked, ordinary sense, a discovery is not patentable. A discovery of a new principle, force, or law, operating, or which can be made to operate, on matter, will not entitle

hands of the public in a condition for immediate use, requiring no further speculation or experiment, but fitted, as it is, for the accomplishment of its intended ends.

the discoverer to a patent. It is only where the explorer has gone beyond the mere domain of discovery, and has laid hold of the new principle, force, or law, and connected it with some particular medium or mechanical contrivance, by which, or through which, it acts on the material world, that he can secure the exclusive control of it under the Patent Act. He then controls his discovery through the means by which he has brought it into practical action, or their equivalent, and only through them. It is then an invention, although it embraces a discovery. Sever the force or principle discovered from the means or mechanism through which he has brought it into the domain of invention, and it immediately falls out of that domain and eludes his grasp. It is then a naked discovery, and not an invention. . . . Every invention may, in a certain sense, embrace more or less of discovery, for it must always include something that is new ; but it by no means follows that every discovery is an invention. It may be the *soul* of an invention, but it cannot be the subject of the exclusive control of the patentee, or of the patent law, until it inhabits a *body*, any more than a disembodied spirit can be subjected to the control of human laws." 2 Fisher, 320 (323).

In *Wintermute v. Redington* (1856), 1 Fisher, 239, Willson, J. : (247) "It is true that a patent cannot be sustained for a mere principle. For instance, Sir Isaac Newton's discovery of the principle of gravitation could not be the subject of a patent. But it is equally true, that a principle may be embodied and applied, so as to afford some result of practical utility in the arts and manufactures, and that under such cir-

cumstances a principle may be the subject of a patent. It is, however, *the embodiment and the application of the principle which constitute the grant of the patent*. And it has been justly said 'that the principle so embodied and applied, and the principle of *such* embodiment and application, are essentially distinct ; the former being a truth of exact science, or a law of natural science, or a rule of practice ; the latter a practice founded upon such truth, law, or rule.'"

In *Detmold v. Reeves* (1851), 1 Fisher, 127, Kane, J. : (130) "There is no doubt, that he who has discovered some new element or property of matter, may secure to himself the ownership of his discovery, so soon as he has been able to illustrate it practically, and to demonstrate its value. His patent, in such a case, will be commensurate with the principles, which it announces to the world, and may be so broad as the mental conception itself. But, then, the mental conception must have been susceptible of embodiment, and must have been, in fact, embodied in some mechanical device, or some process of art. The abstract must have been resolved into the concrete. The patent must be for a thing — not for an idea merely."

In *Whitney v. Emmett* (1831), Baldwin, 303, Baldwin, J. : (311) "Nor is a discovery of some new principle, theory, elementary truth, or an improvement upon it, abstracted from its application, a new invention. But when such discovery is applied to any practical purpose, in the new construction, operation or effects of machinery or composition of matter, producing a new substance, or an old one in a new way, by new machinery, or a new com-

§ 126. Reduction to Practice Requires the Practice of an Art or the Construction of an Instrument.

This requirement of the law is satisfied by nothing less than the actual practice of some art, or the construction of some article of manufacture.¹ A written description of the pro-

bination of the parts of an old one, operating in a peculiar, better, cheaper, or quicker method, a new mechanical employment of principle already known, the organization of a machine embodied and reduced to practice on something visible, tangible, vendible, and capable of enjoyment, some new mode of practically employing human art or skill. It is a 'discovery,' 'invention' or 'improvement,' within the acts of congress, and a 'new manufacture' by the statute of James." 1 Robb, 567 (579).

That reduction to practice is essential, also see *Judson v. Bradford* (1878), 16 O. G. 171; 3 Bann. & A. 539; *Burke v. Partridge* (1878), 58 N. H. 349; *Graham v. Gammon* (1877), 7 Bissell, 490; 3 Bann. & A. 7; *Smith v. Prior* (1873), 2 Sawyer, 461; 6 Fisher, 469; *Jones v. Sewall* (1873), 3 Clifford, 563; 6 Fisher, 343; 3 O. G. 630; *Webb v. Quintard* (1872), 9 Blatch. 352; 5 Fisher, 276; 1 O. G. 525; *Seymour v. Osborne* (1870), 11 Wall. 516; *Roberts v. Reed Torpedo Co.* (1869), 3 Fisher, 629; *Whitely v. Swayne* (1868), 7 Wall. 685; *Union Sugar Refinery v. Matthiesson* (1865), 3 Clifford, 639; 2 Fisher, 600; *White v. Allen* (1863), 2 Clifford, 224; 2 Fisher, 440; *Union Mfg. Co. v. Lounsbury* (1863), 2 Fisher, 389; *Johnson v. Root* (1862), 2 Clifford, 108; 2 Fisher, 291; *Cox v. Griggs* (1861), 1 Bissell, 362; 2 Fisher, 174; *Potter v. Wilson* (1860), 2 Fisher, 102; *Matthews v. Skates* (1860), 1 Fisher, 602; *Le Roy v. Tatham* (1859), 22 How. 132; *Ellithorp v. Robertson* (1859), 4 Blatch. 307; 2 Fisher, 83; *Poppenhusen v. N. Y. Gutta Percha Comb*

Co. (1858), 2 Fisher, 62; *Sickels v. Borden* (1856), 3 Blatch. 535; *Parkhurst v. Kinsman* (1849), 1 Blatch. 488; *Many v. Jagger* (1848), 1 Blatch. 372; *Allen v. Blunt* (1846), 2 W. & M. 121; 2 Robb, 530; *Reed v. Cutter* (1841), 1 Story, 590; 2 Robb, 81.

§ 126. ¹ In *White v. Allen*, (1863), 2 Clifford, 224, Clifford, J.: (230) "While the suggested improvement, however, rests merely in the mind of the originator of the idea, the invention is not completed, within the meaning of the patent law, nor are crude and imperfect experiments sufficient to confer a right to a patent; but in order to constitute an invention, in the sense in which that word is employed in the Patent Act, the party alleged to have produced it, must have proceeded so far as to have reduced his idea to practice, and embodied it in some distinct form. *Gayler v. Wilder*, 10 How. 498; *Parkhurst v. Kinsman*, 1 Blatch. 494; *Curt. on Pat. § 43*. Mere discovery of an improvement does not constitute it the subject-matter of a patent, although the ideas which it involves may be new, but the new set of ideas, in order to become patentable, must be embodied into working machinery and adapted to practical use. *Sickels v. Borden*, *Law's Dig.* 423, per Nelson, J." 2 Fisher, 440 (446).

In 11 Am. Law Reg. n. s. 612, 665, (1872), an able writer, after discussing the cases on the subject, arrives at the following result: (679) "Before an invention can be considered as having been so reduced to practice as to give its author, without further effort on his part, an irrefragable title to it, if duly

posed invention, even when so fully illustrated by drawings that any person skilled in the art could carry out the ideas of the inventor, is not sufficient.² A model exhibiting the article in all its parts, disclosing its mode of operation and clearly showing its feasibility, is equally objectionable.³ An application for a patent, in which description, drawings, and model are combined, comes no nearer to a compliance with the law;⁴ nor does the granting of a patent, after due examination

asserted, it must have been embodied in a practical working machine, capable of being operated to perform its intended functions for business purposes. If not capable of such embodiment, it must have been brought to an equivalent state of perfection in some other way. Upon this point there is no conflict in our judicial tribunals."

² In *Draper v. Potomska Mills Co.* (1878), 13 O. G. 276, Shepley, J.: (276) "Illustrated drawings of conceived ideas do not constitute an invention, and unless they are followed up by a reasonable observance of the requirements of the patent laws, they can have no effect upon a subsequently granted patent to another." 3 Bann. & A. 214 (215).

In the *Northwestern Fire Extinguisher Co. v. The Philadelphia Fire Extinguisher Co.* (1874), 6 O. G. 34, McKennan, J.: (36) "A written description of a machine, although illustrated by drawings, which has not been given to the public, does not constitute an invention, within the meaning of the patent laws. It may be so full and precise as to enable any one, skilled in the art to which it appertains, to construct the machine described, but until it has been embodied in a form capable of useful operation, it has not attained the proportions or the character of a complete invention." 10 Phila. 227 (231); 1 Bann. & A. 177 (185).

See further *Lyman Ventilating & Refrigerator Co. v. Lalor* (1874), 6 O. G.

642; 12 Blatch. 303; 1 Bann. & A. 403; *Reeves v. Keystone Bridge Co.* (1872), 1 O. G. 466; 5 Fisher, 456; 9 Phila. 368; *Ellithorp v. Robertson* (1859), 4 Blatch. 307; 2 Fisher, 83; also cases cited to same point in § 318, n. 2.

That drawings may show conception but are not reduction to practice, see *Odell v. Stout* (1884), 22 Fed. Rep. 159; 29 O. G. 862.

³ That a model is not reduction to practice, see *Stilwell & Bierce Mfg. Co. v. Cincinnati Gaslight & Coke Co.* (1875), 7 O. G. 829; 1 Bann. & A. 610; *Johnson v. McCullough* (1870), 4 Fisher, 170; and cases cited to same point in § 318, n. 2.

⁴ That an application for a patent is not reduction to practice, see *Howes v. McNeal* (1878), 15 Blatch. 103; 15 O. G. 608; 3 Bann. & A. 376; *Barker v. Stow* (1878), 15 Blatch. 49; 14 O. G. 559; 3 Bann. & A. 337; *Herring v. Nelson* (1877), 14 Blatch. 293; 12 O. G. 753; 3 Bann. & A. 55; and cases cited to same point in § 318, n. 2.

That the filing of the application does not prove reduction to practice, though it may establish the fact of the conception of the idea, see *Huntley v. Smith* (1880), 18 O. G. 795.

That diligence in making his application shows that the inventor has faith in the practicability of his invention and may thus supply in some cases the necessity of reducing to practice, see *Huntley v. Smith* (1880), 18 O. G. 795.

by the proper officers, prove that this requisite has been fulfilled or relieve the inventor from its obligations.⁶

§ 127. **Reduction to Practice must Demonstrate that the Idea of Means is Practically Useful.**

Moreover, the law demands, for the completion of the inventive act, that the art shall be so practised, or the article of manufacture be so tested, that its efficacy and utility are fully demonstrated. "Reduction to practice" means "reduction to successful practice."¹ Experiments in the direction of the desired result are not such reduction, no matter how nearly they approximate that end. The work of the inventor must be finished, physically as well as mentally. Nothing must be left for the inventive genius of the public; and his invention must show this for itself before he is entitled to a patent. If his invention be an art, he must not only have practised it according to its theory, but in the same manner which the public must employ in order to render it of use to them. If it be an article, it must appear,

⁶ That the granting of a patent does not prove reduction to practice, see *Hitchcock v. Tremaine* (1871), 8 Blatch. 440; 4 Fisher. 508; *Whitely v. Swayne* (1868), 7 Wall. 685.

That the granting of a patent, in which the invention is so clearly set forth by language and drawings, etc., that it shows itself to be practicable, is sufficient evidence of reduction to practice, see *Starr v. Farmer* (1883), 23 O. G. 2325, 2327.

See also *Wheeler v. Mower & Reaper Co.* (1872), 2 O. G. 442; 6 Fisher, 1; 10 Blatch. 181.

§ 127. ¹ That "reduction to practice" means successful practice, see *Lyman Ventilating & Refrigerator Co. v. Lalor* (1874), 12 Blatch. 303; 6 O. G. 642; 1 Bann. & A. 403; *Whitely v. Swayne* (1868), 7 Wall. 685; *Agawam Co. v. Jordan* (1868), 7 Wall. 583; *Cahoon v. Ring* (1859), 1 Clifford, 592; 1 Fisher, 397.

That an invention is operative if it can be made so by mere mechanical skill, see *Royer v. Coupe* (1886), 39 O. G. 239.

The doctrine of this and the preceding paragraph is similar to that involved in Prior Use, so far as the latter requires the prior existence of a practically operative invention identical with the one whose novelty is questioned on the ground of such prior use. As to what constitutes a complete invention, as distinguished from a mere description or representation of the inventor's theory on one hand and from an unsuccessful experiment on the other, the principles discussed and the cases cited are the same. As their legal significance is more apparent in the latter connection than in the present one, the authorities are collected principally under the title Prior Use, in §§ 318, 319, etc., *post*, which see for further references.

either upon its face or through the tests to which it is subjected, that it is able to accomplish the purpose for which it was designed.

§ 128. Reduction to Practice does not in all Cases Require the Practical Use of the Invention.

Whether the art or article must have been practically used for business purposes seems to have been disputed. Cases of eminent authority are found in which this is regarded as indispensable.¹ In other cases of equal value it has been decided that if evidently capable of practical application in the arts the invention need not have been actually employed.² These propositions may be both correct, each governing a distinct class of inventions. Where the availability of an invention for immediate use is apparent from an inspection of the invention itself, as often may be true of a machine or manufacture, its actual employment in the arts is not essential to the establishment of its utility and efficacy. And, on the other hand, when nothing less than such employment can afford this evidence, as in the case of an art or chemical composition, and sometimes of machines and manufactures, such tests must be applied as will determine that the end which it purports to serve can be accomplished.³ In either of these methods the object of the law will be attained; the invention itself manifesting that the inventive genius of the inventor

§ 128. ¹ That unless an invention is actually used for the purpose designed the reduction to practice is incomplete, and the whole remains in experiment, see *Cahoon v. Ring* (1859), 1 Clifford, 592; 1 Fisher, 397. See also 11 Am. Law Reg. n. s. 665.

² That if the invention be so far completed as to be capable of practical use, and this is apparent from the construction of the invention itself, no actual use in the arts is required, see *Broadnax v. Stock Yard & Transit Co.* (1880), 4 Fed. Rep. 214; 5 Bann. & A. 609; *Knox v. Loweree* (1874), 6 O. G. 802; 1 Bann. & A. 589; *Wheeler v. Clipper Mower & Reaper Co.* (1872), 10 Blatch.

181; 6 Fisher, 1; 2 O. G. 442; *Coffin v. Ogden* (1869), 7 Blatch. 61; 3 Fisher, 640; *Hayden v. Suffolk Mfg. Co.* (1862), 4 Fisher, 86; *Pitts v. Wemple* (1855), 2 Fisher, 10; 1 Bissell, 87.

³ That the invention must either be used or capable of useful operation, see *Moore v. Thomas* (1877), 3 Bann. & A. 13; 14 O. G. 1.

That successful practical use is evidence that the invention is complete, see *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.* (1874), 1 Bann. & A. 177; 6 O. G. 34; 10 Phila. 227; *Coffin v. Ogden* (1869), 7 Blatch. 61; 3 Fisher, 640.

has occupied the whole field of the invention, and that for its entire appropriation to the public use no further exercise of the creative faculties will be required.

§ 129. **Reduction to Practice does not Require Mechanical Perfection or Incapability of Improvement.**

But while this practical embodiment of the idea of the inventor must contain and represent his whole invention, it is not necessary that the art or article should be mechanically perfect.¹ Mechanical perfection is the achievement of the artisan rather than the inventor, and does nothing to develop or to illustrate the idea of the invention. Possibilities of greater excellence in shape, location, arrangement, material, or adjustment do not affect the fact that the inventor has produced a practically operative means, and all such possibilities are legally embraced in what the inventor already has accomplished. Nor is it necessary that the invention, as a means, should be incapable of further improvement by the exercise of additional inventive skill. If it accomplishes the end desired it is a perfected invention, although some newly generated idea, or some better mode of application, may reach

§ 129. ¹ In *Seymour v. Marsh* (1872), 2 O. G. 675, McKennan, J.: (876) "That a machine when first applied in practice does not perfectly accomplish the work for which it was designed, or does not accomplish all that its inventor supposed it would, is not enough to secure its rejection as a patentable invention. . . . Taken as a whole, in its construction and operation, if it is an advance upon the state of the art to which it appertains, furnishing a better though still imperfect method of performing a useful function than was before available, it is not to be discarded as destitute of patentable merit." 6 Fisher, 115 (120); 9 Phila. 380 (382).

In *The American Hide & Leather Splitting & Dressing Machine Co. v. The American Tool & Machine Co.* (1870), Holmes, 503, Shepley, J.: (513)

"A perfect machine, in that sense of the word 'perfect,' means a perfected invention; not a perfectly constructed machine, but a machine so constructed as to embody all the essential elements of the invention, in a form that would make them practical and operative so as to accomplish the result. But it is not necessary that it should accomplish that result in the most perfect manner and be in a condition where it was not susceptible of a higher degree of perfection in its mere mechanical construction." 4 Fisher, 284 (299).

See also *Dolbear v. American Bell Telephone Co.* (1888), 43 O. G. 377.

That if mechanical skill can remedy the defects in an invention the patent may be valid, see *Temple Pump Co. v. Goss Pump & Rubber Bucket Mfg. Co.* (1887), 39 O. G. 467.

the same end in a more perfect manner. It is enough that the inventor has devised a means, has put his thought into a practical and useful form, and placed it where the public can at once employ it.

§ 130. **Reduction to Practice does not Affect the Essence of the Invention, nor the Scope of the Patent Privilege.**

Finally, it is to be remembered that although an idea of means not yet reduced to practice is not an invention, still it is the idea, and not the practical embodiment, which constitutes the essence of the invention and to which the protection of the patent is awarded.¹ If an idea is capable of tangible

§ 130. ¹ In *American Bell Telephone Co. v. Dolbear* (1883), 15 Fed. Rep. 418, Gray, J.: (449) "There can be no patent for a mere principle. The discoverer of a natural force or a scientific fact cannot have a patent for that. But if he invents for the first time a process by which a certain effect of one of the forces of nature is made useful to mankind, and fully describes and claims that process, and also describes a mode or apparatus by which it may be usefully applied, he is, within the meaning and the very words of the patent law, 'a person who has invented or discovered any new and useful art;' and he is entitled to a patent for the process of which he is the first inventor, and is not restricted to the particular form of mechanism or apparatus by which he carries out that process. Another person, who afterwards invents an improved form of apparatus, embodying the same process, may indeed obtain a patent for his improvement, but he has no right to use the process, in his own or any other form of apparatus, without the consent of the first inventor of the process. . . . (453) If that art or process is . . . the only way by which [that effect of the natural force can be produced] that fact does not lessen the merit of his invention, or the protection which the law

will give to it." 23 O. G. 535 (535, 537).

In *Sewall v. Jones* (1875), 91 U. S. 171, Hunt, J.: (184) "When a party has invented some mode of carrying into effect a law of natural science or a rule of practice, it is the application of that law or rule which constitutes the peculiar feature of the invention. He is entitled to protect himself from all other modes of making the same application; and every question of infringement will present the question, whether the different mode, be it better or worse, is in substance an application of the same principle." 9 O. G. 47 (49).

In *Wintermute v. Redington* (1856), 1 Fisher, 239, Willson, J.: (250) "We have already stated that when a person has invented some mode of carrying into effect a law of natural science, or a rule of practice, which constitutes the peculiar feature of his invention, such discovery may be secured to him by a patent. Hence it follows that he is entitled to protect himself from all other modes of making the same application. The substantial *identity*, therefore, that is to be looked to, respects that which constitutes the essence of the invention, namely, *the application of the principle*. If the mode of carrying the same principle into effect, adopted by the defend-

expression under different forms, the difference in these forms is merely formal, not substantial; and the concrete inventions, however varied in appearance, or arrangement, or capacity, are nevertheless identical.² If the idea can be embodied in but

ant, still shows that the principle admits of the same application in a variety of forms, or by a variety of apparatus, the jury will be authorized to treat such mode as a piracy of the invention. But if the defendant has adopted variations which show that the application of the principle is varied, that some other law, or rule of practice or science, is made to take the place of that which the patentee claims as the essence of his invention, then there is no infringement."

See also discussion of same doctrine and citations in §§ 134-143, 161, etc., and notes, *post*.

² In *Jupe v. Pratt* (1837), 1 Web. 145, Alderson, B.: (146) "You cannot take out a patent for a principle; you may take out a patent for a principle coupled with the mode of carrying the principle into effect, provided you have not only discovered the principle, but invented some mode of carrying it into effect. But then you must start with having invented some mode of carrying the principle into effect; if you have done that, then you are entitled to protect yourself from all other modes of carrying the same principle into effect." 2 Abb. P. C. 464 (467). The entire argument of Sir F. Pollock and Richards in this case is valuable as drawing clear distinctions between the principle or spirit of an invention and its form or embodiment, and exhibiting the relation which each occupies toward the other. The following extracts are especially worthy of attention: (145) "The fair mode of looking at a patent and the specification is, to inquire what is the spirit of the invention, or the principle; and this must be embodied in some mode or method, because it is admitted

on all hands you cannot take out a patent for a principle. But although the law says, undoubtedly and correctly enough, that you cannot take out a patent for a principle, that is, for a barren principle, when you have clothed it with a form, and given it body and substance, in which the principle may live and produce the benefit which you claim to result from it, why then in many cases (and it is a consolation to every just and honest feeling one has on the subject of invention), although you cannot have a patent for a principle in substance, you can have a patent for the spirit of your invention; for if any other person comes and clothes the spirit of your invention with a different body, and puts that principle in use in any other shape or fashion, it is always a question for a jury, whether, however different in appearance, in shape, in form, in method — whether the article or the practice, if it be matter connected with the arts and manufactures, be or be not substantially an adaptation of the principle, applied with the same view, to answer the same end, and merely imitated in substance, whatever difference there may be in point of form." Again, (148) "However plain the principle may be, and however obvious when so given to the public, still the patentee must take care to lay it before the public in a practical shape, though he assumes to himself nothing in respect of that shape." Again, (148) "Is it to be said, if a man has discovered a principle, and goes to a mechanic and says — 'This is my view of an invention, just give me a little mechanical assistance in bringing that into effect;' and the man says, 'I think you might do it thus, and thus;' — is it

one art or article, no other art or article can be the application of the same idea, or constitute the same invention. In deciding conflicts between one invention and another, as well as in construing claims and specifications, the law draws this line of distinction very sharply; securing, in the one class of inventions, the original idea of means under whatever visible expression the subsequent development of the industrial arts may have led other persons to employ; confining, in the other class, the right of the inventor to the precise art or article in which his idea may have found its only practical embodiment.

**§ 131. Reduction to Practice Effected by Mechanical Skill:
Inventor may Employ Others for that Purpose.**

The act of reducing to practice may be performed either by the inventor himself or by others working under his direction. The idea of means, in which resides the essence of the invention, must be his own; but having conceived this, its practical embodiment must often, in the ordinary course of events, be left to those skilled in the art to which the means belongs.¹ The inventor has the right thus to employ "an adroit hand to carry into effect the conceptions of his own original head;" and during this proceeding he may avail

to be said that person, who had merely supplied, you might say, the tools or the materials, has a right to claim such invention?" 2 Abb. P. C. 464 (466, 470, 470).

§ 131. ¹ In *Blandy v. Griffith*, (1869), 3 Fisher, 609, Swayne, J. : (616) "Invention is the work of the brain, and not of the hands. If the conception be practically complete, the artisan who gives it reflex and embodiment in a machine is no more the inventor than the tools with which he wrought. Both are instruments in the hands of him who sets them in motion and prescribes the work to be done. Mere mechanical skill can never rise to the sphere of invention. The latter involves higher thought, and brings into activity a different faculty. Their domains are distinct. The line which separates them

is sometimes difficult to trace; nevertheless, in the eye of the law, it always subsists. The mechanic may greatly aid the inventor, but he cannot usurp his place. As long as the root of the original conception remains in its completeness, the outgrowth — whatever shape it may take — belongs to him with whom the conception originated."

Says Mr. Webster in a note: (1 Web. 126) "If a person be employed to perfect the details of or carry out into execution the original idea of the patentee, that which he suggests or invents while so employed, and subsidiary to such idea, is in law the invention of the patentee."

See also *Allen v. Rawson* (1845), 1 C. B. 551; *Minter v. Wells* (1834), 1 Web. 127; 2 Abb. P. C. 26; and §§ 393-395, *post*.

himself of any assistance or suggestions which do not change the essential character of the means he has created.

§ 132. Reduction to Practice fixes the Date of the Completion of the Inventive Act.

The date of the completion of the inventive act is thus the date when the idea of the inventor is embodied in a practically operative article or art. Up to that moment there is nothing which the law considers an invention, nothing of which either use or proprietorship can be predicated, or to which the protection of a patent can be extended.¹ For certain purposes, however, the law takes notice of the existence of the idea apart from its reduction to a physical form. Where there are rival claimants of the same invention, the one who first conceived the idea of means as now embodied in the invention is regarded as the first inventor, unless by his own negligence in reducing the idea to practice he has forfeited his right to such preferment; and, therefore, as between two, the first of whom has used due diligence, the date of the invention is the date of the conception of the complete idea.² When the inventor's previous knowledge of the invention is asserted on the ground of prior use or publication, the date of his inventive act is that of the development of his idea of means, not of its reduction to practical use.³ But when the legal novelty

§ 132. ¹ That the date of a patented invention is *prima facie* the date of the application for a patent, see *Dane v. Chicago Mfg. Co.* (1872), 3 Bissell, 380; 2 O. G. 677; 6 Fisher, 130.

That the actual date is that of reduction to practice, see §§ 126, 127 and notes, *ante*.

² That as between rival inventors the date is that of the complete conception of the idea of means, provided the inventor used due diligence in reducing to practice, see *Kneeland v. Sheriff* (1880), 5 Bann. & A. 482; 2 Fed. Rep. 901; 18 O. G. 242; *National Filtering Oil Co. v. Arctic Oil Co.* (1871), 8 Blatch. 416; 4 Fisher, 514; *Colt v. Massachusetts Arms Co.* (1851), 1 Fisher, 108. See also §§ 370-391, *post*.

³ That when the question is whether the inventor drew his information from prior use, prior patent, or prior publication, the date of his invention is the date when he first clearly conceived the idea of means, see *Woodman v. Stimpson* (1866), 3 Fisher, 98.

That the date when the inventor conceived his idea of means may be shown by his drawings, statements, or any other relevant evidence, see *Loom Co. v. Higgins* (1881), 105 U. S. 580; 21 O. G. 2031; *Kneeland v. Sheriff* (1880), 18 O. G. 242; 5 Bann. & A. 482; 2 Fed. Rep. 901; *Reeves v. Keystone Bridge Co.* (1872,) 1 O. G. 466; 9 Phila. 368; 5 Fisher, 456; *Philadelphia & Trenton R. R.*

of the invention is attacked on the ground of prior use in this country or a prior patent or publication, the date of reduction to practice is regarded as the *prima facie* date of the invention;⁴ although the inventor is still allowed to carry the date of his inventive act back to his conception of the idea of means in order to establish his own priority.

SECTION V.

OF THE NATURE OF THE COMPLETE RESULT OF THE INVENTIVE ACT.

§ 133. Concrete Invention an Art or Instrument: Not a Principle or Force, a Function, or an Effect.

From this analysis of the inventive act it is evident that its complete result must be either an art or an instrument. Every effect in the material world is produced by some force which, being applied through certain corporeal agents or in a certain method, accomplishes the end desired. The operative means is not the force alone, but the force acting through the specific agent, or in the specific manner; and the inventive faculties are exercised, not simply to supply the force, but also to devise the art or instrument by which the force can be directed to that end. A concrete invention is thus either a mode of practically applying force, or an instrument through which force is practically applied; and must, therefore, be distinguished alike from the principle or force which it employs, from the function which it performs, and from the effect which it produces.

§ 134. "Principle," a Term of Two Meanings.

No proposition has been more frequently or positively stated by the courts than that a principle is not a patentable inven-

Co. v. Stimpson (1840), 14 Peters, 448; Spring Co. v. Union Car Spring Mfg. Co. (1874), 6 O. G. 224; 12 Blatch. 2 Robb, 46.

⁴ That on the question of the legal novelty of an invention the date is that of reduction to practice, see National 80; Webb v. Quintard (1872), 1 O. G. 525; 9 Blatch. 352; 5 Fisher, 276; but see § 321 and note 1, *post*.

tion,¹ and yet with almost equal positiveness and frequency they have declared that the subject-matter covered by a patent is the principle of the invention.² This apparent contradic-

§ 134. ¹ In *American Bell Telephone Co. v. Dolbear* (1883), 15 Fed. Rep. 448, Gray, J.: (449) "There can be no patent for a mere principle. The discoverer of a natural force or a scientific fact cannot have a patent for that." 23 O. G. 535 (535).

In *McComb v. Brodie* (1872), 2 O. G. 117, Woods, J.: (119) "A patent cannot be granted for a principle or an idea, or for any abstraction whatever." 1 Woods, 153 (158); 5 Fisher, 384 (391).

In *Morton v. N. Y. Eye Infirmary* (1862), 5 Blatch. 116, Shipman, J.: (121) "In its naked, ordinary sense, a discovery is not patentable. A discovery of a new principle, force, or law, operating, or which can be made to operate, on matter, will not entitle the discoverer to a patent." 2 Fisher, 320 (323).

See also *Boyd v. Cherry* (1853), 4 McCrary, 70; *Roberts v. Dickey* (1872), 4 Fisher, 532; 1 O. G. 4; 4 Brews. 260; *Burr v. Duryee* (1863), 1 Wall. 531; *Tilghman v. Werk* (1862), 1 Bond, 511; 2 Fisher, 229; *Le Roy v. Tatham* (1859), 22 How. 132; *Bell v. Daniels* (1858), 1 Bond, 212; 1 Fisher, 372; *Wintermute v. Redington* (1856), 1 Fisher, 239; *Rich v. Lippincott* (1853), 2 Fisher, 1; *O'Reilly v. Morse* (1853), 15 How. 62; *Detmold v. Reeves* (1851), 1 Fisher, 127; *Smith v. Downing* (1850), 1 Fisher, 64; *Smith v. Ely* (1849), 5 McLean, 76; *Wyeth v. Stone* (1840), 1 Story, 273; 2 Robb, 23; *Stone v. Sprague* (1840), 1 Story, 270; 2 Robb, 10; *Whitney v. Emmett* (1831), Baldwin, 303; 1 Robb, 567; *Evans v. Eaton* (1816), 1 Peters C. C. 322; 1 Robb, 68; *Crossley v. Potter* (1853), Macrory's P. C. 240; *Househill Co. v. Neilson* (1843), 1 Web. 673;

Neilson v. Harford (1841), 1 Web. 331; *Jupe v. Pratt* (1837), 1 Web. 145; 2 Abb. P. C. 464; *Hornblower v. Boulton* (1799), 8 T. R. 95; 1 Abb. P. C. 98; *Boulton v. Bull* (1795), 2 H. Bl. 463; 1 Abb. P. C. 59.

That neither principles, nor abstract ideas, nor natural functions of matter, animate or inanimate, are patentable, see opinion Atty. Gen. (1856), 8 Op. At. Gen. 269.

² That the principle of the invention is the subject-matter of the patent, see *Knapp v. Joubert* (1881), 19 Blatch. 148; 7 Fed. Rep. 219; *Boston Elastic Fabrics Co. v. East Hampton Rubber Thread Co.* (1874), Holmes, 372; 5 O. G. 696; 1 Bann. & A. 222; *Seymour v. Marsh* (1872), 6 Fisher, 115; 9 Phila. 380; 2 O. G. 675; *McComb v. Brodie* (1872), 2 O. G. 117; 1 Woods, 153; 5 Fisher, 384; *Bailey Washing & Wringing Mach. Co. v. Lincoln* (1871), 4 Fisher, 379; *Blanchard v. Puttman* (1867), 2 Bond, 84; 3 Fisher, 186; *Stainthorp v. Humiston* (1864), 4 Fisher, 107; *Burr v. Duryee* (1863), 1 Wall. 531; *Smith v. Higgins* (1859), 1 Fisher, 537; *Cahoon v. Ring* (1859), 1 Fisher, 397; 1 Clifford, 592; *Latta v. Hawk* (1859), 1 Fisher, 465; 1 Bond, 259; *Foss v. Herbert* (1856), 1 Bissell, 121; 2 Fisher, 31; *Sickels v. Borden* (1856), 3 Blatch. 535; *Blanchard v. Beers* (1852), 2 Blatch. 411; *Parker v. Stiles* (1849), 5 McLean, 44; *Roberts v. Ward* (1849), 4 McLean, 565; 2 Robb, 746; *Brooks v. Jenkins* (1844), 3 McLean, 432; *Brooks v. Bicknell* (1843), 3 McLean, 250; 2 Robb, 118; *Smith v. Pearce* (1840), 2 McLean, 176; 2 Robb, 13; *Evans v. Eaton* (1822), 7 Wheaton, 356; 1 Robb, 336; *Barrett v. Hall* (1818), 1 Mason, 447; 1 Robb, 207; *Evans v. Eaton* (1818), 3 Wash.

tion has arisen from the use of the word "principle" to denote two entirely distinct entities, which have nothing in common except that both require corporeal expression in order to become serviceable in the arts. In the discussion of this common requisite, the word has sometimes been employed in its two different senses in the same connection, the peculiar attributes of one erroneously predicated also of the other, to the confusion of a subject which, in its fundamental truth, presents no special difficulty.³ In this, as in most other cases, to properly distinguish is to comprehend.

443 ; 1 Robb, 193 ; *Odiorne v. Winkley* (1814), 2 Gallison, 51 ; 1 Robb, 52 ; *Whittemore v. Cutter* (1813), 1 Gallison, 478 ; 1 Robb, 40.

³ In *Detmold v. Reeves* (1851), 1 Fisher, 127, Kane, J.: (130) "There is no doubt, that he who has discovered some new element or property of matter, may secure to himself the ownership of his discovery, so soon as he has been able to illustrate it practically, and to demonstrate its value. His patent, in such a case, will be commensurate with the principles, which it announces to the world, and may be so broad as the mental conception itself. But, then, the mental conception must have been susceptible of embodiment, and must have been, in fact, embodied in some mechanical device, or some process of art. The abstract must have been resolved into the concrete. The patent must be for a thing — not for an idea merely." This extract illustrates the method by which the real doctrine concerning a principle has been obscured by faulty language. The learned judge starts out with the idea of natural force, expressed in the terms "element" and "property of matter," and alleges that the discoverer of these can protect his discovery by a patent when he has practically illustrated it and demonstrated its value. This is, of course, untrue, no element or property of matter being under any circumstances patentable. In the sec-

ond sentence his ground changes, and the scope of the patent is declared to be commensurate with the "mental conception" of the inventor. Now the mental conception of the inventor cannot be the same thing as the element or property of matter which he has discovered, nor can it be synonymous with the act of discovery, which is transient and already past. Obviously the only mental conception of an inventor which can, as the third sentence requires, be embodied, is his idea of a means in which the element or property of matter can be applied to some physical object with a beneficial result. But when this embodiment has taken place, it is not the abstract element or property of matter that has now become concrete, but the abstract idea of its application to an object ; and this is the true and only principle protected by the patent.

Similar ambiguity occurs in the dissenting opinion of Judge Nelson in *Le Roy v. Tatham* (1852), 14 Howard, 156. Speaking of the patentability of a principle in the light of *Forsyth's Case* (1 Web. 94, 97, n.) he says: (185) "This case is founded upon a doctrine which has been recognized in several subsequent cases in England, namely, that where a person discovers a principle or property of nature, or where he conceives of a new application of a well-known principle or property of nature, and also, of some mode of carrying it out

§ 135. "Principle," in one sense, Means Force.

In one sense, the word "principle" denotes the physical force employed by an invention. The other appellations given to

into practice, so as to produce or attain a new and useful effect or result, he is entitled to protection against all other modes of carrying the same principle or property into practice for obtaining the same effect or result." Here that which is true only of a principle in the sense of the mental conception of the inventor, is predicated of the principle or force for whose useful employment the inventor has devised or adopted a means. Then citing Neilson's Case (1 Web. 310, 342, 371), hereafter discussed in a note to § 143, he proceeds: (186) "The settled doctrine to be deduced from them, I think, is, that a person having discovered the application for the first time of a well-known law of nature, or well-known property of matter, by means of which a new result in the arts or in manufactures is produced, and has pointed out a mode by which it is produced, is entitled to a patent; and, if he has not tied himself down in the specification to the particular mode described, he is entitled to be protected against all modes by which the same result is produced, by an application of the same law of nature or property of matter. And *a fortiori*, if he has discovered the law of nature or property of matter, and applied it, is he entitled to the patent, and aforesaid protection. And why should not this be the law? The original conception — the novel idea in the one case, is the new application of the principle or property of matter, and the new product in the arts or manufactures — in the other, in the discovery of the principle or property, and application, with like result. The mode or means are but incidental, and flowing naturally from the original conception; and hence of inconsiderable merit. But, it is said, this is patenting

a principle, or element of nature. The authorities to which I have referred, answer the objection. . . . And what if the principle is incorporated in the invention, and the inventor protected in the enjoyment for the fourteen years. He is protected only in the enjoyment of the application for the special purpose and object to which it has been newly applied by his genius and skill. For every other purpose and end, the principle is free for all mankind to use."

In considering the weight to be attached to the positions taken in this dissenting opinion, it is well to remember that there is one class of inventions to which the general doctrine here announced is truly applicable. Where the discovery relates to new susceptibilities in the object, and consists in the perception that it may be affected in a new way by the application to it of a force not hitherto known as capable of producing this effect upon it, the direction of such force upon this object is a new and substantive invention, and may be patented as a process, or mode of treatment of the object, without reference to the particular instruments employed. Of such an invention it could be truly said that one who had, for the first time, applied this force to this specific object might be protected against any other application of the same force to the same object in order to produce the same effect. It should also be remembered that the invention in the case at bar, as well as in the principal case cited by Judge Nelson, was apparently of this description. In *Le Roy v. Tatham*, the discovery had been made that lead possessed such properties that being subjected to certain forces certain results would follow; and hence it was true

this force are very numerous, and most of them are wholly inappropriate. It has been called "an elementary truth," "a principle of science," "a property of matter," "an element of matter," "a law of nature," the "root and ground of science;" but the idea which underlies these phrases is sufficiently apparent, and is neither less nor more than that of some natural power or energy, which operates with uniformity under given circumstances, and may thus be contemplated as obedient to law.¹ A principle, in this sense, is a necessary

that one, who had reduced this mode of treating lead to practice, was entitled to protection against all other methods of subjecting lead to the influence of the same force for the same purpose. In the Neilson patent the inventor had discovered that the charge in a smelting-furnace was susceptible to strong currents of hot air, and if so treated yielded peculiar results; and having put his discovery to practical use by proper apparatus he was entitled to regard all persons, who treated the same objects with currents of hot air for the same purpose, as infringing upon his invention. In the struggle of the judges, in both these cases, to support inventions which they saw to be meritorious and patentable, but whose real nature and scope were not then understood, on grounds applicable only to different classes of inventions, they were led into the use of language inappropriate to the discussion, and into the apparent declaration that when the novelty resides in the force or in the use of the force for a given purpose, all other uses of the force for the same purpose are covered by the patent; a declaration which is not correct unless the purpose is new, and can be accomplished only by applying to a certain object the force adopted and applied by the inventor. Conceding this to have been the doctrine they were endeavoring to elaborate, no criticism can be made upon the legal propositions stated. But the ambiguity of language resulting from

the varied use of the word "principle" only becomes more evident when it is seen that in the discussion of this class of inventions it cannot be employed at all, except in its second sense of an idea of means.

An additional example of the confusion introduced into this subject by the equivocal use of the word "principle" may be found in the discussion between the court and counsel in *Neilson v. Harford*, 1 Web. 342, 343, and notes; where Alderson, B., uses the term to denote the force employed, and Sir F. Pollock employs it to describe the idea of means or spirit of the invention. The reader will never wonder at the difficulties which have arisen in so simple a subject, after examining this discussion, and remembering that neither the judge nor the lawyer were engaged in a mere contest of words, but were honestly endeavoring to understand each other.

§ 135. ¹ Of the numerous phrases used assynonymous with "principle" in the sense of a physical force, those cited in the text may serve as fair examples. The real meaning intended is generally indicated by the explanations and illustrations given by the judges. Thus in *Barrett v. Hall* (1818), 1 Mason, 447, Story, J., having stated that the word "principle" is sometimes used to denote an "elementary truth or power," continues: (470) "So that [in that sense] all machines, which perform their appropriate functions by motion, in whatever

factor in every means which produces physical effects, whether such means be natural or artificial, and it is generally this which makes the chief impression on the senses of the observer; but it is in itself no true invention, nor can it be protected by a patent. And this for the three following reasons: —

§ 136. "Principle," as a Force, not the Result of Inventive Skill.

Firstly, a principle, considered as a natural physical force, is not the product of inventive skill. It exists in nature independently of human effort, and can neither be diminished nor increased by human power. Man can discover and employ it, but his employment of it in the modes or through the instruments by which it is applied in nature are mere imitations of what every man is able to perceive and reproduce as well as he. Not until some new instrument or method is

way produced, are alike in principle since motion is the element employed." In *Le Roy v. Tatham* (1852), 14 How. 156, McLean, J., after remarking that want of precision in the use of this term has led to much confusion, says: (175) "A principle . . . is a fundamental truth; an original cause; a motive;" and exemplifies the non-patentability of principles by reference to steam-power and electricity as principles. In *O'Reilly v. Morse* (1853), 15 How. 62, Grier, J., uses the phrase, (132) "element, or law, or principle of nature," as conveying the idea of some electrical, mechanical, or chemical force. A writer on this subject in 7 *Am. Law Reg. n. s.* 129 (1868), employs as synonymous the names "law of nature," "property of matter," and "mathematical principle." In the earlier English cases the same meaning is apparent, though the expressions used in defining a principle were somewhat more extraordinary. Thus in *Boulton v. Bull* (1795), 2 H. Bl. 463, Buller, J., describes it as "the first ground and rule for arts and sciences, or in other

words the elements and rudiments of them." What this means he indicates by saying: "A patent must be for some new production from those elements, and not for the elements themselves . . . all machines which are worked by steam are worked on the same principle." In the same case *Rooke, J.*: "The term principle . . . may denote either the radical elementary truths of a science, or those consequential axioms which are founded on radical truths. . . . The radical principles, on which all steam-engines are founded, are the natural properties of steam, its expansiveness and condensibility." 1 *Abb. P. C.* 59 (80, etc.). These citations are sufficient to show that what is thus variously called a "truth," a "principle," a "law," an "axiom," a "ground and rule," etc., is really a natural force or energy manifesting itself through the properties of matter, and operating to produce physical effects.

That an invention is an application of principles or elementary powers, see *Holden v. Curtis* (1819), 2 N. H. 61.

contrived for its direction toward ends which it cannot naturally accomplish, does his creative genius manifest itself; but even these new instruments and methods effect no change within the force itself, nor do they render it in any manner the result of his inventive act.

§ 137. "Principle," as a Force, the Common Property of Mankind.

Secondly, a principle, considered as a natural physical force, is the common property of all mankind. It lacks the one essential attribute of private property, — the capability of exclusive appropriation by an individual to his own use.¹ In its degree, in its location, in the times and methods of its manifestations, it is wholly beyond his control. He must take it as he finds it, and having studied its phenomena and ascertained its laws, he must accommodate himself to its requirements, and be content with such advantages as he is thus enabled to secure. But all endeavors to confine it to himself are at once futile and unjust. It exists for all men, as well after his discovery as before; and if their artificial methods of employing it are unlike his, their use takes from

§ 137. ¹ In *Le Roy v. Tatham* (1852), 14 How. 156, McLean, J. : (175) "A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right. Nor can an exclusive right exist to a new power, should one be discovered in addition to those already known. Through the agency of machinery a new steam power may be said to have been generated. But no one can appropriate this power exclusively to himself, under the patent laws. The same may be said of electricity, and of any other power in nature, which is alike open to all, and may be applied to useful purposes by the use of machinery."

In *Detmold v. Reeves* (1851), 1 Fisher, 127, Kane, J. : (131) "The more comprehensive truths of all philosophy, whatever specific name we give

to them, cannot be specially appropriated by any one. They are almost elements of our being. We have not reasoned them out, perhaps, and may be even unconscious of their action; yet they are about us, and within us, entering into and influencing our habitual thoughts, and pursuits, and modes of life — contributing to our safety and happiness. And they belong to us as effectively as any of the gifts of Heaven. If we could search the laws of nature, they would be, like water and the air, the common property of mankind; and those theories of the learned which we dignify with this title, partake, just so far as they are true, of the same universally diffused ownership. It is their application to practical use, which brings them within the domain of individuals; and it is the novelty of such an application that constitutes it the proper subject of a patent."

him nothing which he can in any manner call his own. The law necessarily recognizes and protects this universal right. It does not suffer any man to debar others from the use of that which nature has bestowed on all, simply because he was the first one to discover it. Nor even when he has, by his inventive skill, devised a new mode of applying it to the attainment of a certain end, does the protection of the law extend beyond the scope of his invention, or prohibit the employment of the same force by others for the same purpose, provided their artificial instruments and methods are not identical with his.

§ 138. "Principle," as a Force, not an Operative Means.

Thirdly, a principle, considered as a natural physical force, is not a complete and operative means.¹ Before it can pro-

§ 138. ¹ In *Morton v. N. Y. Eye Infirmary* (1862), 5 Blatch. 116, Shipman, J. : (121) "In its naked, ordinary sense, a discovery is not patentable. . . . It is only where the explorer has gone beyond the mere domain of discovery, and has laid hold of the new principle, force, or law, and connected it with some particular medium or mechanical contrivance, by which, or through which, it acts on the material world, that he can secure the exclusive control of it under the Patent Act. He then controls his discovery through the means by which he has brought it into practical action, or their equivalent, and only through them. It is then an invention, although it embraces a discovery." 2 Fisher, 320 (323). This is another instance of defective phraseology. Is the principle here spoken of a natural force, or the spirit of the invention, i. e., the idea of means? If it be the former, the patentee does *not* "secure the exclusive control of it under the Patent Act." If it be the latter, why is it treated as a *force* to be discovered? True, each is an abstraction, and must be connected with "some particular

medium or mechanical contrivance" before it can come within the scope of patentable inventions, either as a new idea of means or a subordinate element in a new idea of means; but this common attribute does not make them identical in nature nor bring them into the same relation with the complete invention or with the patent by which it is protected.

In *Wintermute v. Redington* (1856), 1 Fisher, 239, Willson, J. : (247) "It is true that a patent cannot be sustained for a mere principle. For instance, Sir Isaac Newton's discovery of the principle of gravitation could not be the subject of a patent. But it is equally true, that a principle may be embodied and applied, so as to afford some result of practical utility in the arts and manufactures, and that under such circumstances a principle may be the subject of a patent." In this opinion, the judge subsequently explains that by "principle," in this last sentence, he does not mean a force or property of matter, but the mode devised by the inventor for applying the force or property.

In *O'Reilly v. Morse* (1853), 15 How.

duce effects it must be brought in contact with its object, either through some substance which thereby becomes its instrument, or through some mode of operation in which its object is subjected to its influence. Until this is accomplished, although the force is material in itself, it remains in reference to its object practically a mere abstraction, and is of no more value to mankind, and has no higher right to the protection of a patent, than any other unapplied idea.

§ 139. "Principle," in the other sense, Signifies the Idea of Means.

In its second sense, the word "principle" denotes the spirit of the invention, that characteristic thought which is embodied in the operative means devised by the inventor. In reference to a machine, it is defined as its "*modus operandi*," its "structure and constituent parts;" in reference to all inventions, as "the mode of applying powers to produce results," the "operative cause by which a certain result is produced," "the manner of producing the effect."¹ All

62, Grier, J. : (132) "The mere discovery of a new element, or law, or principle of nature, without any valuable application of it to the arts, is not the subject of a patent. But he who takes this new element or power, as yet useless, from the laboratory of the philosopher, and makes it the servant of man; who applies it to the perfecting of a new and useful art, or to the improvement of one already known, is the benefactor to whom the patent law tenders its protection."

That the capacity of a chemical agent to produce a result is not an invention, see opinion Atty. Gen. (1856), 8 Op. At. Gen. 269.

That a patent cannot be granted for the discovery that certain natural substances will produce certain effects on the human body, see opinion Atty. Gen. (1856), 8 Op. At. Gen. 269.

That the production of insensibility, or suggestions of the ability to perform surgical operations while the patient is

insensible, are not patentable, see opinion Atty. Gen. (1856), 8 Op. At. Gen. 269.

That a medicament, whose administration must depend on professional skill, is not patentable, see opinion Atty. Gen. (1856), 8 Op. At. Gen. 269.

§ 139. ¹ For cases where the word "principle" is used in reference to a machine as synonymous with "*modus operandi*," or "mode of operation," see *Latta v. Shawk* (1859), 1 Fisher, 465; 1 Bond, 259; *Smith v. Pearce* (1840), 2 McLean, 176; 2 Robb, 13; *Whittemore v. Cutter* (1813), 1 Gallison, 478; 1 Robb, 40: as synonymous with "structure and constituent parts," see *Barrett v. Hall* (1818), 1 Mason, 447; 1 Robb, 207: as synonymous with "the mode of applying powers to produce results," see *Smith v. Pearce* (1840), 2 McLean, 176; 2 Robb, 13: as synonymous with "the operative cause by which a certain effect is produced," see *Brooks v. Jenkins* (1844), 3 McLean, 432: as synon-

these phrases evidently refer to the idea of means, the intellectual essence of that artificial method by which the inventor has applied, to some determinate end, the natural force described by the word "principle," as employed in its more general signification.² A principle, in this sense, thus differs *toto cælo*

ymous with "the mode of effecting a result," see *Pitts v. Wemple* (1855), 2 Fisher, 10; 1 Bissell, 87: as synonymous with "the spirit or substance of the invention," see *Lund*, 7.

² Concurrently with all the involved and perplexing discussions concerning the status of a principle before the law, such explanations have been given, both from the bench and bar, of the true distinction between these two senses of the term "principle," as ought long ago to have removed all difficulties from the subject, and have placed this second meaning of the word in the clearest light as expressing the very essence of every patentable invention. In *Boulton v. Bull* (1795), 2 H. Bl. 463, a case pregnant with mischief, on account of the loose and almost meaningless language used by some of the judges, Lord Chief Justice Eyre remarked: (495) "Undoubtedly there can be no patent for a mere principle; but for a principle so far embodied and connected with corporeal substances, as to be in a condition to act, and to produce effects in any art, trade, mystery, or manual occupation, I think there may be a patent. Now this is, in my judgment, the thing for which the patent stated in the case was granted, and this is what the specification describes, though it miscalls it a principle. It is not that the patentee has conceived an abstract notion, that the consumption of steam in fire-engines may be lessened, but he has discovered a practical manner of doing it; and for that practical manner of doing it he has taken this patent. Surely this is a very different thing from taking a patent for a principle." 1 Abb. P. C. 59 (91). Thus, at a very early

period, this sagacious and learned judge had perceived that the real thing protected by a patent was the method conceived by the inventor and reduced to practice; that it was not the force employed, on the one hand, nor the mere corporeal substance through which the idea of the inventor was expressed upon the other; but embraced the principle or abstract essence of the invention in whatever form it might be embodied.

Again, in the argument of counsel in the case of *Jupe v. Pratt* (1837), 1 Web. 145, the following remarks occur: (145) "The fair mode of looking at a patent and the specification is, to inquire what is the spirit of the invention, or the principle; and this must be embodied in some mode or method, because it is admitted on all hands you cannot take out a patent for a principle. But although the law says . . . that you cannot take out a patent for a principle, . . . you can have a patent for the spirit of your invention; for if any other person comes and clothes the spirit of your invention with a different body, and puts that principle in use in any other shape or fashion, it is always a question for a jury, whether . . . the article or the practice . . . be not substantially an adaptation of the principle, applied with the same view, to answer the same end, and merely imitated in substance, whatever difference there may be in point of form." 2 Abb. P. C. 464 (466).

In this country Judge Willson, in *Wintermute v. Redington* (1856), 1 Fisher, 239, after asserting the non-patentability of a property of matter, and the patentability of an embodied principle

from a principle considered as a force. The latter is the operative energy; the former is the means in which the latter operates. One is created by the author of the universe; the other owes its origin to human ingenuity. One belongs equally to all mankind; the other is the exclusive property of him who has devised it, until it pleases him to give it to the world.

§ 140. "Principle," as an Idea of Means, not an Operative Means.

The principle or essence of an invention, however, when taken by itself, is no more patentable than the principle or force which it proposes to employ.¹ Like that, it is but an abstraction, resting in theory alone, and not an operative means. Until reduced to practice it is not a complete invention, nor does it stand on any higher ground of legal merit than the discovery of an existing natural power. It must become "a principle, put in practice and applied," a "practice

continues: (247) "It is, however, *the embodiment and the application of the principle which constitute the grant of the patent.* And it has been justly said 'that the principle so embodied and applied, and the principle of *such* embodiment and application, are essentially distinct; the former being a truth of exact science, or a law of natural science, or a rule of practice; the latter, a practice founded upon such truth, law, or rule.'"

Many of the cases arising on machine-patents also discuss this same proposition, uniformly holding that the subject-matter of the patent is the principle, or idea of means, embodied in the machine, and that no change in the embodiment, as distinguished from the principle, can affect the identity of the invention.

See §§ 178, 179, and notes, *post*.

§ 140. ¹ In *Andrews v. Carman* (1876), 9 O. G. 1011, Benedict, J.: (1013) "There can be no patent for a principle; but 'for a principle so far embodied and connected with corporeal substances as to be in a condition to act and to pro-

duce effects in any trade, mystery, or manual occupation there may be a patent.' The idea or principle of forcing water from the earth into a well-pit by the use of artificial power is new, but is not by itself patentable. The idea, when made available by a method whereby it is put to practical use, is patentable as a process, and is thus secured to the person who has conceived the idea and invented the method." 13 Blatch. 307 (312); 2 Bann. & A. 277 (281).

In *McComb v. Brodie* (1872), 2 O. G. 117, Woods, J.: (119) "A patent cannot be granted for a principle or an idea, or for any abstraction whatever; for instance, for the naked idea of a slit, slot, or aperture, disconnected from any application. But when the idea is applied to a material thing, so as to produce a new and useful effect or result, it ceases to be abstract, and becomes a proper subject to be covered by a patent." 1 Woods, 153 (158); 5 Fisher, 384 (391).

See also cases cited under Reduction to Practice, §§ 125-130, *ante*.

founded on principle," before it passes from the shadowy regions of mere intellectual apprehension into the domain of the industrial arts.²

§ 141. "Principle," as an Idea of Means, the Essence of the Concrete Invention.

Yet when once embodied in an operative means, this principle is the true subject-matter of the patented invention. Whatever forms of tangible expression it receives through the varied skill and industry of the mechanic, this idea and essence still remain unchanged. The exclusive right of the inventor is co-extensive with the limits of the original conception, and though its spirit may be clothed with many different bodies the individuality of the invention is not disturbed nor its identity destroyed.¹ One who has thus devised a principle,

² In *Boulton v. Bull* (1795), 2 H. Bl. 463, Buller, J.: (486) "I think it impossible to support a patent for a method only, without having carried it into effect and produced some new substance. But here it is necessary to enquire, what is meant by a principle reduced into practice. It can only mean a practice founded on principle, and that practice is the thing done or made." 1 Abb. P. C. 59 (81).

That an abstract principle or idea is not patentable, see *Worswick Mfg. Co. v. City of Buffalo* (1884), 20 Fed. Rep. 126; 27 O. G. 1239.

That a principle is not patentable except in connection with a mode of application, see *Burke v. Partridge* (1878), 58 N. H. 349.

§ 141. ¹ In *American Bell Telephone Co. v. Dolbear* (1883), 15 Fed. Rep. 448, Gray, J.: (449) "There can be no patent for a mere principle. The discoverer of a natural force or a scientific fact cannot have a patent for that. But if he invents for the first time a process by which a certain effect of one of the forces of nature is made useful to mankind, and fully describes and claims

that process, and also describes a mode or apparatus by which it may be usefully applied, he is, within the meaning and the very words of the patent law, 'a person who has invented or discovered any new and useful art;' and he is entitled to a patent for the process of which he is the first inventor, and is not restricted to the particular form of mechanism or apparatus by which he carries out that process. Another person, who afterwards invents an improved form of apparatus, embodying the same process, may indeed obtain a patent for his improvement, but he has no right to use the process, in his own or any other form of apparatus, without the consent of the first inventor of the process. . . . (453) If that art or process is the only way by which [that effect of the natural force can be produced] that fact does not lessen the merit of his invention, or the protection which the law will give to it." 23 O. G. 535 (535).

See also cases cited under § 130, *ante*.

In a brief, but able, discussion of this subject, in 7 Am. Law Reg. N. S. 129 (1868), after considering the leading

or mode of operation, in which a force is applied to the production of a given result, becomes thereby the inventor, not merely of the instrument he uses or the method he describes, but of all other instruments and methods embodying the same principle or mode of operation, however different in form or structure or arrangement such instruments or methods may appear.

§ 142. "Application of Principle" a phrase of Two Meanings.

This subject is still more confused by the use of the word "application," and of the phrase "application of a principle," in different significations. "Application," as predicated of a principle when considered as a force, is the specific artificial method in which that force is directed to the accomplishment of a given result. In other words, it is the idea of means, the principle of the invention in which the force is actually employed. In this sense, the "application of the principle" is the essence of the invention, the entire subject-matter of the patent, and any other application of the same principle or force, even for the same purpose, is a different invention. But "application," as predicated of a principle when considered as the spirit of an invention, is the embodiment of that spirit in some instrument or operation, or in other words, it is reduction to practice. In this sense, the "application of the principle" is not the essence of the invention nor the en-

American and English cases, the writer reaches the following conclusions: (143)

"1. Every discoverer of a new and useful application of any law of nature, any quality of matter, or any mathematical principle, is entitled to a patent for it [i. e. for the new application].

"2. It is not necessary to entitle him to a patent, that he should have been the first to search out and make known the law, quality, or principle which he has thus applied. And his having been the first to bring it to light adds nothing to his claims.

"3. He will be protected in his right by holding as infringements of his patent all mechanical equivalents for the de-

vices for carrying his discovery into effect, which he has described and designated in his specification as his invention. And he can have no other protection, even though the principle he has applied was first discovered by him.

"4. No one can legally specify as his invention, and take out a patent for the exclusive use of any such law, quality, or principle when employed for the same purpose as his. No instance can be found where any such patent has been sustained, and they have been repeatedly pronounced invalid by the courts."

tire subject-matter of the patent. Here the essence of the invention and the subject-matter of the patent is the principle itself, and every other application of this principle, whatever be its purpose, belongs to the original inventor of the principle and can neither be used nor patented by others.

§ 143. Propositions Embracing these Phrases and Terms Interpreted.

When, therefore, courts lay down the doctrine that a principle cannot be patented, the proposition which they undertake to state is either that a natural force cannot be appropriated for any purpose to the exclusive use of any one, not even of its discoverer, or that an idea of means is not entitled to a patent until it is embodied in a practical and useful form. When they declare that a patent for the application of a principle covers only that specific mode of application, they refer solely to the application of a natural force in some peculiar manner in an artificial means.¹ When they assert that one who has discovered and applied a prin-

§ 143. ¹ In *Steam Gauge & Lantern Co. v. St. Louis Railway Supplies Mfg. Co.* (1885), 25 Fed. Rep. 491, Treat, J.: (492) "The party supposes he has discovered a principle, and he thinks that any sort of device which covers that principle is within the terms of his patent. This court does not admit that. It is the device by which he may avail himself of the beneficial influence of his principle, and this court always restricts a party to his device. I think that is the meaning of all the rulings of the Supreme Court."

In *Sewall v. Jones* (1875), 91 U. S. 171, Hunt, J. : (184) "When a party has invented some mode of carrying into effect a law of natural science or a rule of practice, it is the application of that law or rule which constitutes the peculiar feature of the invention. He is entitled to protect himself from all other modes of making the same application." 9 O. G. 47 (49).

In *Wintermute v. Redington* (1856), 1 Fisher, 239, Willson, J. : (250) "We have already stated that when a person has invented some mode of carrying into effect a law of natural science, or a rule of practice, which constitutes the peculiar feature of his invention, such discovery may be secured to him by a patent. Hence it follows that he is entitled to protect himself from all other modes of making the same application. The substantial *identity*, therefore, that is to be looked to, respects that which constitutes the essence of the invention, namely, *the application of the principle*. If the mode of carrying the same principle into effect, adopted by the defendant, still shows that the principle admits of the same application in a variety of forms, or by a variety of apparatus, the jury will be authorized to treat such mode as a piracy of the invention."

principle is entitled to all methods of applying it, they speak of an idea of means, capable of being applied or reduced to practice in different instruments or operations, each of which is the tangible embodiment of the same idea, and all of which are only formal variations of the same substantial means.²

² One of the leading cases in which the patentability of a principle has been discussed, and the doctrine announced that a patent for the application of a principle covers all modes of applying it, is *Househill Co. v. Neilson* (1843), 1 Web. 673. As this case has been cited, criticised, and explored for additional light in almost every subsequent cause involving the same propositions, it deserves more than a passing reference. Before Neilson's invention only cold air had been employed for the blast in iron and similar furnaces. He discovered that to blow with hot air was better than to blow with cold. His method consisted in blowing the air through a heated receptacle into the furnace. In his specification he declared that the materials, size, &c., of the receptacle, as well as the mode of heating it, were immaterial, provided the air were heated between the bellows and the furnace. Practically, no other method of blowing with hot air is possible, and as a consequence his mode of heating the air covered all applications of hot air in blast. An analysis of this invention leads to the following results: (1) That a strong current of hot air directed into the furnace will produce certain effects upon the substances contained in the furnace is a fact in nature, open to discovery and use by all men; (2) By the discovery of this fact, Neilson invented nothing; the forces and susceptibilities discovered remained abstract and unapplied; (3) When he devised a method of producing such a current by blowing the air through a heated receptacle into the furnace his idea of means became complete; the three subordinate ideas of force, object,

and mode of application were united into one idea and needed only practical embodiment to become an operative means; (4) He reduced this idea to practice by actually blowing the air through the heated receptacle into the furnace, and was, therefore, entitled to a patent for the process he had invented, whether the receptacle, the bellows, or other apparatus he employed were new or old.

Now three different views may be taken of the character of this inventive act, depending on which of the three subordinate ideas were evolved by its exercise. If the inventive act were directed toward the force said to be discovered in the heated air, the invention was a process of treating substances with air heated while in blast, and the character of the instruments used or the objects treated was immaterial, provided the force discovered were applied and effective. If the mode of application were the discovery, then the arrangement of bellows, receptacle, and furnace for that purpose was the invention, and any other arrangement by which hot air could be blown into the furnace would be a different invention. If the inventive act related to the object — the materials in the furnace — and consisted in discovering their susceptibility to a hot blast, and in applying to them a current of hot air, then the process of treating these materials with hot air was the invention, and any other application of a current of hot air to these materials, by any method or by any apparatus, would be covered by his patent. The two former views were both taken during the discussion and decision of the case. Those who adhered to the second view argued that

§ 144. "Function" Defined.

The distinction between a practically operative means and the function it performs is somewhat more obscure. When-

the specification was defective because it did not specifically describe the apparatus claimed to be invented. Those who adopted the first view regarded this as of less consequence, since the invention was a process of blowing with hot air, and as a general form of apparatus for that purpose was pointed out that was sufficient reduction to practice to warrant the issue of a patent. The court accepted this view, holding that the specification was sufficient, that the principle of the invention consisted in the use of air heated while in blast, and that all modes of embodying this principle, or idea of means, were covered by the patent. This is the view taken of the invention by text-writers and judges in more recent cases. See Curtis, § 133; *O'Reilly v. Morse* (1853), 15 How. 62; *Le Roy v. Tatham* (1852), 14 How. 156, &c.

But is not the third view more nearly in accordance with the truth, and more commensurate with the real merit of the inventor? Did his discovery relate to the properties of hot air in motion? Did he not rather discover the susceptibility of the materials contained in the furnace to the action of a strong current of heated air? And having discovered this did not his real invention consist in treating these materials with hot air instead of cold, and thus include every manner in which the hot air could be brought in contact with this new object? If his method of heating the air had been previously employed, as, for instance, to warm buildings or dry clothes, would the merit or originality or patentability of his invention have been any less; and was he not entitled to consider this part of the invention as a mere form of embodiment and claim protection for the process of subjecting the materials in the furnace to the action of a hot blast,

in whatever manner the hot blast could be practically applied? I throw out this suggestion because not only in this case but in many others doubt has arisen in my mind whether by failing to recognize that discovery may relate to the object as well as the agent, and that the inventive act may consist in bringing a new object into relation with old forces as well as in bringing new forces into relation with old objects, much of the real merit of the invention has been lost sight of, and the rules of law have been incorrectly applied.

To return, however, to the case as it was regarded by the court, viz., as a process of blowing with hot air, in which the form and arrangement of the apparatus is of no consequence, provided the process can be carried out through them, the following extract from the decision, if carefully followed, will be found to contain an accurate and instructive dissertation on the relation of a principle to an invention. Hope, J., says: (683) "It is quite true that a patent cannot be taken out solely for an abstract philosophical principle — for instance, for any law of nature, or any property of matter, apart from any mode of turning it to account in the practical operations of manufacture, or the business, and arts, and utilities of life. The mere discovery of such a principle is not an invention, in the patent law sense of the term. Stating such a principle in a patent may be a promulgation of the principle, but it is no application of the principle to any practical purpose. And without that application of the principle to a practical object and end, and without the application of it to human industry, or to the purposes of human enjoyment, a person cannot in the abstract appropriate a principle to him-

ever any means, whether it be an instrument or operation, is employed for the attainment of an end, three facts become

self. But a patent will be good, though the subject of the patent consists in the discovery of a great, general, and most comprehensive principle in science or law of nature, if that principle is by the specification applied to any special purpose, so as thereby to effectuate a practical result and benefit not previously attained. The main merit, the most important part of the invention, may consist in the conception of the original idea — in the discovery of the principle in science, or of the law of nature, stated in the patent, and little or no pains may have been taken in working out the best manner and mode of the application of the principle to the purpose set forth in the patent. But still, if the principle is stated to be applicable to any special purpose, so as to produce any result previously unknown, in the way and for the objects described, the patent is good. It is no longer an abstract principle. It comes to be a principle turned to account, to a practical object, and applied to a special result. It becomes, then, not an abstract principle, which means a principle considered apart from any special purpose or practical operation, but the discovery and statement of a principle for a special purpose, that is, a practical invention, a mode of carrying a principle into effect. That such is the law, if a well-known principle is applied for the first time to produce a practical result for a special purpose, has never been disputed. It would be very strange and unjust to refuse the same legal effect, when the inventor has the additional merit of discovering the principle as well as its application to a practical object. The instant that the principle, although discovered for the first time, is stated, in actual application to, and as the agent of, producing a certain specified effect, it is no longer

an abstract principle, it is then clothed with the language of practical application, and receives the impress of tangible direction to the actual business of human life. . . . (684) Is it, I next inquire, an objection to the patent, that, in its application of a new principle to a certain specified result, it includes every variety of mode of applying the principle according to the general statement of the object and benefit to be attained? You will observe that the greater part of the defender's case is truly directed to this objection. This is a question of law, and I must tell you distinctly, that this generality of claim, that is, for all modes of applying the principle to the purpose specified, according to or within a general statement of the object to be attained, and of the use to be made of the agent to be so applied, is no objection whatever to the patent. That the application or use of the agent for the purpose specified, may be carried out in a great variety of ways, only shows the beauty, and simplicity, and comprehensiveness of the invention. But the scientific and general utility of the proposed application of the principle, if directed to a specified purpose, is not an objection to its becoming the subject of a patent. That the proposed application may be very generally adopted in a great variety of ways, is the merit of the invention, not a legal objection to the patent. The defenders say — you announce a principle, that hot air will produce heat in the furnace; you direct us to take the blast without interrupting or rather without stopping it, to take the current in blast, to heat it after it leaves the blast, and to throw it hot into the furnace. But you tell us no more — you do not tell us how we are to heat it. You say — you may heat in any way, in any sort of form of vessel.

apparent: (1) the means employed; (2) the effect produced; and (3) the action of the means upon the object while pro-

You say — I leave you to do it how you best can. But my application of the discovered principle is, that if you heat the air, and heat it after it leaves the blowing engine (for it is plain you cannot do it before), you attain the result I state; that is the purpose to which I apply the principle. The benefit will be greater or less. I only say, benefit you will get, I have disclosed the principle; I so apply it to a specified purpose by a mechanical contrivance, viz., by getting the heat when in blast, after it leaves the furnace; but the mode and manner, and extent of heating, I leave to you, and the degree of benefit, on that very account, I do not state. The defenders say, the patent, on this account, is bad in law. I must tell you, that taking the patent to be of this general character, it is good in law. I state to you the law to be, that you may obtain a patent for a mode of carrying a principle into effect; and if you suggest and discover, not only the principle, but suggest and invent how it may be applied to a practical result by mechanical contrivance and apparatus, and show that you are aware that no particular sort or modification, or form of the apparatus, is essential, in order to obtain benefit from the principle, then you may take your patent for the mode of carrying it into effect, and are not under the necessity of describing and confining yourself to one form of apparatus. If that were necessary, you see, what would be the result? Why, that a patent could hardly ever be obtained for any mode of carrying a newly discovered principle into practical results, though the most valuable of all discoveries. For the best form and shape or modification of apparatus, cannot in matters of such vast range, and requiring observation on such a great scale,

be attained at once; and so the thing would become known, and so the right lost, long before all the various kinds of apparatus could be tried. Hence, you may generally claim the mode of carrying the principle into effect by mechanical contrivance, so that any sort of apparatus applied in the way stated will, more or less, produce the benefit, and you are not tied down to any form. The best illustration I can give you, and I think it right to give you this illustration, is from a case as to the application of that familiar principle the lever to the construction of chairs, or what is called the self-adjusting lever. (Minter's patent. 1 Web. 126, 134.) This case, which afterwards came under the consideration of the whole court, was tried in the court of Exchequer during the presidency of Lord Lyndhurst. The case was as to the patent reclining chair, the luxury of which some of you may have tried; it had a self-adjusting lever, so that a person sitting or reclining, . . . in whatever situation he placed his back, there was sufficient resistance offered through means of the lever, to preserve the equilibrium. Now anything more general than that, I cannot conceive; it was the application of a well-known principle, but for the first time applied to a chair. He made no claim to any particular parts of the chair, nor did he prescribe any precise mode in which they should be made; [he did describe modes in which they *might* be made. R.], but what he claimed was a self-adjusting lever to be applied to the back of a chair, where the weight of the seat acts as a counterpoise to the back, in whatever posture the party might be sitting or reclining. Nothing could be more general. Well, a verdict passed for the patentee, with liberty to have it set aside; but Lord Lyndhurst

ducing the effect. The latter is the function of the means. It is the action of the means considered, not with reference

and the rest of the court held, that this was not a claim to a principle, but to the construction of a chair on this principle, in whatever shape or form it may be constructed. Just so as to the hot blast, only the principle is also new. The patentee says, 'I find hot air will increase the heat in the furnace, that a blast of hot air is beneficial for that end.' Here is the way to attain it -- 'heat the air under blast, between the blowing apparatus and the furnace; if you do that, I care not how you may propose to do it -- I neither propose to you, nor claim, any special mode of doing it; you may give the air more or less degrees of heat; but if you so heat it, you will get by that contrivance the benefit I have invented and disclosed, more or less, according to the degree of heat.' This is very simple, very general; but its simplicity is its beauty and its practical value -- not an objection in law."

To gather the thread of thought running through this extended citation, and group the important propositions, may serve a useful purpose. The judge begins by stating that a principle, considered as a law of nature or force is not patentable apart from some mode of turning it to account in the practical affairs of life; but when turned to such account the patent will be good, though the principle or force be general and newly discovered. This position he bases, not upon the ground that the force is natural and merely discovered, not invented, by the patentee, but only on the ground that it is abstract and incapable of producing practical results. He then declares that the principle ceases to be abstract when discovered and stated to be useful for a special purpose, or "stated in actual application to, and as the agent of, producing a cer-

tain specified effect" and "clothed with the language of practical application, and receives the impress of tangible direction to the actual business of human life." From the context, and especially from what follows, it is apparent that the learned judge is not here speaking of the embodiment of the idea of the inventor in tangible materials, but of the complete conception in the mind of the inventor of the method by which the principle or force is to be applied to its objects in order to produce the specified effect. He then states that having thus brought the principle into relation with practical affairs, the particular form in which he reduces it to practice is immaterial, but that "all modes of applying the principle to the purpose specified, *according to or within a general statement of the object to be attained and of the use to be made of the agent* [principle or force] *to be so applied*" are within the patent. The remainder of the opinion, answering the objections of the defenders and illustrating the doctrine by a reference to Minter's patent, follows the same line of thought, and places the doctrine as to this kind of "principle" in the clearest light.

The discussion of this case in *O'Reilly v. Morse* (1853), 15 How. 62, and in the dissenting opinion of Judge Nelson in *Le Roy v. Tatham* (1852), 14 How. 156, shows at once the influence it has exercised upon the ideas entertained by the courts and the errors into which they have sometimes been led by following the language of the decision rather than the propositions intended to be conveyed. Still more recently, in *Tilghman v. Proctor* (1881), 102 U. S. 707; 19 O. G. 859, § 163, note, *post*, it has received another examination. All these reviews of this famous case are valuable and instructive, and the more thoroughly

to the subject acting, but with reference to the object acted on; and apart from such an object it can neither be apprehended by the senses nor contemplated by the mind. Thus when a machine for smoothing lumber is practically used, the eye and intellect of the observer perceive the machine or means employed, the smoothness or effect produced, and the function or act of smoothing to which the lumber is subjected. Or when a fulminating compound is applied to the ignition of explosives, he sees the means or fulminate, the effect or ignition of the explosive, and the function or the communication of heat to the explosive by the deflagrating fulminate.¹ That in these cases, as in all others, the presence of the object acted on is necessary to the manifestation of the function is evident. Though the machine be perfect and exhaust its capabilities of operation, it can perform no act of smoothing until the boards are placed between its whirling knives. The deflagrating fulminate communicates no heat unless the explosive comes within reach of its fiery tongue.

§ 145. Function Distinct both from Means and Effect.

Yet while no function can exist without the application of some operative means to the production of a physical effect, the function is essentially distinct both from the means and the effect. It is not included in the idea of means nor in the practical embodiment of that idea. Every means is neces-

they are examined and the more carefully they are compared, does the true theory as stated in the text, and in the decision of Judge Gray (*Am. Bell Telephone Co. v. Dolbear* (1883), 23 O. G. 535; 15 Fed. Rep. 448), cited to § 141, *ante*, become apparent, viz., that the principle of the invention, or idea of means, consists in the application of the principle or natural force in some manner to a physical object; that a patent for this application covers and protects it only; but, that when this application or principle of the invention is embodied and practically applied in the arts, the forms of this embodiment and practical application are not material, and the same patent covers and protects them all.

§ 144. ¹ In *Corning v. Burden* (1853), 15 How. 252, Grier, J.: (268) "But the term process is often used in a more vague sense, in which it cannot be the subject of a patent. Thus we say that a board is undergoing the process of being planed, grain of being ground, iron of being hammered, or rolled. Here the term is used subjectively or passively as applied to the material operated on, and not to the method or mode of producing that operation, which is by mechanical means, or the use of a machine, as distinguished from a process. In this use of the term it represents the function of a machine, or the effect produced by it on the material subjected to the action of the machine."

sarily complete within itself, whether or not an object is subjected to its operation. Neither the planer nor the fulminate are changed in character or capability by the presence or the absence of the lumber or the explosive. They act with equal energy, and in precisely the same manner, whether their action terminates on the material objects in which their appropriate effects may be produced, or issues only in the beating of the air or in the illumination of surrounding space. And not only is every means thus independent of the function, but every function is in the same measure independent of any individual means. A function is so far identified with an effect that by whatever means the function is performed the effect must be produced. Smoothness will exist whenever an act of smoothing has preceded it, and this act is performed by every means which removes irregularities of surface, whether it be the attrition of some harder substance, the constant flow of water, the excision of the surface by a single knife or by a group of rapidly revolving blades. So the explosive is ignited whenever heat is communicated to it by some foreign substance; but this may be accomplished by a red-hot iron, the flame of burning paper, or the electric spark, as well as by the compound which deflagrates upon percussion. Whichever of these various means is used the effect and function are the same, the object acted on being subjected, under all these different methods, to the same operation, and exhibiting the same result. And yet the function is no part of the effect produced. Although in its relation to the means it has the character of an effect, it is not the ultimate effect which the means is intended to accomplish. The latter is a permanent, concrete effect, perpetually manifested in the object. The function is an abstract, fugitive effect, known only through its sensible results, and ceasing with the operation of the means. They are not even contemporaneous, for the effect comes into being only as the function ceases, and the completion of the one is thus conditioned on the termination of the other. As independent of the effect as of the means, a function is in law as well as fact a separate entity, possessing its own characteristic attributes, and governed by its own peculiar rules.

§ 146. Function Possesses no Attribute of an Invention.

The nature of a function, and its relation to the means and the effect, show that it is wanting in all the necessary attributes of an invention, and, therefore, cannot be protected by a patent.¹ Forming no part of the idea of means, it does not owe its origin to a creative act. As a prerequisite to the effect, it is discerned as soon as the desirability of the effect becomes apparent, and before the inventive faculties attempt to provide means by which the effect can be produced. It is incapable of tangible embodiment, almost of verbal or pictorial description; and is presented to the mind only through processes of abstract reasoning or by the observation of its practical results. Performed by many different means, it cannot be exclusively attributed to any, but remains open to attainment by all methods which human ingenuity is able to devise. Identified with the effect in origin though not in nature, it is, like the effect, the common property of all men; and could it be appropriated to the use of one, all others would be deprived of their right to the effect, whether produced by methods new or old. Thus for all reasons which can be applied to any subject-matter, a function is outside the sphere of an invention, and no patent for the means can be so extended as to protect the operation of the means upon the object in producing the effect.

§ 146. ¹ In *Corning v. Burden* (1853), 15 How. 252, Grier, J.: (268) "But it is well settled that a man cannot have a patent for the function or abstract effect of a machine, but only for the machine which produces it."

Further, that a function is not patentable, see *Excelsior Needle Co. v. Union Needle Co.* (1885), 23 Blatch. 147; 32 Fed. Rep. 221; *Reay v. Raynor* (1884), 22 Blatch. 13; 19 Fed. Rep. 308; 26 O. G. 1111; *Matthews v. Schoneberger* (1880), 18 O. G. 1464; 4 Fed. Rep. 635; 18 Blatch. 357; *Union Paper Collar Co. v. White* (1875), 7 O. G. 698, 877; 2 Bann. & A. 60; *Wheeler v. Simpson* (1874), 1 Bann. & A. 420; 6 O. G. 435; *Blanchard v.*

Sprague (1839), 3 Sumner, 535; 1 Robb, 734.

That where a new function is performed the real invention is either the physical structure, the combination of devices, or the process, see *Matthews v. Schoneberger* (1880), 18 O. G. 1464; 4 Fed. Rep. 635; 18 Blatch. 357.

That the means, not the function, is the invention, see *Excelsior Needle Co. v. Union Needle Co.* (1885), 23 Blatch. 147; 32 Fed. Rep. 221; *Albany Steam Trap Co. v. Felthousen* (1884), 22 Blatch. 169; 20 Fed. Rep. 633; *Pattee v. Moline Plow Co.* (1881), 22 O. G. 173; 10 Bissell, 377; 9 Fed. Rep. 821.

§ 147. "Effect" or "Result" Defined.

The line of demarcation between the means employed and the effect produced, though often difficult to draw in practice, in theory at least is broad and readily discernible. The want of technical language has resulted, here as elsewhere, in some needless ambiguity. The words "result" and "product" are sometimes employed to represent the idea more properly expressed by the term "effect." At other times they are used to denote the art or article in which the idea of means is practically embodied. The courts, employing these two words in different senses, have in some cases stated and in some denied that a "result" could be the subject-matter of a patent, without explaining in which sense the word was used.¹ A

§ 147. ¹ In *Fuller v. Yentzer* (1876), 94 U. S. 288, Clifford, J.: (288) "Patents for a machine will not be sustained if the claim is for a result, the established rule being that the invention, if any, within the meaning of the patent act, consists in the means or apparatus by which the result is obtained." 11 O. G. 551 (551).

In *Corning v. Burden* (1853), 15 How. 252, Grier, J.: (268) "It is for the discovery or invention of some practicable method or means of producing a beneficial result or effect, that a patent is granted, and not for the result or effect itself."

In *Le Roy v. Tatham* (1852), 14 How. 156, McLean, J.: (175) "A patent is not good for an effect, or the result of a certain process, as that would prohibit all other persons from making the same thing by any means whatsoever."

In *Whittemore v. Cutter* (1813), 1 Gallison, 478, Story, J.: (480) "A patent can, in no case, be for an effect only, but for an effect produced in a given manner, or by a peculiar operation. For instance, no patent can be obtained for the admeasurement of time, or the expansive operation of steam; but only for a new mode or new application of machinery, to produce these effects." 1 Robb, 40 (42).

See also *Palmer v. Gatling Gun Co.* (1881), 20 O. G. 815; 19 Blatch. 392; 8 Fed. Rep. 513; *Anilin v. Higgin* (1878), 14 O. G. 414; 3 Bann. & A. 462; 15 Blatch. 290; *Union Paper Collar Co. v. White* (1875), 7 O. G. 698, 877; 2 Bann. & A. 60; *Hoe v. Simpson* (1874), 6 O. G. 435; 1 Bann. & A. 420; *Ex parte Merrill* (1874), 5 O. G. 120; 1 MacArthur, 301; *Marsh v. Dodge & Stevenson Mfg. Co.* (1873), 5 O. G. 398; 6 Fisher, 562; *Bailey Washing & Wringing Mach. Co. v. Lincoln* (1871), 4 Fisher, 379; *Morton v. N. Y. Eye Infirmary* (1862), 5 Blatch. 116; 2 Fisher, 320; *Case v. Brown* (1862), 1 Bissell, 382; 2 Fisher, 268; *Morris v. Barrett* (1859), 1 Bond, 254; 1 Fisher, 461; *Burr v. Cowperthwait* (1858), 4 Blatch. 163; *Potter v. Holland* (1858), 4 Blatch. 238; 1 Fisher, 382; *O'Reilly v. Morse* (1853), 15 How. 62; *Carver v. Hyde* (1842), 16 Peters, 513.

That a patent cannot be granted for all modes of producing an effect, this being equivalent to a patent for the effect itself, see *Marsh v. Dodge & Stevenson Mfg. Co.* (1873), 6 Fisher, 562; 5 O. G. 398; *O'Reilly v. Morse* (1853), 15 How. 62.

But that for a result in the sense of a product, or new art or instrument,

moment's attention to the topic under discussion is usually sufficient to remove all obscurity. An effect is never an invention, whether described as a concrete and independent article or as a new condition of existing objects; but an instrument or operation, in which the idea of means has been embodied, is an invention and is always patentable, under whatever name it may be known.

§ 148. Effect not the Result of an Inventive Act.

Two attributes of an invention are wanting in an effect. In the first place, it is the end and not the means. It is that changed condition of affairs which constitutes the satisfaction of a human want. Although produced by an invented means, it is not the fruit of inventive skill, but has existed, at least in intellectual contemplation, ever since the want which it supplies arose. As the antithesis of this want, it is perceptible to every person to whom the want itself becomes apparent, and none can claim the merit of its sole discovery, or assert a superior title to its benefits. Like everything that is not due to the creative genius of an individual, it is the property of all, and neither indirectly nor directly can the public be restricted in its enjoyment.

§ 149. Effect Producing by Various Means and thus Peculiar to None.

Again, with few exceptions, every effect may be produced by several different means. Each of these means, if artificial, is a true invention and may properly be employed by its inventor for his exclusive benefit. But the invention of one means confers on its inventor no right, either natural or legal, to prohibit others from inventing, for their own use, other and substantially different means.¹ Yet this would be the result

a patent may be granted, see *Anilin v. Higgin* (1878), 14 O. G. 414; 3 Bann. & A. 462; 15 Blatch. 290; *Arkell v. The Hurd Paper Bag Co.* (1870), 7 Blatch. 475.

means it may be produced, see *Anilin v. Higgin* (1878), 4 O. G. 414; 3 Bann. & A. 462; also § 184 and notes, *post.*

And that the inventor of a result (product) may protect it by whatever

§ 149. ¹ In *New Process Fermentation Co. v. Maus* (1884), 20 Fed. Rep. 725, Drummond, J.: (732) "It

if one who had discovered an effect, and had invented means for its production, could patent the effect as well as means. The progress of inventive genius in the same direction, through whatever different paths, would be suspended. The public would be confined to the use of his means and his only, no matter how imperfect or expensive in comparison with others that might be devised. The rights of the inventor of the means would be subordinated to the claims of the discoverer of the effect, and thus a higher premium be placed on the perception of what all can see than on the creation of that useful and important agency which, but for the inventor, might never have been employed. The principles of justice give no support to such a claim. The scope of the inventor's right is limited by the means he has devised, and whether the effect be new or old, all others are at liberty to produce it by any method which is not substantially identical with his.

§ 150. Essential Requisites of a Concrete Invention.

Thus excluding from the sphere of the invention the principle or force which it employs, the function it performs, and the effect which it produces, we see that the complete result of the inventive act consists in an idea of means, embodied in some instrument or operation, and capable, when brought in contact with its proper object, of performing certain functions and thereby producing in the object certain definite effects. If any of these four essential requisites are wanting, there can

seems to be admitted in the various process cases decided in the supreme court, which have been referred to, and others which might be named, if the process consists of a chemical combination by which the particular result is produced, that does not prevent another inventor from making a mechanical combination which produces the same result. Otherwise, there would be a revolution in what has always been understood to be a principle of the patent law, that a person could not patent a result, but only the means or acts by which the result was produced; and

that certainly should be true as well of a chemical as a mechanical combination."

Further, that a patent can cover only the method of effecting a result, not the result itself, see *Steam Gauge & Lantern Co. v. St. Louis Railway Supplies Mfg. Co.* (1886), 38 O. G. 107; *Pattee v. Moline Plow Co.* (1881), 22 O. G. 173; 10 Bissell, 377; 9 Fed. Rep. 821.

That a patent cannot cover all modes of producing a result, see *Blake v. San Francisco* (1885), 113 U. S. 679; 31 O. G. 380; § 147, note 1, *ante*.

be no invention. An idea other than an idea of means, whether it be of principle, of function, or effect; the complete embodiment of an incomplete idea of means; the incomplete embodiment of a complete idea of means; and the complete embodiment of a complete idea of means in any other than a practically operative form, — all these fall short of that result of the inventive act to which the law accords the title and prerogatives of an invention.

§ 151. Concrete Invention a Unit.

An invention, as thus defined, is necessarily a unit. The idea of means, which is its essence, is one, complete, invariable. Though capable of practical embodiment in instruments of different form, or in operations involving actions of apparently different character, its individuality is not affected and its identity remains unchanged. Each of these different instruments may be composed of many parts, each of these different operations may require the use of numerous agents or the performance of long series of acts, but the idea which underlies the instrument or operation is indivisible. Though its effects are various, in the production of each one of them it acts in its entirety, — the whole idea, in its complete embodiment, being employed in the accomplishment of every end.

§ 152. Principal and Subordinate Inventions are Distinct Units.

In most inventions, this attribute of unity is easily discerned and demands slight attention. But in two cases it becomes a matter of importance, and at the same time presents more formidable difficulties. It often happens in the industrial arts that an inventor, in attempting to accomplish some important end, is confronted with wants hitherto unknown, which must be satisfied before his greater want can be supplied. In his endeavors to produce an instrument, for instance, by which an ultimate effect can be performed, he finds himself compelled to devise operations by which the instrument may be produced; and for these operations still lesser agencies must be contrived until, in order to attain his principal result, various subordinate exertions of inventive skill must be exhibited, each bringing into being some new

means for the accomplishment of its subordinate end. But these various means, principal and subordinate, though tending toward the fulfilment of a common purpose, are not one invention. Each is complete within itself. Each is a separate idea of means, embodied in a separate instrument or operation, having its own essential factors, and capable of independent use.¹ A patent for the means in which the efforts of the inventor culminate, therefore, does not secure to him the right to the exclusive use of the subordinate means. Each is a true invention and the subject-matter of a patent, and in reference to legal rights and obligations must be regarded independently of all the rest.

§ 153. Combinations and their Elements Distinct Units: "Combination" Defined.

This doctrine of the unity of an invention becomes especially important in connection with that class of inventions known as "combinations." A combination is an instrument or operation, formed by uniting two or more subordinate instruments or operations in a new idea of means.¹ In one

§ 152. ¹ Practical illustrations of this truth are found in cases where the inventor has not only devised a new product but the process by which it is produced, or constructed a new machine some of the subordinate parts of which are also new; or invented a new manufacture as well as the instruments by which it is made. In all such cases he is entitled to protect each of his inventions; sometimes under a single patent, sometimes under separate patents, according to their relation to each other. Otherwise his inventive acts would go unrewarded, since if only his ultimate invention could be patented, or the others were protected only as embraced within it, the subordinate inventions would become public property for every other purpose except the one for which they were specifically devised by him.

See *Ex parte Bancroft* (1881), 20 O. G. 1893.

That the same rule applies when the same inventor has invented both the elements of a combination and the combination as a whole, see *Holly v. Vergennes Mach. Co.* (1880), 18 O. G. 1177; 18 Blatch. 327; 4 Fed. Rep. 74; *Herring v. Nelson* (1877), 12 O. G. 753; 14 Blatch. 293; 3 Bann. & A. 55; *Stevens v. Pritchard* (1876), 10 O. G. 505.

§ 153. ¹ In *Ex parte Marshall* (1883), 25 O. G. 882, Butterworth, Com.: (882)

"1. What is a combination, using the term in its generic sense?

"2. What is a patentable combination?

"Considered as a generic term, a combination may be defined to be a *co-ordination of individual functions, so as to constitute a common function.* Co-ordination necessarily implies some *modification of the individual function*

sense every invention is a combination, since every art and article is composed of elements which by inventive genius have been brought together to serve a common use. But the distinction between a combination in this general sense, and that in which the term is technically employed in Patent Law, seems to be this: that in a patentable combination every subordinate element must, in its separate state, have been an operative means, capable of discharging its own peculiar functions and producing its own physical effects, and also must, while in the combination, still perform its individual functions and, except perhaps in chemical compositions, retain its individual identity.

§ 154. **Combination not a mere Aggregation.**

Where operations or instruments are thus united, one of two results must follow. Either each element remains unchanged in function and effect; or by the action of the elements upon each other, or their joint action on their common object, they perform additional functions and accomplish additional effects. The former union is a mere collocation or aggregation of the elements.¹ Although they have been

of each part as it existed prior to the combination. This principle is recognized and asserted by the Supreme Court of the United States in many cases, notably *Pickering et al. v. McCullough et al.*, (14 Otto, 310,) *Hailes v. Van Wormer*, (20 Wall. 353,) and in case of *J. D. Sarven v. Elihu Hall & Co.*, (U. S. C. C. District of Conn., reported in 11 Blatchf. 295.) To be patentable a combination must conform to the requirements of the definition given above, and must also contain two other elements—that is to say, there must be a *combination*. That combination must be *novel*. It must be *useful*.”

In *Yale & Greenleaf Mfg. Co. v. North* (1867), 3 Fisher, 279, Shipman, J. : (287) “A combination in mechanism must consist of distinct mechanical parts, having some relation to each other, and each having some func-

tion in the organism.” 5 Blatch. 455 (461).

That the combination of a new device with an existing machine is patentable, see *Locomotive Engine Safety Truck Co. v. Penna. R. R. Co.* (1874), 10 Phila. 252; 1 Bann. & A. 470; 6 O. G. 927.

That in a patent for a combination, the whole combination as such must be original with the inventor or the patent will be void, see *Holliday v. Rheem* (1852), 18 Pa. St. 465.

§ 154. ¹ In *Hoffman v. Young* (1880), 2 Fed. Rep. 74, Butle; J. : (77) “A mere aggregation of old parts, without any new result issuing from their united action, is not patentable. The parts must combine in operation, and by their joint effect produce a new result. . . . It would seem . . . that two things are always necessary. *First,*

brought together in an apparent organism and rendered more available for use, they still remain the same distinct and in-

a novel assemblage of parts, exhibiting invention; *Second*, the co-operation of the parts in producing a new result. By the term co-operate, however, the courts do not mean merely acting together or simultaneously, but unitedly to a common end, a unitary result. Each and every part must have its sub-function to perform, and each must have a certain relation to, and dependence upon, the other." 18 O. G. 794 (794); 5 Bann. & A. 316 (318); 14 Phila. 428 (429).

In *Reckendorfer v. Faber* (1874), 5 O. G. 697, Woodruff, J.: (700) "When the functions and uses of each are unaffected by the union and the means of uniting has no novelty, it is not obvious, certainly, that anything of invention can be alleged of the combined implements. (*Sawyer v. Bixby*, 9 Blatch. 362.) That the aggregated result may be very convenient, may, for that reason, be popular, and may find a ready sale, and that such sales are very large and show a great demand does not determine the question. As suggested in several cases relating to aggregation as distinguished from patentable combinations, the aggregate result may be the production of a better structure as an aggregate than was ever before produced, and yet, for the lack of novelty of device or new result produced by the aggregation and due thereto, it may have no patentable quality." 12 Blatch. 68 (79); 1 Bann. & A. 229 (239).

In *Hailes v. Van Wormer* (1873), 20 Wall. 353, Strong, J.: (368) "Merely bringing old devices into juxtaposition, and then allowing each to work out its own effect without the production of something novel, is not invention." 5 O. G. 89 (90).

That a union of elements is a mere

aggregation unless by their united action they perform some function which they do not separately discharge, see *Combined Patents Can Co. v. Lloyd* (1882), 15 Phila. 485; 11 Fed. Rep. 153.

That collocation or aggregation of elements is not combination, see *Thatcher Heating Co. v. Burtis* (1887), 121 U. S. 286; 39 O. G. 587; *Hasselman v. Gaar* (1886), 29 Fed. Rep. 318; *Stephenson v. Brooklyn R. R. Co.* (1885), 114 U. S. 149; 31 O. G. 263; *Mosler Safe & Lock Co. v. Mosler* (1885), 31 O. G. 1689; 22 Fed. Rep. 901; *Bussey v. Excelsior Mfg. Co.* (1884), 110 U. S. 131; 26 O. G. 733; *Hayes v. Bickelhaupt* (1884), 22 Blatch. 463; 29 O. G. 367; 21 Fed. Rep. 566; *Stutz v. Armstrong* (1884), 20 Fed. Rep. 843; 28 O. G. 367; *Double Pointed Tack Co. v. Two Rivers Mfg. Co.* (1883), 109 U. S. 117; 25 O. G. 1075; *Clark Pomace Holder Mfg. Co. v. Ferguson* (1883), 21 Blatch. 376; 17 Fed. Rep. 79; 24 O. G. 1090; *Wood v. Packer* (1883), 17 Fed. Rep. 650; *Ex parte Marshall* (1883), 25 O. G. 882; *Thatcher Heating Co. v. Burtis* (1882), 22 O. G. 262; 12 Fed. Rep. 569; *Perry v. Co-operative Foundry Co.* (1882), 20 Blatch. 498; 22 O. G. 1623; 12 Fed. Rep. 436; *Wilson Packing Co. v. Chicago Packing & Provision Co.* (1882), 105 U. S. 566; 21 O. G. 1689; *Combined Patents Can Co. v. Lloyd* (1882), 11 Fed. Rep. 153; 15 Phila. 485; *Pickering v. McCullough* (1881), 104 U. S. 310; 21 O. G. 73; *Strobridge v. Landers* (1881), 21 O. G. 1027; 11 Fed. Rep. 880; 20 Blatch. 73; *Edgerton v. Furst & Bradley Mfg. Co.* (1881), 21 O. G. 261; 10 Bissell, 402; 9 Fed. Rep. 450; *Fisher v. Commissioner* (1881), 1 Mackey, 212; 20 O. G. 957; *Hoffman v. Young* (1880), 14 Phila. 428; 2 Fed. Rep.

dependent means, still acting as so many separate units and not co-operating with each other to perform additional functions and accomplish additional results. Such unions, therefore, are not the creation of new means. They do not involve an exercise of the inventive faculties, nor can they be protected by a patent.

§ 155. Combination a New Means.

But when these elements are so united that by their reciprocal influence upon each other, or their joint action on their common object, they perform additional functions and accomplish additional results, the union is a true combination.¹

74 ; 18 O. G. 794 ; 5 Bann. & A. 316 ; Doubleday v. Roess (1880), 11 Fed. Rep. 737 ; 22 O. G. 861 ; Slawson v. Grand St. R. R. Co. (1880), 4 Fed. Rep. 531 ; 17 Blatch. 512 ; Double Pointed Tack Co. v. Two Rivers Mfg. Co. (1880), 3 Fed. Rep. 26 ; 18 O. G. 683 ; 9 Bissell, 258 ; Double Pointed Tack Co. v. Mann (1880), 5 Bann. & A. 465 ; Perfection Window Cleaner Co. v. Bosley (1880), 5 Bann. & A. 449 ; 9 Bissell, 385 ; 2 Fed. Rep. 574 ; Alcott v. Young (1879), 16 Blatch. 134 ; 16 O. G. 403 ; 4 Bann. & A. 197 ; Webster Loom Co. v. Higgins (1879), 4 Bann. & A. 88 ; 15 Blatch. 446 ; 16 O. G. 675 ; Kerosene Lamp Heater Co. v. Littell (1878), 3 Bann. & A. 312 ; 13 O. G. 1009 ; Bussey v. Wager (1876), 9 O. G. 300 ; Sawyer v. Bixby (1872), 1 O. G. 165 ; 5 Fisher, 283 ; 9 Blatch. 361 ; Sarven v. Hall (1872), 1 O. G. 437 ; 9 Blatch. 524 ; 5 Fisher, 415 ; Swift v. Whisen (1867), 3 Fisher, 343 ; 2 Bond, 115.

That if the connecting means in an aggregation are new they may be an invention, but the claims of the patent must rest on these, see Thatcher Heating Co. v. Burtis (1887), 121 U. S. 286 ; 39 O. G. 587.

That no combination is patentable unless each element qualifies every

other, producing a new device or a result due to a co-operation of all the forces, distinct from the sum of their collective action, see Peard v. Johnson (1885), 23 Fed. Rep. 507 ; 32 O. G. 895 ; Clark Pomace Holder Co. v. Ferguson (1883), 21 Blatch. 376 ; 17 Fed. Rep. 79 ; 24 O. G. 1090 ; Pickering v. McCullough (1881), 104 U. S. 310 ; 21 O. G. 73 ; Swift v. Whisen (1867), 2 Fisher, 343 ; 2 Bond, 115.

That to place old elements in juxtaposition, without a new function or effect, is not combination, see Dosh v. A. J. Medlar Co. (1887), 40 O. G. 1242 ; Thatcher Heating Co. v. Burtis (1887), 121 U. S. 286 ; 39 O. G. 587 ; Troy Laundry Mach. Co. v. Bunnell (1886), 27 Fed. Rep. 810 ; 23 Blatch. 558.

That a union of parts having no common purpose is not a combination, see Tower v. Bemis & Call Hardware & Tool Co. (1884), 19 Fed. Rep. 498.

§ 155. ¹ In *Stutz v. Armstrong* (1884), 20 Fed. Rep. 843, Acheson, J.: (847) "Now, certainly there is no patentable combination in a mere aggregation of old devices which produce no new effect or result due to their concurrent or successive joint and co-operating action. But it is by no means essential to a patentable combination . . . that the several devices or elements thereof

While every element remains a unit, retaining its own individuality and identity as a complete and operative means,

should coact upon each other ; it is sufficient if all the devices co-operate with respect to the work to be done, and in furtherance thereof, although each device may perform its own particular function only." 28 O. G. 367 (369).

In *Stephenson v. Brooklyn Railroad Co.* (1885), 114 U. S. 149, Woods, J.: (157) "A combination is patentable only when the several elements of which it is composed produce by their joint action a new and useful result, or an old result, in a cheaper or otherwise more advantageous way." 31 O. G. 263 (265).

In *Clark Pomace Holder Co. v. Ferguson* (1883), 21 Blatch. 376, Coxe, J.: (378) "All the component parts must so enter into a combination of old elements, that each qualifies every other. . . . If the elements of the combination act independently of each other, or, if one element acts independently of the others, it is an aggregation of parts, and not entitled to protection as a combination." 17 Fed. Rep. 79 (80); 24 O. G. 1090 (1091).

In this opinion there is a confusion of combination and result, as when the judge says that a new and useful result must be produced and "unless this is the case, even though the elements act reciprocally and in combination, the requirements of the law are not satisfied. The combination must be new; so must the result." If this means anything more than that the elements in combination must so coact as to produce a result essentially different from that obtained by their separated or aggregated action, it is erroneous. The result need not be new in any other sense than this. See § 156, note 1, *post*.

In *Hall v. Johnson* (1883), 23 O. G. 2411, Marble, Com.: (2412) "Combinations may be made up of parts entirely new or entirely old, or part new and

part old ; but if the parts when brought together so co-act as to produce a new and beneficial result, the party so bringing them together has made an invention, and is entitled, if he makes claim thereto, to a patent therefor. If new elements are added to an imperfect combination, and if by the addition of such new elements the combination is made perfect and operative, the person who adds such elements is entitled to claim the new combination."

In *Wood v. Packer* (1883), 17 Fed. Rep. 650, Nixon, J.: (651) "In a combination, the elemental parts must be so united that they will dependently co-operate and produce some new and useful result."

In *Pickering v. McCullough* (1881), 104 U. S. 310, Matthews, J.: (318) "In a patentable combination of old elements, all the constituents must so enter into it as that each qualifies every other ; to draw an illustration from another branch of the law, they must be joint tenants of the domain of the invention, seized each of every part, *per my et per tout*, and not mere tenants in common, with separate interests and estates. It must form either a new machine of a distinct character and function, or produce a result due to the joint and co-operating action of all the elements, and which is not the mere adding together of separate contributions. Otherwise it is only a mechanical juxtaposition, and not a vital union." 21 O. G. 73 (75).

In *Hailes v. Van Wormer* (1870), 7 Blatch. 443, Woodruff, J.: (452) "The mere addition of an old device producing a specific result, to another old device producing its own result, in such wise that their combination produces these same two results, and no other, is not invention. . . . On the other hand, if

their combination embodies an entirely new idea of means, and thus becomes another unit, whose essential attributes depend on the co-operative union of the elements of which it is composed.² Such a combination is a different invention from the elements themselves, whether considered in their separate or their aggregated state, the method of their co-

the combination itself produces a new and useful result, not due to the separate action of either, nor attained thereby, but due to the co-operative or reciprocal action of the combined devices, a totally different question arises; for, obviously, invention generally (as distinguished from discovery) consists in new modes of employing what was before known, so as to produce thereby effects either not produced before, or not produced in that manner, or not produced so usefully. So, also, if the combination of the old devices be supplemented by other and new devices co-operating therewith, and thereby a new and useful result is produced, not attained by the action of the old devices, there, also, is invention."

But that the elements may coact upon each other only, see *Hailes v. Van Wormer* (1870), 7 Blatch. 443; or upon their common object only, see *Stutz v. Armstrong* (1884), 20 Fed. Rep. 843; 28 O. G. 367; *Stilwell & Bierce Mfg. Co. v. Cincinnati Gas Light & Coke Co.* (1875), 1 Bann. & A. 610; 7 O. G. 829.

That in a combination there must be coaction of the elements and a new function, see *Scott Mfg. Co. v. Sayre* (1885), 26 Fed. Rep. 153; 35 O. G. 255.

That the invention is a combination if some features of each of the elements coact, see *Strobridge v. Landers* (1881), 21 O. G. 1027; 11 Fed. Rep. 880; 20 Blatch. 73.

² That a combination is an entirety, a unit, see *Rowell v. Lindsay* (1881), 10 Bissell, 217; 6 Fed. Rep. 290; 19 O. G. 1565; *Williams v. Rome, Watertown,*

& Ogdensburg R. R. Co. (1878), 15 O. G. 653; 15 Blatch. 200; 3 Bann. & A. 413; *Schumacher v. Cornell* (1877), 96 U. S. 549; *Ex parte Gould* (1874), 5 O. G. 121; 1 MacArthur, 410; *Westlake v. Cartter* (1873), 6 Fisher, 519; 4 O. G. 636; *Watson v. Cunningham* (1871), 4 Fisher, 528; *Densmore v. Schofield* (1868), 4 Fisher, 148; *Case v. Brown* (1864), 2 Wall. 320; *Vance v. Campbell* (1861), 1 Black, 427.

That the identity and individuality of a combination depend neither upon its elements alone, nor upon the manner of their co-operation alone, but upon the union of certain elements in a certain mode of co-operation, see *Allis v. Buckstaff* (1882), 13 Fed. Rep. 879; 22 O. G. 1705; *Dederick v. Cassell* (1881), 20 O. G. 1233; 9 Fed. Rep. 306; *Rowell v. Lindsay* (1881), 6 Fed. Rep. 290; 10 Bissell, 217; 19 O. G. 1565; *Hebeman v. Whitman* (1880), 5 Bann. & A. 530; *Water Meter Co. v. Desper* (1879), 01 U. S. 332; *Williams v. Boston & Albany R. R. Co.* (1879), 16 O. G. 906; 17 Blatch. 21; 4 Bann. & A. 441; *American Whip Co. v. Lombard* (1878), 14 O. G. 900; 4 Clifford, 495; 3 Bann. & A. 598; *Sanford v. Merrimac Hat Co.* (1876), 4 Clifford, 494; 10 O. G. 466; 2 Bann. & A. 408; *Converse v. Cannon* (1873), 2 Woods, 7; 9 O. G. 105; *Locomotive Engine Safety Truck Co. v. Erie Railway Co.* (1872), 10 Blatch. 292; 3 O. G. 93; 6 Fisher, 187; *Le Roy v. Tatham* (1859), 22 How. 132; *Curtis v. Platt* (1864), 11 L. T. Rep. n. s. 245, and cases cited under § 282, *post*.

operation in the combination being the result of the inventive act.³ Whether the elements are new or old,⁴ and whether

³ That the union of the elements in a mode of co-operation is the true inventive act in a combination, see *Fuller v. Yentzer* (1876), 94 U. S. 288; 11 O. G. 551; *Smith v. Marshall* (1876), 10 O. G. 375; 2 Bann. & A. 371; *Gill v. Wells* (1874), 22 Wall. 1; *Harrison v. Anderson Foundry Co.* (1876), L. R. 1 App. 574.

Thus that though the elements remain unchanged and the effect produced by the combination is the same, yet the mode of combining the elements may differ, and if so the combination is a different invention, see *Allis v. Buckstaff* (1882), 13 Fed. Rep. 879; 22 O. G. 1705; *Pattee v. Moline Plow Co.* (1881), 10 Bissell, 377; 9 Fed. Rep. 821; 22 O. G. 173; *Dederick v. Cassell* (1881), 9 Fed. Rep. 306; 20 O. G. 1233; *Hebeman v. Whitman* (1880), 5 Bann. & A. 530; *Gallahue v. Butterfield* (1872), 10 Blatch. 232; 2 O. G. 645; 6 Fisher, 203; *Woodward v. Dinsmore* (1870), 4 Fisher, 168; *Murray v. Clayton* (1872), L. R. 7 Ch. Ap. 570; *Curtis v. Platt* (1864), 11 L. T. Rep. n. s. 245; *Carpenter v. Smith* (1841), 1 Web. 530.

That the elements and the combination are separate inventions, see *McMillin v. Rees* (1880), 5 Bann. & A. 269; 17 O. G. 1222; 1 Fed. Rep. 722.

⁴ In *Dederick v. Cassell* (1881), 20 O. G. 1233, Butler, J.: (1234) "If it be true . . . that all the parts embraced in the plaintiff's [combination] may be found in the various devices previously used [for the same purpose], the plaintiff's right to the new combination which he constructed would be none the less complete. It will not answer to say this required no invention, that any mechanic might have selected the parts and combined them. The same might be said with equal force in almost every instance in which a patent for combination is

issued. The fact that no mechanic did select and combine the parts and produce such a [combination], notwithstanding the great need for it, is a sufficient answer to the suggestion." 9 Fed. Rep. 306 (309).

In *Hoe v. Cottrell* (1880), 18 O. G. 59, Shipman, J.: (61) "In the determination of the question whether there was invention in any particular combination the important point is to ascertain whether novelty and utility existed. It is true that these requisites may result from mere mechanical skill, and a new and useful combination may be formed by the mere mechanical addition of an old member to an old set of members; but when a device has a new mode of operation which accomplishes beneficial results 'courts look with favor upon it,' and are not exacting as to the degree of inventive skill which was required to produce the new result. There must be some, but a little will suffice." 17 Blatch. 546 (552); 1 Fed. Rep. 597 (602); 5 Bann. & A. 256 (262).

In *Imhaeuser v. Buerk* (1879), 101 U. S. 647, Clifford, J.: (660) "Where the thing patented is an entirety, consisting of a single device or combination of old elements incapable of division or separate use, the respondent cannot escape the charge of infringement by alleging or proving that a part of the entire invention is found in one prior patent, printed publication, or machine, and another part in another prior exhibit, and still another part in a third exhibit, and from the three or any greater number of such exhibits draw the conclusion that the patentee is not the original and first inventor of the patented improvement." 17 O. G. 795 (797).

In *Hailes v. Van Wormer* (1873), 20 Wall. 353, Strong, J.: (368) "It must be conceded that a new combination, if

they coact successively or simultaneously is of no impor-

it produces new and useful results, is patentable, though all the constituents of the combination were well known and in common use before the combination was made." 5 O. G. 89 (90).

In *Blake v. Stafford* (1868), 6 Blatch. 195, Shipman, J.: (205) "The question is not whether the elements are new, but whether the combination is new. Though the separate parts are all as old as the art of the mechanic, if they are organized into a new machine, having a new mechanical operation, and the organization of this new machine involved the exercise of original thought and is productive of useful results, then it is patentable." 3 Fisher, 294 (305).

In *The Union Sugar Refinery v. Matthiesson & Co.* (1865), 3 Clifford, 639, Clifford, J.: (659) "A patented improvement, consisting of old elements, cannot be proved to be invalid by showing some one of the elements in some prior machine, and another in another prior machine, until it is shown that all the elements which constitute the improvement were in prior use, because the theory of such a patent is, that the elements are old, and the invention consists in a new combination, whereby a new and useful result is obtained." 2 Fisher, 600 (622).

In *Ryan v. Goodwin* (1839), 3 Sumner, 514, Story, J.: (518) "The true question is, whether the combination of materials by the patentee is substantially new. Each of these ingredients may have been in the most extensive and common use, and some of them may have been used for matches, or combined with other materials for other purposes. But if they have never been combined together in the manner stated in the patent, but the combination is new, then, I take it, the invention of the combination is patentable." 1 Robb, 725 (729).

That a new union of old elements is

a new combination, see *Shaver v. Skinner Mfg. Co.* (1887), 41 O. G. 232; *Hoe v. Knap* (1886), 27 Fed. Rep. 204; 36 O. G. 1244; *May v. County of Fond du Lac* (1886), 27 Fed. Rep. 601; *Scott Mfg. Co. v. Sayre* (1885), 26 Fed. Rep. 153; 35 O. G. 255; *Bell v. U. S. Stamping Co.* (1884), 19 Fed. Rep. 312; 22 Blatch. 27; *Webster Loom Co. v. Higgins* (1882), 105 U. S. 580; 21 O. G. 2031; *Gottfried v. Crescent Brewing Co.* (1882), 18 Fed. Rep. 479; 22 O. G. 1447; *Gale Mfg. Co. v. Prutzman* (1880), 5 Bann. & A. 154; 17 O. G. 743; *Wisner v. Grant* (1880), 5 Bann. & A. 215; 17 O. G. 447; 7 Fed. Rep. 485; *Williams v. Rome, Watertown, & Ogdensburg R. R. Co.* (1879), 15 O. G. 653; 15 Blatch. 200; 3 Bann. & A. 413; *Willimantic Linen Co. v. Clark Thread Co.* (1879), 4 Bann. & A. 133; *Bates v. Coe* (1878), 98 U. S. 81; 15 O. G. 337; *Albright v. Celluloid Harness Trimming Co.* (1877), 12 O. G. 227; 2 Bann. & A. 629; *Booth v. Parks* (1874), 1 Flippin, 381; 1 Bann. & A. 225; *In re Gould* (1874), 1 MacArthur, 410; 5 O. G. 121; *Eickemeyer Hat Blocking Mach. Co. v. Pearce* (1873), 10 Blatch. 403; 3 O. G. 150; 6 Fisher, 219; *Child v. Boston & Fairhaven Iron Works Co.* (1873), 6 Fisher, 606; 5 O. G. 61; *Holmes*, 303; *Forsyth v. Clapp* (1873), 6 Fisher, 528; 4 O. G. 527; *Holmes*, 278; *Westlake v. Cartter* (1873), 6 Fisher, 519; 4 O. G. 636; *Watson v. Cunningham* (1871), 4 Fisher, 528; *Woodward v. Dinsmore* (1870), 4 Fisher, 163; *Woodman v. Stimpson* (1866), 3 Fisher, 98; *Emigh v. Chicago, Burlington, & Quincy R. R. Co.* (1863), 1 Bissell, 400; 2 Fisher, 387; *Latta v. Shawk* (1859), 1 Fisher, 465; 1 Bond, 259; *Whipple v. Middlesex Co.* (1859), 4 Fisher, 41; *Furbush v. Cook* (1857), 2 Fisher, 668; *Pitts v. Edmonds* (1857), 1 Bissell, 168; 2 Fisher, 52; *Carr v.*

tance.⁵ To unite them in a new means by the exercise of

Rice (1356), 1 Fisher, 198; *Pitts v. Wemple* (1855), 6 McLean, 558; *Crosby v. Lapournillo* (1854), Taney, 374; *Buck v. Hermance* (1849), 1 Blatch. 398; *Washburn v. Gould* (1844), 3 Story, 122; 2 Robb, 206; *Pitts v. Whitman* (1843), 2 Story, 609; 2 Robb, 189; *Earle v. Sawyer* (1825), 4 Mason, 1; 1 Robb, 490; *Pennock v. Dialogue* (1825), 4 Wash. 538; 1 Robb, 466; *Barrett v. Hall* (1818), 1 Mason, 447; 1 Robb, 207; *Evans v. Eaton* (1816), 1 Peters C. C. 322; 1 Robb, 68; *Harrison v. Anderston Foundry Co.* (1876), L. R. 1 App. 574; *Murray v. Clayton* (1872), L. R. 7 Ch. Ap. 570; *Cannington v. Nuttall* (1871), L. R. 5 H. L. 205; *Morton v. Middleton* (1863), 1 Cr. S. 3d Series, 721; *Lister v. Leather* (1858), 8 El. & B. 1004; *Bovill v. Keyworth* (1857), 7 El. & B. 725; *Cornish v. Keene* (1837), 3 Bing. N. C. 570; 2 Abb. P. C. 406; *Brunton v. Hawkes* (1821), 1 Carp. 410; 1 Abb. P. C. 336; *Patric v. Sylvester* (1876), 23 Grant Ch. (Can.) 573; *Emery v. Ise-dale* (1861), 11 Can. C. P. 106.

That in a combination of old elements other evidence of inventive skill than mere novelty and utility must appear, see *Enterprise Mfg. Co. v. Sargent* (1886), 28 Fed. Rep. 185; 37 O. G. 891.

That a combination of old elements may be a new invention, though many of them were combined in a similar device before, see *Donoughe v. Hubbard* (1886), 27 Fed. Rep. 742; 35 O. G. 1561.

That changes in the elements so as to enable them to enter into combination may be invention, see *Troy Laundry Mach. Co. v. Bunnell* (1886), 27 Fed. Rep. 810; 23 Blatch. 558.

⁵ In *McKesson v. Carndick* (1881), 21 O. G. 137; Blatchford, J.: (138) "It is also objected that there is no

combination between the comb-bar and needles and the pill-holder, but only an aggregation of parts. This is an erroneous view. The pill-holder holds the pill while the needle carried by the comb-bar is being thrust into the pill. The concert of action takes place when the needle enters the pill, and although such concert of action continues only from the time the needle enters the pill until the pill is removed by the needle from the holder, yet the combination made by such concert of action continues as long as it needs to continue, and the concert of action could not exist at all so as to impale the pill on the needle if the pill were not carried by the holder and the needle were not carried by the comb-bar. So, when the needle enters the pill, there is a combination or concert of action between the comb-bar and needle and the holder carrying the pill." 19 Blatch. 158 (161).

In *Hoffman v. Young* (1880), 14 Phila. 428, Butler, J.: (429) "The parts must combine in operation, and by their joint effect produce a new result. They need not act simultaneously. If so arranged that the successive action of each contributes to produce the result, which when obtained is the product of all the parts, viewed as a whole, a valid claim for this combination may be sustained. . . . By the term 'co-operate,' however, the courts do not mean, merely acting together, or simultaneously, but unitedly, to a common end — a unitary result. Each and every part must have its sub-function to perform, and each must have a certain relation to, and dependence upon, the other." 18 O. G. 794 (794); 2 Fed. Rep. 74 (77); 5 Ban. & A. 316 (318).

In *Furbush v. Cook* (1857), 2 Fisher, 668, Curtis, J.: (639) "To make a valid claim for a combination, it is not neces-

inventive skill is invention, and renders the combination, as an entirety, the subject-matter of a patent.

§ 156. Fact of Combination shown by its Result.

This union of elemental instruments or operations in a new operation or instrument must necessarily produce effects beyond the sum of the effects producible by all the elements in their separated state.¹ This is often the only test by which

sary that the several elementary parts of the combination should act simultaneously. If those elementary parts are so arranged that the successive action of each contributes to produce some one practical result, which result, when attained, is the product of the simultaneous or successive action of all the elementary parts, viewed as one entire whole, a valid claim for thus combining those elementary parts may be made."

Further, that the co-operation of the elements may be either successive or simultaneous, see *Railway Register Mfg. Co. v. Broadway & Seventh Ave. R. R. Co.* (1884), 22 Fed. Rep. 655 ; 30 O. G. 180 ; *Hoe v. Cottrell* (1880), 1 Fed. Rep. 597 ; 17 Blatch. 546 ; 18 O. G. 59 ; 5 Bann. & A. 256 ; *Herring v. Nelson* (1877), 14 Blatch. 293 ; 12 O. G. 753 ; 3 Bann. & A. 55 ; *Birdsall v. McDonald* (1874), 6 O. G. 682 ; 1 Bann. & A. 165.

That where one lock is set in motion by the injury done to another, it is a true combination, see *Newbury v. Fowler* (1886), 28 Fed. Rep. 454 ; 36 O. G. 817.

That if the elements coact for a time and then act separately it is a combination, see *McKesson v. Carndick* (1881), 21 O. G. 137 ; 19 Blatch. 158.

This doctrine reaches its present extreme limit in the case of the *Yale Lock Mfg. Co. v. Norwich National Bank* (1881), 19 Blatch. 123 ; 6 Fed. Rep. 377, where it is held that if two elements, when combined, produce only their separate results, but each result so

operates in connection with the other that a net result is obtained beyond what either could accomplish alone, or both could accomplish if separately used, there is co-operation and a true combination.

That elements acting successively and independently are not a combination, see *Yale Lock Mfg. Co. v. Berkshire Nat. Bank* (1883), 17 Fed. Rep. 531 ; (denying *Lock Case*, 6 Fed. Rep. 377 ; 19 Blatch. 123 *ante*).

That dies used in succession and each doing its own work only are not a combination, see *Becher Mfg. Co. v. Atwater Mfg. Co.* (1885), 114 U. S. 523 ; 31 O. G. 1306.

§ 156. ¹ It is frequently stated in the decisions of the courts that no new combination can be produced unless its result or effect be also new. This is to be understood as referring to the effect of the combination as compared with the effect of its elements in their separate or aggregated state, not as compared with the effect of other combinations of the same or different elements. It is true that no combination can have been invented unless it is capable of producing effects beyond those resulting from the use of any or all the elements in their separated state. But it is not true that the same elements cannot be grouped into different combinations, governed by different co-operative laws, although their practical effect as arts or instruments may be the same. The decisions are to be read with this distinction in mind.

In *Niles Tool Works v. Betts Ma-*

a combination can be distinguished from an aggregation, and is the one usually applied by the courts. And it is certainly

chino Co. (1886), 27 Fed. Rep. 301, Wales, J. : (305) "The propositions established by these cases are that a combination is patentable (1) if it produces new and useful results, though all the constituents of the combination were well known and in common use before the combination was made, provided the results are a product of the combination, and not a mere aggregate of several results, each the product of one of the combined elements ; (2) if it produces a different force, effect, or result in the combined forces or processes from that given by their separate parts, and a new result is produced by their union ; (3) if it either forms a new machine of distinct character or formation, or produces a result which is not the mere aggregate of separate contributions, but is due to the joint and co-operating action of all the elements ; (4) when the several elements of which it is composed produce, by their joint action, *either a new and useful result, or an old result in a cheaper or otherwise more advantageous way.* . . . These are but varied expressions of the same doctrine."

In *Loom Co. v. Higgins* (1882), 105 U. S. 580, Bradley, J. : (591) "It may be laid down as a general rule, though perhaps not an invariable one, that if a new combination and arrangement of known elements produce a new and beneficial result, never attained before, it is evidence of invention." 21 O. G. 2031 (2035).

In *Slawson v. Grand St., Prospect Park, & Flatbush R. R. Co.* (1880), 4 Fed. Rep. 531, Benedict, J. : (534) "In order to constitute a patentable combination, the result must be some effect different from the effect of the separate parts, and produced by the combined forces. A new result must arise from the reunion of the elements of the com-

bination, and not simply from the separate action of each element." 17 Blatch. 512 (515).

In *Williams v. The Rome, Watertown, & Ogdensburg R. R. Co.* (1879), 15 O. G. 653, Blatchford J. : (656) "The doctrine of *Hailes v. Van Wormer* (20 Wall. 353) is, that a mere combination, if it produces new and useful results, is patentable, though all the constituents of the combination were well known and in common use before the combination was made ; that the results, however, must be a product of the combination, and not a mere aggregate of several results, each the complete product of one of the combined elements ; that merely bringing old devices into juxtaposition, and then allowing each to work out its own effect without the production of something novel, is not invention ; and that no one, by bringing together several old devices without producing a new and useful result, the joint product of the elements of the combination, and something more than an aggregate of old results, can acquire a right to prevent others from using the same devices, either singly or in other combinations." 15 Blatch. 200 (211) ; 3 Hann. & A. 413 (423).

In *Hailes v. Van Wormer* (1873), 20 Wall. 353, Strong, J. : (368) "But the results must be a product of the combination, and not a mere aggregate of several results each the complete product of one of the combined elements. Combined results are not necessarily a novel result, nor are they an old result obtained in a new and improved manner. Merely bringing old devices into juxtaposition, and then allowing each to work out its own effect without the production of something novel, is not invention. No one by bringing together several old devices without pro-

reliable. For since diversity of end necessitates diversity of means, if the new combination accomplishes results that could not have been achieved either by its individual or collective

ducing a new and useful result the joint product of the elements of the combination and something more than an aggregate of old results, can acquire a right to prevent others from using the same devices, either singly or in other combinations, or, even if a new and useful result is obtained, can prevent others from using some of the devices, omitting others, in combination." 5 O. G. 89 (90).

That no combination is a new invention unless it presents a new force, or effect, or result, see *Sawyer v. Miller* (1882), 4 Woods, 472; 12 Fed. Rep. 725; *Reckendorfer v. Faber* (1876), 92 U. S. 347; 10 O. G. 71.

That a combination is patentable only when its elements produce by their joint action a new and useful effect, or an old effect in a better or cheaper manner, see *Railway Register Mfg. Co. v. North Hudson Co. R. Co.* (1886), 26 Fed. Rep. 411; *Railway Register Mfg. Co. v. North Hudson Co. R. Co.* (1885), 24 Fed. Rep. 793; 83 O. G. 355; *Stephenson v. Brooklyn R. R. Co.* (1885), 114 U. S. 149; 31 O. G. 263.

For other cases in which the novelty of the result is stated to be an essential characteristic of the new combination, see *Millner v. Voss* (1882), 4 Hughes, 262; *Simpson v. Davis* (1882), 20 Blatch. 413; 12 Fed. Rep. 144; *Ex parte Fisher* (1881), 20 O. G. 957; *Ex parte Skinner* (1881), 19 O. G. 662; *Packing Co. Cases* (1881), 105 U. S. 566; 21 O. G. 1689; *Ex parte Strong* (1880), 17 O. G. 446; *Slawson v. Grand St. Prospect Park, & Flatbush R. R. Co.* (1880), 17 Blatch. 512; 4 Fed. Rep. 531; *Sharp v. Tift* (1880), 17 O. G. 1282; 2 Fed. Rep. 697; 18 Blatch. 132; 5 Bann. & A. 399; *Double Pointed Tack*

Co. v. The Two Rivers Mfg. Co. (1880), 18 O. G. 683; 9 Bissell, 258; 3 Fed. Rep. 26; *Gottfried v. Philip Best Brewing Co.* (1879), 17 O. G. 675; 5 Bann. & A. 4; *Webster Loom Co. v. Higgins* (1879), 16 O. G. 675; 15 Blatch. 446; 4 Bann. & A. 88; *Alcott v. Young* (1879), 16 Blatch. 134; 16 O. G. 403; 4 Bann. & A. 197; *Williams v. Boston & Albany R. R. Co.* (1879), 16 O. G. 906; 17 Blatch. 21; 4 Bann. & A. 441; *Kerosene Lamp Heater Co. v. Littell* (1878), 13 O. G. 1009; 3 Bann. & A. 312; *Reckendorfer v. Faber* (1876), 92 U. S. 347; 10 O. G. 71; *Reckendorfer v. Faber* (1874), 12 Blatch. 68; 5 O. G. 697; 1 Bann. & A. 229; *Gallahue v. Butterfield* (1872), 10 Blatch. 232; 2 O. G. 645; 6 Fisher, 203; *Sarven v. Hall* (1872), 1 O. G. 437; 9 Blatch. 524; 5 Fisher, 415; *Woodward v. Dinsmore* (1870), 4 Fisher, 163; *Swift v. Whisen* (1867), 2 Bond, 115; 3 Fisher, 343; *Saxby v. The Gloucester Wagon Co.* (1881), L. R. 7 Q. B. 305; *Cannington v. Nuttall* (1871), L. R. 5 H. L. 205.

That on the other hand this new result need not be new with reference to other combinations even of the same elements, see *Allis v. Buckstaff* (1882), 18 Fed. Rep. 879; 22 O. G. 1705; *Pattee v. Moline Plow Co.* (1881), 10 Bissell, 377; 9 Fed. Rep. 821; 22 O. G. 173; *Detroit Lubricator Mfg. Co. v. Renchard* (1881), 9 Fed. Rep. 293; *Murray v. Clayton* (1872), L. R. 7 Ch. Ap. 570; *Curtis v. Platt* (1864), 11 L. T. Rep. N. s. 245.

That an alleged combination, if not operative without additions not covered by the combination as described, is not an invention, see *Tarrant v. Duluth Lumber Co.* (1887), 30 Fed. Rep. 830.

elements, their union must inevitably have brought into action some new or as yet unawakened energy, which constitutes a new and independent means.²

² Although the characteristics of a combination, as distinguished from a simple invention, will hereafter more clearly appear, their statement in a few general propositions may be appropriate:—

1. A combination is a union of elemental means in a mode of co-operation; and, as such, it necessarily performs functions into which all its elements enter as operative agents, and produces results which depend upon the presence and action of every one of the elements combined.

2. A combination may result either from mechanical ingenuity and experiment or from the exercise of inventive skill; in the latter case only is it an invention, and the subject-matter of a patent.

3. A combination may be composed of elements wholly new, or wholly old, or partly new and partly old; in every case the combination is a means distinct from the elements, whether new or old, and is the proper subject for a different patent; or, if the elements are new inventions of the same inventor, for a different claim in the same patent.

4. Combinations belong to the same legal class as their elemental means; the co-operative union of elemental arts

forming a new art; that of elemental machines, a new machine, etc.; the union of elements of different classes, where such union is possible (as of a manufacture with a machine), not being a true combination, but an improvement on the principal invention with which the subordinate is united.

5. The identity of a combination depends upon that of its elemental means and that of the co-operative law under which its elements are united; any substantial change in either means or law destroying its identity and resulting in the final segregation of the elements or in a new and wholly different combination.

6. This dependence of the identity of a combination upon the identity both of its elements and of their co-operative law requires a departure from the rules governing simple inventions upon several points, especially in relation to *Equivalents, Double Use, &c.*

7. A patented combination is the combination described and claimed in the patent; i. e., it is composed of the described elements coacting under the described co-operative law, whether or not such description correctly enumerates the true elements or sets forth the real mode of their co-operation.

CHAPTER II.

OF THE CLASSES OF PATENTABLE INVENTIONS.

**§ 157. Patentable Invention an Operation or an Instrument:
"Operation" and "Instrument" Defined.**

EVERY invention in the industrial arts is either an operation or an instrument. An operation is an idea of means, embodied in some act or series of acts which is performed by some physical agent either animate or inanimate. An instrument is an idea of means, embodied in some article or combination of articles which, when employed in the manner designed by the inventor, is capable of producing a certain predetermined effect. In an operation the embodiment of the idea is temporary; the conception of the mind being apparent to the senses only while the means is actually accomplishing its ends. In an instrument, on the contrary, the embodiment of the idea is permanent; the conception of the mind being an object of perpetual observation, though often less clearly apprehended by the observer when the instrument is idle than when it is engaged in the performance of its appropriate functions. This difference between an operation and an instrument is essential, and results in some important variations in the rules by which the completeness and patentability of each is to be determined. To one or the other, however, all inventions must belong, and it has been the object of the Patent Laws, both of England and of the United States, to afford the protection of a patent to every improvement in the industrial arts which could properly be included under either of these two heads.

§ 158. Classes of Patentable Operations and Instruments.

Many attempts have been made by the English courts and writers to arrange subordinate classes, to some one of which

each individual invention might be referred. The statute of James I. embraces all under the term, "Manufacture;" but by the application of various definitions, literal and figurative, to this term it has been extended to include almost every possible species of improvement in the arts. In the United States the classification given in the acts of Congress is, perhaps, as complete as the subject will permit. Under the name "Art" it comprises every kind of operation, and divides instruments into four groups: "Machines," "Manufactures," "Compositions of Matter," and "Designs."¹

SECTION I.

OF AN ART.

§ 159. "Art" Defined.

An art or operation is an act or a series of acts performed by some physical agent upon some physical object, and producing in such object some change either of character or of condition. It is also called a "process," or a "mode of treatment;" and is said to require that "certain things should be done with certain substances in a certain order."¹ It is so far abstract that it is capable of contemplation by the mind apart from any one of the specific instruments by which it is per-

§ 158. ¹ In *Ex parte Blythe* (1884), 30 O. G. 1321, Butterworth, Com. : (1822). "It is evident that the words 'art,' 'machine,' 'manufacture,' and 'composition of matter,' were carefully chosen to cover what were regarded as four great and distinct classes of inventions. It is undoubtedly the intention of the law to distinguish as separate inventions 'a new art,' 'a new machine,' 'a new manufacture,' 'a new composition of matter,' 'an improved art,' 'an improved machine,' 'an improved manufacture,' 'an improved composition of matter,' — eight in all. These may be called the 'statutory classes of invention,' between

which the lines of division are sharply drawn."

§ 159. ¹ In *Cochrane v. Deener* (1876), 94 U. S. 780, Bradley, J. : (788) "A process is a mode of treatment of certain materials to produce a given result. It is an act, or series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing. If new and useful, it is just as patentable as is a piece of machinery. In the language of the patent law, it is an art. The machinery pointed out as suitable to perform the process may or may not be new or patentable; while the process itself may be altogether new, and produce an en-

formed.² It is so far concrete that it consists in the application of physical force through physical agents to physical objects, and can thus become apparent to the senses only in connection with some tangible instrument and object.

§ 160. Patentability of an Art formerly Denied: not a "Vendible Substance."

This abstract character of an art was the occasion of much difficulty in the earlier development of Patent Law. Some of the English authors and judges held that an invention, to be useful to the public, must be a "vendible substance;" that unless a new mode of operation created a new "substance" its inventor had conferred no benefit upon the public and was not entitled to a patent; and that whenever a new operation

tirely new result. The process requires that certain things should be done with certain substances, and in a certain order; but the tools to be used in doing this may be of secondary consequence." 11 O. G. 687 (689).

That an art is "the application or operation of some element or power of nature or of one subject to another," see *Boyd v. Cherry* (1883), 4 McCrary, 70.

In *Corning v. Burden* (1853), 15 How. 252, Grier, J. : (267) "A process, *eo nomine*, is not made the subject of a patent in our act of Congress. It is included under the general term 'useful art.' An art may require one or more processes or machines in order to produce a certain result or manufacture. The term machine includes every mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result. But where the result or effect is produced by chemical action, by the operation or application of some element or power of nature, or of one substance to another, such modes, methods, or operations, are called processes. A new process is usually the result of discovery; a machine, of invention. The arts of tanning, dyeing, making water-

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

² That a patentable process must have an existence independent of the apparatus which performs it, see *Ex parte Herr* (1887), 41 O. G. 463.

That where the function of a machine cannot exist apart from that machine it cannot be a process, see *Ex parte Herr* (1887), 41 O. G. 463.

That the entirely separate action of two machines, each performing its independent function, may not be a process, see *Ex parte Herr* (1887), 41 O. G. 463.

had resulted in a new substance the patentable invention was the substance, and not the operation by which it was produced.¹ This error had its origin in a confusion of the idea

§ 160. ¹ The doubt whether a process or art was the subject of a patent found perhaps its fullest and most pointed expression in the case of *Boulton and Watt v. Bull* (1795), 2 H. Bl. 463. Watt had invented a method of lessening the consumption of steam, and consequently of fuel, in engines. This method consisted in a mode of employing existing machines, not in the creation of a new machine nor in the production of any new vendible substance. He described his method as composed of certain "principles." This invention was eventually held to be patentable (*Hornblower v. Boulton* (1799), 8 T. R. 95); but in their opinions in the first case the dissenting judges advanced objections and stated doctrines which for a long time found adherents in the bar and on the bench. Thus Heath, J.:

(481) "What then falls within the scope of the proviso [stat. Jac. I.]? Such manufactures as are reducible to two classes. The first class includes machinery, the second substances, (such as medicines), formed by chemical and other processes, where the vendible substance is the thing produced, and that which operates preserves no permanent form. In the first class the machine, and in the second the substance produced, is the subject of the patent. . . . (482) That which is the subject of the patent . . . ought to be that which is vendible, otherwise it cannot be a manufacture. . . . I asked in the argument for an instance of a patent for a *method*, and none such could be produced. I was then pressed with patents for chemical processes, many of which are for a *method*, but that is from an inaccuracy of expression, because the patent in truth is for a vendible substance." 1 Abb. P. C. (76). And Buller, J.:

(486) "The method and the mode of doing a thing are the same; and I think it impossible to support a patent for a method only, without having carried it into effect and produced some new substance. But here it is necessary to enquire, what is meant by a principle reduced into practice. It can only mean a practice founded on principle, and that practice is the thing done or made, or in other words the manufacture which is invented. . . . In most of the instances of the different patents mentioned . . . the patents were for the manufacture, and the specification rightly stated the method by which the manufacture was made; but none of them go the length of proving, that the method of doing a thing without the thing being done, or actually reduced into practice, is a good foundation for a patent. When the thing is done or produced, then it becomes the manufacture which is the proper subject of a patent." 1 Abb. P. C. (81). Lord Chief Justice Eyre, taking a broader view, held that a method, as such, was patentable, and says: (492) "It was admitted in the argument at the bar, that the word 'manufacture' in the statute, was of extensive signification, that it applied not only to things made, but to the *practice of making*, to principles carried into practice in a new manner, to new results of principles carried into practice. Let us pursue this admission. Under *things made*, we may class in the first place, new compositions of things, such as manufactures in the most ordinary sense of the word: secondly, all mechanical inventions, whether made to produce old or new effects, for a new piece of mechanism is certainly a thing made. Under the *practice of making*, we may class all new artificial manners

of end with that of means. The true and ultimate benefit which the public derive from any invention resides in the

of operating with the hand, or with instruments in common use, new processes in any art, producing effects useful to the public. When the effect produced is some new substance or composition of things, it should seem that the privilege of the sole working or making, ought to be for such new substance or composition, without regard to the mechanism or process by which it has been produced, which though perhaps also new, will be only useful as producing the new substance. . . . (493) When the effect produced is no substance or composition of things, the patent can only be for the mechanism, if new mechanism is used, or for the process, if it be a new method of operating, with or without old mechanism, by which the effect is produced. . . . (494) In the list of patents with which I have been furnished, there are several for *new methods* of manufacturing articles in common use, where the sole merit and the whole effect produced are the saving of time and expense, and thereby lowering the price of the article, and introducing it into more general use. Now I think these *methods* may be said to be *new manufactures*, in one of the common acceptations of the word, as we speak of the manufactory of glass, or any other thing of that kind. . . . The patent cannot be for the effect produced, for it is either no substance at all, or what is exactly the same thing as to the question upon a patent, no new substance, but an old one, produced advantageously for the public. It cannot be for the mechanism, for there is no new mechanism employed. It must then be, for the method; and I would say, in the very significant words of Lord Mansfield in the great case of the copyright [Miller v. Taylor (1769), 4 Burr. 2397], it must be for *method*

[idea] detached from all physical existence whatever. . . . I believe I might say three fourths of all patents granted since the statute passed, are for *methods of operating* and of manufacturing, producing no new substances and employing no new machinery. . . . (495) An improper use of the word *principle* in the specification set forth in this case, has I think served to puzzle it. Undoubtedly there can be no patent for a mere principle; but for a principle so far embodied and connected with corporeal substances, as to be *in a condition to act*, and to *produce effects* in any art, trade, mystery, or manual occupation, I think there may be a patent. Now this is, in my judgment, the thing for which the patent stated in the case was granted, and this is what the specification describes, though it *miscalls it a principle*. It is not that the patentee has conceived an abstract notion, that the consumption of steam in fire engines may be lessened, but he has discovered a *practical manner* of doing it; and for that *practical manner of doing it* he has taken his patent. Surely this is a very different thing from taking a patent for a principle, it is *not for a principle*, but *for a process*." 1 Abb. P. C. (87, 88, 89, 91). Rooke, J., supported his decision upon the theory that every new method of employing existing instruments presupposes some change in their construction. He says: (478) "What method can there be of saving steam or fuel in engines, but by some variation in the construction of them? A *new invented method* therefore conveys to my understanding, the idea of a *new mode of construction*. I think those words are tantamount to *fire engines of a newly invented construction*; at least I think they will bear this meaning, if they do not necessarily

end accomplished, not in the means employed, — in that changed condition of affairs in which the want ceases, not in

exclude every other." 1 Abb. P. O. (72). Heath and Buller, JJ., deciding against the patent, and Eyre, C. J., and Rooke, J., in its favor, though each on different grounds, the case itself was left undetermined. The same patent, however, came before King's Bench in 1799, in the case of *Hornblower et al. v. Boulton et al.* (8 T. R. 95), when the patent was sustained. The judges, in rendering their opinions, take various positions, not harmonious with each other except as to the result. Lord Kenyon, C. J., says: (99) "This is a patent for a manufacture, which I understand to be something made by the hands of man." Ashurst, J., assents without giving any reason other than the utility of the invention. Grose, J., says: (103) "He [the patentee] specifies the particular parts requisite to produce the effect intended, and states the manner how they are to be applied. . . . Can it then be said that the making and combining of these parts is not some manner of new manufacture? . . . I do not consider it as a patent for the old engine, but only for the addition to or improvement of the old engine. . . . (104) A patent cannot be granted for a mere principle; but I think that, although in words the privilege granted is to exercise a method of making or doing anything, yet if that thing is to be made or done by a manufacture, and the mode of making that manufacture is described, it then becomes in effect, (by whatever name it may be called), not a patent for a mere principle but for a manufacture, for the thing so made, and not merely for the principle upon which it is made." Lawrence, J., considers the patent, (106) "a patent for an engine or mechanical contrivance for lessening the consumption of steam in fire engines;" and construing the

word "method" in the patent, says: "Engine and method mean the same thing and may be the subject of a patent. 'Method,' properly speaking, is only placing several things and performing several operations in the most convenient order: but it may signify a contrivance, or device; so may engine, and therefore I think it may answer the word 'method.'" In the King's Bench it will be seen that none of the judges followed the doctrine given by Eyre, C. J., in the former case, — a doctrine certainly correct and founded in the nature of things, but apparently inappreciable by minds in which the idea of a vendible substance had become identified with that of a "manufacture." 1 Abb. P. C. 98 (100, 104, 107, 108).

The same doubt is apparent in several subsequent cases and until a comparatively recent period. Thus in *Rex v. Wheeler* (1819), 2 B. & Ald. 845, Abbott, C. J., speaks of a process as follows: (349) "Now the word 'manufacture' has been generally understood to denote either a thing made, which is useful for its own sake, and vendible as such . . . or an engine or instrument. . . . (350) Or it may perhaps extend also to a new process to be carried on by known implements," &c. 1 Abb. P. C. 317 (321). The whole opinion in this case is permeated with the same conjectural tone.

In *Crane v. Price* (1842), 1 Web. 393, Tindal, C. J.: (409) "We are of opinion, that if the result produced by such a combination is either a new article, or a better article, or a cheaper article to the public, than that produced before by the old method, that such combination is an invention or manufacture intended by the statute, and may well become the subject of a patent. Such an assumed state of facts falls

the instrument or operation by which this change has been effected; and the real merit of every inventor thus consists, not in his invention of the means, as such, but in his removal or supply of the public want through the instruments or operations which he has invented. Now if the subject-matter of

clearly within the principle exemplified by Abbott, C. J. (*Rex v. Wheeler*, 2 B. & Ald. 349), where he is determining what is or what is not the subject of a patent, namely, it may, perhaps, extend to a new process to be carried on by known implements or elements acting upon known substances, and ultimately producing some other known substance, but producing it in a cheaper or more expeditious manner, or a better or more useful kind. . . . There are numerous instances of patents which have been granted, where the invention consisted in no more than in the use of things already known, and acting with them in a manner already known, and producing effects already known, but producing those effects so as to be more economically or beneficially enjoyed by the public."

In *Gibson v. Brand* (1842), 1 Web. 631, Tindal, C. J.: (633) "Undoubtedly there is a very strong reason to suppose, if the specification is carefully and properly prepared, so as to point out, with great distinctness and minuteness, what the process is, that such a patent may be good in law." The other judges (Erskine and Cresswell) speak in the same doubtful manner. The latter says: (639) "This patent right, as explained by the counsel for the plaintiffs, is undoubtedly of a very singular character. The plaintiffs do not claim any article produced by the process, they do not claim the machinery used in producing it, nor do they claim any ingredient used in producing it. They claim, it is said, merely a process. Certainly, there are dicta in the books, that a process may be the subject-matter of a pat-

ent. Whenever that question arises, of course, I shall be prepared to give it every consideration, and form the best judgment I can upon it."

In *Crossley v. Potter* (1853), Maccrory's P. C. 240, Pollock, C. B.: (244) "It is very true that patents are continually taken out for what are called 'methods' or 'processes;' but the real object of the patent, the real end that is secured by the statute, the matter that is alone mentioned in it capable of being made the subject of a patent, is a new manufacture; and everybody who takes out a patent under the name of a process, really takes it out for that which is the result of the process, for the thing that is manufactured, or the process by which it is produced."

Mr. Godson, in discussing the patentability of a process in the light of the principles of Patent Law as then understood and of the cases then decided, thus writes in 1822: (79) "A patent, when it is said to be for a method, cannot be supported, unless the thing invented is a substance or machine. . . . (80) A patent must be for a vendible matter. . . . (88) In other words, though the patent is for *something called* a method, yet the *real subject* of the grant is either a substance, machine, improvement or combination. . . . (94) When an inventor obtains a patent for a new method, if he does not give to the world some new and useful substance, or machine, something material and tangible, the grant is invalid."

To the same effect see *Coryton*, 65-80, where the non-patentability of a process, as such, is strongly argued and the cases considered.

the patent were the end, as distinguished from the means, inasmuch as the end consists in the changed condition of material objects, the invention must be a material object in its changed condition, and the doctrine above stated would have been correct. But since the invention is the means and not the end, and since an end resulting from a means which becomes tangible only when in actual operation is as conducive to the public welfare as an end whose means is permanently apparent to the senses, both forms of means are equally useful to the public, and the inventor of the one deserves the same reward, encouragement, and protection as the inventor of the other.

§ 161. Patentability of an Art formerly Denied; Confounded with the Force which it Applies.

From the same characteristic of an art arose the further error that its protection by a patent must involve the grant of an exclusive right to the principle or force which it employs.¹ An art, considered apart from the specific physical agent by which it is performed, is simply a force in operation ;

§ 161. ¹ This objection to a process as patentable subject-matter appears, like the former (§ 160), in *Boulton and Watt v. Bull* (1795), 2 H. Bl. 463. Thus Buller, J. : (486) "I think it impossible to support a patent for a method only without having carried it into effect and produced some new substance. But here it is necessary to enquire what is meant by a principle reduced into practice. It can only mean a practice founded on principle, and that practice is the thing done or made or in other words the manufacture which is invented." Eyre, C. J., grasping the real truth of the matter, denied this, and stated the now universally received doctrine that (495) "a principle so far embodied and connected with corporeal substances as to be in a condition to act and to produce effects is patentable." 1 Abb. P. C. 59 (81, 91). But in *Hornblower v. Boulton* (1799), 8 T. R. 95,

Grose, J., reiterated the old idea and said (104): "A patent cannot be granted for a mere principle ; but I think that, although in words the privilege granted is to exercise a method of making or doing anything, yet if that thing is to be made or done by a manufacture, and the mode of making that manufacture is described, it then becomes in effect (by whatever name it may be called), not a patent for a mere principle but for a manufacture, for the thing so made, and not merely for the principle upon which it is made." 1 Abb. P. C. 97 (107).

The portions of Godson and of Coryton, referred to in the notes to § 160, *ante*, are also pervaded with the same notion, and further citations may be found in the notes to §§ 134-143, *ante*, where the patentability of a principle is considered.

and since a force in operation, unless applied to physical objects through tangible instruments contrived by man, must either be the force itself, as it exists and operates in nature, or be entirely without physical effects, it was assumed that the inventor of an art was merely the discoverer of the natural operative force, unless he also had devised the instruments through which the force was practically applied. The difficulty here proceeded from the failure to discern the character of the inventive act, and to distinguish between the three subordinate ideas which enter into the complete idea of means. The force, as it exists in nature, acts upon certain objects, and through certain instruments, and in a certain manner. In this condition it is a true subject of discovery, and of discovery only. But to bring other objects under its influence, or to change its mode of operation by applying it in other methods or through other instruments, is not the mere discovery and employment of the natural force in its natural operation for additional and cognate purposes, but is an inventive act resulting in the creation of new means, whether the objects, the modes of application, or the instruments in themselves be new or old. To grant a patent for such a means is not to grant a patent for a principle; nor does the exclusive right to use the force in this specific manner or upon this specific object constitute a wider privilege in the inventor, in relation to the natural force itself, than if the instruments through which he applies the force, or the object upon which it is directed, were made the subject-matter of the patent.

§ 162. Patentability of an Art finally Conceded.

The logical consequences of these errors were too momentous to allow them to remain long uncorrected. If rigorously maintained they would have excluded from the protection of a patent every exercise of inventive skill which did not result in some new vendible substance; and since several of the most important and valuable inventions, whose patentability was controverted in the courts, consisted of new processes and operations performed by well-known instruments, the judges were driven to the alternative of repudiating these

ancient theories, or of denying to the most meritorious of inventors those privileges which the spirit of the law would have certainly conferred upon them.¹ In this emergency, closer attention was devoted to the real nature of the inventive act and to the grounds on which the claims of the inventor rest; and after various struggles with the language of the law, as contained in the statutes and in previous decisions, the doctrine was established that a new "mode of operating," or a "manner of making," was equally patentable with an operating instrument or an object made.

§ 163. Patentability of an Art always Recognized in the United States.

In the Patent Law of the United States no such problems have arisen. Our earliest statute recognized an art as a true operative means, and as having the same title to protection as a machine or an article of manufacture.¹ In the endeavors of

§ 162. ¹ The first person to definitely assert and attempt to prove that an application of force was patentable, without reference to the particular apparatus used or results produced, was Lord Chief Justice Eyre, in *Boulton v. Bull* (1795), 2 H. Bl. 463. 1 Abb. P. C. 59. The tardiness and hesitation with which his example was followed by later judges may be seen in the opinions quoted in notes to §§ 160, 161, *ante*. That the doctrine is now settled on the proper basis in England is apparent from *Hills v. London Gas Light Co.* (1860), 5 H. & N. 312; *Ralston v. Smith* (1865), 11 H. L. 222.

For further cases on the same subject see *Hall v. Jarvis* (1822), 1 Web. 100; 1 Abb. P. C. 363; *Russell v. Cowley* (1832), 1 Web. 457; *Heath v. Unwin* (1844), 2 Web. 218; *Steiner v. Heald* (1851), 6 Exch. 607; *Wallington v. Dale* (1852), 7 Exch. 888; *Booth v. Kennard* (1856), 1 Hurl. & N. 527; *Higgs v. Godwin* (1858), E. B. & E. 529; *Young v. Fernie* (1864), 4 Giff.

577; *Simpson v. Holliday* (1865), 11 L. T. N. S. 99; in which the history and development of the doctrine may be traced.

§ 163. ¹ In *New Process Fermentation Co. v. Maus* (1884), 20 Fed. Rep. 725, Drummond, J.: (728) "It is well known that the term 'process' is not used in the statute, but it has been uniformly held that there may be a patent for a process, because it is regarded as an art, which is a word used in the statute. But it must be confessed that it is often one of the most difficult questions to decide, in the practical application of claims made in a patent, what is a process which may be the subject of a patent. To illustrate and prove this, it is only necessary to refer to the case of *Mitchell v. Tilghman*, 19 Wall. 287, which was most elaborately argued and fully considered, and where a majority of the court held that although the manufacture of fat acids and glycerine from fatty or oily substances by the action of water at a high temperature and pressure was a process, yet that the patentee was

the courts to define or describe it, and to draw the line between it and its principle or force on one side, and the instru-

limited to the particular method or means of applying highly-heated water under pressure, pointed out in the specifications, although the claim was on its face broader than that, and to the case of *Tilghman v. Proctor*, 102 U. S. 707, where the same patent was in question, and where the court held that it was a patent for a process, irrespective of the particular mode or form of apparatus for carrying it into effect. If, then, we now consider this last case in connection with one of the first cases decided by the Supreme Court, (*Corning v. Burden*, 15 How. 252), and some of the intervening cases where patents have been sustained for a process, we ought to be able to determine the rule established by that court as to what is a process for which a patent can issue. In *Corning v. Burden* the court said that one might discover a new and useful improvement in the process of dyeing, tanning, &c., irrespective of any particular form of machine or mechanical device, and another might invent a labor-saving machine, by which the same process might be performed, and each might be entitled to his patent; that one by exposing India rubber to a certain degree of heat, in mixture or connection with certain metallic salts, might produce a valuable product and be entitled to a patent for his discovery as a process or improvement in the art, irrespective of mechanical devices. And another might invent a furnace or stove, or some apparatus by which the same process might be carried on with a saving of labor and of expense, and he would be entitled to a patent for his machine as an improvement in the art, and yet one could not have a patent for a machine, nor the other for a process. Each would be entitled to a patent for the method of producing certain results, but not for the result itself. And the court further

stated that it was when the term 'process' was used to represent the means of producing a result that it was patentable, and it would include all methods or means not effected by mechanism. This definition is intelligible. A part of it, but not the whole, is cited in *Tilghman v. Proctor*. In *Corning v. Burden* the court held that Burden had not discovered any new process, but a new machine or combination of mechanism by which the result was produced. In *McClurg v. Kingsland*, 1 How. 202, where the only change made in the method of casting iron rolls was by directing the metal into the mould, when in a liquid state, at a tangent, the patent was sustained, although there does not seem to have been much discussion directly upon the patentability of the claim. All that was done in that case was simply to change the direction of the tube which carried the metal into the mould, the old method being to convey it from the furnace to the mould in a horizontal or perpendicular direction. In *Mowry v. Whitney*, 14 Wall. 620, and *Tilghman v. Proctor*, *supra*, the court sustained the claim in each as a patent for a process. In the latter case, the court says that the patent law is not confined to new machines and new compositions of matter, but extends to any new or useful art and manufacture, and that a manufacturing process is an art. Goodyear's patent was for a process; namely, vulcanizing India Rubber. The apparatus for performing the process was not material, and was not patented, and the court then refers to Neilson's English patent. Neilson's patent was for the discovery, which he made, of applying a blast of hot air, instead of cold, to a smelting furnace, and for describing a method by which that was accomplished, that

ments which it employs upon the other, some ambiguity in the use of language has necessarily occurred ; but this is dis-

method not being material, and the court declares that Neilson's patent was sustained as a process patent, and quotes the language of the Court of Exchequer, 'that the plaintiff did not merely claim a principle, but a machine embodying a principle, and a very valuable one ;' and also the language of Lord Campbell, in the House of Lords, that 'the patent must be taken to extend to all machines, of whatever construction, whereby the air is heated intermediately between the blowing apparatus and the blast furnace;' and therefore it was unnecessary to compare one apparatus with another. The court, in *Tilghman v. Proctor*, also quotes the language of Chief Justice Taney in *O'Reilly v. Morse*, 15 How. 112, where he says, in commenting on Neilson's Case, 8 M. & W. 806, — 'That the manner in which air might be heated was immaterial. His patent was supported because he (Neilson) had invented the mechanical apparatus by which the current of hot air could be thrown in. The interposition of a heated receptacle in any form was the novelty he invented.' And, after quoting still further from the opinion of the Chief Justice in *O'Reilly v. Morse*, the court states : 'It seems to us that this clear and exact summary of the law affords the key to almost every case that can arise. "Whoever discovers that a certain useful result will be produced in any art by the use of certain means, is entitled to a patent for it, provided he specifies the means." It is very certain that the means need not be a machine or an apparatus ; it may be, as the court says, a process. A machine is a thing. A process is an act or mode of acting. . . . The mixing of certain substances together, or the heating of a substance to a certain temperature, is a process. If the mode of doing it, or the apparatus in or by

which it may be done, is sufficiently obvious to suggest itself to persons skilled in the particular art, it is enough in the patent to point out the process to be performed, without giving supererogatory directions as to the apparatus or method to be employed.' The majority of the court in *O'Reilly v. Morse* refused to sustain the eighth claim of Morse, because he disavowed the specific machinery or means mentioned, but claimed the use of the motive power of the electric current, however developed ; and this was held to be a principle simply. There has always been some difference of opinion as to the true grounds upon which this rejection of the eighth claim of Morse was placed, it being maintained by some that Morse was not entitled to have a patent including all applications of what he termed electro-magnetism in the transmission of words, letters, and signs, but only his own particular application. It has been uniformly held that a patent for a mere principle, or what is sometimes called a law of nature, cannot be sustained ; but in all the cases referred to, from the Neilson to the Tilghman patent, the law or laws of nature discovered were utilized, and it is said that in giving this construction to principle and process, a patent for a process leaves the field open to future inventors ; whereas a patent for a principle or law of nature would give a monopoly to the person making that discovery. So that the rule established by the Supreme Court is said to be that the patent for a process will include every application of the principle that involves the use of the process described and claimed by the patentee, and this does not include the particular machine or apparatus described by the patentee, but the mode of operation which is carried out by means of the apparatus. Walk. Pat. § 14. In

appearing as the nature of the inventive act, and the relation of the end accomplished to the means applied, become more

Neilson's Case the defendant did not use the means employed by Neilson in throwing the hot air into the smelting furnace, for it was admitted he used a better device ; but it was assumed that when once the idea existed in the mind of the superiority of a hot-air blast to a cold one, any person skilled in smelting could devise his own mode of introducing the hot air to the furnace. And see *Cochrane v. Deener*, 94 U. S. 780, and *Rubber Co. v. Goodyear*, 9 Wall. 796. It is to be regretted that the difficulty inherent in the subject is so great that a more intelligible distinction has not been made, for it must be admitted that the application of the rule which has been established by the Supreme Court to other cases, as they hereafter arise, may cause embarrassment, for there must be a method by which the principle or law which has been discovered is applied ; and if that method is immaterial, then it is difficult to understand why it does not become substantially a patent for the discovery of the principle or the law of nature. Such seems to have been the opinion of Mr. Justice Nelson. See *Foote v. Silsby*, 1 Blatch. 445, and 2 Blatch. 260 ; and the case on appeal, 20 How. 378 ; *Le Roy v. Tatham*, 14 How. 156, and 22 How. 132."

In some portions of this opinion the learned judge seems not to distinguish between the "method" *in* which the principle or force is applied to its object, and the "mechanism" or "apparatus" *through* which it is applied. The "method" of treating ore in the Neilson case, rubber in the Goodyear case, metal in McClurg's case, wheels in Mowry's case, and fat in the Tilghman case, by subjecting them to certain forces in a certain order and degree, was a true process, entirely independent of the instruments by means of which

those forces were applied. The forces or laws of nature and the susceptibility to them of the objects named existed, not by the creation of the inventor, but by the act of God. When the inventor discovered that the latter were capable of being influenced by the former with certain results, and devised a series of operations by which these influences might be brought to bear on these objects, his conception of the method or process was complete, although no idea of the particular utensils or instruments to be employed had been presented to him. The reduction of this method to practice, by selecting suitable apparatus or mechanism for carrying out this method, would be, so far as this invention was concerned, the work of the constructor, not of the inventor, and if the apparatus were wholly new and original with him, yet its relation to the method devised by him would be the same. As mechanism and apparatus it would be a new invention, but with reference to the method it would still be mere reduction to practice. In every case of invention a method and an instrumentality for employing that method must exist. Where the method is new it is patentable as a process. Where the method is old and the instrumentality new, the latter may be patented as a machine, a manufacture, or a composition, according to its form. But the method is never the natural force, nor the natural object, nor the instrumentality, but has a distinct physical and legal existence, and if possessing the other necessary requisites is a patentable subject-matter.

In *Tilghman v. Proctor* (1881), 102 U. S. 707 ; *Bradley, J.* : (722) "That a patent can be granted for a process, there can be no doubt. The patent law is not confined to new machines and

clearly understood. It has, however, always been the settled law of this country that any artificial operation performed by

new compositions of matter, but extends to any new and useful art of manufacture. A manufacturing process is clearly an art, within the meaning of the law. Goodyear's patent was for a process, namely, the process of vulcanizing india-rubber by subjecting it to a high degree of heat when mixed with sulphur and a mineral salt. The apparatus for performing the process was not patented, and was not material. The patent pointed out how the process could be effected, and that was deemed sufficient. Neilson's patent was for the process of applying the hot blast to furnaces by forcing the blast through a vessel or receptacle situated between the blowing apparatus and the furnace, and heated to a red heat; the form of the heated vessel being stated by the patent to be immaterial. These patents were sustained after the strictest scrutiny and against the strongest opposition. On the subject of patents for processes, Mr. Justice Grier, in delivering the opinion of this court in *Corning v. Burden* (1853, 15 How. p. 267) said: 'A process *eo nomine* is not made the subject of a patent in our act of Congress. It is included under the general term of "useful art." An art may require one or more processes in order to produce a certain result or manufacture. The term "machine" includes every mechanical device or combination of mechanical powers and devices to perform some function, or to produce a certain effect or result. But where the result or effect is produced by chemical action, by the operation or application of some element or power of nature, or of one substance to another, such modes, methods, or operations are called "processes." A new process is usually the result of a discovery; a machine of invention. The arts of tanning, dyeing, making

waterproof cloth, vulcanizing india-rubber, smelting ores, and numerous others, are usually carried on by processes as distinguished from machines. One may discover a new and useful improvement in the process of tanning, dyeing, &c., irrespective of any particular form of machinery or mechanical device. And another may invent a labor saving machine, by which the operation or process may be performed, and each may be entitled to his patent. As, for instance: A has discovered that by exposing india rubber to a certain degree of heat, in mixture or in connection with certain metallic salts, he can produce a valuable product or manufacture; he is entitled to a patent for his discovery as a process or improvement in the art irrespective of any machine or mechanical device. B, on the contrary, may invent a new furnace or stove or steam apparatus by which this process may be carried on with much saving of labor and expense of fuel, and he will be entitled to a patent for his machine as an improvement in the art.' 15 How. 252, 267. Neilson's patent, above referred to, had some features very similar to those of Tilghman's. The strong objection urged against the latter is that the particular apparatus described in the specification is not that which is generally used, and that it cannot be used with much profit or success in large manufacturing operations; whereas the slower method of dissolving fats in a common boiler or digester at a lower temperature even than that of melting bismuth, which is not described in the specification, is the one which is generally adopted. Precisely this circumstance existed in reference to the patent of Neilson. The specification directed that the blast or current of air produced by the blowing apparatus should be

physical agents and producing physical effects, when within the domain of the industrial arts, is a true invention, and can

passed into an air vessel or receptacle heated to a red heat, and from thence into the furnace. Then, after stating that the air vessel or receptacle should be increased in size according to the size of the forge or furnace to be supplied, the specification adds: The form or shape of the vessel or receptacle is immaterial to the effect, and may be adapted to the local circumstances or situation. Now, the most simple and natural form of an air vessel for heating the blast, as here directed, would be a box or chamber or a cylindrical vessel; but it turned out in practice that a receptacle of this kind would answer the purpose but very imperfectly, and that the best and most useful method was to heat the blast in a series of tubes placed in a heated oven. This was held to be no ground for invalidating the patent, or for preventing it from covering intermediate tubes, as well as an intermediate box or chamber, the jury being of opinion that a man of ordinary skill and knowledge in the construction of blowing and air-heating apparatus would be able, from the information contained in the specification, to erect a machine which would answer some beneficial purpose in the application of the process, and would not be misled and prevented from so doing by the declaration that the form or shape of the vessel or receptacle was immaterial to the effect. In this view of the subject the patent was sustained after very great consideration. Some question has indeed been made whether Neilson's patent was sustained as a patent for a process. The Court of Exchequer, in reviewing the proceedings at the trial and answering the objection that it was a patent for a principle, said: 'It is very difficult to distinguish it from the specification of a patent for a principle, and this at first

created in the minds of some of the court much difficulty; but after full consideration we think that the plaintiff does not merely claim a principle, but a machine embodying a principle, and a very valuable one. We think the case must be considered as if, the principle being well known, the plaintiff had first invented a mode of applying it by a mechanical apparatus to furnaces; and his invention consists in this,—by interposing a receptacle for heated air between the blowing apparatus and the furnace. In this receptacle he directs the air to be heated by the application of heat externally to the receptacle, and thus he accomplishes the object of applying the blast, which was before of cold air, in a heated state to the furnace.' Web. P. C. 275, 371. In this passage we think that the Court of Exchequer, (who spoke through Baron Parke), drew the true distinction between a mere principle as the subject of a patent and a process by which a principle is applied to effect a useful result. That a hot blast is better than a cold blast for smelting iron in a furnace was the principle or scientific fact discovered by Neilson; and yet, being nothing but a principle, he could not have a patent for that. But, having invented and practically exemplified a process for utilizing this principle, namely, that of heating the blast in a receptacle between the blowing apparatus and the furnace, he was entitled to a patent for that process, although he did not distinctly point out all the forms of apparatus by which the process might be applied,—having nevertheless pointed out a particular apparatus for that purpose, and having thus shown that the process could be practically and usefully applied. Another person might invent a better apparatus for applying the process than

be patented as such without reference to the specific instruments engaged or the specific objects in which its effects may be produced.

that pointed out by Neilson, and might obtain a patent for such improved apparatus, but he could not use the process without a license from Neilson. His improved apparatus would in this respect stand in a relation to the process analogous to that which an improvement on a patented machine bears to the machine itself. That Neilson's patent was regarded as for a process is apparent from what is said by the judges who had it under consideration. Thus Baron Parke at the trial had said: 'The specification and patent together make it clear what the discovery was; it was the introduction of hot air by means of heating it before it was introduced into the furnace between the blowing apparatus and the furnace.' *Web. P. C.* 275, 312. And when the matter came before the House of Lords, after a trial in Scotland, Lord Campbell said: 'After the construction first put upon it [the patent] by the learned judges of the Court of Exchequer, sanctioned by the high authority of my noble and learned friend now upon the woolsack, when presiding in the Court of Chancery, I think the patent must be taken to extend to all machines of whatever construction, whereby the air is heated intermediately between the blowing apparatus and the blast furnace. That being so, the learned judge was perfectly justified in telling the jury that it was unnecessary for them to compare one apparatus with another, because, confessedly, that system of conduit-pipes was a mode of heating air by an intermediate vessel between the blowing apparatus and the blast furnace, and therefore it was an infraction of the patent.' *Id.* 715. This case of the hot blast was commented upon in the great case of *O'Reilly v. Morse* (reported in 15 Howard, 62), and is there recog-

nized and approved in the opinion of this court, delivered by Chief Justice Taney. After quoting the remarks of Baron Parke in the Court of Exchequer, cited above, the Chief Justice says: 'We see nothing in this opinion differing in any degree from the familiar principles of law applicable to patent cases. Neilson claimed no particular mode of constructing the receptacle or of heating it. He pointed out the manner in which it might be done, but admitted that it might also be done in a variety of ways, and at a higher or lower temperature, and that all of them would produce the effect in a greater or less degree, provided the air was heated by passing through a heated receptacle. . . . Whoever, therefore, used this method of throwing hot air into the furnace used the process he had invented, and thereby infringed his patent, although the form of the receptacle or the mechanical arrangements for heating it might be different from those described by the patentee. For whatever form was adopted for the receptacle, or whatever mechanical arrangements were made for heating it, the effect would be produced in a greater or less degree, if the heated receptacle was placed between the blower and the furnace, and the current of air passed through it. . . . The patent was supported because he [Neilson] had invented a mechanical apparatus by which a current of hot air, instead of cold, could be thrown in. And this new method was protected by the patent. The interposition of a heated receptacle in any form was the novelty he invented.' (15 How. 62, 115, 116.) We have quoted these remarks of the Chief Justice more fully because they show most clearly that he put the same construction upon Neilson's patent that

§ 164. An Art the most Comprehensive of Inventions.

As every patentable invention is either an instrument or an operation, and as the term "art" includes all those which

was put upon it by Lord Campbell, and that he fully acquiesced in the legality and validity of a patent for a process. Yet it has been supposed that the decision in *O'Reilly v. Morse* was adverse to patents for mere processes. The mistake has undoubtedly arisen from confounding a patent for a process with a patent for a mere principle. We think that a careful examination of the judgment in that case will show that nothing adverse to patents for processes is contained in it. The eighth claim of Morse's patent was held to be invalid, because it was regarded by the court as being not for a process, but for a mere principle. It amounted to this, namely, a claim of the exclusive right to the use of electro-magnetism as a motive power for making intelligible marks at a distance; that is, a claim to the exclusive use of one of the powers of nature for a particular purpose. It was not a claim of any particular machinery, nor a claim of any particular process for utilizing the power, but a claim of the power itself,—a claim put forward on the ground that the patentee was the first to discover that it could be thus employed. This claim the court held could not be sustained. That this was the true ground of the decision will be manifest from the following observations of the Chief Justice in the opinion already quoted from. He says: 'He [Morse] claims the exclusive right to every improvement where the motive power is the electric or galvanic current, and the result is the marking or printing intelligible characters, signs, or letters at a distance. If this claim can be maintained, it matters not by what process or machinery the result is accomplished. For aught that we now know, some future inventor, in the onward march of science,

may discover a mode of writing or printing at a distance by means of the electric or galvanic current, without using any part of the process or combination set forth in the plaintiff's specification. . . . In fine, he claims an exclusive right to use a manner and process which he has not described, and indeed had not invented, and therefore could not describe, when he obtained his patent. The court is of opinion that the claim is too broad and not warranted by law. . . . It is the high praise of Professor Morse that he has been able by a new combination of known powers, of which electro-magnetism is one, to discover a method by which intelligible marks or signs may be printed at a distance. And for the method or process thus discovered he is entitled to a patent. But he has not discovered that the electro-magnetic current, used as a motive power in any other method and with any other combinations, will do as well.' After reviewing the statutes and decisions bearing upon the subject the Chief Justice makes a summary conclusion of the whole matter, as follows: 'Whoever discovers that a certain useful result will be produced in any art, machine, manufacture, or composition of matter by the use of certain means is entitled to a patent for it, provided he specifies the means he uses in a manner so full and exact that any one skilled in the science to which it appertains can, by using the means he specifies, without any addition to or subtraction from them, produce precisely the result he describes. And if this cannot be done by the means he describes, the patent is void. And if it can be done, then the patent confers on him the exclusive right to use the means he specifies to produce the result or effect he describes,

cannot be embraced under one or more of the four groups of instruments enumerated in the statute, its outer limits are less

and nothing more. And it makes no difference in this respect whether the effect is produced by chemical agency or combination, or by the application of discoveries or principles in natural philosophy known or unknown before his invention, or by machinery acting altogether upon mechanical principles. In either case he must describe the manner or process as above mentioned, and the end it accomplishes. And any one may lawfully accomplish the same end without infringing the patent, if he uses means substantially different from those described.' *Id.* 119. It seems to us that this clear and exact summary of the law affords the key to almost every case that can arise. 'Whoever discovers that a certain useful result will be produced in any art by the use of certain means is entitled to a patent for it, provided he specifies the means.' But everything turns on the force and meaning of the word 'means.' It is very certain that the means need not be a machine or an apparatus; it may, as the court says, be a process. A machine is a thing. A process is an act or a mode of acting. The one is visible to the eye, — an object of perpetual observation. The other is a conception of the mind, seen only by its effects when being executed or performed. Either may be the means of producing a useful result. The mixing of certain substances together, or the heating of a substance to a certain temperature, is a process. If the mode of doing it, or the apparatus in or by which it may be done, is sufficiently obvious to suggest itself to a person skilled in the particular art, it is enough in the patent to point out the process to be performed, without giving supererogatory directions as to the apparatus or method to be employed. If the mode of applying the

process is not obvious, then a description of a particular mode by which it may be applied is sufficient. There is, then, a description of the process and of one practical mode in which it may be applied. Perhaps the process is susceptible of being applied in many modes and by the use of many forms of apparatus. The inventor is not bound to describe them all in order to secure to himself the exclusive right to the process, if he is really its inventor or discoverer. But he must describe some particular mode or some apparatus by which the process can be applied with at least some beneficial result, in order to show that it is capable of being exhibited and performed in actual experience." 19 O. G. 859 (863).

In *Mitchell v. Tilghman* (1873), 19 Wall. 287, Clifford, J. : (392) "Doubtless an invention may be good though the subject of it consists in the discovery of some principle of science or property of matter never before known or used, by which some new and useful result is obtained; and such an invention or discovery may be the subject of a valid patent, without including in the claim any new arrangement of machinery to accomplish the object, provided the inventor describes, as required in the patent law, the method, process, or means of applying the invention to practical use, and of obtaining the described new and useful result. (*Househill Co. v. Neilson*, 1 Web. 683; *Curtis*, p. 279; *Foots v. Silsby*, 2 Blatch. 260.)" 5 O. G. 299 (304).

In *Roberts v. Dickey* (1871), 1 O. G. 4, Strong, J. : (5) "It is not to be doubted that a novel process or method of operation, that amounts to a successful application of known things to a practical use, is patentable as an art." 4 Fisher, 532 (538).

In *O'Reilly v. Morse* (1853), 15 How.

easily discernible than those of any other class of operative means. These limits are, however, indicated by the charac-

62, Grier, J.: (130) "A new and useful art, or a new and useful improvement on any known art, is as much entitled to the protection of the law as a machine or manufacture. The English patent acts are confined to 'manufactures' in terms; but the courts have construed them to cover and protect arts as well as machines, yet without using the term, 'art.' Here we are not required to make any latitudinous construction of our statute for the sake of equity or policy; and surely we have no right, even if we had the disposition, to curtail or narrow its liberal policy by astute or fanciful construction. It is not easy to give a precise definition of what is meant by the term 'art' as used in the acts of Congress; some, if not all, the traits which distinguish an art from the other legitimate subjects of a patent are stated with clearness and accuracy by Mr. Curtis, in his *Treatise on Patents*. 'The term art applies,' says he, 'to all those cases where the application of a principle is the most important part of the invention, and where the machinery, apparatus, or other means, by which the principle is applied, are incidental only, and not of the essence of his invention. It applies also to all those cases where the result, effect, or manufactured article is old, but the invention consists in a new process or method of producing such result, effect, or manufacture.' *Curt. on Pat.* 80. A machine, though it may be composed of many parts, instruments, or devices combined together, still conveys the idea of unity. It may be said to be invented, but the term 'discovery' could not well be predicated of it. An art may employ many different machines, devices, processes, and manipulations, to produce some useful result. In a previously known art

a man may discover some new process, or new application of a known principle, element, or power of nature, to the advancement of the art, and will be entitled to a patent for the same, as an 'improvement in the art,' or he may invent a machine to perform a given function, and then he will be entitled to a patent only for his machine. That improvements in the arts, which consist in the new application of some known element, power, or physical law, and not in any particular machine or combination of machinery, have been frequently the subject of patents, both in England and in this country, the cases in our books most amply demonstrate. . . . (133) When a new and hitherto unknown product or result, beneficial to mankind, is effected by a new application of any element of nature, and by means of machines and devices, whether new or old, it cannot be denied that such invention or discovery is entitled to the denomination of a 'new and useful art.' The statute gives the inventor of an art a monopoly in the exercise of it as fully as it does to the inventor of a mere machine. And any person who exercises such new art without the license of the inventor is an infringer of his patent, and of the franchise granted to him by the law as a reward for his labor and ingenuity in perfecting it."

In *Whitney v. Emmett* (1831), Baldwin, 303, Baldwin, J.: (312) "A patent may be for a mode, or method of doing a thing; mode, when referred to something permanent, means an engine or machine, when to something fugitive, a method, which may mean engine, contrivance, device, process, instrument, mode and manner of effecting the purpose; the word "principle" may mean engine, in an act of parliament under which the patent issued, or may mean

teristic attributes of three species of arts which lie upon the boundary line between the creative and the imitative acts; (1) The application of a new force to known objects, through known instruments used in their accustomed manner and producing previously known effects;¹ (2) The application of a known force to a new object, through known instruments used in their accustomed manner and producing known effects;² (3) The application of a known force to known objects, through known instruments used in a new manner and producing effects either new or old.³ Each of these arts is a new operative means. In the first, the force is new; in the second, the object; and in the third, although the instrument is old as a concrete embodiment of one idea of means, its new use constitutes a means of an entirely different character in reference to the operation in which it is now employed. Beyond these three, no result of an inventive act can be imagined. Whatever lies between them and the concrete instruments must be an art or operation.

the constituent parts thereof. A patent for a method of producing a new thing may apply to the mechanism, a new method of operating with old machinery, or producing an old substance; a patent for a mode or method detached from all physical application would not refer to an engine or machine, but when referred to the mode of operation, so as to produce the effect, would be considered as for an engine or machine. The words used as mode or method are not the subject of the patent; it is the thing done by the invention, and patents are so construed *ut res magis valeat quam pereat.*" 1 Robb, 567 (579).

That an art or process is patentable without reference to new results or new apparatus, see also *Goodyear v. Wait* (1867), 3 Fisher, 242; 5 Blatch. 468; *French v. Rogers* (1851), 1 Fisher, 133.

That an art means a useful art, see *Smith v. Downing* (1850), 1 Fisher, 64.

§ 164. ¹ That the practical application of a new or hitherto unapplied natural force is a new art, see *Roberts*

v. Dickey (1871), 1 O. G. 4; 4 Fisher, 532; 4 Brews. 260; *Poillon v. Schmidt* (1869), 6 Blatch. 299; 37 How. Pr. 77; 3 Fisher, 476; *Goodyear v. Wait* (1867), 3 Fisher, 242; 5 Blatch. 468; *Le Roy v. Tatham* (1859), 22 How. 132; *Smith v. Ely* (1849), 5 McLean, 76.

² That the practical application of a known force to a new object is a new art, see *Whitney v. Mowry* (1867), 2 Bond, 45; 3 Fisher, 157; *Steiner v. Heald* (1851), 6 Exch. 607.

³ That the application of a known force to known objects in a new manner is a new art, see *Foot v. Silsby* (1849), 1 Blatch. 445; *Higgs v. Goodwin* (1858), E. B. & E. 529.

That a new mode of using old apparatus may be a new art, see *Lawther v. Hamilton* (1888), 42 O. G. 487.

That to do by machine what had before been done by hand is not a new process though the machine may be new, see *Marchand v. Emken* (1886), 26 Fed. Rep. 629; 23 Blatch. 435; 34 O. G. 1275.

§ 165. An Art may be either a "Force Applied," a "Mode of Application," or the "Specific Treatment of a Specific Object."

An art may fall within either of the three great fundamental groups of means, according to the number of its essential factors, and the subject of the process of discovery. In many arts the force or capability has been discovered by the inventor of the art, and is made practically useful by its union with a mode of application. Such an art is a force applied, and its essential factors are the force and mode of application.¹ Other arts employ known forces on known objects in new methods, the availability of the art or instrument adopted as the connecting agency between the force and object being the subject of discovery. These arts are simply modes of application, and have no other essential factor than the mode itself. In still other arts the object or susceptibility is the discovered factor, and the art consists in operating with specific forces through specific modes of application on this object or susceptibility. To such arts the three factors are essential, and a substantial change in either constitutes a different art.

§ 166. An Art must Produce Physical Effects.

But though an art embraces so wide a field of inventive skill, it includes only such operations as are capable of producing physical effects. Every invention, when applied according to the design of its inventor, must accomplish some change in the character or condition of material objects. This is as essential in a patentable art as in an instrument.¹

§ 165. ¹ That the discovery that steam may be made to become self-packing is patentable as a process not merely as an apparatus, see *Poillon v. Schmidt* (1869), 37 How. Pr. 77; 6 Blatch. 299; 3 Fisher, 476.

That a mode of controlling a natural force may be a patentable art, see *Dolbear v. American Bell Telephone Co.* (1888), 43 O. G. 377.

§ 166. ¹ A distinction is necessarily drawn by the courts between a plan or project for doing something and the

method by which it is to be physically effected. The former, if the ideas or mode of delineation are new, may be protected by copyright, not by patent; since the plan or project though capable of being carried out by the use of means is not in itself a means. Thus an architectural plan for the building of a house, though new and original, is not an art or any other form of invention. See *Jacobs v. Baker* (1868), 7 Wall. 295.

A distinction is also drawn between a method by which a change is pro-

Hence a plan or theory of action which, if carried into practice, could produce no physical results proceeding directly from the operation of the theory or plan itself, is not an art within the meaning of the Patent Law, however greatly it may promote the comfort or the welfare of mankind. It is, indeed, a means and may accomplish an important end, but it lies outside the domain of the industrial arts; and its inventor, if he is entitled to protection from any source, must seek it from the Copyright and not the Patent Law.

§ 167. An Art is Distinct from the Instruments which it Employs: may Employ any Available Instrument.

While an art cannot be practised except by means of physical agents through which the force is brought in contact with or is directed toward its object, the existence of the art is not dependent on any of the special instruments employed. It is a legal, practical invention in itself. Its essence remains unchanged, whatever variation takes place in its instruments, as long as the acts of which it is composed are properly performed.¹

duced in some physical substance and a mode of giving an agreeable appearance to the substance, unless such appearance amounts to a design. Thus a new manner of arranging articles for sale, or of packing simply, is not an art or an invention of any kind, see *Forn-crook v. Root* (1884), 29 O. G. 774; 21 Fed. Rep. 328; *King v. Gallun* (1883), 109 U. S. 99; 25 O. G. 980; *Langdon v. De Groot* (1822), 1 Paine, 203; 1 Robb, 433.

§ 167. ¹ In *Ex parte Blythe* (1884), 30 O. G. 1321, Butterworth, Com. : (1323) "Process and apparatus, therefore, constitute two separate inventions. If they are separate inventions when one has been invented by one person and the other by another, they must be separate inventions when both have been invented by the same person."

In *James v. Campbell* (1881), 104 U. S. 356, Bradley, J. : (377) "But a process and a machine for applying the

process are not necessarily one and the same invention. They are generally distinct and different." 21 O. G. 337 (343).

In *Goodyear v. The Railroad* (1853), 2 Wall. Jr. 356, Grier, J. : (360) "It must be obvious, also, that there is not only a distinction, but a wide difference, between one who merely invents a new method or process by which a well known fabric, product, or manufacture is produced in a cheaper or better way, and the discovery of a new compound, substance, or manufacture, having qualities never found to exist together in any other material. In the first case, the inventor can patent nothing but his process, and not his composition of matter. In the latter, both are new and original, and both patentable, not severally, but as one discovery or invention. It is evident, also, that the question of infringement must, in such cases, depend on different condi-

These instruments, therefore, may be either new or old. If new, they are separate and complete inventions, even though useless outside of the art for which they were devised. Though old, the art in which they are now used may nevertheless be new. For the same reason these instruments may be either natural or artificial. The elements, the earth, the

tions. Steel is a well-known substance. Any one who could devise a new and cheaper method of combining the iron and carbon in order to form it could patent his process only; and every other person would be at liberty to devise any different process for effecting the same purpose. But if steel, as a substance, was before unknown, the person who first discovered that a composition of iron and carbon could be made to assume such valuable qualities, would have a right to patent not only his process, but his product. And no person who had thus taken the benefit of the patentee's discovery, and by it was informed of the valuable qualities of this compound of iron and carbon, could, by varying or improving the mode or process of its production, rob the patentee of his franchise." 1 Fisher, 626 (632).

In *Foot v. Silsby* (1851), 2 Blatch. 260, Nelson, J. : (264) "Where a party has discovered a new application of some property in nature never before known or in use, by which he has produced a new and useful result, the discovery is the subject of a patent, independently of any peculiar or new arrangement of machinery for the purpose of applying the new property in nature; and hence the inventor has a right to use any means, old or new, in the application of the new property to produce the new and useful result, to the exclusion of all other means."

That the process and instrument used are two different inventions, see also *Dolbear v. American Bell Telephone Co.* (1888), 43 O. G. 377; *Phillips v.*

Kochert (1887), 31 Fed. Rep. 39; *Eastern Paper Bag Co. v. Standard Paper Bag Co.* (1887), 30 Fed. Rep. 63; 41 O. G. 231; *New Process Fermentation Co. v. Maus* (1887), 122 U. S. 413; 39 O. G. 1419; *Scrivner v. Oakland Gas Co.* (1884), 22 Fed. Rep. 98; 10 Sawyer, 390; *New Process Fermentation Co. v. Koch* (1884), 21 Fed. Rep. 580; 29 O. G. 535; *Nichols v. Ross* (1849), 8 C. B. 679.

That a process may be new though the apparatus is old, see *Lawther v. Hamilton* (1888), 42 O. G. 487; *New Process Fermentation Co. v. Maus* (1887), 122 U. S. 413; 39 O. G. 1419; *Celluloid Mfg. Co. v. American Zylonite Co.* (1887), 31 Fed. Rep. 904.

That an improvement in the apparatus used does not constitute a new process, see *Lawther v. Hamilton* (1884), 21 Fed. Rep. 811; 29 O. G. 449.

That a patentable process must have an existence distinct from the apparatus that performs it, see *Ex parte Herr* (1887), 41 O. G. 463.

That the process and product are two different inventions, see *Excelsior Needle Co. v. Union Needle Co.* (1885), 23 Blatch. 147; *Tucker v. Dana* (1881), 7 Fed. Rep. 213; *Kelleher v. Darling* (1878), 4 Clifford, 424; 14 O. G. 673; 3 Bann. & A. 438; *Jones v. Sewall* (1873), 3 Clifford, 563; 6 Fisher, 343; 3 O. G. 630; *Waterbury Brass Co. v. Miller* (1871), 5 Fisher, 48; 9 Blatch. 77; *Goodyear v. Wait* (1867), 3 Fisher, 242; 5 Blatch. 468; *Goodyear v. Providence Rubber Co.* (1864), 2 Clifford, 351; 2 Fisher, 499.

animal creation, the members of the human body are as available as the machines and chemical compositions which have resulted from inventive skill.² Their action may be positive or negative,—working their changes in material objects by adding to or altering their quantity or qualities, or by subtracting or suspending attributes which otherwise would hinder a desired result.³ To the inventor of an art the entire universe thus offers itself as his armory, and all the works of God and man are ready to become his instruments. Whatever he may deem it best to use in the practical expression of his idea of means, the idea is not thereby changed, nor can another practise the same art, either by the same or any other instruments, without infringing upon his exclusive rights.

§ 168. **An Art may be a Simple Art or a Combination.**

An art may consist either of one act alone, or of a series of acts so related to each other as to co-operate in the production of an ultimate result.¹ There is no limit, on the one hand, to the simplicity or, on the other hand, to the complexity of the operations included in the practice of an art,—a single motion

² That a new use of the earth, or any other natural object may be a new art, see *Andrews v. Cross* (1881), 8 Fed. Rep. 269; 19 Blatch. 294; 19 O. G. 1705; *Andrews v. Carman* (1876), 9 O. G. 1011; 13 Blatch. 307; 2 Bann. & A. 277; *Gilbert & Barker Mfg. Co. v. Tirrell* (1874), 12 Blatch. 144; 8 O. G. 2; 1 Bann. & A. 315.

That a method of using heat which accomplishes a new purpose and result is a new process, see *Cary v. Lowell Mfg. Co.* (1887), 40 O. G. 1239.

That to employ the natural instincts of animals to induce them to move a machine is not a new art, see *Merrill v. Cousins* (1866), 26 U. C. Q. B. 49.

³ That to discover that the presence of the mucous membrane prevents the effectual curing of fish, and to devise or adopt a method of removing it, is a new

art of curing fish, see *Crowell v. Harlow* (1880), 1 Fed. Rep. 140; 5 Bann. & A. 63.

That to discover that the obstacles to the proper use of a chemical composition are caused by certain impurities therein, and to devise or adopt a method of removing them, constitutes a new and patentable process, see *United Nickel Co. v. Harris* (1878), 17 O. G. 325; 3 Bann. & A. 627; 15 Blatch. 319.

§ 168. ¹ That a new combination of old processes constitutes a new process, see *Wallace v. Noyes* (1882), 23 O. G. 435; 21 Blatch. 83; 13 Fed. Rep. 172; *Andrews v. Carman* (1876), 9 O. G. 1011; 13 Blatch. 307; 2 Bann. & A. 277; *Cannington v. Nuttall* (1871), L. R. 5 H. L. 205; *Bovill v. Keyworth* (1857), 7 El. & B. 725.

of the human arm, or of some little instrument, as often constituting a new means as the prolonged action of many pieces of intricate machinery.

§ 169. **Essential Attributes of an Art.**

The essential attributes of an art reside either in the nature of the acts of which it is composed, or in their relation to the object upon which they act, or in the mode of their co-operation with each other. Where the art consists of a single act, the characteristics which distinguish it from every other art are found either in the nature of the act alone, or in its relation to the object upon which it operates; and such an act is a new art only when the act itself is new, or when it is for the first time directed toward an object whose susceptibility to its influence was hitherto unknown. Where it is composed of several acts, its essence is to be sought not only in the nature of the acts themselves, and in their individual relation to their common object, but also in their relation to each other, or the method in which they co-operate in the production of their joint result. This relation to each other may consist in the operation of one act upon another, modifying in some manner its natural activities, or in the simultaneous or successive influence exerted by these acts upon their common object; and may depend on the mere order of performance, or even on the interruption of one act by another at a particular period in its execution.

§ 170. **An Art a Unit: its Unity how Destroyed.**

An art, like every other invention, is a unit. Whatever number of acts it may employ, it is still one; and any variation in the number or the character of its elements which introduces a different idea of means constitutes a different art, and, if hitherto unknown, a new invention.¹ Thus the addi-

§ 170. ¹ In *New Process Fermentation Co. v. Maus* (1884), 20 Fed. Rep. 725, Drummond, J.: (732) "Where, in a process, there is a combination of different substances, and to that combination another substance or element is added, by which a new result is obtained, that is a process which we can easily understand; and if unknown before, and it is useful, the person devising it may be entitled to a patent. . . . If a process exists which consists of different steps

tion to an existing art of a single step by which its essential character is changed, or the omission of one act which was a necessary element in the art as previously practised, or even a material alteration in the order of the acts performed, is sufficient to destroy its unity, and produce another art which is entitled to the same protection as the old.

§ 171. **An Art not Complete until Reduced to Practice.**

Although an art cannot be permanently embodied in a tangible form, it is no more the subject of a patent before it is reduced to practice than is an article of manufacture.¹ Indeed, the rule which governs this part of the inventive act seems to be more stringent in reference to an art than in regard to any other species of invention. An instrument may perhaps be considered as completed, within the meaning of the law, when it has been so far perfected as to be capable of

created by machinery, and there is an improvement in that process caused by a new element added to or taken away from the machinery, then, the process existing and being known, the party who added or took away the part of the machinery might, if it were useful, be entitled to a patent, not for the process which formerly existed and was well known, but only for that which had been added to or taken from the mechanism."

That no change in the proportions of materials used in a process will affect its identity, if it operates in the same way to produce the same result, see *Rumford Chemical Works v. Lauer* (1872), 10 Blatch. 122; 5 Fisher, 615; 3 O. G. 349.

That the omission of one step hitherto regarded as necessary to a process may constitute a new process, see *Hammer-schlag Mfg. Co. v. Judd* (1886), 28 Fed. Rep. 621; *Heller v. Bauer* (1884), 19 Fed. Rep. 96; *Arnold v. Phelps* (1884), 20 Fed. Rep. 315; 29 O. G. 538; *Ham-merschlag v. Garrett* (1882), 10 Fed. Rep. 479; 21 O. G. 1199; *Dittmar v.*

Rix (1880), 17 O. G. 973; 1 Fed. Rep. 342; 5 Bann. & A. 240; *Booth v. Kennard* (1856), 1 H. & N. 527.

That a substantial alteration in one step in a process may make a new process, see *Cotter v. New Haven Copper Co.* (1882), 18 Fed. Rep. 234; 23 O. G. 740.

That the materials used in a process are "similar" to each other when they act or are acted on, in that process, in the same way, see *American Wood Paper Co. v. Fibre Disintegrating Co.* (1868), 3 Fisher, 362; 6 Blatch. 27.

§ 171. ¹ That a process resting in idea only, no means being devised or adopted for carrying it into operation, is not a complete invention, see *Downton v. Yaeger Milling Co.* (1880), 1 McCrary, 26; 5 Bann. & A. 112; 17 O. G. 906; 1 Fed. Rep. 199.

That a process cannot be fully invented until apparatus is constructed by which the process can be performed, see *Eastern Paper Bag Co. v. Standard Paper Bag Co.* (1887), 30 Fed. Rep. 63; 41 O. G. 231.

immediate practical employment, though never actually used in the arts, — its capability of use being apparent from an inspection of the instrument itself. But an art cannot become known to the public as a practical means unless it has been tested by actual use, in the manner and for the purpose intended by the inventor; and the law, therefore, should and does require that it shall be subjected to such tests before it can receive the indorsement of a patent.

§ 172. **An Art Reducible to Practice in Many Forms : all Identical Inventions.**

It is evident from the nature of an art that the form of its embodiment is susceptible of great variations while the essence of the art itself remains unchanged. The acts of which it is composed are the same acts whenever they express the same idea, however they appear to differ from each other; and the essential nature of the acts is not diversified by any substitution of one instrument for another unless a new idea of action is thereby substituted for the old.¹ The scope of an

§ 172. ¹ In *Piper v. Brown* (1870), Holmes, 20, Shepley, J.: (22) "It follows, from the law as expounded by the Supreme Court of the United States in *Corning v. Burden*, and in *O'Reilly v. Morse*, 15 How. 62, — where the true distinction between a principle and a process is clearly defined in the explanations given by the court of the case of *Neilson v. Harford*, — that where a result or effect is produced by mechanical action, the patent can ordinarily only be for the mechanical appliances or means employed; where the result is attained or effect produced by chemical action, by the operation or application of some element or power of nature, or of some property in matter, or of one substance to another, then the patent may be for the art, process, or method. It is essential to the validity of the process as an invention, to show how it may be adapted to practical use. In showing this, the inventor may describe

mechanical means of applying, or peculiarly shaped vessels for containing, any of the ingredients used in his process or art. But they constitute no part of his invention. Another person may discover new and useful means of applying or using the inventor's process, and be entitled to a patent for that improvement, without the right to use the process. So the inventor himself may discover such new means or invent new appliances, which may be the subjects of a patent to him, separate and apart from his patent for the art itself." 4 Fisher, 175 (179).

That a patent for a process, describing one means for performing it, covers all other methods of performing the same process, see *Bridge v. Brown* (1871), Holmes, 53.

That the use of an old process upon a different object, involving no inventive skill in the use itself, does not affect the identity of the process, see

invention of this class is, therefore, very broad, reaching far beyond the limits of any of the machines or other instruments employed. Hence it is advisable, wherever the nature of an invention will permit, to treat it as an art in which various instruments may be indifferently used, rather than as an instrument itself. This may be done in every art unless the practice of the art consists only in the employment of an instrument which is also the invention of the same inventor.²

Brown v. Piper (1875), 91 U. S. 37 ; 10 O. G. 417.

That the use of anything in an art, without other invention than the mere employment of it for the first time in that art, is not a change in the art itself, see *Morton v. N. Y. Eye Infirmary* (1862), 5 Blatch. 116 ; 2 Fisher, 320.

² Where a process consists entirely in the operation of a machine or other instrument, it approaches so nearly to the function of the instrument employed that several decisions have been rendered identifying it therewith, and hence denying its patentability. But the process and the function are, after all, two entirely separate entities, both in intellectual and physical contemplation ; the former being capable of conception apart from any object acted on, the latter not so. The difficulty is another form of the old confusion between the end and the means, and is to be avoided by defining sharply the end to be accomplished, and determining whether the machine or the operation performed by it is the actual means. For if the operation performed by the machine is new in reference to the object upon which it is employed, a new process has been invented ; and this is no less true if the machine or instrument employed is new than if it were old, or if the process can be performed in no other known way than by this particular machine. While, on the other hand, if the operation is known in reference to the object, the invention of a new machine for per-

forming it does not make a new process, but only a new instrument for applying it. Thus in the art of planing lumber, if the end to be accomplished were the smoothing of the boards, and there were no known methods of attaining this end, the process of smoothing by removing inequalities would be a means, and the inventor of this process would be entitled to a patent for it, no matter what method he may have employed. But it being once apparent that smoothness could be effected by removing inequalities, the removal of inequalities becomes the end, and a process for removing them the means ; and if the process now invented for that purpose be the cutting of the surface by a group of knives applied in a certain speed or order of succession, this also, as a new means, is a new invention. This peculiar excision of the surface now becomes an end, and every machine devised for performing it a means, and at this point invention passes from process into instrument, and every subsequent invention for the same end is only as broad as the new character of the instrument produced. Whether or not a new machine is the reduction to practice of a new process, or is a new instrument for the performance of an old process, is, therefore, to be determined by the state of the art at the date of the invention. If it is the former, the process is patentable, though the machine be new. If the latter, only the machine can be allowed the protection of the law. Thus in *New Process*

Here, as the art and the operation of the instrument are identical, a patent for the one would effectually protect the other. Such instances are, however, comparatively rare, and the possibility which always exists that some new instrument may be devised, by which the same act could be performed, renders a patent for an art the only sure protection to the inventor. By it, as by no other, he can appropriate to himself the entire benefit of his original conception, and yet remain free to employ in its embodiment every known or imaginable variety of instrument.

SECTION II.

OF A MACHINE.

§ 173. "Machine" Defined.

A machine is an instrument composed of one or more of the mechanical powers, and capable, when set in motion, of producing, by its own operation, certain predetermined physical effects. It is an artificial organism, governed by a permanent artificial rule of action, receiving crude mechanical force from the motive power, and multiplying, or transforming, or transmitting it, according to the mode established by that rule. This rule of action, imposed by the inventor on the material substances of which the machine consists, is what the courts have called the "principle of the machine;"

Fermentation Co. v. Koch (1884), 21 Fed. Rep. 580, *Brown, J.*: (582) "Indeed, we understand the law to be that, where a patent clearly shows and describes a machine whose use necessarily involves the production of a certain process, no other person can afterwards patent that process." 29 O. G. 535 (535).

See, also, that where the process is identical with the *modus operandi* of the machine, the machine alone is patentable, *Ex parte Herr* (1887), 41 O. G. 463; *Excelsior Needle Co. v. Union Needle Co.* (1885), 32 Fed. Rep. 221; 23 Blatch. 147; *Dryfoos v. Wiese* (1884), 26 O. G. 639; 19 Fed. Rep. 315; 22

Blatch. 19; *Hatch v. Moffitt* (1883), 15 Fed. Rep. 252; *McKay v. Jackman* (1882), 20 Blatch. 466; 22 O. G. 85; 12 Fed. Rep. 615; *Brainard v. Cramme* (1882), 20 Blatch. 530; 12 Fed. Rep. 621; 22 O. G. 769; *New v. Warner* (1882), 22 O. G. 587; *Goss v. Cameron* (1882), 11 Bissell, 389; 23 O. G. 741; 14 Fed. Rep. 576; *Matthews v. Schoneberger* (1880), 4 Fed. Rep. 635; 18 Blatch. 357; 18 O. G. 1464.

That the operation of a machine may be a patentable process, see *Ex parte Herr* (1887), 41 O. G. 463; *McKay v. Dibert* (1881), 19 O. G. 1351; 5 Fed. Rep. 587.

a phrase synonymous with "*modus operandi*" and "structural law." It is, however, neither more nor less than the idea of means, which is embodied in the machine itself.¹ It is the conception of a mechanical force operating in a specific manner through agents of a specific character; and the expression of that idea in any one of those specific agents constitutes the patentable machine.

§ 173. ¹ In *Burr v. Duryoo* (1863), 1 Wall. 531, Grier, J.: (570) "A machine is a concrete thing, consisting of parts, or of certain devices and combinations of devices. The principle of a machine is properly defined to be its 'mode of operation,' or that peculiar combination of devices which distinguish it from other machines."

In *Roberts v. Ward* (1849), 4 McLean: 565 (566) "The word 'principle,' as applied to mechanics, is where two machines or things are made to operate substantially in the same way so as to produce a similar result, they are considered the same in principle." 2 Robb, 746 (748).

In *Brooks v. Jenkins* (1844), 3 McLean, 432 (451) "The word 'principle' is not used here in its general signification, but as applied to the structure of a machine. It means the operative cause by which a certain effect is produced. I observe the board before you is made smooth upon its surface, on one edge of it a groove is formed and on the other a tongue. This has been done by the machine before you in one operation. That machine is formed, as you perceive, by a combination of certain mechanical powers. This combination of powers is what is called the principle of the machine. Now it does not follow that the same effect may not be produced by a machine different in principle from the plaintiff's. But where a similar effect is produced by a combination of the same mechanical powers, though the machines may be somewhat different in their structure, in principle they are the same."

In *Smith v. Pearce* (1840), 2 McLean, 176, the court say: (178) "The principle here spoken of is not a new mechanical power. . . . The principle consists in the mode of applying or combining mechanical powers which produce a certain result." 2 Robb, 13 (16).

In *Barrett v. Hall* (1818), 1 Mason, 447, Story, J.: (470) "The true legal meaning of the principle of a machine, with reference to the patent act, is the peculiar structure or constituent parts of such machine." 1 Robb, 207 (232).

In *Whittemore v. Cutter* (1813), 1 Gallison, 478, Story, J.: (480) "By the principles of a machine (as these words are used in the statute) is not meant the original elementary principles of motion, which philosophy and science have discovered, but the *modus operandi*, the peculiar device or manner of producing any given effect. The expansive powers of steam, and the mechanical powers of wheels, have been understood for many ages; yet a machine may well employ either the one or the other, and yet be so entirely new in its mode of applying these elements as to entitle the party to a patent for his whole combination. The intrinsic difficulty is to ascertain, in complicated cases like the present, the exact boundaries between what was known and used before, and what is new, in the *mode of operation*." 1 Robb, 40 (42).

See also *Latta v. Shawk* (1859), 1 Fisher, 465; 1 Bond, 259; *Pitts v. Wemple* (1855), 1 Bissell, 87; 2 Fisher, 10.

§ 174. Machine how Distinguished from an Art.

A machine thus differs from an art in that the act or series of acts which constitutes the art becomes, in the machine, inseparably connected with a specific physical structure. The idea, which in the one may be temporarily expressed through any instruments capable of performing the act, is in the other permanently expressed in a determinate instrument by which the act is not merely performed, but is performed in an invariable manner.¹ The art is, therefore, the primary conception; the machine, like every other instrument, the secondary,—the idea of the act to be performed necessarily preceding the idea of the special agent to be employed; and the union of the idea of the act with the idea of a particular instrument for performing it is thus a limitation, not an extension, of the scope of the invention.

§ 175. Machine how Distinguished from other Instruments.

A machine differs from all other mechanical instruments in that its rule of action resides within itself.¹ Such other in-

§ 174. ¹ The distinction between the "operation" of a machine and its "mode of operation" is a necessary and fundamental one. The former is in its nature an art or process, and if new may be patented as such. See § 172, and notes. The latter is inseparable from the machine itself and cannot be patented apart from some mechanical structure in which it is embodied. It is to the latter only that the decisions hereafter cited can properly refer, although their language is broad enough to cover both. Thus in *Burr v. Duryee* (1863), 1 Wall. 531, Grier, J.: (570) "We find here no authority to grant a patent for a 'principle' or a 'mode of operation' or an *idea* or any other abstraction. . . . A machine is not a principle or an idea. The use of ill-defined abstract phraseology is the frequent source of error. It requires no great ingenuity to mystify a subject by the use of abstract

terms of indefinite or equivocal meaning. Because the law requires a patentee to explain the mode of operation of his peculiar machine, which distinguishes it from others, it does not authorize a patent for a 'mode of operation as exhibited in a machine.'" This latter sentence must not be understood to deny that the mode of operation is *covered* by the patent, only that the mode of operation apart from the tangible embodiment, is not patentable subject-matter. See also *Hatch v. Moffitt* (1883), 15 Fed. Rep. 252, and cases named under § 172.

§ 175. ¹ In spite of some doubts on the part of judges and law-writers as to the existence of such a distinction as is here indicated between machines and other instruments, it is nevertheless certain that the harmony of the law and the proper application of the decisions of the courts to their subject-matter require it to be drawn. The

struments receive their law of operation as well as their motive power from exterior sources, and act in a variety of methods according to the will of their employer or the *modus operandi* of the machine to which they may be temporarily attached. The structural law of a machine, however, is its

whole doctrine of "*modus operandi*," as the distinguishing element of a machine, is involved in it and inexplicable without it; and it has been sufficiently recognized to place it among the established features of our patent system. Thus in *Hammerschlag v. Scamoni* (1881), 7 Fed. Rep. 584, Blatchford, J. : (589) "In all machinery, the arrangement of it is designed to secure the operation of laws whose operation is certain to follow such arrangement of it, and those certain laws are the laws of nature; and it is because those known laws are certain to follow such arrangement, that the arrangement is made. The arrangement is none the less an invention because it brings into operation the laws of nature." 20 O. G. 75 (76).

So also in *Parker v. Hulme* (1849), 1 Fisher, 44, Kane, J. : (50) "All machines may be regarded as merely devices, by the instrumentality of which the laws of nature are made applicable and operative to the production of a particular result. He who first discovers that a law of nature can be so applied, and having devised machinery to make it operative, introduces it in a practical form to the knowledge of his fellow-men, is a discoverer and inventor of the highest grade, — not merely of the mechanism, the combination of iron, brass, and wood, in the form of levers, screws, or pulleys, but the force which operates through the mechanical medium — the principle — or, to use the synonyme given for this term in the act of 1793, the *character* of the machine, and this title, as a discoverer, he may lawfully assert, and secure to himself

by letters-patent; thus establishing his property, not only in the formal device for which mechanical ingenuity can at once, as soon as the principle is known, imagine a thousand substitutes, — some as good, others better, perhaps all dissimilar, yet all illustrative of the same principle, and depending on it, — but in the essential principle which his machine was the first to embody, to exemplify, to illustrate, to make operative, and to announce to mankind."

That a machine is an organization of materials and that its characteristics are in the organism, not in the materials or their arrangement merely, see *Bailey Washing & Wringing Mach. Co. v. Lincoln* (1871), 4 Fisher, 379.

Among the statements which appear to deny this characteristic of a machine, the following may be cited: In *Coupe v. Weatherhead* (1883), 23 O. G., 1927, Lowell, J. : (1928) "The argument that a machine must be automatic in order to be patentable is not sound. A piano is not automatic, nor is any tool or implement intended for use by hand, but improvements in any such tool used in an art or industry are patentable." 16 Fed. Rep. 673 (675). But here it is evident that the term "machine" is employed as a synonyme of "instrument," and not in its technical sense as one class of instruments. A piano is not a machine, though the mechanism which is constituted by each of its keys, in connection with its own hammer, &c., might be so regarded; nor is a tool or an implement characterized by any *modus operandi*, but is an ordinary manufacture. See also *Ex parte Blythe* (1884), 30 O. G. 1321.

one enduring and essential characteristic. It becomes a complete invention only when it is capable of entire practical obedience to this law; and when its power to correspond therewith is interrupted or destroyed, it at once ceases to be the machine on which that law was formerly imposed.

§ 176. Machine may be a Simple Machine or a Combination.

A machine may be either a single organism or a combination of organisms so related to each other as to co-operate, successively or simultaneously, in the production of the required result.¹ When it is composed of parts, none of which

§ 176. ¹ In *Union Sugar Refinery v. Matthiesson & Co.* (1865), 3 Clifford, 639, Clifford, J.: (641) "Inventions pertaining to machines may . . . be divided into four classes. First, where the invention embraces the entire machine, as a car for a railway, or a sewing-machine, as was decided by this court in a well-known case. Such inventions are seldom made, but when made, and duly patented, any person is an infringer who, without license, makes or uses any portion of the machine. Under such a patent the patentee holds the exclusive right to make, use, and vend to others to be used, the entire machine; and if another, without license, makes, uses, or vends any portion of it, he invades the right of the patentee. The second class of inventions referred to are those which embrace one or more of the elements of the machine, but not the entire machine; as the coulter of the plough, or the divider of the reaping-machine. In patents of that class any person may make, use, or vend all other parts of the machine or implement, and he may employ a coulter or a divider in the machine mentioned, provided it be substantially different from that embraced in the patent. The third class of machines which are to be mentioned are those which embrace both a new element, and a new combination

of elements previously used and well-known. The property in the patent in such a case consists in the new element and in the new combination. No one can lawfully make, use, or vend the machine containing such new element or such new combination. They may make, vend, or use the machine without the patented improvements, if it is capable of such use; but they cannot use either of those improvements, without making themselves liable as infringers. The fourth class of machines to be mentioned are those where all the elements of the machine are old, and where the invention consists in a new combination of those elements, whereby a new and useful result is obtained. Most of the modern machines are of this class, and many of them are of great utility and value." 2 Fisher, 600 (605).

That any new combination or organization of old mechanical elements may be a machine, see *Wintermute v. Redington* (1856), 1 Fisher, 239.

But that no co-operation between the product and the machine while in action will make the two together a new machine, see *Dederick v. Cassell* (1881), 20 O. G. 1233; 9 Fed. Rep. 306.

That the combination of two existing machines is patentable, see *Holliday v. Rheem* (1852), 18 Penn. St. 465.

without all the others constitute a machine, or when certain of its parts form a complete machine but the other portions, whether taken singly or together, are incapable of organic action, the machine is a single organism. But when two or more machines, each in itself complete and operating in accordance with its own law, are united in a new organism the elemental machines of which co-operate to effect a single result, their union forms a combination, which is a new machine with a new rule of action, distinct in law as well as in mechanics from any and from all of the subordinate machines of which it is composed.

§ 177. Machine Distinct from its Integral Parts or Elements.

As its rule of action is the only essential characteristic of a machine, its various parts if it be a single organism, or if it be a combination its elemental machines, may either be original with its inventor or may be borrowed by him from nature or from the inventions of other men.¹ A union of old parts, or a combination of old machines, is as truly a new machine, provided the rule of action be new, as if all the parts or elements were previously unknown. In like manner, the force employed as the motive power of the machine, and the effect produced by it in the objects upon which it acts, may be old or new; for the machine still operates in obedience to its inherent law, from whatever source its energies are drawn, and on whatever substance its activities are exercised.

§ 178. Essential Attributes of a Machine.

The essence of a machine thus consists of its principle, or structural law. Its shape, appearance, size, materials, and arrangement are of no importance, except as they control its mode of operation.¹ No change in any of its parts, no sub-

§ 177. ¹ That it is not necessary that every part of a machine be invented by the patentee, see *Holliday v. Rheem* (1852), 18 Penn. St. 465.

§ 178. ¹ In *Union Paper Bag Machine Co. v. Murphy* (1877), 97 U. S. 120, Clifford, J. : (125) "The court or jury, as the case may be, are not to

judge about similarities or differences by the names of things, but are to look at the machines or their several devices or elements in the light of what they do, or what office or function they perform and how they perform it, and to find that one thing is substantially the same as another if it performs sub-

stitution of a new part for an old where the same office is performed by both, or of another motive power for that origi-

stantially the same function in substantially the same way to obtain the same result, always bearing in mind that devices in a patented machine are different, in the sense of the patent law, when they perform different functions, or in a different way, or produce a substantially different result. Nor is it safe to give much heed to the fact that the corresponding device in two machines, organized to accomplish the same result, is different in shape or form, the one from the other, as it is necessary in every such investigation to look at the mode of operation or the way the device works, and at the result as well as at the means by which the result is attained. Inquiries of this kind are often attended with difficulty; but if special attention is given to such portions of a given device as really do the work, so as not to give undue importance to other parts of the same, which are only used as a convenient mode of constructing the entire device, the difficulty attending the investigation will be greatly diminished, if not entirely overcome." 13 O. G. 366 (367).

In *Union Sugar Refinery v. Matthiesson & Co.* (1865), 3 Clifford, 639, Clifford, J. : (663) "In determining that question, you are not to determine about similarities or differences merely by the names of things; you are to look at the machines and their several devices and elements in the light of what they do, or what office or function they perform, and how they perform it; and to find that a thing is substantially the same as another if it performs substantially the same function or office in substantially the same way, to attain substantially the same result; and that the things are substantially different when they perform different duties in substantially a different way, or produce a

substantially different result. For the same reasons you are not to judge about similarities or differences merely because things are apparently the same or apparently different in shape or form; but the true test of similarity or difference in making the comparison is the same in regard to shape or form as in regard to name, and in both cases you must look at the mode of operation, — the way that the parts work, and at the result, as well as at the means by which the result is attained. In all your inquiries about the mode of operation of other machines, you are to inquire about and consider more particularly those portions of the particular part or element which really do the work, so as not to attach too much importance to the other portions of the same part, which are only used as a convenient method of constructing the entire part or device. You will regard a well-known substantial equivalent of a thing as being the same as the thing itself; so that, if two machines, having the same mode of operation, do the same work in substantially the same way, and accomplish the same result, they are the same. And so, also, if the parts of two machines, having the same mode of operation, do the same work in substantially the same way, and accomplish substantially the same result, those parts are the same, although they may differ in name, form, or shape. But in both cases, if the two things perform a different work, or in a way substantially different, or do not accomplish the same result, then they are substantially different." 2 Fisher, 600 (626).

In *Eames v. Cooke* (1860), 2 Fisher, 146, Sprague, J. : (148) "In comparing the plaintiff's patent with any other machine in order to determine whether

nally employed by the inventor, although such change or substitution may increase the speed, capacity, or usefulness of the

the mechanism is the same, we must first see whether such other contains substantially the same devices, and if it does, then whether the arrangement or mode of applying them is substantially the same. . . . If either the devices or the mode of applying them, in any other machine, be substantially different from the plaintiff's, then it is not the same. In order to determine whether the mechanism of any other machine is the same as the plaintiff's, we may not only look at the mechanism itself, — that is, the devices and the arrangement of them, — but also at their mode of operation, and their effects or results. If the mode of operation be different, it is evidence that the mechanism is different. Or, if the result be different, then, reasoning from effects to causes, we may presume that some new instrumentality has been introduced. If, upon examining the mechanism, we find that it is substantially different in two machines, then they are not the same, although they may produce the same result. That would be the common case where the same end is attained by different processes or instrumentalities. But, if a materially different result is reached, it is evidence of some new course or means, although the mechanism may, apparently, be substantially the same. Hence a greater degree of utility being achieved by one machine is evidence, and sometimes conclusive evidence, of novelty in the means or instrumentalities which are used."

In *Latta v. Shawk* (1859), 1 Fisher, 465, Leavitt, J.: (470) "On the question of identity the law regards substance and not form, and the real question is, whether the machine used by the defendant is in *principle* the same as that patented to the plaintiff. . . . By the term 'principle of a machine'

we understand its mode or manner of operation, and hence there may be two structures widely different in appearance or dimensions, and yet identically the same in principle." 1 Bond, 259 (264).

In *Foss v. Herbert* (1856), 1 Bissell, 121, Drummond, J.: (126) "A machine is an infringement of another if it incorporates in its structure and operation, the substance of the invention; that is, by an arrangement of mechanism which performs the same service, or produces the same effect in the same way, or substantially the same way. Mere colorable alterations, or adroit evasions, by substituting one mechanical equivalent for another in the combination which constitutes the machine, should never be allowed to protect a party. . . . (127) The question to be determined is, whether, under a variation of form, or by the use of a thing which bears a different name, the defendant accomplishes, in his machine, the same purpose, object or effect, as that accomplished by the patentee, or whether there is a real change of structure and purpose." 2 Fisher, 31 (36).

In *Tatham v. Le Roy* (1852), 2 Blatch. 474, Nelson, J.: (488) "It will be seen from these observations, that a difference in the mechanical arrangement and construction of the two machines is not necessarily a test by which to determine that the two are not identical. They may be, apparently, very different externally, and still embrace the same substantial identity in principle or mode of operation. So, on the other hand, the converse of the proposition is equally true. The two may, apparently, be very similar externally, and still in principle and mode of operation be very different. I do not know any better mode of examining a question of this kind, than to inquire

machine, can alter its essential character, as long as it still operates according to the same inherent law. Yet greater

whether the mechanical arrangement and construction of the two embrace the same set of ideas, the same leading features or ideas, which, in practical operation, produce the useful result. In other words, whether the arrangement and combination of the parts of machinery found in each are substantially the same, and operate in substantially the same way in producing the result. Hence, the real question in this case, as it respects the identity of the two machines, looks simply to their mechanical arrangement and construction, as to whether or not the defendant's incorporates, in its structure and operation, the spirit and substance of the plaintiff's improvement; that is, uses the arrangement and mechanism of the plaintiff's to perform the same functions or produce the same effect in the same way, or substantially the same way."

In *Barrett v. Hall* (1818), 1 Mason, 447, Story, J.: (470) "In the minds of some men, a principle means an elementary truth, or power, so that in the view of such men, all machines which perform their appropriate functions by motion, in whatever way produced, are alike in principle, since motion is the element employed. No one, however, in the least acquainted with law, would for a moment contend that a principle in this sense is the subject of a patent; and if it were otherwise, it would put an end to all patents for all machines which employed motion, for this has been known as a principle, or elementary power, from the beginning of time. The true legal meaning of the principle of a machine, with reference to the patent act, is the peculiar structure or constituent parts of such machine. And in this view the question may be very properly asked, in cases of doubt or complexity, of skilful persons,

whether the principles of two machines be the same or different. Now the principles of two machines may be the same, although the form or proportions may be different. They may substantially employ the same power in the same way, though the external mechanism be apparently different. On the other hand, the principles of two machines may be very different, although their external structure may have great similarity in many respects." 1 Robb, 207 (231).

In *Evans v. Eaton* (1818), 3 Washington, 443, Washington, J.: (449) "We take the rule to be, and so it has been settled in this and other courts, that, if the two machines be substantially the same, and operate in the same manner, to produce the same result, though they may differ in form, proportions, and utility, they are the same in principle; and the one last discovered has no other merit than that of being an improved imitation of the one before discovered and in use, for which no valid patent can be granted to any one; &c." 1 Robb, 193 (199).

In *Odiorne v. Winkley* (1814), 2 Gallison, 51, Story, J.: (54) "It is often a point of intrinsic difficulty to decide whether one machine operates upon the same principles as another. In the present improved state of mechanics, the same elements of motion, and the same powers must be employed in almost all machines. The lever, the wheel, and the screw, are powers well known; and if no person could be entitled to a patent who used them in his machine, it would be in vain to seek for a patent. The material question, therefore, is not whether the same elements of motion, or the same component parts are used, but whether the given effect is produced substantially by

usefulness or an increased economy of time or power may, in the absence of all other evidence, sometimes suffice to demonstrate that the structural law itself has undergone a change, and therefore that a new machine has been created.

the same mode of operation and the same combination of powers in both machines." 1 Robb, 52 (55).

Further, that identity of machines consists in identity of principle or mode of operation, see *Morley Sewing Mach. Co. v. Lancaster* (1885), 23 Fed. Rep. 344; *Blanchard v. Puttman* (1867), 2 Bond, 84; 3 Fisher, 186; *Cahoon v. Ring* (1859), 1 Fisher, 397; 1 Clifford, 592; *Foss v. Herbert* (1856), 1 Bissell, 121; 2 Fisher, 31; *Sickels v. Borden* (1856), 3 Blatch. 535; *Blanchard v. Beers* (1852), 2 Blatch. 411; *Parker v. Stiles* (1849), 5 McLean, 44; *Brooks v. Bicknell* (1844), 3 McLean, 432; *Evans v. Eaton* (1822), 7 Wheaton, 356; 1 Robb, 336.

The same proposition is stated by the courts in various ways. Thus, for example, that machines are identical when they perform the same function, or attain the same result in the same way, see *Cantrell v. Wallick* (1886), 117 U. S. 689; 35 O. G. 871; *Holly v. Vergennes Mach. Co.* (1880), 4 Fed. Rep. 74; 18 Blatch. 327; 18 O. G. 1177; *Wicke v. Ostrum* (1880), 103 U. S. 461; 19 O. G. 867; *Tatham v. Le Roy* (1852), 2 Blatch. 474; *Brooks v. Bicknell* (1844), 3 McLean, 432.

That differences in the shape of the parts of the machine do not disturb its identity, if the mode of operation remains unchanged, see *Blanchard v. Puttman* (1867), 3 Fisher, 186; 2 Bond, 84; *Sickels v. Borden* (1856), 3 Blatch. 535; *Wilson v. Barnum* (1849), 2 Fisher, 635; 2 Robb, 749.

That difference in the arrangement of parts does not destroy the identity of

the machine unless its structural law is changed, see *Ives v. Hamilton* (1875), 92 U. S. 426; 10 O. G. 336; *Florence Sewing Mach. Co. v. Grover & Baker Sewing Mach. Co.* (1872), 110 Mass. 70; *Roberts v. Ward* (1849), 4 McLean, 565; 2 Robb, 746.

That mode of use does not change the machine unless the structural law is also changed, see *Sewing Mach. Co. v. Frame* (1884), 24 Fed. Rep. 596; 28 O. G. 96.

But that any change producing a new result indicates a change in the mode of operation, and hence produces a new machine, see *Sewing Mach. Co. v. Frame* (1884), 24 Fed. Rep. 596; 28 O. G. 96; *Barber v. Hallett* (1879), 20 O. G. 449; 10 Fed. Rep. 130.

And that even a change in the rapidity or economy with which the machine operates may show the existence of a new mode of operation, see *Gallahue v. Butterfield* (1872), 2 O. G. 645; 10 Blatch. 232; 6 Fisher, 203.

That such a change in a machine that it requires fewer persons to operate it indicates that it is a different machine, see *Coupe v. Weatherhead* (1883), 23 O. G. 1927; 16 Fed. Rep. 673.

That changes in the materials of which a machine is composed, unless affecting the principle on which it operates, do not disturb its identity, see *Bailey Washing & Wringing Mach. Co. v. Lincoln* (1871), 4 Fisher, 379.

That to omit some parts of a machine and add others may make a new machine, see *Coupe v. Weatherhead* (1883), 23 O. G. 1927; 16 Fed. Rep. 673.

§ 179. Machine a Unit : its Unity how Destroyed.

The unity of a machine also resides in the same rule of action. Whether composed of a single organism or of several subordinate organisms, as a machine it is a unit, and is destroyed whenever any change, addition, or withdrawal of its elements results in the alteration of its structural law.¹

§ 179. ¹ All the cases cited in the notes to § 178 bear upon this question of the unity of a machine. In addition thereto are the following, equally germane perhaps to the doctrines of identity and individuality. In *Seymour v. Osborne* (1870), 11 Wall. 516, Clifford, J.: (548) "Particular changes may be made in the construction and operation of an old machine so as to adapt it to a new and valuable use not known before, and to which the old machine had not been, and could not be, applied without those changes; and under those circumstances, if the machine, as changed and modified, produces a new and useful result, it may be patented, and the patent will be upheld under the existing laws. Such a change in an old machine may consist merely of a new and useful combination of the several parts of which the old machine is composed, or it may consist of a material alteration or modification of one or more of the several devices which entered into its construction, and whether it be one or the other, if the change of construction and operation actually adapts the machine to a new and valuable use not known before, and it actually produces a new and useful result, then a patent may be granted for the same, and it will be upheld as a patentable improvement."

In *Stainthorp v. Humiston* (1864), 4 Fisher, 107, Hall, J.: (110) "Upon the question of identity of machines, or of mechanical devices, whenever that question arises in a patent case, the mode of operation and the result produced are important considerations ;

and if the modes of operation and the results produced are both clearly and substantially different, when the material or substance brought under their operation is the same, the question of identity must ordinarily, at least, be determined in the negative ; and this is generally true, whether the invention patented is an organized machine, or an improvement upon an existing machine; and whether the patent is for a machine or a mechanical device, new in all its parts, or merely for a combination of two or more well known existing machines or mechanical devices."

In *Brooks v. Bicknell* (1843), 3 McLean, 250, McLean, J.: (262) "It may be proper, however, to remark, that a mere colorable or slight alteration of a machine, or a change in its proportions, gives no ground for a patent ; nor can it shelter an individual from the consequences of an infringement. In such cases the inquiry always is, whether the principle of the two machines is the same. If the principle on which the machinery works is the same, and the effect is similar in both, in contemplation of law the machines are identical. A change in the position of the operating powers or in the thing on which the effect is produced, is of no importance. Such a modification does not rise to the dignity of an invention. There must be an essential difference in the application of the mechanical power, to make the machines dissimilar." 2 Robb, 118 (130).

That the principle is the essence of the machine, and may remain the same though the machine be apparently much

While this law remains undisturbed, any such change, addition, or subtraction is at the most an improvement on the old machine, however marked may be the effect produced upon its shape or usefulness. But when the increase or withdrawal of its parts introduces a new law or mode of operation, with or without a change in shape or usefulness, the unity of the machine disappears and a new instrument is substituted for the old.

§ 180. Machine not Complete until Reduced to Practice.

Although the *modus operandi* is thus the essence of the machine, it becomes entitled to protection by a patent only when reduced to practice and embodied in an operative instrument.¹ An operative instrument is one capable of immediate practical use in the arts, in the manner proposed by its inventor. The expression of his idea in language, drawings, or a model does not fulfil the requirements of the law. A machine must be constructed of sufficient size, strength, and capacity to serve

changed, see *Smith v. Higgins* (1859), 1 Fisher, 537.

That no change in the mode of use of the machine can make it a different machine unless the principle be changed, see *Sewing Mach. Co. v. Frame* (1884), 24 Fed. Rep. 596; 28 O. G. 96; *Boston Elastic Fabrics Co. v. East Hampton Rubber Thread Co.* (1874), Holmes, 372; 5 O. G. 696; 1 Bann. & A. 222.

That unless the organism be changed the unity of the machine is not affected, see *Seymour v. Marsh* (1872), 6 Fisher, 115; 9 Phila. 380; 2 O. G. 675.

And that the introduction into a compound machine of one new operating agency does change the principle and destroy the unity, see *Sanford v. Merri-mac Hat Co.* (1876), 4 Clifford, 404; 10 O. G. 466; 2 Bann. & A. 408; *Le Roy v. Tatham* (1859), 22 How. 132.

§ 180. ¹ That the inventive act is complete only when an operative machine is produced, see *Knox v. Loweree* (1874), 6 O. G. 802; 1 Bann. & A. 589;

Burr v. Duryce (1863), 1 Wall. 531; *Hayden v. Suffolk Mfg. Co.* (1862), 4 Fisher, 86; *Winans v. N. Y. & Harlem R. R. Co.* (1855), 4 Fisher, 1; *Pitts v. Wemple* (1855), 2 Fisher, 10; 1 Bissell, 87.

That the machine, if clearly capable of use, need not have been actually operated in public, see *Knox v. Loweree* (1874), 6 O. G. 802; 1 Bann. & A. 589; *Wheeler v. Clipper Mower & Reaper Co.* (1872), 2 O. G. 442; 10 Blatch. 181; 6 Fisher, 1; *Hayden v. Suffolk Mfg. Co.* (1862), 4 Fisher, 86; *Pitts v. Wemple* (1855), 2 Fisher, 10; 1 Bissell, 87.

That a rude machine, made for experiment and then abandoned, is not a practically operative machine, see *Gottfried v. Phillip Best Brewing Co.* (1879), 17 O. G. 675; 5 Bann. & A. 4.

But that the machine need not be perfect provided it be practically operative, see *Wheeler v. Clipper Mower & Reaper Co.* (1872), 2 O. G. 442; 10 Blatch. 181; 6 Fisher, 1.

as an effective means for the accomplishment of its predetermined end. Its sufficiency, if not apparent on its face, must be demonstrated by such tests as prove its readiness for immediate public use. But otherwise than for the purposes of such demonstration, it need not have been actually employed; nor is it necessary that its mechanical execution be so perfect as to leave no room for further improvement.

§ 181. **Machine Reducible to Practice in Many Forms: all Identical Inventions.**

It is evident that the structural law or idea of means embodied in a machine must often be capable of expression through several mechanical structures, differing from each other either in the shape, the number, or the arrangement of their subordinate parts. Each of these different structures is, however, the same machine. The inventor may select whatever form he chooses for the embodiment of his idea, but all its various forms are supposed to be present to his mind, and to be equally his property with that which he adopted and delineated in his application for a patent. And therefore his letters-patent, when obtained, protect him as effectually against all other possible embodiments of the same structural law as against the imitation or appropriation of the one he has described.

SECTION III.

OF A MANUFACTURE.

§ 182. **"Manufacture" Defined.**

A manufacture is an instrument created by the exercise of mechanical forces and designed for the production of mechanical effects, but not capable, when set in motion, of attaining by its own operation to any predetermined result. It has no inherent law which compels it to perform its functions in a given method, but receives its rule of action from the external source which furnishes its motive power. In this absence of "principle" or "*modus operandi*" lies the distinction

between a manufacture and a machine, — the former requiring the constant guidance and control of some separate intelligent agent, the latter operating under the direction of that intelligence with which it was endowed by its inventor when he imposed on it its structural law.

§ 183. "Manufactures" a Comprehensive Class of Inventions.

The species of inventions belonging to this class are very numerous, comprehending every article devised by man except machinery upon the one side, and compositions of matter and designs upon the other. Thus the parts of a machine considered separately from the machine itself, all kinds of tools and fabrics, and every other vendible substance which is neither a complete machine nor produced by the mere union of ingredients, is included under the title "manufacture."¹ The mechanical effects which they are intended to produce are of all varieties, from the simple interruption of the action of natural forces to the direction and application of forces artificially developed. In this wide field of inventions many articles must, of course, be found lying so close to the dividing line that doubt may well arise whether they do not more properly belong to the class which follows or precedes it; but even here careful attention to the exact idea of means which the inventor has intended to express will usually remove all ambiguity.

§ 184. Manufacture Distinct from its Component Substances and from the Means Employed in its Production.

A manufacture is an entity distinct from the substances of which it is composed, and from the instruments or art by which it is produced.¹ It is an instrument by itself, embody-

§ 183. ¹ That an article of ornament, if of new utility also, may be a manufacture, see *Simpson v. Davis* (1882), 20 Blatch. 413; 12 Fed. Rep. 144.

That a bond and coupon register, in the form of a book, is a manufacture, see *Munson v. Mayor of N. Y.* (1880), 3 Fed. Rep. 338; 18 Blatch. 237; 5 Bann. & A. 486.

That a wood pavement is a manufacture, see *Stead v. Williams* (1843), 2 Web. 126.

§ 184. ¹ In *Milligan & Higgins Glue Co. v. Upton* (1874), 4 Clifford, 237, Clifford, J. : (251) "Nothing short of invention or discovery will support a patent for a manufacture, any more than for an art, machine, or composition

ing a separate and complete idea of means, and derives from this idea its own essential character. If known already to the

of matter, as is clearly illustrated in another case decided in this circuit: *Merrill v. Yeomans*, 5 Gaz. 267; where the circuit judge says that a patentee who has invented a process in the arts, whereby an article of manufacture is produced, new in kind and not before known, may separately claim and patent both the art and the manufacture, if both are new and useful in the sense of the patent law; and it is doubtless true, if the thing be new in and of itself, it is patentable as a new manufacture, and that the patent would be infringed by the unlicensed construction or use of the product, though produced by other means than those described in the specifications of the patent. Inventions of the kind are rare, as it much more frequently happens that the process is inseparable from the product, so that the patentee cannot claim the product if produced by hand tools, or by other means substantially different from those employed by the inventor or discoverer. Patentees in the former case may claim the new product without qualification, but in the latter, they should claim the product only when made by the described means or their equivalents, as the process inheres in the manufacture and constitutes an element of the invention." 6 O. G. 837 (842); 1 Bann. & A. 497 (512).

In *Wooster v. Calhoun* (1873), 11 Blatch. 215, Woodruff, J. : (216) "Nor am I prepared to assent to the proposition, that the product of a machine is patentable on the mere ground that it makes an already known article more perfectly than it has been, or can be, made without a machine. The idea being old, men strive to embody it perfectly. Human skill is exhausted in the effort. Human hands, less exact

and unvarying in their movements, only approximate perfection. A machine is devised which makes it better than it has ever before been made. Another machine is invented which approaches more nearly. Still another machine is invented which performs, it may be, better, — it may be, not so well. Is the product of the best human skill, in such case, patentable? Is the product of each successive machine patentable? If all the makers are not entitled to a patent for the article, as a product, which of them is entitled? Surely, improvements in degree or quality are not the subject of a patent." 8 Fisher, 514 (516).

In *The Wood-Paper Patent* (1873), 23 Wall. 566, Strong, J. : (593) "It is quite obvious that a manufacture, or a product of a process, may be no novelty, while, at the same time, the process or agency by which it is produced may be both new and useful, — a great improvement on any previously known process, and therefore patentable as such. And it is equally clear, in cases of chemical inventions, that when, as in the present case, the manufacture claimed as novel is not a new composition of matter, but an extract, obtained by the decomposition or disintegration of material substances, it cannot be of importance from what it has been extracted. There are many things, well known and valuable in medicine, or in the arts, which may be extracted from divers substances. But the extract is the same, no matter from what it has been taken. A process to obtain it from a subject from which it has never been taken may be the creature of invention, but the thing itself, when obtained, cannot be called a new manufacture. It may have been in existence and in common use before the

arts, its production by a new process or by new instruments cannot make it new; nor if unknown is it the less a new invention that the agencies or methods by which it is now evolved are old. As to all the conditions required to render it a patentable invention it must stand or fall alone.

§ 185. **Manufacture may be a Simple Manufacture or a Combination.**

A manufacture may consist of a single instrument, or of a combination of instruments which act together for a common purpose. The instrument is single where none of the parts of which the manufacture is composed could be used without other parts in the production of mechanical effects. But where two or more single instruments are united in a new instrument, and co-operate with each other in the production of an effect beyond the sum of the effects of the individual instruments, they form a combination which is a new manufacture. The distinction between a combination and an aggregation is

new means of obtaining it was invented, and possibly before it was known that it could be extracted from the subject to which the new process is applied. Thus, if one should discover a mode, or contrive a process, by which prussic acid could be obtained from a subject in which it is not now known to exist, he might have a patent for his process, but not for prussic acid."

That a manufacture is not new and patentable unless the creative act in which it originated is distinct from that required to invent the process or apparatus by which it is made, see *Union Paper Collar Co. v. Van Deusen* (1875), 23 Wall. 530; 7 O. G. 919; *Draper v. Hudson* (1873), 3 O. G. 354; *Holmes*, 208; 6 Fisher, 327.

That a manufacture, if new in itself, may be patentable, whether the process or apparatus by which it is produced be new or old, see *Anilin v. Hamilton Mfg. Co.* (1878), 13 O. G. 273; 3 Bann. & A. 235; *Draper v. Hudson* (1873), 3 O. G. 354; 6 Fisher, 327; *Holmes*,

208; *Young v. Lippman* (1872), 2 O. G. 249; 9 Blatch. 277; 5 Fisher, 230; *Woodward v. Morrison* (1872), 2 O. G. 120; *Holmes*, 124; 5 Fisher, 357.

That a manufacture is an invention distinct from the mode of producing it, see *United Nickel Co. v. Pendleton* (1883), 21 Blatch. 226; 24 O. G. 704.

That a new process producing a new manufacture involves two separate inventive acts, see *Tucker v. Dana* (1881), 7 Fed. Rep. 213; *Ex parte Bancroft* (1881), 20 O. G. 1893.

That to make an article by a new process or new apparatus is not to produce a new manufacture, see *McCloskey v. Dubois* (1881), 19 Blatch. 205; 8 Fed. Rep. 710; 19 O. G. 1286; 20 O. G. 371; *McCloskey v. Dubois* (1881), 20 Blatch. 7; 9 Fed. Rep. 38; *Anilin v. Hamilton Mfg. Co.* (1878), 13 O. G. 273; 3 Bann. & A. 235; *Draper v. Hudson* (1873), 6 Fisher, 327; 3 O. G. 354; *Holmes*, 208; *Rex v. Else* (1785), 1 Web. 76; 1 Abb. P. C. 40.

not so easily discerned in this class of inventions as in the case of a machine. Where two machines, each having its own law of operation, are united, it is not generally difficult to ascertain whether each operates only according to its own peculiar law, or whether by their union a new structural law has been imposed on the conjoined machines, whereby they have become the expression of a new idea of means which severally and collectively they did not suggest. But in a manufacture the law of operation is in the source from which the motive power is drawn; and the action of the instruments in their united state, so far as it depends upon the instruments themselves, often remains the same as before they were united. In such cases the act of the inventor in the collocation of these instruments gives the resulting instrument no new inherent mode of operation, but simply places the collocated instruments in such relations to a common object that under the direction of the external motive power their co-action upon it or upon each other may produce some effect which, if they acted separately, could not be obtained. Thus it may be assumed as to most inventions of this class that a true combination has been formed whenever the action of the combined elements leads to a result essentially distinct from any that could be attained by the employment of the elements in a separated state, although the mode of their co-operation cannot be perceived;¹ while in a machine the principal if not the sole test of the formation of a new combination is to be sought, not in its product or result, but in its manifestation of a new structural law.

§ 185. ¹ That a new end or result is accomplished by an art or instrument is conclusive evidence that the art or instrument is also new. Hence when the collocation of two simple manufactures produces an instrument capable of doing what neither manufacture could have done alone, and what both could not have done if each were used independently of the other, this resulting instrument is necessarily a different manufacture, whether the fact or the mode of

the co-operation between the combined instruments is otherwise discernible or not. It may well be doubted whether many of the cases which have been decided against the patentees of manufactures on the ground that the instrument claimed was a mere aggregation have not been governed by principles applicable rather to machines than manufactures, and really meritorious inventions been thus denied the protection of the law.

§ 186. **Manufacture may be Composed of Known Substances.**

The substances of which a manufacture is composed form no part of its essential nature, except so far as their respective properties endow it with its characteristic attributes. The idea embodied in it is an idea distinct from that which is expressed in any of its integral elements, and may be capable of the same embodiment in an instrument composed of different members. That all these substances or elements have long been known, or even that they have previously been associated in an instrument effecting the same end, is immaterial. As in all other cases, the inventor of a manufacture is free to select any sufficient method of embodying his conception of the instrument, and does not imperil his own creation by using the same tangible materials which others have employed.

§ 187. **Manufacture Identical however Produced.**

Although every manufacture is an instrument essentially distinct in its idea of means from every other instrument, it has sometimes been held that the invention of a method whereby a natural substance can be artificially produced, or a product heretofore too costly for general use can be manufactured at an expense which places it for the first time within reach of the public, entitles the inventor to a monopoly of the substance or the product resulting from the employment of his method, as if it were a new product or substance, legally if not physically different from its natural or costly prototype.¹ This position is manifestly erroneous. The arti-

§ 187. ¹ In *Stevens v. Keating* (1847), 2 Web. 181, Pollock, C. B. : (182) "All patents must be for a manufacture. The real invention may be not so much for the thing when produced as for the mode in which it is produced ; and its novelty may consist not so much in its existence as a new substance, as in its being an old substance, but produced by a different process. In one sense, an old substance produced by a new process is a new manufacture; of that there cannot be a doubt; and there- fore, although the language of the Act has been said to apply only to manufactures and not to processes, when you come to examine it, either literally or even strictly, it appears to me the expression 'manufacture' is free from objection, because, though an old thing, if made in a new way, the very making of it in a new way makes it a new manufacture." And in this country it has been held that to make by artificial means a substance, which as a natural product is already known in the arts, is

ficial or inexpensive substance, or, what is the same thing, the fact that the substance can be artificially or inexpensively produced, may indeed have been discovered by the inventor, but this discovery is not the creation of a means, it is merely the discerning of an end to be accomplished by the method which he has devised. Were the substance itself hitherto unknown an inventive act would be required for its production, but being known its reproduction by a new method cannot change its essential characteristics, nor demand any other exercise of the inventive faculties than such as are engaged in the creation of the method from which it results. While, therefore, the inventor may have added to the stock of scientific knowledge by his discovery that the substance can be manufactured artificially or cheaply, it is not this discovery which confers upon the public any practical advantage. It is only when he discovers and constructs a process or device by which the substance can be artificially or inexpensively supplied, that he increases the industrial appliances of mankind, and brings the fruit of his researches and experiments within the field of patentable inventions.

a new invention both as to the process and the product. See *Anilin v. Cochran* (1879), 16 Blatch. 155; *Anilin v. Higgin* (1878), 15 Blatch. 290. So also it has been decided that where an article, though produced before, but at so great an expense as to be useless in the arts, is now supplied by a new method or new apparatus so cheaply as to be available for public use, it is to be treated as in itself a new invention, because although known before it was never reduced to practical utility. See *Lamb v. Hamblen* (1882), 11 Fed. Rep. 722; *Hammerschlag v. Scamoni* (1881), 7 Fed. Rep. 584; 20 O. G. 75.

These decisions have, however, now been overruled and the true doctrine stated in *Cochrane v. Anilin* (1884) 111 U. S. 293, where Blatchford, J., says: (311) "It was an old article. While a new process for producing it was patentable, the product itself could not be pat-

ented, even though it was a product made artificially for the first time, in contradistinction to being eliminated from the madder root. Calling it artificial alizarine did not make it a new composition of matter, and patentable as such, by reason of its having been prepared artificially for the first time from anthracine, if it was set forth as alizarine, a well-known substance." 27 O. G. 813 (818). See also *Wooster v. Calhoun* (1873), 11 Blatch. 215; 6 Fisher, 514.

That a new form of an old article may be a new manufacture, see *Duff v. Calkins* (1883), 25 O. G. 601.

That to perceive a hitherto unknown quality in an existing substance is not the invention of a new substance, see *Ansonia Brass and Copper Co. v. Electrical Supply Co.* (1887), 32 Fed. Rep. 81; 42 O. G. 1168.

§ 188. **Essential Attributes of a Manufacture.**

The essence of a manufacture resides in the idea of means which it embodies. A manufacture, being a finished product, usually impresses the observer as a complete realization of the purposes of the inventor, and suggests the idea of an end accomplished rather than that of a means by which an end may be attained. This impression is, however, incorrect. Until applied by some one, a manufacture is as useless as an unemployed machine; and when applied it benefits the public, not by its mere existence nor by its simple application, but by producing some change in the condition of material objects. Those qualities of the manufacture which enable it, when so applied, to produce those changed conditions are the expression of its idea of means, and by these, as a group of attributes, its essential character is manifested. Whenever its shape, materials, size, or proportions are among these attributes they become the necessary features of the invention, and any change in either constitutes a different means.¹ But when unnecessary to enable it to effect such changes of condition, these qualities of the manufacture may be subjected to any number or degree of substitutions and alterations without destroying its identity.

§ 188. ¹ In *Emerson v. Howe* (1881), 8 Fed. Rep. 327, Lowell, J.: (329) "In these patents for small articles slight differences are often important; and, if such things are patentable at all, it must almost always be in virtue of a more useful adaptation to the needs of commerce by small changes of structure, which in a great machine might be merely alternate modes of reaching a part of a general result."

In *Glue Co. v. Upton* (1877), 97 U. S. 3, Field, J.: (6) "A distinction must be observed between a new article of commerce and a new article which, as such, is patentable. Any change in form from a previous condition may render the article new in commerce; as powdered sugar is a different article in commerce from loaf sugar, and ground

coffee is a different article in commerce from coffee in the berry. But to render the article new in the sense of the patent law, it must be more or less efficacious, or possess new properties by a combination with other ingredients; not from a mere change of form produced by a mechanical division. It is only where one of these results follows that the product of the compound can be treated as the result of invention or discovery, and be regarded as a new and useful article."

That to pulverize or comminute an existing product, involving no change in its actual properties, though rendering it more convenient for transportation and use, is not to invent a new product, see *The Milligan & Higgins Glue Co. v. Upton* (1874), 4 Clifford, 237; 6 O. G. 837; 1 Bann. & A. 497.

§ 189. Manufacture a Unit: its Unity how Destroyed.

A manufacture is a unit to whose existence the presence of each one of its characteristic attributes is necessary. When the manufacture is a simple instrument, the withdrawal of any attribute destroys its unity; and if those which remain constitute an operative means, the means so constituted is a different manufacture from the former. The addition of an attribute, which so far modifies the action of the others that they can no longer produce the same effects, is also the creation of a new instrument and the destruction of the old; while if the former action and effect are still preserved, but have been brought, by the addition, to a higher excellence or a wider application, the unity of the manufacture continues undisturbed, and the addition is a mere improvement. When the manufacture is a combination of several instruments its unity consists in the correlation of its elemental instruments, and is dissolved by the withdrawal of any one of these essential elements, or by the substitution for either of one which is not in the combination the equivalent of that whose place it occupies, or by any rearrangement of the elements which introduces different methods of co-operation, or by the addition of new elements which modify the action of existing elements upon each other, or upon their common object, in such a manner that their action is no longer able to produce the old result. But when the withdrawal, substitution, or addition leaves the previous co-operation of the elements undisturbed, merely enabling them to achieve their joint result in a more perfect or more serviceable manner, an improvement only has been effected, and the unity of the manufacture still remains unbroken.

§ 190. Manufacture not Complete until Reduced to Practice.

Reduction to practice, in reference to this species of inventions, consists in the production of an operative instrument adapted for immediate public use. The requirements in regard to tests and practical employment are the same as those which govern a machine. Whatever may be necessary, in order to establish the sufficiency of the manufacture for the accomplishment of its proposed results, must be performed

by its inventor before his inventive act is considered as complete and his invention becomes entitled to the protection of the law. Sometimes the instrument carries in itself the evidence of its own capabilities; in other cases actual use is indispensable.

§ 191. Manufacture Reducible to Practice in Many Forms: all Identical Inventions.

The inventor of a manufacture, as of other instruments, by the embodiment of his idea in one operative instrument appropriates to himself all other practical expressions of the same idea. The scope of an idea which is embodied in a manufacture may be very broad, as in the case of most generic simple manufactures, or may be very narrow, as in improvements and in combinations. But whether broad or narrow, under whatever form or name it is embodied, it is always the same manufacture, and belongs to the originator of its characteristic idea.

SECTION IV.

OF A COMPOSITION OF MATTER.

§ 192. "Composition" Defined.

A composition of matter is an instrument formed by the intermixture of two or more ingredients, and possessing properties which belong to none of these ingredients in their separate state. An ingredient is a substance which, though capable of independent existence, may yet so far lose its identity and individuality, when mingled with other substances, as no longer to be distinguishable from them. In this respect it differs from a part or element of a machine or manufacture which, however closely united with its associated parts or elements, always preserves its own identity, and is discernible in its independent as well as in its combined condition. The intermixture of ingredients in a composition of matter may be produced by mechanical or chemical operations, and its result may be a compound substance resolvable

into its constituent elements by mechanical processes, or a new substance which can be destroyed only by chemical analysis. Its properties may be entirely new, — never before possessed by any substance, simple or compound; or may be new only in relation to its own ingredients, being essentially distinct from any with which they are separately or collectively endowed.

§ 193. **Composition a True Combination.**

A composition of matter is always a true combination. Each of its ingredients is itself a means whose operative forces manifest themselves through the chemical or mechanical properties by which it is distinguished. The intermixture of these ingredients results in the co-operation of their respective forces in such a manner as to produce a new force, which is distinct both from the forces of the individual elements and from the sum of their collective forces, and is exhibited in the new qualities with which the composition is endowed. It differs from all other combinations in that its ingredients or elemental means, when once united in the combination, often become individually undiscernible by human sense, and can be recovered and distinguished only by the destruction of the combination as a whole. This difference leads to radical differences in the rules by which the identity of these elemental forces is determined, as will hereafter be particularly explained.¹

§ 193. ¹ Although the rule is often stated to be that chemical and mechanical equivalents rest on the same basis of principle, the statement cannot be taken without material qualification. As will hereafter (§ 254 and notes) appear, the rule which governs equivalents in mechanical combinations is not the same as that which applies to equivalents in a simple machine or manufacture, — the test in the latter case being that the alleged equivalents perform the same function in the mechanism; in the former case, that they perform the same function in the same way. Chemical equivalents generally

follow the rule of equivalents in simple instruments, and are equivalent when they discharge the same office in the composition, and were known as such at the date of its invention. See § 254 and notes; also *Roots v. Hyndman* (1873), 6 Fisher, 439; 4 O. G. 29; *Rumford Chemical Works v. Lauer* (1872), 10 Blatch. 122; 5 Fisher, 615; 3 O. G. 349; *Woodward v. Morrison* (1872), 2 O. G. 120; *Holmes*, 124; 5 Fisher, 357; *Poppenhusen v. Falke* (1862), 2 Fisher, 213; 5 Blatch. 46; *Goodyear v. Railroad* (1853), 2 Wall. Jr. 356; 1 Fisher, 626.

§ 194. Composition Distinct from its Elements and from their Mode of Intermixture.

A composition of matter is a complete and independent means, having an existence distinct from that of the substances of which it is composed, and from the processes by which it is created. Though these substances are old, the composition may be new. Though they have been already grouped together, the forces then called into action and co-operating in that union may have resulted in a different composition. Though the same mode of intermixture may have been employed in reference to various substances, its application to the present elements may produce a compound never previously known. The character of a composition of matter cannot, therefore, be determined from an examination of its elements alone, nor of the method by which they have been combined. It must be judged also by its own intrinsic attributes. While it must be composed of substances, no particular substance is essential unless it is the only one by which the necessary elemental force can be supplied. While some mode of intermixture must be employed, no special mode is indispensable unless the substances can by no other mode be so united that the same properties will be developed in the composition as a whole.

§ 195. Essential Attributes of a Composition.

The essence of a composition of matter resides in the idea of means expressed by the co-operation of its specific elemental forces in the production of its new and characteristic force. While two compositions which possess different properties are essentially distinct, two compositions which possess the same properties are not necessarily the same. Such compositions are identical only when the forces which are manifested through their characteristic properties result from the same co-operation of the same elemental forces; and this requires that the composition should consist of the same grouping of the same ingredients.¹ Ingredients are the same,

§ 195. ¹ In *Goodyear v. Berry* (1868), 3 Fisher, 439, Leavitt, J. : (449) "The principle is conceded that a patent for a mechanical structure or contrivance, producing a new and useful result, is no protection against the use of an invention producing the same result by appliances and on principles substantially different

however they may differ as mere substances, when they furnish to the composition the same elemental force; and groupings of ingredients are the same when in each grouping every elemental force co-operates with every other in the same manner to produce the new resulting force.² Hence no addition, substitution, or withdrawal of ingredients can affect the identity of the composition unless it introduces, or removes, or modifies the action of an elemental force; nor can a change in the proportions of ingredients, or in the order of their intermixture, vary the character of the result unless it summons into action, in the same ingredients, some new elemental force or imposes on existing forces some new method of co-operation.³

§ 196. Composition a Unit: its Unity how Destroyed.

A composition of matter is a unit, whose integrity depends upon the preservation of the precise union and co-operation

from the patented invention. The rights of the patentee or proprietor of the patent are only invaded by a result like that of his invention, effected by what are substantially the same means. And so in the case of patented chemical combinations; the exclusive right to the invention imports nothing but protection against the use of the same or substantially the same elements, compounded and treated on principles substantially the same as those of the patented article. In brief, a patent right does not cover every possible mode of accomplishing the result proposed by an inventor." 2 Bond, 189 (202).

That compositions are the same where the same or equivalent ingredients are compounded and treated on principles substantially the same, see *Francis v. Mellor* (1871), 5 Fisher, 153; 1 O. G. 48; *Goodyear v. Berry* (1868), 2 Bond, 189; 3 Fisher, 439.

² That two substances are not the same ingredient unless they perform the same office in the composition, though chemically they may be the same, see *Bridgeport Wood Finishing Co. v.*

Hooper (1880), 5 Fed. Rep. 63; 20 O. G. 156; 18 Blatch. 459.

That substances are the same ingredient when, in reference to the composition, they have similar properties and produce the same effects, see *Matthews v. Skates* (1860), 1 Fisher, 602.

³ That the addition of substances which do not change the properties, effect, or usefulness of the composition, do not destroy its identity, see *Klein v. Russell* (1873), 19 Wall. 433.

That the substitution of purer materials, rendering the composition more useful, or useful for additional purposes, analogous to the former ones, if the materials perform the same office, is no change of ingredients or of the composition itself, see *Buchan v. McKesson* (1880), 7 Fed. Rep. 100; 19 O. G. 222; 18 Blatch. 485.

That no change in the shape or appearance of a composition destroys its identity while its properties remain unchanged, see *Milligan & Higgins Glue Co. v. Upton* (1874), 4 Clifford, 237; 6 O. G. 837; 1 Bann. & A. 497.

of those elemental forces which are furnished to it by its essential ingredients. Substances which neither supply the composition with an elemental force nor affect the operation of its elemental forces are not ingredients, and may be added, altered, or withdrawn without attacking its integrity.¹ A change in the ingredients or in their mode of intermixture which leaves the elemental forces and their method of co-operation undisturbed, but yet endows the composition with increased efficiency, is an improvement in the existing composition, not a new one. But every modification in the ingredients or the process of combining them, which varies either the number, character, or co-operation of its elemental forces, is a destruction of its unity, and any composition which results from such a modification of another must be essentially different therefrom.²

§ 197. Composition Identical however Produced.

A composition of matter, in order to be patentable, must, like a manufacture, differ in its essential characteristics from any substance previously known.¹ The artificial combination

§ 196. ¹ In *Loutrel v. Mellor* (1871), 1 O. G. 48, *McKenna, J.* : (51) "While characteristic resemblance is preserved they may, perhaps, be considered as identical within the meaning of the patent law, although one of them may not contain some of the constituents of the other, which are not necessary to impart to it its peculiar attributes."

² That to change the proportions of the ingredients and thus secure new properties in the resulting composition is a new invention, see *Loutrel v. Mellor* (1871), 1 O. G. 48; *Francis v. Mellor* (1871), 5 *Fisher*, 153; 1 O. G. 48.

That to add an ingredient producing new properties in the compound makes a new composition, see *Rogers v. Ennis* (1878), 14 O. G. 601; 15 *Blatch*. 47.

That to omit one essential ingredient makes of the remainder a different composition, see *Tarr v. Folsom* (1874), 1 *Bann. & A.* 24; 5 O. G. 92; *Holmes*, 312.

That to discover the causes of defects in a chemical composition, and devise means to remove them, is the invention of a new chemical composition and covers all modes of curing the defects, see *United Nickel Co. v. Harris* (1878), 15 *Blatch*. 319; 17 O. G. 325; 3 *Bann. & A.* 627.

That a composition consisting of certain substances of a given quality, mixed in a specific manner, and producing certain resultant properties, is a different composition from one comprising the same substances but mingled without reference to any particular quality or any special mode of mixing, and possessing different properties, see *Muntz v. Foster* (1843), 2 *Web.* 93, 96.

§ 197. ¹ If the position that a manufacture for the first time made accessible to the public is to be regarded as a new manufacture were correct, the same rule would, of course, apply to compositions

of ingredients into a substance which exists in nature is simply a new process for the production of that substance, not the creation of a new substance; and in such cases the process, not the substance, is the patentable invention.

§ 198. **Composition not Complete until Reduced to Practice.**

Reduction to practice, in reference to a composition of matter, consists in the actual intermixture of those ingredients which are necessary to supply it with its elemental forces, in such a manner that the co-operation of these forces will endow the resulting compound with its essential characteristic properties.¹ The specific substances employed as ingredients are of no consequence, since all substances are the same ingredient when they furnish to the composition the same elemental force. The particular mode of intermixture is also immaterial, since all modes which subject these elemental forces to the required law of co-operation are identical. A practically operative compound must, however, be produced, capable of immediate useful application. Neither recipes, formulæ, nor descriptions are sufficient. Nor, where tests are necessary in order to determine whether or not the composition possesses those properties which constitute its essential character as an operative means, can the invention be re-

also. The lower courts have been divided on this subject. On one hand it has been urged that an artificial substance is not identical either legally or scientifically with a natural substance, though both are composed of the same constituents and possess the same properties. (See § 187, and notes, *ante*.) On the other hand it has been claimed that the only invention in such cases is a process, either consisting in a specific treatment of new objects, or in applying new forces to the treatment of known objects, and that a patent for the process adequately protects the inventor. (See § 187, and notes, *ante*.) The latter view is correct in principle and has recently been sanctioned by the Supreme Court of the United States. (See *Cochrane v. Anilin*

(1884), 111 U. S. 293; 27 O. G. 813.) If proper protection is given in the patent to the process by which the artificial substance is produced, the inventor may secure the exclusive right to the artificial substance resulting from his process or from any process equivalent thereto. To go further and award him a patent for the substance, however produced, would create in him a monopoly in the scientific fact which he has discovered, namely, that the substance can be artificially produced, — a fact which is an effect and not a means.

§ 198. ¹ That a chemical invention is not complete if experiment is still necessary to render it operative, see *Tyler v. Boston* (1868), 7 Wall. 327.

garded as complete until such tests have been applied and have been successfully endured.

§ 199. Composition Reducible to Practice in Many Forms: all Identical Inventions.

As a composition of matter is a union of elemental forces, each of which may be supplied by various substances, it is evident that the idea of means which it embodies may often be expressed by several combinations composed of different substances or intermingled in different methods. But in such cases all these combinations are the same composition, representing the same intellectual conception and furnishing to the industrial arts the same operative means. All are therefore presumed to have been contemplated by the inventor, whose idea has been reduced to practice in but one, and by his patent for that one all are alike appropriated to his exclusive use.

SECTION V

OF A DESIGN.

§ 200. "Design" Defined.

A design is an instrument created by the imposition upon a physical substance of some peculiar shape or ornamentation which produces a particular impression upon the human eye, and through the eye upon the mind. Its creation involves a change in the substance itself, and not merely in the mode of presenting it for sale; and affects, not its abstract qualities, nor those on which its practical utility depends, but those only which determine its appearance to the sight.¹ Thus, while an

§ 200. ¹ In *Theberath v. Harness Trimming Co.* (1883), 23 O. G. 1121, Nixon, J. : (1122) "They differ from patents for inventions or discoveries in this respect, that they have reference to appearance rather than utility. Their object is to encourage the arts of decoration more than the invention of useful products. A picture or design that

merely pleases the eye is a proper subject for such a patent, without regard to the question of utility which is always an essential ingredient in an invention or discovery patent." 15 Fed. Rep. 246 (250).

In *Gorham Manufacturing Co. v. White* (1871), 14 Wall. 511, Strong, J. : (524) "The Acts of Congress, which

increase in the beauty of the substance is the purpose of this species of invention, a mere increase in beauty, without an alteration in the shape or ornamentation of the substance, does not possess the characteristics of a design; nor, on the other hand, does a change of shape or ornament intended to increase the practical value of an instrument in the industrial arts, although such change augments the beauty of the instrument, bring it within this species of invention. When a new design is created by the exercise of the inventive faculties, and not otherwise, it is a patentable invention.²

authorize the grant of patents for designs, were plainly intended to give encouragement to the decorative arts. They contemplate not so much utility as appearance, and that not an abstract impression or picture, but an aspect given to those objects mentioned in the acts. . . . And the thing invented or produced, for which a patent is given, is that which gives a peculiar or distinctive appearance to the manufacture or article to which it may be applied or to which it gives form." 2 O. G. 592 (593); 6 Fisher, 94 (100).

That a design must be new and original, but not useful, see *Miller v. Young* (1864), 33 Ill. 354.

That a design is a matter of decoration, of "æsthetic 'art," which reaches the mind through the eye, not a matter of industrial utility, see *Ex parte Schulze-Berge* (1888), 42 O. G. 293.

That "utility" in a design is the power to create agreeable sensations through the eye, see *Ex parte Schulze-Berge* (1888), 42 O. G. 293.

That a mere beautiful appearance is not a design, but a new appearance resulting from inventive skill, see *Northrup v. Adams* (1877), 2 Bann. & A. 567; 12 O. G. 430; *Ex parte Neidringhaus* (1875), 8 O. G. 279; 2 MacArthur, 149; *Adams v. Clementson* (1879), L. R. 12 Ch. D. 714; *Lazarus v. Charles* (1873), L. R. 16 Eq. 117.

That the new appearance must result

from a change in the substance itself, not merely in the mode of presenting it for sale, see *Pratt v. Rosenfeld* (1880), 18 Blatch. 234; 3 Fed. Rep. 335; 21 O. G. 866.

That a design is an entirely different thing from the substance to which it is applied, see *Mulloney v. Stevens* (1864), 10 L. T. N. s. 190; *Norton v. Nichols* (1859), 1 El. & El. 761.

That a design is patentable though not more beautiful than former ones, see *Lehnbeuter v. Holthaus* (1882), 105 U. S. 94; 21 O. G. 1783.

² In *Western Electric Mfg. Co. v. Odell* (1883), 18 Fed. Rep. 321, Blodgett, J. : (322) "I find the law on the subject of design patents so well condensed and stated in a little work lately published by Mr. Simonds, that I cannot do better than read his summary, as stated on page 212: 'For a time it was the practice of the patent-office to grant these design patents for almost any subject-matter presented, and with little or no inquiry as to whether any degree of patentable origination had been exercised. It is now tolerably well settled that design patents stand on as high a plane as utility patents, and require as high a degree of exercise of the inventive or origination faculty. In patentable designs a person cannot be permitted to select an existing form and simply put it to a new use any more than he can be permitted to take

§ 201. Design Distinct from its Component Parts.

A design is to be distinguished both from the elements of which it is composed and from the impression which it makes upon the mind of the observer.¹ Its elements are the lines

a patent for a mere double use of a machine ; but the selection and adaptation of an existing form may amount to patentable design as the adaptation of an existing mechanical device may amount to patentable invention.' In support of this enunciation of the law, Mr. Simonds quotes from *Wooster v. Crane*, 2 Fisher, Pat. Cas. 583, as follows : 'The act, although it does not require utility in order to secure the benefit of its provisions, does require that the shape produced shall be the result of industry, effort, genius, or expense, and must also, I think, be held to require that the shape or configuration sought to be secured shall at least be new and original as applied to articles of manufacture.' So, also, in *Northrup v. Adams*, 2 Bann. & A. 567, it is said : 'The same general principles of construction extend to both. To entitle a party to the benefit of the act, in either case, there must be originality and the exercise of the inventive faculty. In the one there must be novelty and utility ; in the other, originality and beauty. There must be something akin to genius, — an effort of the brain as well as the hand. The adaptation of old devices or forms to new purposes, however convenient, useful, or beautiful they may be in their new role, is not invention. . . . If a combination of old designs be patentable at all, — of which I have some doubt, — the combination must be such as to produce a new appearance. If the effect produced be simply the aggregation of familiar designs it would not be patentable. For example, if one should paint upon a familiar vase a copy of Stuart's portrait of Washington,

it would not be patentable, because both elements of the combination, — the portrait and the vase, — are old ; but if "any new and original impression or ornament" were placed upon the same vase, it would fall within the express language of the section.' In *Gorham Co. v. White*, 14 Wall. 511, the Supreme Court said : 'In whatever way produced it is the new thing produced which the patent law regards.'"

That there are two kinds of patents, mechanical patents and design patents, see *C. A. Yale Cigar Mfg. Co. v. Yale* (1884), 80 O. G. 1183.

That where industrial utility depends on shape or configuration the invention is a manufacture, not a design, see *Ex parte Schulze-Berge* (1888), 42 O. G. 293.

That a design is not less a design because the substance as shaped has industrial utility, see *Kraus v. Fitzpatrick* (1888), 42 O. G. 1292.

That all patent regulations apply to designs, see *Theberath v. Rubber & Celluloid Harness Trimming Co.* (1883), 23 O. G. 1121 ; 15 Fed. Rep. 246.

§ 201. ¹ The distinction between the design or appearance given to the substance and the means by which it is produced was clearly indicated in the case of *Gorham Manufacturing Co. v. White*. In the Circuit Court (1870), 7 Blatch. 513, Judge Blatchford treated the appearance as the effect, and the arrangement of lines, etc., as the means from which the appearance resulted, and held that the latter, not the former, was the patentable design. Thus he says: (521) "A patent for a design, like a patent for an improvement in machinery, must be for the means of produc-

and images which, when imposed upon the substance, result in the design. But though the design results from these, arranged in certain courses or groupings, they do not enter into its essential character except in cases where no other lines or images could be employed to effect the same apparent change. Every design containing more than one line or image is in its nature a true combination. Each of its elements, when taken by itself, produces an impression on the eye. Combined together, each co-operates with all the others in the creation of a form or decoration which, taken as a whole, makes an impression entirely different from that of either of its separated elements. The essence of a design, therefore, resides not in its elements alone, nor in their method of arrangement alone, but in that appearance which results from the co-operation of these elements as they are employed in the design.

ing a certain result or appearance, and not for the result or appearance itself. . . . Even if the same appearance is produced by another design, if the means used in such other design to produce the appearance are substantially different from the means used in the prior patented design to produce such appearance, the later design is not an infringement of the patented one."

That the appearance given to the substance is an effect of the arrangement of lines, etc., is undoubtedly true; and if the appearance, as predicable of the substance, had been the end to be accomplished by the invention, the decision of the learned judge would have been correct. But the real end to be attained was the impression upon the mind of the observer; that is, the appearance of the substance not in itself but to the eye; and this end is achieved by giving to the substance any appearance which produces this impression. Hence the true means invented and patentable is the aspect assumed by the substance in consequence of the configuration or decoration imposed upon it; and this means is always the same as long as the

appearance of the substance is the same, no matter what lines or ornaments be employed to produce it.

This is the view taken by the Supreme Court in the same case (1871), 14 Wall. 511; overruling the decision of Judge Blatchford upon this point. Says Strong, J. : (526) "We are now prepared to inquire what is the true test of identity of design. Plainly it must be sameness of appearance, and mere difference of lines in the drawing or sketch, a greater or smaller number of lines or slight variances in configuration, if insufficient to change the effect upon the eye, will not destroy the substantial identity. An engraving which has many lines may present to the eye the same picture, and to the mind the same idea or conception, as another with much fewer lines. The design, however, would be the same. . . . The same conception was in the mind of the designer, and to that conception he gave expression." 2 O. G. 592 (593); 6 Fisher, 94 (101).

That a design and a device for producing it are different inventions, see *Clark v. Bousfield* (1869), 10 Wall. 133.

§ 202. Design Distinct from the Impression it makes on the Mind of the Observer.

Again, though a design is an instrument created for the purpose of making an impression, through the eye, upon the mind of the observer, this impression cannot be regarded as necessarily corresponding with the design itself. The accuracy with which an eye whose visual powers are unimpaired perceives an object cannot be called in question; for the same rays of light, reflected from the same surfaces, must form the same image upon every healthy retina. But the accuracy of a mental impression depends not only on the accuracy of physical vision, but on the degree of attention with which the mind contemplates the object, and on its acquaintance with the class of objects in which the one now subject to inspection is embraced. The image formed upon the retina may often differ widely from that formed in the mind, — one being the exact representation of the object as it really is; the other being composed of certain features of the object only, or of those features in connection with such elements as are suggested by the imagination or the memory. Hence, while no test can be applied to the character of a design except by the mind through the eye,¹ this test is not reliable unless the impression made upon the mind corresponds in all its essential characteristics with the appearance presented to the eye.

§ 203. Design is an Appearance Imparted to an Object.

A design is thus a specific physical means for the production of a specific physical effect. The idea, as it lies in the mind

§ 202. ¹ In *Holdsworth v. McCrea* (1867), L. R. 2 H. L. 380, Lord Westbury: (388) "Now in the case of those things as to which the merit of the invention lies in the drawing, or in forms that can be copied, the appeal is to the eye, and the eye alone is the judge of the identity of the two things. Whether, therefore, there be piracy or not is referred at once to an unerring judge, namely, the eye, which takes the one figure and the other figure, and ascertains whether they are or are not the same."

In *Harrison v. Taylor* (1859), 4 H. & N. 815, Cockburn, C. J.: (819) "The question is one of fact, viz.; whether this is a new and original design. . . . This is a question to be determined by the eye — is it a design in the sense of drawing? . . . That leads to the question, is it in its present shape . . . a new design? That is a matter of which anybody can satisfy himself by looking at it. There is a new combination, which is in substance a new design."

of the inventor, is that of an appearance imparted to a material substance by imposing upon it whatever lines or images may be necessary and sufficient for that purpose. The appearance thus imparted to the substance, when presented to the eye in such a manner that the eye receives and transmits to the mind of the observer its essential characteristics, becomes an operative means and produces its appropriate effect. If any of these essential characteristics escape the eye and mind of the observer, the appearance of the substance to him is not identical with that imparted to the substance by the inventor.¹ If in addition to those essential characteristics, he

§ 203. ¹ The fact that the impressions made upon the mind do not always correspond with the actual appearance presented by the object becomes important in reference to the question whether the true design is that perceived by the ordinary careless observer or that which is detected by the experienced and cautious examiner. It must be conceded that the eye is the sole judge; but whose eye? and how carefully applied? The principal authority in this country is the case of *Gorham Manufacturing Co. v. White* (1871), 14 Wall. 511. In the Circuit Court (1870), 7 Blatch. 513, the presiding judge had said: (519) "It is impossible to assent to the view, that the test, in regard to a patent for a design, is the eye of an ordinary observer. . . . (520) There must be a uniform test, and that test can only be, as in the case of a patent in respect to machinery, substantial identity, not in view of the observation of a person whose observation is worthless, because it is casual, heedless and unintelligent, and who sees one of the articles in question at one time and place and the other of such articles at another time and place, but in view of the observation of a person versed in the business of designs in the particular trade in question. . . . The question is not whether one design will be mistaken for another by a person who examines the two so carelessly as to be

sure to be deceived, but whether the two designs can be said to be substantially the same when examined intelligently side by side. There must be such a comparison of the features which make up the two designs. As against an existing patented design, a patent for another design cannot be withheld because, to a casual observer, the general appearance of the later design is so like that of the earlier one as to lead him, without proper attention, to mistake the one for the other."

This view was the logical consequence of the position taken by the learned judge as to the real nature of a design (see § 201, n. 1, *ante*). If the design be the particular arrangement of lines, etc., by which the appearance is imparted to the substance, it is evident that as only a skilled and careful observer can determine whether two similar appearances are produced by the same arrangement of the same lines, etc., such an observer alone is competent to judge as to the identity of two designs. Thus the decision of Judge Blatchford, if not correct in principle, was at least consistent with itself.

In overruling this doctrine as to the essential nature of a design, the Supreme Court went also to the opposite extreme upon the question now under consideration. Thus Strong, J.: (527) "If then identity of appearance, or (as ex-

perceives the individual elements by whose arrangement and co-operation the appearance is produced, the impressions made

pressed in *McCrea v. Holdsworth*) sameness of effect upon the eye, is the main test of substantial identity of design, the only remaining question upon this part of the case is, whether it is essential that the appearance should be the same to the eye of an expert. The court below was of opinion that the test of a patent for a design is not the eye of an ordinary observer. . . . With this we cannot concur. Such a test would destroy all the protection which the act of Congress intended to give. There never could be piracy of a patented design, for human ingenuity has never yet produced a design in all its details exactly like another, so like, that an expert could not distinguish them. . . . (528) Experts, therefore, are not the persons to be deceived. Much less than that which would be substantial identity in their eyes would be undistinguishable in the eyes of men generally, of observers of ordinary acuteness, bringing to the examination of the article upon which the design has been placed that degree of observation which men of ordinary intelligence give. . . . We hold, therefore, that if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other." 2 O. G. 592 (593); 6 Fisher, 94 (102).

Here the court seem to regard a design as subject to very much the same rule as a trade-mark, although in all its essential characteristics it is entirely different. It is not the primary object of a design, in the eye of the law at least, to distinguish one class of goods, or the product of one manufactory, from others; for a design is the same inven-

tion, to whatever substance it may be applied, and it is the appearance imparted to the substance, not the substance to which the appearance is given, that is the subject-matter of the patent. And it is not in harmony with the spirit of the age or of the law which represents it, that when one person has devised an appearance of a certain general character, the field of invention is closed in that direction against every designer, unless his production differ so widely from the former that "an ordinary observer, giving such attention as a purchaser usually gives" would detect essential variations between them. A design is a work of art, a thing of beauty; and shades of difference, wholly imperceptible to the uneducated eye, may have required for their creation a high degree of inventive skill, and in the opinion of any competent observer may constitute entirely separate designs. It is submitted that this doctrine was too broadly stated in the case at bar, and that distinctions must be made among observers to correspond with those which exist between different classes of designs. Simple designs, such for example as spoon-patterns, may well be left to the judgment of the ordinary observer. But the triumphs of a higher art demand for their discrimination a more experienced and cultured eye.

The English case which the Supreme Court professed to follow in this decision does not sustain the extreme view advanced by Mr. Justice Strong. In that case (*McCrea v. Holdsworth* (1865), 5 B. & S. 495), Blackburn, J., had said: (504) "In all cases . . . the question must arise, what is the design? More or less of what is there seen may be the design, and that is a question of fact to be asked of the jury.

upon his eye and mind are incorrect unless he distinguishes the appearance produced by the employment of these elements from the appearance of the elements themselves. What characteristics are essential to any given appearance is a matter to be determined by the evidence of persons who are able to perceive and competent to judge. In this respect certain designs may well present far greater difficulties than others, and demand for their accurate discernment a high degree of experience and skill.

§ 204. Design may Consist in Configuration or Ornamentation or Both.

A design may consist in the simple configuration of a substance or the form given to it as a whole, or in the ornamentation imposed upon it without reference to its general form, or in such configuration and ornamentation both.¹ Thus the

It may be difficult to say what degree of evidence is necessary; but it must be a question for the jury, applying their eyes to the article before them." And Cockburn, C. J., stated: (502) "The combination which is what the fabric itself, *when submitted to the eye of a competent judge*, shows to be the design," &c. It was thus evidently in the minds of the judges that the question of identity between two similar designs might be one of some difficulty, and that it could be determined only by the eye of a person competent to distinguish their essential characteristics. As the opinion in our own tribunal was given by a divided court, it is not improbable that, upon further consideration, it may be so far modified as to recognize that differences may exist between designs which, though they escape the notice of an "ordinary observer, giving such attention as a purchaser usually gives," may nevertheless constitute substantial advances in art and deserve the recompense awarded to inventive skill. The rule there laid down has, however, been since adopted in

numerous cases, and must be regarded as settled, until further discussion in the higher court. Thus in *Jennings v. Kibbe* (1882), 20 Blatch. 353, Blatchford, J.: (354) "In *Gorham Co. v. White* (14 Wallace, 511), the Supreme Court considered directly the question of identity in regard to a patent for a design. It held that the true test of identity of design is sameness of appearance, in other words, sameness of effect upon the eye; that it is not necessary that the appearance should be the same to the eye of an expert; and that the test is the eye of an ordinary observer, the eyes of men generally, of observers of ordinary acuteness, bringing to the examination of the article, upon which the design has been placed, that degree of observation which men of ordinary intelligence give." 10 Fed. Rep. 669 (670).

See also *Miller v. Smith* (1880), 5 Fed. Rep. 359; 18 O. G. 1047; *Cone v. Morgan Envelope Co.* (1879), 4 Bann. & A. 107; *Perry v. Starrett* (1878), 3 Bann. & A. 485; 14 O. G. 599.

§ 204. ¹ In *Ex parte Traitel* (1883),

essential characteristics of the appearance imparted to a substance may reside in its exterior outlines only, or in the decorations formed by lines or images imposed upon its surface, or in the union of certain outlines and decorations to produce the given design. The same substance, therefore, may exhibit two entirely different designs, one in its outline, the other in its ornament; or one design alone, into which both its form and decoration enter as essential elements.

§ 205. Design may be a Simple Design or a Combination.

A design may either be composed of single lines or images, or it may be created by combining two or more separate designs.¹ But in the latter case the new design must differ in

25 O. G. 783, Butterworth, Com. (783)
 "A design is merely a delineation of form or figure, either plane or solid — a shape or configuration. The construction of an article in accordance with that delineation is the materialization of the conception of design. The conception of a building of some particular shape, form, or configuration, and which is delineated on paper or described in language, is a design. The various shapes and figures which appear in colors on the surface of prints and carpets are the expression of so many different designs. The material out of which the building is constructed, whether of stone, brick, wood, or glass, forms no part of a design. The character of the material, whether velvet, cloth, cotton, or wool, upon which the designs find expression, forms no part of the design. The colors in which they find expression are of no possible importance in describing the design itself. A combination of red and blue and green may be beautiful, and the effect very desirable, but it forms no part of the design, but is the medium through which a design, which relates solely to form and configuration, finds expression, or materializes. Then since a design, as used in the statute, relates solely to form

and configuration, how should it be described? There is no design which is not capable of delineation and description on paper, one or both, such delineations being the primary means. Where the forms are known forms, as in the case of geometrical figures, language may be employed as an auxiliary to describe them. And it follows as a corollary to the foregoing that the applicant's design, if he has one, is capable of being described or delineated on paper without reference to the materials used, or the colors employed, or the mode of their utilization in the construction of the article for which the design is intended."

In *Gorham Mfg. Co. v. White* (1871), 14 Wall. 511, Strong, J. : (525) "The appearance may be the result of peculiarity of configuration, or of ornament alone, or of both conjointly; but in whatever way produced, it is the new thing or product which the patent law regards." 2 O. G. 592 (593) 6 Fisher, 94 (100).

§ 205. ¹ In *Simpson v. Davis* (1882), 20 Blatch. 413, Benedict, J. : (414) "In the matter of ornamentation, mere juxtaposition of old forms is, doubtless, sufficient to authorize a patent for an ornament, when, by means of such jux-

its essence both from its individual and collective elements, presenting a new appearance and making a new and different impression on the eye. The collocation of designs, without such new resulting appearance, is a mere aggregation and possesses no attribute of an invention.

§ 206. Essential Attributes of a Design.

The essence of a design resides in the idea of that configuration or ornamentation which constitutes the new appearance given to the substance. If this idea embraces outline only, no change in decoration will disturb its identity unless the apparent configuration of the substance be also changed. If it relates to the adornment of a substance of some known external form, the form may be indefinitely varied and yet the design of ornament remain the same. Where both configuration and adornment, being new, enter into the same design, a change in the necessary attributes of either changes the essence of the whole design; but when though new they are

ta position, accomplished by industry, genius, effort, and expense, the old forms are made to become component parts of an ornament substantially new in its effect. But the result of the industry, genius, effort and expense employed must, as I suppose, be a single ornament, which, taken as a whole, can be considered to be the embodiment of a new idea in ornamentation. The amount of the novelty may be small, but the effect of the ornament must, to some extent, at least, be new." 12 Fed. Rep. 144 (145).

In *Harrison v. Taylor* (1859), 4 H. & N. 815, Wightman, J. : (820) "The Act uses the words 'any new and original design.' That is not a project or idea in the nature of an invention, but the representation of something which a draughtsman has for the first time produced. If that be the true meaning of the word 'design,' there is no doubt in this case that there was a design; for there was a drawing and it was an original drawing. It is true that all its

component parts had already been produced; but no one had produced such a pattern. It was said in the court below, that this was 'a mere' combination in a manner well known; so it is with a picture, all its parts may be old; but the combination forms a new design. It seems to me that it was properly left to the jury to say whether this was substantially a new and original design; and the jury have found that it was."

That a new design may consist of a combination of old designs, see *Kraus v. Fitzpatrick* (1888), 42 O. G. 1292; *Northrup v. Adams* (1877), 2 Bann. & A. 567; 12 O. G. 430; *Holdsworth v. McCrea* (1867), L. R. 2 H. L. 380; *McCrea v. Holdsworth* (1864), 5 B. & S. 495; *Norton v. Nichols* (1859), 1 El. & El. 761.

But that a mere aggregation of old designs is not a new design, see *Northrup v. Adams* (1877), 2 Bann. & A. 567; 12 O. G. 430.

distinct designs, each stands upon a separate foundation and can be affected only by a variation in its own essential elements. Moreover, the identity of a design is not destroyed by its imposition upon different substances unless the inherent qualities of the substance cause the outline or the ornament to assume a different appearance; and hence the impartation of an old appearance to a new material is not alone sufficient to create a new design.¹

§ 207. Design a Unit: its Unity how Destroyed.

The unity of a design remains unbroken, notwithstanding any changes in its elements, as long as its essential character as an appearance is preserved. Any addition, substitution, or withdrawal of lines or images, which simply increases its beauty without destroying the identity of the impression made upon the eye, is a mere improvement. But if its elements are dissociated from each other and reorganized into a new appearance, making a distinct impression, the former design ceases to exist and a new one is substituted in its place.¹

§ 208. Design not Complete until Reduced to Practice.

Reduction to practice, in reference to a design, consists in the embodiment of the idea of the appearance, as conceived

§ 206. ¹ That a design is the same, to whatever substances it may be applied, see *Ex parte Traitel* (1893), 25 O. G. 783; *Mulloney v. Stevens* (1864), 10 L. T. N. S. 190.

That the transfer of an old appearance to a different object is not a new design, but the appearance itself must be new, see *New York Belting & Packing Co. v. New Jersey Car Spring & Rubber Co.* (1887), 30 Fed. Rep. 785; *Wooster v. Crane* (1865), 5 Blatch. 282; 2 Fisher, 583.

That a design, though embodying certain features of another design, may nevertheless be so unlike the former in outline and detail as to be a new design, see *Wood v. Dolbey* (1881), 20 O. G. 523; 7 Fed. Rep. 475; 19 Blatch. 214.

That novelty is required in designs as in other inventions, see *Northrup v. Adams* (1877), 2 Bann. & A. 567; 12 O. G. 430; *Niedringhaus v. Commissioner* (1875), 2 MacArthur, 149; 8 O. G. 279.

§ 207. ¹ That a design is an entirety, and any substantial change, by addition, substitution, or rearrangement, makes a new design, see *Holdsworth v. McCrea* (1867), L. R. 2 H. L. 380.

But that though details may differ, yet if the impression upon the eye is the same, it is the same design, see *Wood v. Dolbey* (1881), 7 Fed. Rep. 475; 20 O. G. 523; 19 Blatch. 214; *McCrea v. Holdsworth* (1870), L. R. 6 Ch. Ap. 418.

by the inventor, in such a visible, substantial form as produces the intended effect upon the eye of an observer. A design differs from the preceding classes of inventions in that it accomplishes the end for which it was created through its mere perception by the sense to which it is addressed; and this perception may often be as perfect when obtained from a mere drawing of the design as from a permanent form or ornamentation imparted to a physical substance. Having been once impressed upon the eye in any manner, the design thereby becomes a practically operative means.¹ Whether the inventor need go farther, except where his design relates to a particular substance only, and embody his idea in a material object upon which his conception of the appearance is permanently imposed, or whether the requirements of the law are satisfied by any method of communication which will serve to convey to others this conception, is not yet determined.

§ 209. Design Reducible to Practice in Many Forms: all Identical Inventions.

In view of the distinction already taken between the appearance of the design as a whole and the lines and images by whose arrangement it is created, it is evident that the same idea of an appearance may sometimes be embodied by several different methods. As the idea of the appearance first forms itself in the mind of the inventor the elements of which it is

§ 208. ¹ Although not directed to the question of reduction to practice, many of the opinions, both of our own and the English courts, contain statements which indicate that any representation sufficient to convey the idea of the new appearance would comply with this requirement. Thus in *Harrison v. Taylor* (1859), 4 H. & N. 815, Crompton, J. : (821) "A design means something in the nature of a drawing, picture, or diagram, applicable to the ornamentation of some article of manufacture. . . . When we look at a picture or drawing we can say whether it is an original design or the same as one which has been already painted or

drawn." And in *Gorham Mfg. Co. v. White* (1871), 14 Wall. 511, Strong, J. : (526) "Mere difference of lines in the drawing or sketch . . . if insufficient to change the effect upon the eye will not destroy the substantial identity." And since, unless the design derives some of its essential characteristics from the qualities of the substance on which it is imposed, the impression made upon the eye by drawings and sketches may be as accurate and complete as by any other way, and thus bring the design fully to the tests of novelty and utility, reason would indicate that any of those methods would answer the provisions of the law.

composed are not necessarily present to his mental vision. All its essential characteristics, whether of form or ornament, must indeed enter into his conception, but the lines and their arrangement by which these essential characteristics are imparted to the physical substance are obviously matters of second thought, perhaps of long study and experiment. All modes of fashioning by which the essential characteristics of the design can be produced thus lie open to employment by the inventor. His use of one is legally equivalent to the use of all, and hence his patent for the design, expressed in any mode, covers the same design by whatever other elements or arrangement it can be produced.

SECTION VI.

OF AN IMPROVEMENT.

§ 210. "Improvement" Defined.

An improvement is an addition to or alteration in some existing means, which increases its efficiency without destroying its identity.¹ It includes two necessary ideas: first, the idea of a complete and practically operative art or instrument, either natural or artificial, as the original to be improved; and second, the idea of some change in such art or instrument, not affecting its essential character, but enabling it to produce its appropriate results in a more perfect or a more economical manner. When such a change involves the exercise of the inventive faculties it is a true invention and is known as an improvement.²

§ 210. ¹ In *Geiger v. Cook* (1842), 3 Watts & Serg. 266, Sergeant, J.: (269) "When there is an addition to an old machine or parts of a machine, or a mere alteration in some of its subordinate parts, the claim may be for an improvement only; but where the whole mode of forming the thing, and its effect are new, it may be claimed as new." See also §§ 307-313 and notes, *post*.

² In his commentary on the stat.

Jac. I. Sir Edward Coke declared, upon the authority of *Bircot's Case*, E. T. 15, E. 4, in the Exchequer, that "if the substance was *in esse* before, and a new addition thereunto, though that addition made the former more profitable, yet it is not a new manufacture in law." 3 Inst. 184.

In *Morris v. Bransom* (1776), Buller, N. P. 76; 1 Abb. P. C. 21, Lord Mansfield discarded this doctrine and held

§ 211. Improvement Implies an Original.

An improvement is thus neither the creation of a means entirely new nor a mere formal variation of the old. It occupies an intermediate position; yet often practically it approaches so nearly to the one or to the other that the line of demarcation becomes quite obscure. An inaccurate use of language adds to this obscurity; for in the title and specification of a patent an entirely new means is often described as an "improvement;" and even courts have said that an "improved machine" and an "improvement in a machine" are phrases expressive of the same idea. But in theory, at least, the distinction is always clear, and an examination of the principles which underlie this theory will furnish rules by which the separation of the three may generally be accomplished.¹

that an addition or improvement was a good subject-matter for a patent. This decision was followed in *Boulton v. Bull* (1795), 2 H. Bl. 463; 1 Abb. P. C. 59; *Hornblower v. Boulton* (1799), 8 T. R. 95; 1 Abb. P. C. 98; *Lister v. Leather* (1858), 8 El. & B. 1004.

In this country the patentability of an improvement has never been doubted. In *Kirby v. Dodge & Stevenson Mfg. Co.* (1872), 10 Blatch. 307, Woodruff, J.: (318) "Invention may be as necessary to reform or adapt an existing machine to the performance of work which it would not, as originally constructed, perform as it is to make a new machine; and whether this is done by removing a device or by adding one, by removing a bolt or by inserting a bolt, by making an apparently great mechanical change or a small one, the principle governing the subject is the same. The change being a substantial one, and producing a different result, may, if it be new, be the subject of a new patent," &c. 3 O. G. 181 (185); 6 Fisher, 156 (172).

See also *Barrett v. Hall* (1818), 1 Mason, 447; 1 Robb, 207; *Seymour v. Osborn* (1870), 11 Wall. 516.

§ 211. ¹ Confusion on this point may be avoided by distinguishing be-

tween an improvement and an independent invention on another ground. An independent invention always stands alone, or as a separable element in a combination. An improvement is always relative to an original, and, as an improvement, cannot be contemplated by the mind apart from that original. At the same time any art or article may occupy both of these positions. Considered by itself it may be an independent invention and may be used for numerous purposes. Considered as inserted into or conjoined with other inventions it may develop their ideas of means, and as applied to them be an improvement. Thus a new instrument may be in its own nature a new manufacture and patentable as such; but when introduced into a machine as an integral part thereof, it may be an improvement in the machine; and if its introduction be the result of inventive skill, it may, in its new relation, be patented as an improvement. Combinations may also be improved by substituting for an existing element an improved element of the same character, although the improvement in the element is a distinct patentable invention.

§ 212. Improvement not a Mere Variation in the Mode of Reducing to Practice.

We have already seen that the inventive act consists in the conception of an idea of means and in the reduction of that idea to practice ; that when the idea of means has been conceived it may be reduced to practice either by the inventor himself or by any other person to whom he has communicated his idea ; and that in whatsoever form he first embodies it, all other forms are merely imitations of his own. A variation, therefore, in the method of reducing an idea to practice can never require an exercise of the inventive faculties. It is, at most, a change of form ; not an invention, not even an improvement.

§ 213. Improvement a Development of, but not a Departure from, the Original Idea of Means.

The change which enters into an improvement must thus be a change in the idea of means as conceived by the original inventor. Although this idea must be complete, and capable of embodiment in a practically operative means, before any act of invention can be said to be performed, it is not essential that it be developed to its highest degree of efficiency and usefulness. Vast possibilities may still reside in the same idea, which can be actualized only by some further effort of inventive skill ; and in the discovery of these possibilities, and the contrivance of a method for employing them, lies the field of improvement as distinguished from original invention. But inasmuch as no improvement can subsist without an original on which to rest, this development must always leave the essence of the original invention unimpaired.¹ Whenever, in extending the efficiency of an idea of means, the line which separates that means from every other is crossed, through any change in its essential characteristics, identity is lost, the idea of the original invention is excluded, and the result of the inventive act becomes a new and substantive invention.

§ 213. ¹ In *Evans v. Eaton* (1818), 3 Wash. 443, Washington, J. : (453) "An improvement necessarily implies an original ; and unless the patentee is acquainted with the original, which he supposes he has improved, he must talk idly, when he calls his invention an improvement." 1 Robb, 193 (205). See also *Page v. Ferry* (1857), 1 Fisher, 298.

§ 214. Improvement is a Change in, but not a Change of, the Essential Factors of the Idea of Means.

Again, we have seen that every idea of means embraces three subordinate ideas: the force employed, the method of its application, and the object upon which it acts; and that the identity of an invention is destroyed either by the introduction of a different force, or of a different object, or of a different mode of application. Hence an improvement, being a variation in the idea of means, necessitates a change either in the force, the object, or the mode of application, yet such a change as leaves all their essential characteristics unimpaired. Thus any increase in the efficacy or availability of the force, or in the susceptibility or retentive powers of the object, or in the completeness or economy of the mode of application, unless accomplished by such obvious changes as are presumed to be within the mechanical skill of all persons familiar with the art to which the invention pertains, is a true improvement and has all the attributes of an invention. In theory, therefore, an improvement is not a new art or instrument, nor yet a formal and mechanical alteration in an old one; it is a new development of an old idea embodied in some change effected in an existing operative means.¹

§ 215. Improvement how Distinguished from Change of Form and from Independent Invention.

Practically, changes in an art or instrument are effected either by the addition of new elements, or by a withdrawal of existing elements, or by an alteration in their qualities or arrangement, or by the substitution of a new element for one previously employed. Each of these changes may be a mere change of form, or may result in an improvement of the old invention, or may create a new invention. If it involves only a variation in the method of reducing the original idea to practice, or if, while varying the idea of means, it neither changes its essential character nor gives substantial increase to its practical efficiency, it is a mere change of form, requir-

§ 214. ¹ That an improvement is operation, and results, though in some identical with its original in general respects better, see *Aspinwall Mfg. Co. construction, arrangement, principles of v. Gill* (1887), 40 O. G. 1133.

ing no invention. If the change indicates the introduction into the idea of means of a different force, a different object, or a different mode of application, it is more than a change of form, more even than an improvement; it is a separate invention. If it preserves the essential characteristics of the original invention, applying the same force to the same object by the same method, but accomplishing results with higher excellence or with greater economy of time or power, and is not the product of mechanical skill alone, it is an improvement.

§ 216. Improvement Indicated by its own Character, its mode of Operation, or its Effects.

The tests by which the character of these changes is to be ascertained are the same as those employed in reference to independent and original inventions. Where the apparent variation in the original invention produces no change in its effects or in the economy of time or power, if the factors and the mode of operation of the original and improved inventions are the same, the variation must be in embodiment alone; if different, the inventions are entirely independent of each other. Where the effects produced by the invention in its changed condition differ in nature from those accomplished by it in the old, the change has passed beyond the limits of a mere improvement and has resulted in a new invention. If the effects, although the same in nature, are so enhanced in excellence that the original idea of means, in no form of embodiment, could have produced them, the change is more than formal, but may be either an improvement or a new original invention. In this case, as in that wherein no change occurs in the effects, the original and improved inventions must be compared as operative means, and examined in their mode of action as well as in the subordinate ideas of which each is composed. If this examination discloses a substantial difference either in the nature or the operation of the means, the two inventions are distinct; otherwise the later is a mere improvement on the earlier.

§ 217. Improvements in Simple Inventions and in Combinations.

In applying any of these principles and tests to actual inventions it is necessary to distinguish between simple inventions and combinations. In a simple invention the identity of the invention as a whole does not depend upon the identity of the individual elements of which it is composed ; and any substantial change in these is only an improvement of the invention as a whole, unless its entire character is also changed. Thus in an art consisting of a single act, no alteration in the mode or instruments of its performance which does not vary the essential nature of the act itself is more than an improvement. Or in a manufacture or machine, composed of elements which in themselves are not independent manufactures or machines, a variation in the number, qualities, or arrangement of these elements, if neither merely formal nor destroying the identity of the entire machine or manufacture, is only an improvement.¹ But in a combination the identity of the invention as a whole does depend upon the identity of its subordinate means. The idea which it embodies involves the idea of a group of elements, each being in itself an independent means, and the idea of a law or method of co-operation by which these independent elements become united in a means entirely new. The identity of the combination remains undisturbed only while both of these essential ideas are preserved. Different elements co-operating according to the same law, or the same elements co-operating according to a different law, constitute different combinations. A change in any one of these subordinate elements, other than a mere change of form, either develops the idea of means which it embodies or alters the essential character of that idea itself. If it does the first it is an improvement, both as to the subordinate means and the whole combination ; but if it does the last the combination is entirely new. A change in the ar-

§ 217. ¹ That a change in the shape of parts of a machine may be a patentable improvement, see *Williams v. Barker* (1879), 18 O. G. 243 ; 2 Fed. Rep. 649.

That a device may be improved in structure without changing its capacity,

see *Sinclair v. Backus* (1880), 17 O. G. 1503 ; 4 Fed. Rep. 539 ; 5 Bann. & A. 81.

That cheapness may indicate improvement, see *Cornish v. Keene* (1835), 1 Web. 501 ; 2 Abb. P. C. 139.

rangement of these elements is either the imposition upon them of a new law of co-operation or the more perfect and effectual application of the existing law, — in the former case producing a new combination; in the latter an improvement of the old.² Thus in an art consisting of a series of acts each of which is a subordinate art, the addition of any new act which is itself a means, or the withdrawal of one heretofore employed, or the substitution for it of a different act, or any change in the order of their performance introducing a new method of co-operation, is a new invention, not a mere improvement. So also in a composition of matter or a design, and in such a manufacture or machine as is a true combination, a change in any of its elements or in their arrangement is an improvement only when, not being merely formal, it yet leaves undisturbed the identity of each of its subordinate means and also of their co-operative law. The field of improvement in combinations is, therefore, much narrower than in simple inventions, — an apparently far slighter change sufficing to destroy the identity of the combination and to substitute a different invention in its place.

§ 218. Improvement a Unit: its Essential Attributes.

Although an improvement implies the existence of an original on which it rests, it is a complete invention in itself, and has a unity and an identity of its own.¹ Its essence consists

² In *Bliss v. The City of Brooklyn* (1873), 10 Blatch. 521, Benedict, J. : (523) "An added element, which increases the efficiency of a combination of itself effective, is of the nature of an improvement; but when the added element is essential to the production of any useful result, such an addition is not an improvement, but its use gives birth to the only patentable, because the first useful, combination." 3 O. G. 269 (270); 6 Fisher, 289 (292).

See also *Rheem v. Holliday* (1851), 16 Pa. St. 347.

That an improvement may be made in a combination by changes either in the elements themselves or in their

arrangement, see *Foxwell v. Bostock* (1864), 12 W. R. 723; 10 L. T. N. S. 144.

That a substantial change in the nature of the elements is not a mere improvement but a new combination, see *Hale v. Stimpson* (1865), 2 Fisher, 565.

That to improve the form or capacity of the elements is invention, and may make an improvement or a new combination, see *Sharp v. Tiffit* (1880), 17 O. G. 1282; 18 Blatch. 132; 2 Fed. Rep. 697; 5 Bann. & A. 399.

§ 218. ¹ That the original and improvement are two separate inventions, and that the latter does not include and

in that particular extension or development of the original idea of means which finds expression in the specific change introduced into the actual invention. It is entirely independent of all other extensions or developments that may be given to the same idea, and is to be distinguished from them by the application of the same tests which are employed in discriminating between original inventions. It may become, in its turn, the basis for further improvements by the same process of development through which it was evolved from its original. But from whatever past improvement it has grown, and to whatever new improvements it may lead, it is still distinct from both. It is not an "improved invention," nor an "original invention with improvements;" it is simply "an improvement," a separate, complete, and definite result of the inventive act.

§ 219. Improvement not Complete until Reduced to Practice.

The method by which the idea of means embraced in an improvement is reduced to practice depends upon the nature of the original invention. Its practical utility must be in some manner demonstrated, and its availability for immediate public use be made apparent.¹ If the original invention is one whose actual employment in the arts, or whose subjection to specific tests, alone can satisfy this obligation, the improvement must be submitted to the same ordeal. And on the other hand, if the mere inspection of the original invention, in connection with the improvement, is sufficient to disclose its character as an operative means, embodiment in tangible materials, in a condition suitable for an immediate use, fulfils the requirements of the law.

protect the former after the patent for the former expires, see *Plimpton v. Winslow* (1880), 3 Fed. Rep. 333.

That no improvement upon an old invention can make the whole invention new, see *Carstaedt v. U. S. Corset Co.* (1876), 10 O. G. 8; 13 Blatch. 371; 2 Bann. & A. 331. See also §§ 892-896 and notes, *post*.

That the inventor of an improvement

acquires no rights in the original, see *Leach v. Dresser* (1879), 69 Me. 129.

That slight improvements do not affect the rights of inventors, see *Cowan v. Dodd* (1866), 3 Cold. 278.

§ 219. ¹ That reduction to practice is as essential in the case of improvements as of other inventions, see *Judson v. Bradford* (1878), 16 O. G. 171; 3 Bann. & A. 539.

§ 220. Improvement Reducible to Practice in many Forms : all Identical Inventions.

As in all other inventions, the idea which constitutes the essence of an improvement may often be embodied under several different forms. In such cases these various forms are substantially the same, however they may differ in appearance.¹ All shapes, materials, sizes, and arrangements, which can express the peculiar extension given by the inventor of the improvement to the original idea of means, are his as truly as is the specific size, arrangement, shape, or material that he has employed, and all are alike covered by the patent he obtains.

§ 220. ¹ That a patent for an improvement to one machine covers it in its application to all other machines, see *Burke v. Partridge* (1878), 58 N. H. 349.

CHAPTER III.

OF THE NOVELTY OF INVENTIONS.

§ 221. *Novelty and Utility Requisite to Patentability.*

AN inventor does not become entitled to a patent merely by exercising his creative faculties in the production of an art or instrument. The consideration for the grant of his exclusive privilege is the benefit which he confers upon the public by placing in their hands a means through the use of which their wants may be supplied. If the same means has been already made accessible to them by the inventive genius of a prior inventor, or if though they receive it first from him it is incapable of useful application, no benefit results to them from his inventive act and there is no consideration for his patent. When this want of consideration becomes apparent before a patent has been granted it will be refused; when afterward, the patent is defeated. In order, therefore, that an invention may be patented or protected by a patent, it must be *new*, that is, bestowed for the first time upon the public by the patentee; and *useful*, that is, capable of such employment as results in practical advantage. Of Novelty and Utility, as two essential requisites of every patentable invention, it is thus our next duty to inquire.

§ 222. "*Novelty*" Defined.

Legal novelty may be predicated of an invention whenever it is new to the public as a practically operative means. Every invention which is not already accessible to the public is regarded in law as new to the public, and no invention is accessible to the public until it is perfected and communicated to them in a practically available form. Novelty, therefore, exists unless the invention is already in the possession of the

public as an operative art or instrument, and this occurs only when the invention itself is a matter of existing public knowledge, or is derivable from what is known without the further exercise of inventive skill. In other words, as every variation of form, as distinguished from variation in substance, is considered as effected by the imitative faculties, novelty consists in the substantial variation of the invention in question from all inventions which in contemplation of law are already open to the public.¹

§ 223. Novelty formerly Absolute and Universal.

Formerly, the novelty required as a condition of patentability was absolute both as to place and time. If the invention were known anywhere before the date of the letters-patent, it was regarded as having become public property and no longer entitled to protection. The statute of James I. authorized the granting of a patent only for some "new manufacture which others, at the time of making such Letters Patents and Grants, did not use." By the act of 1790 Congress limited the privilege to inventions "not before known or used," and by the act of 1800 expressly excluded from the provisions of the law every invention which had been previously known and used in this or any foreign country.¹ But such

§ 222. ¹ In *Whitney v. Emmett* (1831), Baldwin, 303, Baldwin, J. : (311) "The novelty of the invention is either the manufacture produced, or the manner of producing an old one ; if the patent is for the former it must be for something substantially new, different from what was before known ; if the latter, the mode of operation must be different, not a mere change of the form and proportions ; if both are the same in principle, structure, mode of operation, and produce the same result, they are not new, though there may be a variance in some small matter for the purpose of evasion, or as a color for a patent." 1 Robb, 567 (579).

That novelty is essential difference from what was before known, and this must be evidenced by the invention

itself, not by the degree of inventive skill exercised in producing it, see *Wood v. Packer* (1883), 17 Fed. Rep. 650.

§ 223. ¹ In *Whitney v. Emmett* (1831), Baldwin, 303, Baldwin, J. : (311) "As to the novelty of the invention the rule is this, 'It must be new to all the world, not the abstract discovery, but the thing invented, not the new secret principle, but the manufacture resulting from it ; it must be new at the time of the application for the patent, in the words of the law ; 2 Peters 20, 22 ; but it will be considered as new then, if the application is within a reasonable time after the discovery, if the patentee has not sold or permitted the use of the invention.'" 1 Robb, 567 (578).

restrictions were soon seen to be disastrous to inventors and needless to the public. The most meritorious of discoverers might be deprived of his reward if it appeared that in some distant corner of the earth the same invention had been in a single instance practically employed before his own discovery had been given to the public, although such use were utterly unknown in his own country until long after the issue of his patent, and though the public for whose benefit he labored had received their only knowledge of the art or instrument from him. And on the other hand, since the existence of such use and knowledge in one nation did not necessarily render the invention accessible to any other, especially in periods of limited commercial intercourse, the prohibition of a patent to an original domestic inventor on account of such foreign use, so far from promoting the public welfare by securing to them the unrestricted enjoyment of the invention, tended rather to deprive them of it altogether, either by discouraging the efforts of that inventor through whom alone they could receive it, or by compelling him to place his discoveries before the public prematurely and in such an imperfect condition as to seriously impair their usefulness. Hence, though the letter of the law carried its restrictions to the last extremity, the courts, as usual, found methods of interpreting it in harmony with the true interests both of inventors and the public; and these interpretations, adopted or ratified by subsequent legislative action, have now become permanently incorporated in the law.

§ 224. Novelty, under the English Law, is Novelty "within the Realm."

The English judges, taking advantage of a phrase occurring in another connection in the statute, early held that prior use and knowledge, to operate against an original inventor, must be "within the realm;" and in this manner they secured the rights of native discoverers.¹ At the same time, by placing the importer of a foreign discovery on an equal footing with domestic inventors, as already noticed, they stimulated the

§ 224. ¹ See *Edgebury v. Stephens* 1 Abb. P. C. 8. See §§ 315-324 and (1691), 1 Web. 35; 2 Salk. 447; notes, *post*.

examination of the arts of other nations and the reproduction of the same industries within their own. But though unnecessary restrictions as to place were thus removed, the limitations as to time remained until the act 15 and 16 Vict. (1852), which provided for the filing of a provisional specification by the inventor, whose date instead of that of his patent fixed the time before which use or knowledge must exist in order to prevent or to defeat the patent. Thus under the English law, an invention is considered new unless known or used within the realm before the application of its inventor for a patent.

§ 225. Novelty, under the American Law, is Novelty within the United States.

In this country the restriction as to place continued in full vigor until the act of 1836. Its inconvenience and injustice were always recognized, but the courts were bound by the express language of the statute, and rigidly enforced its provisions. In the revision of the law and the reconstruction of the patent system in 1836, however, knowledge and use in a foreign country was excluded from among the causes which prevent or defeat a patent, and the limitations of our law on that subject as to place were brought into harmony with those of the law of England. The restriction as to time has been more widely modified. The act of 1793 substituted for the phrase "not before known and used," as it occurred in the act of 1790, the words "not known or used before the application," establishing the same rule afterward adopted in the English statute of 1852. But by a strange construction of these words, in connection with other sections of the same act which provided for the repeal of patents fraudulently obtained by others than the real inventor, our courts soon held that "before the application" was to be regarded as synonymous with "before discovery by the patentee," thus recognizing no use or knowledge as anticipating the invention unless it had preceded the inventive act. This construction was accepted by Congress in the act of 1836, and duly formulated as one of the provisions of that statute. According to our present law, therefore, novelty exists unless the knowl-

edge or use of the invention in this country preceded its conception by the patentee.

§ 226. "Knowledge" and "Use" Defined.

Specific interpretations have also been given to the terms "use" and "knowledge," as employed in reference to this subject. In the statute of James I. no mention is made of prior knowledge as a bar to a patent. The courts, however, held that any such knowledge on the part of the English public as put the invention fairly in their possession was equivalent to actual use, making a prior patent or publication within the realm of the same effect as practical employment in the arts. In our own statutes the phrase "known or used" has always been adopted, and the fact that knowledge may exist without use has been recognized.¹ Thus as use necessarily implies knowledge, the proof of use anywhere, before the act of 1836, was sufficient evidence of knowledge everywhere; and if no use could be shown, knowledge might be

§ 226. ¹ In *Stitt v. Eastern R. R. Co.* (1884), 22 Fed. Rep. 649, Colt, J. : (650) "By § 4886 of the Revised Statutes, to entitle a person to a patent, the invention must be one 'not known or used by others in this country.' The plaintiff contends that, upon a proper construction of the patent law as a whole, both prior knowledge and use must be proved to negative novelty. We think this statement of the rule somewhat too broad. The prior invention relied upon as a defence must be complete and capable of producing the result to be accomplished. It must not be inchoate or rest in speculation or experiment. *Coffin v. Ogden*, 18 Wall. 120. The evidence is sufficient to support the defence of prior knowledge and use, if it proves the invention was complete and capable of working; if it had been put to use and was known to any considerable number of persons. *Judson v. Bradford*, 16 O. G. 174. If the construction of the prior thing of itself demonstrates that it is within the prin-

ciple of the patent, then, perhaps, no use need be established, for it might be said to prove itself. *Sayles v. Chicago & N. W. R. Co.*, 4 Fisher, 584. It is not necessary that the prior invention should have been actually used for the purpose contemplated, but it must have been capable of such use. *Pitts v. Wemple*, 2 Fisher, 10. . . . The primary inquiry is one of identity between two things. If the identity can only be known by actual use such use should be proved. If the identity is apparent on inspection, it is not necessary to prove actual use. If there is a reasonable doubt as to identity, want of novelty is not made out. Walk. Pat. § 72. By the weight of authority and of reason, it would seem that if the prior invention was the same as that described in the patent; if it was complete, and capable of producing the same result, and was known in this country — it is sufficient to sustain the defence of want of novelty."

inferred from any other evidence. But when the distinction between use at home and use abroad was drawn in that act, and foreign use became no longer evidence of knowledge anywhere, the doctrine of the English courts that public knowledge, though derived from foreign use, is equivalent to use at home, was embraced by Congress, and incorporated in the act. But while the English courts had given to foreign use this significance only when the foreign invention had been patented within the realm, or had been described in some publication accessible to the English public, our legislators enacted that a foreign patent or a foreign publication were to be considered equally within the knowledge of our people, and to constitute the same evidence of prior knowledge as if the invention had been actually employed at home. Thus, as our law now stands, a prior use in this country, or a prior patent or publication either at home or abroad, puts the invention before the public so completely that no subsequent inventor can confer on them that benefit which constitutes the only consideration for a patent.

§ 227. Knowledge, to Defeat Novelty, must be Practical and Complete.

It is to be remembered, however, that "knowledge," in this sense, means such an acquaintance with the invention, on the part of the public, as renders it available to them as a practically operative means. If their knowledge is derived from use in this country, the use must be of such a kind as imparts this information. If it rests on any foreign or domestic patent or publication these must be sufficient to accomplish the same result. In neither of these cases must there be any necessity for the exercise of additional inventive skill, since with the employment of the creative faculties, in the adaptation of any invention to the public use, another obligation is incurred which can only be discharged by protecting that inventor in the exclusive use of the invention. Thus we arrive at a more perfect and exhaustive definition of this attribute of novelty, and see that an invention is to be regarded as new whenever it has not already been brought within the practical knowledge of the public as an operative means, either through

prior use at home, or through a prior patent or a prior publication.

§ 228. Novelty Involves two Questions: Identity and Priority.

It is evident that this attribute of novelty can become a subject for examination only when two or more inventions are presented for consideration, both of which are claimed to be identical in substance, and one of which is said to have been known before the other was invented. In every such case, two questions arise: (1) Are the inventions identical? (2) Was the invention, by whose priority to the other the patentability of the latter is sought to be defeated, in use in this country, or had it been patented or described in a printed publication at home or abroad, before the other was invented? In our discussion of the subject in detail, the same questions will be presented, and the same division will be found both serviceable and sufficient.

SECTION I.

**OF THE NOVELTY OF INVENTIONS: IDENTITY: FORM AND
SUBSTANCE.**

**§ 229. Identity is Identity of Idea or Substance, not of Form
or Embodiment.**

In comparing inventions for the purpose of determining their identity, it is first necessary to ascertain the essential character of each by an examination of the idea of means which it embodies. Two inventions cannot be the same unless the same creative act, resulting in the same idea of means, has been performed by both inventors; and therefore no investigation which stops short of this idea, or which accepts as a basis for its conclusions any conception not involved in this idea, can lead to a reliable decision. Hence the importance, in every such investigation, of constantly distinguishing between those attributes of each invention which relate to its substance, and those which relate merely

to its form.¹ This can be done with entire accuracy only by passing through the tangible and concrete art or instru-

§ 229. ¹ This distinction between the substance and the form of the invention was early drawn by the courts, and even in cases where no intelligible rule was suggested for discriminating one from the other. Thus in *Brooks v. Jenkins* (1844), 3 McLean, 432, the court said: (456) "An objection is made to the use of the term 'substantial,' as having no definite signification. It is true the word as applied in this case is not susceptible of an exact definition. But it is generally used in the same sense. No word is more familiar in the action of a court of justice. And in a larger sense it applies to all human affairs. In the exact sciences we look for precision. But beyond the mathematics in human transactions, we may be said to reach the truth more by approximation than by absolute demonstration. A pleading in a civil or criminal case may be substantially good, though it may not be technically formal. An instrument substantially described in a declaration or indictment may be given in evidence. We look more to the substance of things than their forms. In asking you, then, to determine whether the machines are substantially alike or substantially different, you are called to perform only a common duty; not as regards the questions before you so much, as in the discharge of your ordinary duties in life."

Thus also in *Walton v. Potter* (1841), 1 Web. 585, Tindal, C. J.: (586) "Where a party has obtained a patent for a new invention, or a discovery he has made by his own ingenuity, it is not in the power of any other person, simply by varying in form or in immaterial circumstances the nature or subject-matter of that discovery, to obtain either a patent for it himself, or to use it without the leave of the patentee,

because that would be in effect and in substance an invasion of the right; and therefore what you have to look at upon the present occasion is not simply whether in form or in circumstances that may be more or less immaterial that which has been done by the defendants varies from the specification of the plaintiffs' patent, but to see whether in reality, in substance, and in effect, the defendants have availed themselves of the plaintiffs' invention. . . . And therefore it will not be immaterial to call to your attention, upon this first head of inquiry, the specification of the plaintiffs, and next that of the defendants' patent, in order that we may compare them together, and see whether there really is that variation in substance so as to give the denomination of a new discovery to what the defendants have done, or whether they are not following out the invention of the plaintiff with some variation in the description which may not allow it the name of a new discovery. . . . (589) Now, what you have to say is, as I before stated, whether you are satisfied that the [article made by defendants] that was produced before you in evidence . . . is a specious variation in form only, an ingenious alteration in the mode of adaptation, or whether it is really and substantially a new discovery on the part of the defendants."

In *Morgan v. Seaward* (1836), 1 Web. 170, Alderson, B.: (171) "Therefore the two machines are alike in principle; one man was the first inventor of the principle, and the other has adopted it; and though he may have carried it into effect by substituting one mechanical equivalent for another, still you are to look to the substance and not to the mere form, and if it is in substance an infringement, you

ment which is presented to the physical senses, and contemplating the idea of means as it lies unembodied in the mind of the inventor.

§ 230. Identity of Idea not Proved by Identity of Embodiment.

For while it is true that almost every idea of means is capable of embodiment in several different forms, it is equally true that the form which is selected for its expression may in some cases also serve as the embodiment of an entirely different idea.¹ Probably no concrete invention has ever so

ought to find that it is so. If in principle it is not the same, but really different, then the defendants cannot be said to have infringed the patent. . . . So you see you ought to look always to the substance, and not to the form." 2 Abb. P. C. 262 (317).

See also *Carter v. Baker* (1871), 1 Sawyer, 512; 4 Fisher, 404; and cases cited under § 236, *post*.

That identity is identity of means, see *New American File Co. v. Nicholson File Co.* (1887), 31 Fed. Rep. 289; *Electric R. R. Signal Co. v. Hall R. R. Signal Co.* (1885), 114 U. S. 87; 31 O. G. 515.

That if the means is different the inventions cannot be identical, see *Hall v. Stern* (1882), 24 O. G. 206; 15 Fed. Rep. 463.

That the same idea must be the same invention, see *May v. County of Fond du Lac* (1886), 27 Fed. Rep. 691.

That identity is identity of means, not of name, see *Converse v. Cannon* (1873), 2 Woods, 7; 9 O. G. 105; *Union Sugar Refinery v. Matthiesson & Co.* (1865), 3 Clifford, 639; 2 Fisher, 600; *Howe v. Williams* (1862), 2 Fisher, 395; *Cahoon v. Ring* (1861), 1 Clifford, 592; 1 Fisher, 397; *Cutler's Patent* (1839), 1 Web. 418.

That the intention of the inventor to make a different means does not indicate that the means is not identical, see *Henderson v. Cleveland Co-opera-*

tive Stove Co. (1877), 2 Bann. & A. 604; 12 O. G. 4.

That similarity in structure, appearance, and effect may indicate identity, see *Matthews v. Skates* (1860), 1 Fisher, 602.

But that such similarity does not constitute identity, see *McComb v. Ernest* (1871), 1 Woods, 195; *Howes v. Nute* (1870), 4 Clifford, 173; 4 Fisher, 263; *Cahoon v. Ring* (1861), 1 Clifford, 592; 1 Fisher, 397.

That similarity in substance is identity, see *Union Sugar Refinery Co. v. Matthiesson & Co.* (1865), 3 Clifford, 639; 2 Fisher, 600.

That identity is identity in the practically operative means, not in the mere theory upon which they operate, see *Foss v. Herbert* (1856), 1 Bissell, 121; 2 Fisher, 31.

That immaterial changes do not affect identity, see *Brighton v. Wilson* (1883), 18 Fed. Rep. 378.

That colorable differences do not show a want of identity, see *Byam v. Eddy* (1853), 24 Vt. 666.

That an invention is the same under every form of embodiment, see *Florence Sewing Mach. Co. v. Grover & Baker Sewing Mach. Co.* (1872), 110 Mass. 70; *Blanchard v. Beers* (1852), 2 Blatch. 411.

§ 230. ¹ That the same tangible embodiment may represent two entirely distinct ideas of means, see *Newton v. Vaucher* (1851), 6 Exch. 859.

exactly represented the idea of means conceived by its inventor that when considered by itself, as a mere art or instrument, it communicated that idea, without superfluity or ambiguity, to an observer. Thus an examiner of the concrete invention only is liable to err, either by imputing to the essential character of the invention such attributes as are indifferent and formal, or by discerning in it an idea of means distinct from that which its inventor intended to express.² For this reason it is indispensable that the examiner should study the invention from the point of view occupied by the inventor when he first contemplated it as an operative means, and before it became interwoven in his mind with those ideas, derived from his mechanical knowledge, which determined its embodiment in this peculiar form.

§ 231. Identity of Idea to be Examined as the Idea lies in the Mind of the Inventor; the Idea of End the Primary Conception.

Of whatever mental processes an inventor may be conscious, the idea of an end to be accomplished must be regarded as his primary conception. Even where his discovery is the result of accident, he cannot be considered as devising methods of applying forces to their objects, without a previous intention that some particular effect should flow from his endeavors. To feel the pressure of an existing want, to recognize that change in the condition of affairs which will result in its supply, and then to contrive means by which this change may be produced,—this is necessarily the order in which the mental part of the inventive act proceeds, the only order possible to any exercise of the creative faculties. The inventor thus approaches his invention through the end which he designs it to accomplish. To him, its scope and purpose are measured by that end; and its completeness and perfection in his eyes depend on the exactness with which it performs the functions necessary to effect the change pro-

² *Collender v. Griffith* (1880), 2 Fed. Rep. 206; 18 O. G. 241; 18 Blatch. 110; is an instance where the same article embodied both the idea of a manufacture and the idea of a design. Other instances noted in the reports will readily suggest themselves.

posed. If in addition to inventive genius he possesses great industrial skill, the concrete form in which his idea is embodied may so nearly coincide therewith in its essential characteristics that in the art or instrument there will be neither element nor quality which does not enter into the operative means, and contribute to the production of the desired result. Or, on the contrary, his carelessness or ignorance as to industrial details may lead him to select a method of expressing his idea in which the essential features of his invention will be overlaid with superfluities of attribute or element, until from every eye except his own its actual character is almost hopelessly concealed. Still, in whatever form embodied, it remains intelligible and distinct to him as a specific agency achieving a particular result; and one who would perceive it as he perceives it must, like him, contemplate it through the end which he intends it to accomplish, and find in the requirements of that end the precise limitations of its means.

§ 232. Ultimate End or Effect Distinguished from Proximate End or Function.

In contemplating an invention through the end which it accomplishes, it is essential to distinguish between the changed condition of affairs resulting from the operation of the means, and the change produced in their condition by the means while actually in operation. The former is the ultimate end proposed by the inventor, the permanent effect on the material world which remains after the means has ceased to act, and which constitutes the condition of a want supplied. The latter is a proximate end lying between the ultimate end and the operative means, a fugitive effect which exists only while the force is acting upon its appropriate object, and which constitutes the operation to which the object is subjected by the means. Considered in itself, this intermediate end is the exact difference between the unchanged and the changed condition of affairs, the addition, alteration, or subtraction through which the object passes on its way from one condition to another. Considered in reference to the object only, it is a true effect produced upon it by the art or instrument

employed. Considered in relation to the means, it is its function, its action on the object while reducing it to the desired condition.

§ 233. **Effect the Primary Idea ; Function the Secondary ; Means the Tertiary and Final.**

Of these two ends, the ultimate and permanent is the one first presented to the mind of the inventor. It is the natural and complete antithesis of the want which he perceives, and is inevitably suggested to him by the want itself. The contemplation of this ultimate effect, in connection with the existing condition of affairs, discloses to him the difference between them, and the proximate effect or change through which the object to be acted on must pass in order to attain the new condition he requires. This brings him face to face with his true problem, — the invention of a means by which this change can be effected, — and demands from him the employment of such forces through such modes of application as will produce this intermediate effect and leave the object in the changed condition he desires. Thus, for example, in the invention of the planing machine the inventor first perceived the want arising from the roughness of the lumber, and this suggested to him that smoothness in the lumber would supply the want. Considering smooth lumber in connection with the rough, he saw that the real difference between them consisted in the retention by the one of an uneven surface which had been removed from the other; and this disclosed to him that the change through which the first must pass before it reached the condition of the latter was a change of surface by the obliteration of its inequalities. He then perceived that in order to effect this change he must apply force to the lumber in such a manner as to remove these inequalities; and by the exercise of his creative faculties he brought the required force into contact with the lumber, through his machine, in such a manner that the change was effected, the difference between the roughness and the smoothness of the surface disappeared, and the ultimate and permanent end of his invention was accomplished.

§ 234. Means and End Meet in the Function; Function the Measure of Means.

It is, moreover, evident that the true place of meeting between the end and the means is in the proximate result or function of the means, and that the point from which the examiner must contemplate the means, in order to discover its essential character, is its function, not its ultimate effect. The inspection of lumber in its smoothed condition may not disclose whether that smoothness has been attained by removing former irregularities of surface, or by covering the surface with some foreign substance whose smoothness has concealed the roughness of the wood. Though it appears that actual removal has occurred, there may be nothing to suggest its method, whether by slow, continuous attrition or violent, instantaneous excision; and even when excision is clearly indicated, it may still be impossible to discern whether it was accomplished by one progressive movement of a single knife, or by the swift rotation of a group of blades. But when the function of the means is made the subject of examination, these questions are immediately solved. An inspection of the lumber as it undergoes the changes which result in smoothness, or of the machine while it removes the uneven surface of the wood, brings the mind of the observer to the precise point from which the inventor contemplates his own idea of means, and gives him, in the proximate end which it accomplishes, an exact measure of the scope of that idea.

§ 235. Idea of Means Includes whatever is Essential to Performance of Function; the Rest belongs to Form or Embodiment.

The first duty, therefore, of one who examines an invention for the purpose of determining its essential character is to discover the real nature of the function it performs. Having perceived the want which the inventor has endeavored to supply, and the changed condition of affairs which in the inventor's view supplies the want, he must discern the actual change wrought by the invention on its object while engaged in the production of its ultimate result. Then, since the

means devised by the inventor can be a means only so far as it accomplishes effects, and can exist in his mind only so far as it performs the functions he intends it to discharge, the limits of the means become at once apparent through their correspondance with the functions thus discerned. Applying the same principles to the concrete invention, the tests whereby those of its attributes which relate to substance may be distinguished from those which relate to form are easily discovered. Whatever qualities of any art or instrument are indispensable to its discharge of any of the functions for which it was designed by its inventor enter into its essential character, and thus become matters of substance, not of form;¹ and every part and attribute whose presence is unnecessary to the performance of these functions lies outside of its essence, and is a matter of mere form.

§ 236. Identity of Inventions is Identity of Effect, of Function, and of Means, not Identity of Tangible Embodiment.

These tests are constantly employed by the courts in cases requiring the discrimination of apparent from actual diversities. Whether or not a given diversity in the concrete invention is consistent with identity of essential character must always be determined by a reference of the diversity to the standard here erected for distinguishing the substance or idea of means from its form of embodiment. Inventions cannot be identical unless they are identical in substance; nor can they be identical in substance unless they are identical in effect, in function, and in the means by which their functions are per-

§ 235. ¹ In *Treadwell v. Bladen* (1827), 4 Wash. 703, Washington, J. : (706) "What constitutes form, and what principle, is often a nice question to decide; and upon none are the witnesses who are examined in patent causes, even those who are skilled in the particular art, more apt to disagree. It seems to me that the safest guide to accuracy in making the distinction is, first to ascertain what is the result to be obtained by the discovery; and whatever is essential to that object,

independent of the mere form and proportions of the thing used for the purpose, may generally, if not universally, be considered as the principles of the invention." 1 Robb, 531 (537).

That the essence or substance of an invention is to be distinguished from its mere form by ascertaining what function it performs and how it performs it, see also *Converse v. Cannon* (1873), 2 Woods, 7; 9 O. G. 105; *Cahoon v. Ring* (1861), 1 Clifford, 592; 1 Fisher, 397.

formed.¹ And when identical in these respects, they are the same invention, whatever differences may exist in the concrete arts or instruments in which they have been reduced to practice.

§ 230. ¹ In *Adams v. Edwards* (1848), 1 Fisher, 1; *Woodbury, J.*: (7) "When we say a thing is substantially the same, we mean it is the same in all important particulars. It must be of the same material, when the material is important; it must be of the same thickness, when thickness is important; it must be applied in the same way, condition, and extent, . . . when either of these circumstances makes an essential difference."

In *Gray v. James* (1817), 1 Peters C. C. 394, Washington, J.: (397) "What constitutes a difference in principle between two machines is frequently a question of difficulty, more especially if the difference in form is considerable, and the machinery complicated. But we think it may safely be laid down as a general rule that when the machines are substantially the same, and operate in the same manner to produce the same result, they must be in principle the same. I say *substantially* in order to exclude all formal differences; and when I speak of the same result, I must be understood as meaning the same kind of result, though it may differ in extent." 1 Robb, 120 (124).

Further, that where two inventions discharge the same function in the same way, they are identical in substance, however they may differ in form, see *Shaver v. Skinner Mfg. Co.* (1887), 41 O. G. 232; *Pennsylvania Diamond Drill Co. v. Simpson* (1886), 29 Fed. Rep. 288; *Holly v. Vergennes Mach. Co.* (1880), 18 O. G. 1177; 4 Fed. Rep. 74; 18 Blatch. 327; *Cone v. Morgan Envelope Co.* (1879), 4 Bann. & A. 107; *Brown v. Rubber Step Mfg. Co.* (1878), 3 Bann. & A. 232; 13 O. G. 369; *Collender v. Came* (1876), 4 Clifford, 393; 10 O. G. 467; *Myers v.*

Duker (1874), 1 Bann. & A. 535; *Converso v. Cannon* (1873), 9 O. G. 105; 2 Woods, 7; *McComb v. Brodie* (1872), 2 O. G. 117; 5 Fisher, 384; 1 Woods, 153; *Cahoon v. Ring* (1861), 1 Clifford, 592; 1 Fisher, 397; *Lee v. Blandy* (1860), 1 Bond, 361; 2 Fisher, 89; *Judson v. Cope* (1860), 1 Bond, 327; 1 Fisher, 615; *Page v. Ferry* (1857), 1 Fisher, 298; *Smith v. Downing* (1850), 1 Fisher, 64; *Brooks v. Bicknell* (1844), 3 McLean, 432; *Bush v. Fox* (1856), 5 H. L. 707.

But that if the same function be performed in a different way the inventions are not identical, see *Wicke v. Ostrum* (1881), 103 U. S. 461; 19 O. G. 867; *Gottfried v. Bartholomae* (1878), 8 Bissell, 219; 13 O. G. 1128; *Fuller v. Yentzer* (1874), 6 Bissell, 203; 1 Bann. & A. 520; *Morris v. Barrett* (1859), 1 Fisher, 461; 1 Bond, 254; *Heinrich v. Luther* (1855), 6 McLean, 345; *Tatham v. Le Roy* (1852), 2 Blatch. 474; *Hullett v. Hague* (1831), 2 B. & Ad. 370; 1 Abb. P. C. 452.

That modes of applying an old idea, if differing in operation and result, are not identical, see *Field v. De Comeau* (1881), 116 U. S. 137; 34 O. G. 559.

That changes in an old device, causing a difference in principle and result, render it a different invention, see *Parker v. Stow* (1885), 31 O. G. 1171; 23 Fed. Rep. 252.

That a device which cannot be a substitute in actual use cannot be the same invention, see *Crandall v. Parker Carriage Goods Co.* (1884), 28 O. G. 369; 20 Fed. Rep. 851; *Crandall v. Watters* (1881), 9 Fed. Rep. 659; 20 Blatch. 97.

That when the same means produce the same result the inventions must be the same, see *Halliday v. Covel* (1886), 27 Fed. Rep. 217; 37 O. G. 785.

SECTION II.

OF THE NOVELTY OF INVENTIONS: IDENTITY: DIVERSITIES OF SHAPE, SIZE, CAPACITY, PROPORTIONS, ARRANGEMENT, AND MATERIALS.

§ 237. Diversities of Shape, Size, Capacity, Proportions, Arrangement, and Materials, are sometimes Diversities of Substance, but usually of Form.

The principal diversities manifested by inventions which perform or appear to perform the same functions consist in differences of shape, size, capacity, proportions, arrangement, or materials. Each of these diversities may result from a change in the form of embodiment selected as the external expression of the idea of means, or from a variation in the idea itself, or from the development of that idea by a further exercise of inventive skill. Hence every such diversity may be a new invention, or an improvement on an old invention, or a mere formal change; and which of these it is in any given case must be determined by that universal test which serves always to distinguish form and substance. Any diversity which introduces a new function, or a new method of performing the old function, is a new and independent invention. Any diversity which enables the invention to discharge its accustomed functions with greater excellence or economy, and which has been produced by inventive skill, is an improvement. And a diversity which leaves the function and the mode of its performance entirely unaffected, or which did not involve an exercise of the creative faculties, relates only to the method of embodiment, and works no change of substance in the old invention.¹

§ 237. ¹ That changes in the form of embodiment do not affect the identity of the invention, see *Theberath v. Rubber & Celluloid Harness Trimming Co.* (1883), 15 Fed. Rep. 246; 23 O. G. 1121; *Smith v. Nichols* (1874), 21 Wall. 112.

That mechanical differences, where the product and mode of construction remain unchanged, do not affect identity, see *Collender v. Came* (1876), 4 Clifford, 393; 10 O. G. 467.

§ 238. Diverstion of Shape.

Except in a design the shape of an invention, or of its integral elements, does not necessarily affect its essential character. In a design the shape is the invention; and hence any diversity of shape which makes a different impression on the eye changes the substance of the invention, and creates a new design. But in the other instruments this attribute is usually of little consequence.¹ Diversities of shape in a

§ 238. ¹ In *Ex parte Greeley* (1873), Holmes, 284, Shepley, J.: (286) "Such structural changes of form and proportions, although they improve the operation without changing the mode of operation, and produce a much better result, although one of the same kind, are only different and better forms of embodying the same idea, and illustrate the difference between mechanical skill and inventive genius." 6 Fisher, 575 (581); 4 O. G. 612 (612).

In *Wimans v. Denmead* (1859), 15 How. 330, Curtis, J.: (341) "Under our law a patent cannot be granted merely for a change of form. The act of February 21, 1793, § 2, so declared in express terms; and though this declaratory law was not re-enacted in the Patent Act of 1836, it is a principle which necessarily makes part of every system of law, granting patents for new inventions. Merely to change the form of a machine is the work of a constructor, not of an inventor; such a change cannot be deemed an invention. . . . To change the form of an existing machine, and by means of such change to introduce and employ other mechanical principles or natural powers, or, as it is termed, a new mode of operation, and thus attain a new and useful result, is the subject of a patent."

That no change of shape affects the identity of the invention unless it involves a change of function or of mode of operation, see *Asmus v. Alden* (1886), 27 Fed. Rep. 684; 36 O. G. 231; *Pennsylvania Diamond Drill Co. v. Simpson*

(1880), 20 Fed. Rep. 288; *Fryer v. Maurer* (1884), 22 Blatch. 208; *Hatch v. Moffit* (1889), 15 Fed. Rep. 252; *Lull v. Clark* (1882), 21 Blatch. 95; 22 O. G. 1535; 18 Fed. Rep. 456; *Coaling v. Roberts* (1882), 106 U. S. 39; 22 O. G. 1785; *Putnam v. Hutchinson* (1882), 11 Bissell, 240; 12 Fed. Rep. 131; *Loecheher v. Orundal* (1881), 11 Fed. Rep. 872; 20 Blatch. 106; 21 O. G. 863; *Collignon v. Hayes* (1881), 8 Fed. Rep. 912; 20 O. G. 447; *Singer Mfg. Co. v. Stewart Mfg. Co.* (1881), 8 Fed. Rep. 920; 20 O. G. 524; *Graham v. Geneva L. O. Mfg. Co.* (1880), 11 Fed. Rep. 138; 21 O. G. 1536; *Holly v. Vergennes Mach. Co.* (1880), 4 Fed. Rep. 74; 18 O. G. 1177; 15 Blatch. 327; *Double Pointed Tack Co. v. Mann* (1880), 5 Bann. & A. 465; *American Diamond Rock Boring Co. v. Sheldon* (1879), 17 Blatch. 208; 4 Bann. & A. 551; *Wilson Packing Co. v. Clapp* (1879), 8 Bissell, 545; 4 Bann. & A. 355; *Ex parte Greeley* (1873), 6 Fisher, 575; Holmes, 284; 4 O. G. 612; *King v. Louisville Cement Co.* (1878), 6 Fisher, 336; 4 O. G. 181; *Murphy v. Eastham* (1872), Holmes, 113; 2 O. G. 61; 5 Fisher, 306; *McComb v. Brodie* (1871), 1 Woods, 153; 5 Fisher, 384; 2 O. G. 117; *Taylor v. Garretson* (1871), 5 Fisher, 116; 9 Blatch. 156; *Dennis v. Eddy* (1871), 4 Fisher, 423; *Flood v. Hicks* (1869), 4 Fisher, 156; 2 Bissell, 169; *Potter v. Schenck* (1866), 1 Bissell, 515; 3 Fisher, 82; *Sangster v. Miller* (1865), 5 Blatch. 248; 2 Fisher, 533; *Case v. Brown* (1862), 1 Bissell, 382; 2 Fisher, 268;

machine, or in its subordinate parts, are merely formal variations, unless they indicate a change in its principle or mode of operation; and similar alterations in a manufacture do not disturb its identity, unless its functions, or its method of performing them, are also changed. Yet in both these classes of inventions, and perhaps even among compositions of matter, there are peculiar cases where the specific shape given to the instrument by the inventor is the only one which can express his idea of means, and can accomplish the result which he desires.² In that event, its shape becomes of the

Potter v. Wilson (1860), 2 Fisher, 102; *Leo v. Blandy* (1860), 2 Fisher, 89; 1 Bond, 361; *Cahoon v. Ring* (1859), 1 Fisher, 397; 1 Clifford, 592; *Latta v. Shawk* (1859), 1 Fisher, 465; 1 Bond, 259; *Conover v. Roach* (1857), 4 Fisher, 12; *Pitts v. Edmonds* (1857), 2 Fisher, 52; 1 Bissell, 168; *Page v. Ferry* (1857), 1 Fisher, 298; *Carr v. Rice* (1856), 1 Fisher, 198; *Allen v. Hunter* (1855), 6 McLean, 303; *Tatham v. Le Roy* (1852), 2 Blatch. 474; *Hall v. Wiles* (1851), 2 Blatch. 194; *Blanchard v. Reeves* (1850), 1 Fisher, 103; *Wilbur v. Beecher* (1850), 2 Blatch. 132; *Wilson v. Barnum* (1849), 2 Fisher, 635; *Parker v. Stiles* (1849), 5 McLean, 44; *Buck v. Hermance* (1849), 1 Blatch. 398; *Parker v. Haworth* (1848), 4 McLean, 370; 2 Robb, 725; *Many v. Jagger* (1848), 1 Blatch. 372; *Wyeth v. Stone* (1840), 1 Story, 273; 2 Robb, 23; *Smith v. Pearce* (1840), 2 McLean, 176; 2 Robb, 13; *Odiorne v. Winkley* (1814), 2 Gallison, 51; 1 Robb, 52; *Woodcock v. Parker* (1813), 1 Gallison, 438; 1 Robb, 37; *Reutgen v. Kanowrs* (1804), 1 Wash. 168; 1 Robb, 1; *Bramah v. Hardcastle* (1789), 1 Carp. 168; 1 Abb. P. C. 51.

² In *Winans v. Denmead* (1853), 15 How. 330, Curtis, J. : (842) "Patentable improvements in machinery are almost always made by changing some one or more forms of one or more parts, and thereby introducing some mechanical principle or mode of action not

previously existing in the machine, and so securing a new or improved result. And in the numerous cases in which it has been held that to copy the patentee's mode of operation was an infringement, the infringer had got forms and proportions not described, and not in terms claimed. If it were not so, no question of infringement could arise. If the machine complained of were a copy, in form, of the machine described in the specification, of course it would be at once seen to be an infringement. It could be nothing else. It is only ingenious divergencies of form and proportion, presenting the appearance of something unlike the thing patented, which give rise to questions; and the property of inventors would be valueless, if it were enough for the defendant to say: Your improvement consisted in a change of form; you describe and claim but one form; I have not taken that, and so have not infringed. The answer is, my improvement did not consist in a change of form, but in the new employment of principles or powers in a new mode of operation, embodied in a form by means of which a new or better result is produced; it was this which constituted my invention; this you have copied, changing only the form. . . . Undoubtedly there may be cases in which the letters-patent do include only the particular form described and claimed. *Davis v. Palmer*, 2 Brock. 309, seems to

essence of the invention, and cannot be departed from without the introduction of a new and different idea.

have been one of those cases. But they are in entire accordance with what is above stated. The reason why such a patent covers only one geometrical form is not that the patentee has described and claimed that form only; it is because that form only is capable of embodying his invention, and consequently if the form is not copied, the invention is not used. Where form and substance are inseparable, it is enough to look at the form only. Where they are separable, where the whole substance of the invention may be copied in a different form, it is the duty of courts and juries to look through the form for the substance of the invention, — for that which entitled the inventor to his patent, and which the patent was designed to secure; where that is found, there is an infringement; and it is not a defence, that it is embodied in a form not described, and in terms claimed, by the patentee. Patentees sometimes add to their claims an express declaration, to the effect that the claim extends to the thing patented, however its form or proportions may be varied. But this is unnecessary. The law so interprets the claim without the addition of these words. The exclusive right to the thing patented is not secured if the public are at liberty to make substantial copies of it, varying its form or proportions. And therefore the patentee, having described his invention, and shown its principles, and claimed it in that form which most perfectly embodies it, is, in contemplation of law, deemed to claim every form in which his invention may be copied, unless he manifests an intention to disclaim some of those forms."

In *Davis v. Palmer* (1827), 2 Brock. 298, Marshall, C. J.: (310) "It is not every change of form and proportion which is declared to be no discovery, but

that which is *simply* a change of form and proportion, and nothing more. If, by changing the form and proportion, a new effect is produced, there is not simply a change of form and proportion, but a change of principle also." 1 Robb, 518 (531).

In all the foregoing extracts the word "form" is used as synonymous with "shape," as well as expressive of "embodiment" in distinction from "substance or idea." It is not, however, difficult to perceive when the one meaning is intended and when the other.

That a change of shape producing a new result is invention, see *Sharp v. Tiff* (1880), 17 O. G. 1282; 18 Blatch. 132; 2 Fed. Rep. 697; 5 Bann. & A. 399; *Strobridge v. Lindsay* (1880), 18 O. G. 62; 2 Fed. Rep. 692; 5 Bann. & A. 411; *Miller's Falls Co. v. Backus* (1879), 17 O. G. 852; 5 Bann. & A. 531; *Eppinger v. Richey* (1877), 12 O. G. 714; 14 Blatch. 367; 3 Bann. & A. 69; *Swain Turbine & Mfg. Co. v. Ladd* (1877), 11 O. G. 153; *Aiken v. Dolan* (1867), 3 Fisher, 197; *Wintermute v. Redington* (1856), 1 Fisher, 239.

That a change in shape increasing utility may be a new invention, see *Starrett v. Athol Mach. Co.* (1888), 23 O. G. 1729; 14 Fed. Rep. 910.

That shape may be of the essence of the invention, see *Scott v. Evans* (1882), 11 Fed. Rep. 726; *N. Y. Bung & Bushing Co. v. Hoffman* (1881), 20 O. G. 1451; 9 Fed. Rep. 199; 20 Blatch. 3; *Williams v. Barker* (1880), 18 O. G. 243; 2 Fed. Rep. 649; *Swain Turbine & Mfg. Co. v. Ladd* (1877), 11 O. G. 153; *Pearl v. Ocean Mills* (1877), 11 O. G. 2; 2 Bann. & A. 469; *Dennis v. Eddy* (1871), 4 Fisher, 423.

That where shape is of the essence of the invention, any change of shape is a new invention, see *Toepfer v. Goetz*

§ 239. Diversities of Size.

The size of an invention is also generally a matter of mere form.¹ A mode of operation may be as accurately exhibited

(1887), 41 O. G. 933; *Dosh v. A. J. Medlar Co.* (1887), 40 O. G. 1242; *Morley Sewing Mach. Co. v. Lancaster* (1885), 23 Fed. Rep. 344; *Duff v. Sterling Pump Co.* (1882), 107 U. S. 636; 23 O. G. 1622.

That in a combination, if the elements, their mode of operation, and the result remain unchanged, no change of shape can affect the essence of the combination, see *Storrs v. Howe* (1876), 4 Clifford, 388; 10 O. G. 421; *Ex parte Greeley* (1873), 4 O. G. 612; *Holmes*, 284; 6 Fisher, 575; *Case v. Brown* (1864), 2 Wall. 320; *Howe v. Williams* (1868), 2 Fisher, 395; 2 Clifford, 245; *Foss v. Herbert* (1856), 2 Fisher, 31; 1 Bissell, 121; *Winans v. Denmead* (1853), 15 How. 330; *O'Reilly v. Morse* (1853), 15 How. 62.

That any alteration in the shape of the elements of a combination enabling it to produce a new result, or an old result in a new method, is invention, see *Sharp v. Tiffit* (1880), 17 O. G. 1282; 18 Blatch. 132; 2 Fed. Rep. 697; 5 Bann. & A. 399.

That a change in the shape of the parts of a machine may create a new invention, see *Williams v. Barker* (1880), 18 O. G. 243; 2 Fed. Rep. 649.

But that no change in the shape of the parts will affect the identity of the machine unless the purpose or effect is also changed, see *Wilson v. Barnum* (1849), 2 Fisher, 635.

That a change in the shape of a composition of matter does not affect its identity unless its properties are thereby varied, see *Milligan & Higgins Glue Co. v. Upton* (1874), 4 Clifford, 237; 6 O. G. 837; 1 Bann. & A. 497.

That a change in the shape of a manufacture caused by a peculiar mode of packing may produce a useful result

and be an invention, see *Eppinger v. Richoy* (1877), 14 Blatch. 307; 12 O. G. 714; 3 Bann. & A. 69.

But that merely to make it attractive to purchasers by changing its shape is not invention, see *Reed v. Reed* (1874), 8 O. G. 193; 12 Blatch. 366; 1 Bann. & A. 515; *Langdon v. De Groot* (1822), 1 Paine, 203; 1 Robb, 438.

That a change of shape producing a new mode of operation creates a different invention, see *N. Y. Bung & Bushing Co. v. Hoffman*, (1881), 20 Blatch. 3; 9 Fed. Rep. 199; 20 O. G. 1451; *Strobridge v. Lindsay* (1880), 5 Bann. & A. 411; 18 O. G. 62; 2 Fed. Rep. 692; *Sharp v. Tiffit* (1880), 17 O. G. 1282; 2 Fed. Rep. 697; 18 Blatch. 132; 5 Bann. & A. 399; *Willimantic Linen Co. v. Clark Thread Co.* (1879), 4 Bann. & A. 123; *Wilson Packing Co. v. Clapp* (1879), 4 Bann. & A. 355; 8 Bissell, 545; *Thatcher Heating Co. v. Carbon Stove Co.* (1878), 4 Bann. & A. 68; 15 O. G. 1051; *Isaacs v. Abrams* (1878), 3 Bann. & A. 616; 14 O. G. 861; *Pearl v. Ocean Mills Co.* (1877), 2 Bann. & A. 469; 11 O. G. 2; *Union Paper Collar Co. v. White* (1875), 2 Bann. & A. 60; 7 O. G. 698, 877; 11 Phila. 479.

That a change of shape enabling the instrument to perform new functions is invention, see *Wilson v. Coon* (1880), 19 O. G. 482; 18 Blatch. 532; 6 Fed. Rep. 611; *Union Paper Collar Co. v. White* (1875), 7 O. G. 698, 877; 2 Bann. & A. 60; 11 Phila. 479.

§ 239. ¹ In *Cahoon v. Ring* (1861), 1 Clifford, 592, Clifford, J.: (612) "Difference in size and proportions, so long as the construction, arrangement, principles, and mode of operation are substantially the same, is entirely immaterial." 1 Fisher, 397 (411).

That difference in size is not dif-

in a diminutive and fragile model as in a ponderous machine; and all the essential characteristics of a manufacture or a composition or design may subsist equally in its smallest and its largest specimens. The same is true, though with more limitation, in reference to the integral parts both of machines and manufactures, an alteration in the size of which is rarely followed by a change of function, or by a variation in the method in which its functions are fulfilled. Still, instances occur where diminution or increase in this respect affects the mode in which the force employed is brought in contact with its object, changing perhaps the function, perhaps only the means by which it is performed, and producing a diversity of substance which amounts either to a new invention, or to a patentable improvement on the old.

§ 240. Diversities of Capacity.

The capacity of an invention to produce results of greater or less quantity in a given period of time is likewise dependent rather on the mode of its embodiment than upon its essential character.¹ Speed and productive power are gov-

ference in inventions, see *Montross v. Bullard* (1886), 27 Fed. Rep. 64; *Assmus v. Alden* (1886), 27 Fed. Rep. 684; 36 O. G. 231; *Baldwin v. Haynes* (1886), 28 Fed. Rep. 99; 37 O. G. 565; *Belt v. Crittenden* (1880), 2 Fed. Rep. 82; 18 O. G. 191; 1 *McCrary*, 209; 5 *Bann. & A.* 131; *Double Pointed Tack Co. v. Mann* (1880), 5 *Bann. & A.* 465; *Glue Co. v. Upton* (1877), 97 U. S. 3; *Phillips v. Page* (1860), 24 How. 164.

§ 240. ¹In *Loom Co. v. Higgins* (1881), 105 U. S. 580, Bradley, J. : (591) "It may be laid down as a general rule, though perhaps not an invariable one, that if a new combination and arrangement of known elements produce a new and beneficial result never attained before, it is evidence of invention. It was certainly a new and useful result to make a loom produce fifty yards a

day when it never before had produced more than forty; and we think that the combination of elements by which this was effected, even if those elements were separately known before, was invention sufficient to form the basis of a patent." 21 O. G. 2031 (2035).

In the above case it was the fact that, although it had long been desirable to increase the capacity of the loom, no one had found out how to do it that indicated invention, not the mere increase *per se*.

In *Imlay v. The Norwich & Worcester R. R. Co.* (1858), 1 Fisher, 340, Ingersoll, J. : (349) "Where, in two devices, the end to be accomplished is the same, and the substantial means to accomplish the end are the same, the two devices are identical, though one may accomplish the end more effect-

erned generally by the degree of force employed, or by the size of the invention through which it is applied. Diversities in these respects, however, may arise from other causes than from changes in the magnitude of the instrument or the degree of force; and in such cases, though the function still remains the same, the variation in capacity may be so great, or hitherto so unattainable, as to denote either the development of the old idea of means or the introduction of a new and independent idea.³

§ 241. Diversities of Proportion.

The proportion of one part of an invention to the others is frequently a matter of essential consequence. This is especially the case in chemical compositions, whose entire law of ingrediential co-operation often depends upon the strictest preservation of the due proportions between their several elements. To a less extent it is true also of designs,

ally than the other." 4 Blatch. 227 (237).

That changes in capacity or power do not necessarily affect the identity of an invention, see *Brainard v. Evening Post Association* (1884), 22 Blatch. 61; 19 Fed. Rep. 422; *Belt v. Crittenden* (1880), 18 O. G. 191; 1 *McCrary*, 269; 2 Fed. Rep. 82; 5 *Bann. & A.* 131; *Planing Mach. Co. v. Keith* (1879), 101 U. S. 479; 17 O. G. 1031; *Stow v. Chicago* (1877), 8 *Bissell*, 47; 3 *Bann. & A.* 83; *Putnam v. Yerrington* (1876), 9 O. G. 689; 2 *Bann. & A.* 237; *Day v. Bankers & Brokers Telegraph Co.* (1872), 5 *Fisher*, 268; 9 *Blatch.* 345; 1 O. G. 551; *Roberts v. Harnden* (1865), 2 *Clifford*, 500; *Forbes v. Baratow Stove Co.* (1864), 2 *Clifford*, 379; *Cahoon v. Ring* (1861), 1 *Clifford*, 592; 1 *Fisher*, 397; *Phillips v. Page* (1860), 24 *How.* 164.

That an increase of excellence and convenience do not *per se* change the character of an invention, see *Perry v. Co-operative Foundry Co.* (1882), 12

Fed. Rep. 149; 20 *Blatch.* 505; 22 O. G. 1624; *Guidet v. Brooklyn* (1881), 105 U. S. 550; 21 O. G. 1692; *Putnam v. Yerrington* (1876), 9 O. G. 689; 2 *Bann. & A.* 237; *Stevens v. Pierpont* (1875), 42 *Conn.* 360; *Pitts v. Wemple* (1855), 2 *Fisher*, 10; 1 *Bissell*, 87; *Tatham v. Le Roy* (1852), 2 *Blatch.* 474; *Alden v. Dewey* (1840), 1 *Story*, 336; 2 *Robb*, 17.

That a mere increase in simplicity and cheapness may not affect identity, see *Evory v. Burt* (1883), 15 *Fed. Rep.* 112; 23 O. G. 2121; *Odiorne v. Denney* (1878), 13 O. G. 965.

² That changes in capacity or economy of action may sometimes indicate a change in the essence of the invention, see *Sharp v. Tift* (1880), 17 O. G. 1282; 18 *Blatch.* 132; 2 *Fed. Rep.* 697; 5 *Bann. & A.* 899.

That changes in degree are not invention, see *Asmus v. Alden* (188), 27 *Fed. Rep.* 684; 36 O. G. 23; *May v. County of Fond du Lac* (1886), 27 *Fed. Rep.* 691; *Guidet v. Brooklyn* (1882), 105 U. S. 550; 21 O. G. 1692.

and may be so in reference to any manufacture or machine. Wherever the proportions are essential, diversity therein is of course diversity in substance, whether the change results in the ability of the invention to perform new functions, or works an alteration only in its mode of operation. When they are not essential their variations, however great, affect only the form of the embodiment, and leave the identity of the invention undisturbed.¹

§ 242. Diversities of Arrangement.

The arrangement of the parts of an invention, also, sometimes expresses an essential characteristic of its idea of means.⁴

§ 241. ¹ That a mere change of proportions, no new mode of operation being introduced, does not affect the identity of an invention, see *Miller's Falls Co. v. Backus* (1879), 17 O. G. 852; 5 Bann. & A. 53; *Roberts v. Rye* (1875), 91 U. S. 151; 10 O. G. 204; *Tatham v. Le Roy* (1852), 2 Blatch. 474; *Hall v. Wiles* (1851), 2 Blatch. 194; *Parker v. Stiles* (1849), 5 McLean, 44; *Reutgen v. Kanows* (1804), 1 Wash. 168; 1 Robb, 1.

That where the elements, mode of operation, and result of a combination remain the same, no change of proportions can make the combination a new one, see *Isaacs v. Abrams* (1878), 14 O. G. 861; 3 Bann. & A. 616; *Ex parte Greeley* (1873), 4 O. G. 612; 6 Fisher, 575; *Holmes*, 284; *Winans v. Denmead* (1853), 15 How. 330.

That the same rule applies in chemical processes and compositions, see *Rumford Chemical Works v. Lauer* (1872), 10 Blatch. 122; 5 Fisher, 615; 3 O. G. 349.

§ 242. ¹ In *Gilbert & Barker Mfg. Co. v. Walworth Mfg. Co.* (1876), 9 O. G. 746, *Shepley, J.*: (746) "Mere change of location is not patentable, but where change of location brings into existence a new combination . . . to produce a new and useful result, such

new combination is patentable." 2 Bann. & A. 271 (272).

In *Marsh v. Dodge & Stevenson Mfg. Co.* (1873), 6 Fisher, 562, *Woodruff, J.*: (565) "Is the mere location of devices, such devices not being new, patentable? To this the answer must be that it is not. If the result is the same, and nothing new is required to adapt an apparatus to operate in its new location, nothing has been done which can be called invention. If such change of location produced a new combination of devices, producing a new result, then, indeed, something patentable may have been devised; but mere change of location is not invention. On the other hand, where change of location involves the employment of new devices to adapt an apparatus for use in the new position, and a beneficial result is produced, then this location, in its connection with such new devices, — that is, the means by which the result is produced, and not the result itself, — is patentable. And where such change of location brings into existence a new combination of devices, operating by reason of such new combination to produce a new and useful result, such new combination is patentable." 5 O. G. 398 (399).

That a mere change in the location or arrangement of the parts of an inven-

A process usually consists of a series of acts performed in a certain order. A combination is a group of subordinate

tion, without changing its function or mode of operation, does not affect its identity, see *Kirk v. Du Bois* (1887), 42 O. G. 297; *Aron v. Manhattan Ry. Co.* (1886), 26 Fed. Rep. 314; 34 O. G. 1508; *Straw Sewing Mach. Co. v. Eames* (1880), 19 O. G. 359; 18 Blatch. 520; 6 Fed. Rep. 181; *Knox v. Great Western Quicksilver Mining Co.* (1878), 14 O. G. 897; 6 Sawyer, 430; *Pearl v. Ocean Mills* (1877), 11 O. G. 2; 2 Bann. & A. 469; *Adams v. Joliet Mfg. Co.* (1877), 3 Bann. & A. 1; 12 O. G. 93; *Gilbert & Barker Mfg. Co. v. Tirrell* (1874), 8 O. G. 2; 1 Bann. & A. 315; 12 Blatch. 144; *Buerk v. Imhaeuser* (1874), 1 Bann. & A. 337; 5 O. G. 752; *Dane v. Illinois Mfg. Co.* (1872), 2 O. G. 680; 6 Fisher, 124; 3 Bissell, 374; *King v. Maudelbaum* (1871), 8 Blatch. 468; 4 Fisher, 577; *Blake v. Eagle Works Mfg. Co.* (1871), 3 Bissell, 77; 4 Fisher, 591; *Brooks v. Bicknell* (1844), 3 McLean, 432; *Bovill v. Keyworth* (1857), 7 El. & B. 725.

That to change the attachment of one part of a machine to another does not necessarily affect its identity, see *Ives v. Hamilton* (1875), 92 U. S. 426; 10 O. G. 336.

That to reverse the order of parts without changing the idea of the invention does not affect identity, see *Minter v. Wells* (1834), 1 Web. 127; 2 Abb. P. C. 26.

That a change in arrangement by which one part performs a double function, which it before did separately, is not invention, see *Adams v. Bellaire Stamping Co.* (1886), 28 Fed. Rep. 360; 36 O. G. 567.

That a change of arrangement without change of function or result is not invention, see *Belle Patent Button Fastener Co. v. Lucas* (1886), 23 Fed.

Rep. 371; 37 O. G. 1004; *Hancock Inspirator Co. v. Lally* (1886), 27 Fed. Rep. 88; 35 O. G. 1001; *Adams v. Bellaire Stamping Co.* (1886), 28 Fed. Rep. 360; 36 O. G. 567.

That to change the location of one element in a combination without change of function or mode of operation does not affect the identity of the combination, even though the change enables the inventor to dispense with other elements whose functions are now performed by the one thus changed, see *Dane v. Illinois Mfg. Co.* (1872), 3 Bissell, 374; 6 Fisher, 124; 2 O. G. 680.

That to change the location of the elements in a combination does not make it a new combination simply because the change enables it to produce a better effect, see *Adams v. Joliet Mfg. Co.* (1877), 12 O. G. 93; 3 Bann. & A. 1.

That change in arrangement may be invention, see *Brown Mfg. Co. v. Deere* (1884), 28 O. G. 1187; 21 Fed. Rep. 709; *Florence Sewing Mach. Co. v. Grover & Baker Sewing Mach. Co.* (1872), 110 Mass. 70.

That a change of location of parts producing a new result makes a new invention, see *Reay v. Berlin & Jones Envelope Co.* (1884), 28 O. G. 370; 20 Fed. Rep. 506; *Barber v. Hallett* (1881), 20 O. G. 449; 10 Fed. Rep. 130; *Gilbert & Barker Mfg. Co. v. Walworth Mfg. Co.* (1876), 9 O. G. 746; 2 Bann. & A. 271; *Carstaedt v. U. S. Corset Co.* (1875), 13 Blatch. 119; 9 O. G. 151; 2 Bann. & A. 119; *Calkins v. Bertraud* (1875), 6 Bissell, 494; 2 Bann. & A. 215; 9 O. G. 795; *Gilbert & Barker Mfg. Co. v. Tirrell* (1874), 12 Blatch. 144; 8 O. G. 2; 1 Bann. & A. 315.

That to rearrange a well-known article, if changing its idea of means, is to

means, so located with reference to each other that they obey a new law of co-operation. The identity of a design depends upon the place occupied by each line or image in relation to the others. Even a simple machine or manufacture may be unable to discharge its functions, unless the situation of every portion of the instrument remains unchanged. In many of these cases, any variation in arrangement destroys the entire availability of the invention, and renders it incapable of useful action. In others, while it still accomplishes its ends, it does so by a different application of the force which it employs, and thus becomes a different invention. Diversity of arrangement, therefore, though the parts themselves are not affected, is often a diversity of substance, and always must be such when the result of re-arrangement is either a new function or the performance of the old one in a different manner. But when, notwithstanding differences of location or arrangement, the function and the mode of operation are in all respects the same, the diversity is only formal, and the character of the invention is not changed.

§ 243. Diversities of Material.

The materials of which the parts of an invention are composed are not often essential to its identity, except in compositions of matter.¹ In these compositions, the prop-

make a new invention, see *Stanley Works v. Sargent* (1871), 8 Blatch. 844; 4 Fisher, 443.

That to rearrange the elements of a combination, thereby producing a new effect, creates a new combination, see *Woodward v. Dinsmore* (1870), 4 Fisher, 163; *Foxwell v. Bostock* (1864), 12 W. R. 723; 10 L. T. N. s. 144.

And this, though the general principle of the combination remains unchanged, see *Zane v. Peck* (1877), 12 O. G. 518.

And though the action of certain of the elements is unchanged, see *Fitch v. Bragg* (1831), 20 O. G. 1589; 8 Fed. Rep. 588; *Adams v. Joliet Mfg. Co.* (1877), 12 O. G. 93; 3 Bann. & A. 1;

Turrill v. Illinois Central R. R. Co. (1867), 3 Fisher, 330; 3 Bissell, 66.

§ 243. ¹ A "change of material," in reference to an invention, may take place in two ways: (1) By a change in the materials of which the invention itself consists; (2) By a change in the materials of the object upon which the invention is intended to act. Instances of the first change occur where in a process different substances are used, or in a machine or manufacture brass or wood are substituted for iron, &c. Instances of the second change are found where an art or instrument heretofore employed upon one fabric or material is now for the first time directed toward another. These changes

erties of the ingredients are the elemental forces whose union constitutes the new invention; and hence a change which in-

are essentially distinct, and raise entirely different questions in Patent Law. In the former change, these questions relate to the identity of the invention in which the change has taken place, and are answered by determining whether the substitution affects the idea of means previously expressed in the invention. In the latter change, these questions relate to the use of the existing invention, and are answered by determining whether its use upon the new material embodies a new idea of means, involving the exercise of inventive skill, or is a mere analogous or double use. Only the former change and former questions are referred to in this paragraph and the present note. The latter will be found sufficiently discussed in Section IV., §§ 259-271, under the head of "Double Use." Yet in examining the citations and references under both topics, the reader will discover that these two changes are frequently spoken of by the courts as if they were but one, and caution to distinguish what is applicable to each is therefore always necessary.

In *Gardner v. Herz* (1886), 118 U. S. 180, Blatchford, J. : (192) "But a patent cannot be taken out for an article, old in purpose and shape and mode of use, when made for the first time out of an existing material, and with accompaniments before applied to such an article, merely because the idea has occurred that it would be a good thing to make the article out of that particular old material." 35 O. G. 999 (1000).

In *Isaacs v. Abrams* (1878), 14 O. G. 861, Lowell, J. : (862) "It is not invention to change one well-known material for another, or to apply a well-known process, without some adaptation more than every skilled mechanic could apply, to a new art or subject;

but a change in the form of a machine or instrument, though slight, if it works a successful result not before accomplished in a similar way in the art to which it is applied, or in any other, is patentable." 8 Bann. & A. 616 (617).

In *Smith v. The Goodyear Dental Vulcanite Co.* (1876), 98 U. S. 486, Strong, J. : (498) "The patent in that case [*Hotchkiss v. Greenwood*, 11 How. 248, see *post*] was for an improvement in making door and other knobs for doors, locks, and furniture; and the improvement consisted in making them of clay or porcelain in the same manner in which knobs of iron, brass, wood, or glass had been previously made. Neither the clay knob nor the described method of attaching it to the shank were novel. The improvement therefore was nothing more than the substitution of one material for another in constructing an article. The clay or porcelain door-knob had no properties or functions which other door-knobs, made of different materials, had not. It was cheaper and perhaps more durable; but it could be applied to no new use, and it remedied no defects which existed in other knobs. Hence it was ruled that the alleged improvement was not a patentable invention. The case does decide that employing one known material in place of another is not invention, if the result be only greater cheapness and durability of the product. But this is all. It does not decide that no use of one material in lieu of another, in the formation of a manufacture, can in any case amount to invention, or be the subject of a patent. If such a substitution involves a new mode of construction, or develops new uses and properties of the article formed, it may amount to invention. The substitution may be

roduces different ingredients must be a variation in the substance of the means. But in the other classes of inventions

something more than formal. It may require contrivance, in which case the mode of making it would be patentable; or the result may be the production of an analogous but substantially different manufacture. This was intimated very clearly in the case of *Hicks v. Kelsey* (18 Wall. 670), where it was said 'the use of one material instead of another in constructing a known machine is, in most cases, so obviously a matter of mere mechanical judgment and not of invention, that it cannot be called an invention unless some new and useful result, as increase of efficiency or a decided saving in the operation, be obtained.' But where there is some such new and useful result, where a machine has acquired new functions and useful properties, it may be patentable as an invention, though the only change made in the machine has been supplanting one of its materials by another. This is true of all combinations whether they be of materials or processes. In *Crane v. Price* (1 Webster's Patent Cases, 393), where the whole invention consisted in the substitution of anthracite for bituminous coal in combination with a hot-air blast for smelting iron ore, a patent for it was sustained. The doctrine asserted was that if the result of the substitution was a new, a better, or a cheaper article, the introduction of the substituted material into an old process was patentable as an invention. This case has been doubted, but it has not been overruled; and the doubts have arisen from the uncertainty whether any new result was obtained by the use of anthracite. In *Kneass v. The Schuylkill Bank* (4 Wash. C. C. 9), the use of steel plates instead of copper for engraving was held patentable. So has been the flame of gas instead of the

flame of oil to finish cloth. These cases rest on the fact that a superior product has been the result of the substitution, a product that has new capabilities, and that performs new functions." 11 O. G. 246 (249).

In *The Goodyear Dental Vulcanite Co. v. Smith* (1874), Holmes, 354, Shepley, J. : (364) "Strictly speaking, no new manufacture is anything more than a new combination and arrangement of old materials; and whenever such new combination and arrangement produces a new and useful result, there being diversity of method and diversity of result, the invention is patentable." 5 O. G. 585 (589); 1 Bann. & A. 201 (213). In this case also, *Hotchkiss v. Greenwood*, 11 How. 248, is commented on, and explained in accordance with this doctrine.

In *Hicks v. Kelsey* (1873), 18 Wall. 670, Bradley, J. : (673) "The use of one material instead of another in constructing a known machine is in most cases so obviously a matter of mere mechanical judgment, and not of invention, that it cannot be called an invention unless some new and useful result—an increase of efficiency, or a decided saving in the operation—is clearly attained. . . . (674) In *Crane v. Price* (Webster's Pat. Ca. 409), it is true the use of anthracite, instead of bituminous coal, with the hot blast in smelting iron ore was held to be a good invention, inasmuch as it produced a better article of iron at a less expense. But that was a process of manufacture, and in such processes a different article, replacing another article in the combination, often produces different results. The latter case is more analogous to the cases of compositions of matter than it is to those of machinery; and in compositions of

it is seldom necessary that any specific material should be employed. In manufactures and machines, any material ca-

matter, a different ingredient changes the identity of the compound, whereas an iron bar in place of a wooden one and subserving the same purpose, does not change the identity of the machine." 5 O. G. 94 (94).

In *Hotchkiss v. Greenwood* (1850), 11 How. 248, Nelson, J. : (265) "The instruction assumes and, as was admitted on the argument, properly assumes that knobs of metal, wood, etc., connected with a shank and spindle in the mode and by the means used by the patentees in their manufacture had been before known, and were in public use at the date of the patent; and hence, the only novelty which could be claimed on their part was the adaptation of this old contrivance to knobs of potter's clay or porcelain; in other words, the novelty consisted in the substitution of the clay knob in the place of one made of metal or wood, as the case might be. And in order to appreciate still more clearly the extent of the novelty claimed, it is proper to add that this knob of potter's clay is not new, and therefore constitutes no part of the discovery. If it was, a very different question would arise; as it might very well be urged, and successfully urged, that a knob of a new composition of matter, to which this old contrivance had been applied, and which resulted in a new and useful article, was the proper subject of a patent. The novelty would consist in the new composition, made practically useful for the purposes of life by the means and contrivances mentioned. It would be a new manufacture, and none the less so, within the meaning of the patent law, because the means employed to adapt the new composition to a useful purpose was old or well-known. But in the case before us, the

knob is not new, nor the metallic shank or spindle, nor the dovetail form of the cavity in the knob, nor the means by which the metallic shank is securely fastened therein. All these were well known and in common use; and the only thing new is the substitution of a knob of a different material from that heretofore used in connection with this arrangement. Now it may very well be that by connecting the clay or porcelain knob with the metallic shank in this well-known mode, an article is produced better and cheaper than in the case of the metallic or wood knob; but this does not result from any new mechanical device or contrivance, but from the fact that the material of which the knob is composed happens to be better adapted to the purpose for which it is made. The improvement consists in the superiority of the material, and which is not new, over that previously employed in making the knob. But this of itself can never be the subject of a patent. No one will pretend that a machine, made in whole or in part of materials better adapted to the purpose for which it is used than the materials of which the old one is constructed, and for that reason better and cheaper, can be distinguished from the old one, or in the sense of the patent law can entitle the manufacturer to a patent. The difference is formal, and destitute of ingenuity or invention. It may afford evidence of judgment and skill in the selection and adaptation of the materials in the manufacture of the instrument for the purposes intended, but nothing more."

That a mere change of the materials of which an invention consists, no new idea of means being thereby expressed, is not invention, see *Florsheim v. Schilling* (1886), 26 Fed. Rep. 256;

pable of receiving and retaining the forms of their essential parts is usually sufficient for the performance of their func-

35 O. G. 1435 ; *N. Y. Bung & Bushing Co. v. Doelgor* (1885), 23 Fed. Rep. 191 ; 32 O. G. 651 ; 23 Blatch. 167 ; *Palmenbing v. Buchholz* (1882), 23 O. G. 632 ; 13 Fed. Rep. 672 ; *U. S. Stamping Co. v. King* (1879), 17 Blatch. 55 ; 17 O. G. 1399 ; 4 Bann. & A. 469 ; *Phillips v. Detroit* (1879), 4 Bann. & A. 347 ; 17 O. G. 191 ; *Stow v. Chicago* (1877), 8 Bissell, 47 ; 3 Bann. & A. 88 ; *Dalton v. Nelson* (1876), 2 Bann. & A. 225 ; 13 Blatch. 357 ; 9 O. G. 1112 ; *Dunbar v. Myers* (1876), 94 U. S. 187 ; 11 O. G. 35 ; *Reckendorfer v. Faber* (1876), 92 U. S. 347 ; 10 O. G. 71 ; *Putnam v. Yerrington* (1876), 9 O. G. 689 ; 2 Bann. & A. 237 ; *Holbrook v. Small* (1876), 2 Bann. & A. 396 ; 10 O. G. 508 ; *Ingersoll v. Turner* (1875), 2 Bann. & A. 89 ; 12 O. G. 189 ; 7 Fed. Rep. 859 ; *Welling v. Rubber Coated Harness Trimming Co.* (1874), 1 Bann. & A. 282 ; 7 O. G. 606 ; *Opinion Atty. Gen.* (1827), 2 Op. At. Gen. 52 ; *Thompson v. James* (1863), 32 Beav. 570 ; *Mackelcan v. Rennie* (1862), 13 C. B. N. S. 52.

That to substitute for any of the materials used in the parts of a machine a new material discovered by the substitutor does not affect the identity of the machine unless its mode of operation be thereby changed, see *Bailey Washing & Wringing Mach. Co. v. Lincoln* (1871), 4 Fisher, 379.

That the fact that the materials are cheaper and better makes no difference, see *Florsheim v. Schilling* (1886), 26 Fed. Rep. 256 ; 35 O. G. 1435 ; *Putnam v. Weatherbee* (1875), Holmes, 497 ; 8 O. G. 320 ; *Hotchkiss v. Greenwood* (1848), 4 McLean, 456 ; 2 Robb, 730.

That the fact that the material substituted was never before used for the same purpose is of no consequence,

see *Rushton v. Crawley* (1870), L. R. 10 Eq. 522 ; *Jordan v. Moore* (1866), L. R. 1 C. P. 624.

That the substitution of purer materials, whereby a compound becomes more useful, or useful for additional but analogous purposes, does not affect its identity, see *Buchan v. McKesson* (1880), 7 Fed. Rep. 100 ; 18 Blatch. 485 ; 19 O. G. 222.

That where the material is of the essence of the invention, a change in material destroys its identity, see *Western & Wells Mfg. Co. v. Rosenstock* (1887), 30 Fed. Rep. 67 ; 41 O. G. 354 ; *Aikon v. Bemis* (1847), 3 Wood. & Min. 348 ; 2 Robb, 644.

That where the substitution of different materials enables the invention to effect a new result, it may produce substantial change in the invention, see *Dalton v. Nelson* (1876), 2 Bann. & A. 225 ; 13 Blatch. 357 ; 9 O. G. 1112 ; *Goodyear Dental Vulcanite Co. v. Willis* (1874), 1 Bann. & A. 569 ; 7 O. G. 41 ; 1 Flippin, 388.

And that such substantial change may be evidenced by the increased efficiency or economy with which the invention operates, see *Dalton v. Nelson* (1876), 9 O. G. 1112 ; 13 Blatch. 357 ; 2 Bann. & A. 225 ; *Goodyear Dental Vulcanite Co. v. Willis* (1875), 7 O. G. 41 ; 1 Flippin, 388 ; 1 Bann. & A. 568.

That where the substitution of a different material involves the employment of a different process, such substitution may be an invention, see *Goodyear Dental Vulcanite Co. v. Davis* (1880), 102 U. S. 222 ; 19 O. G. 543.

That to use an old material for an entirely new purpose may be invention, see *Jenkins v. Walker* (1872), Holmes, 120 ; *Newton v. Vaucher* (1851), 6 Exch. 859.

That to improve an existing material

tions, and the expression of their ideas of means. A change in such materials may affect the durability of the instrument, or the perfection with which it produces its results, but these attributes relate to the form of embodiment alone, not to the essence of the invention. Yet if diversity of the material employed requires a new mode of construction, or develops new capacities in the invention, as indicated either in the instrument itself or its effects, the change is one of substance, and produces an improvement or a new invention.

§ 244. Degree of these Diversities Immaterial unless they Affect the Substance of the Invention.

It is obvious that neither of these diversities can be accurately judged except by its effect upon the invention as a whole, and that this effect can be ascertained only by studying the art or instrument while in actual operation. However great the apparent magnitude of the diversity, it exists merely in embodiment unless the function or the mode of its performance is also changed. And slight as is the variation to the eye, if a new function is discharged, or if former functions are accomplished by a different force or by different applications of the same force, the variation is essential, and each invention is a distinct and independent means.

SECTION III.

OF THE NOVELTY OF INVENTIONS: IDENTITY: THE DOCTRINE OF EQUIVALENTS.

§ 245. Diversities of Integral Parts are sometimes Diversities of Substance, sometimes of Form.

Inventions which perform the same functions may differ not only in shape, size, capacity, proportions, arrangement, and materials, but also in the individual character of the parts or elements of which they are composed. When such diver-

so as to adapt it to a new use, and then apply it to that use, may be invention, see *Hoffman v. Aronson* (1871), 8 Blatch. 324; 4 Fisher, 456.

sity results in the expression of a different idea of means, the diversity is one of substance, and each of the inventions is distinct from and independent of the other. When the idea of means in both inventions is essentially the same, the variation either indicates a different development of this idea, by which the later invention becomes an improvement on the earlier, or is a simple alteration in the form of its embodiment. The rules which govern these diversities are based on the familiar principles already stated, and taken together, constitute the "Doctrine of Equivalents."

§ 246. "Equivalent" a Term Relating either to Substance or to Form: Equivalence in Form Alone here Considered.

The term "equivalent" is used in Patent Law in two different senses, and in relation to two different subjects. In one sense it denotes the correspondence between agencies which not only perform the same functions, but are in themselves the same operative means. In this sense it is synonymous with "identical;" and can be properly employed only in reference to an invention as a whole.¹ In its second and more

§ 246. ¹ The courts, in using this term "equivalent" have not always been careful to distinguish between these two meanings of the word. Thus in *Gottfried v. Phillip Best Brewing Co.* (1879), 17 O. G. 675, Dyer, J. : (685) "To make one mechanical device the equivalent of another, it must appear not only that it produces the same effect, but that such effect is produced by substantially the same mode of operation." 5 Bann. & A. 4 (34).

In *Conover v. Roach* (1857), 4 Fisher, 12, Hall, J. : (26) "It is not enough, in order to show that one mechanical device is the equivalent of another, that it accomplishes the same result; that it produces the same effect unless that effect is produced by substantially the same mode of operation. In other words, the ultimate end and object of a machine may be to produce a fabric or manufacture of a certain kind, and it

may well appear in the progress of invention that several different inventors may have invented different machines, producing the fabric or that manufacture by entirely different modes of operation, and in that event each successful inventor might be entitled to his patent. They might perhaps be so entirely distinct and different, and independent in their organization and mode of operation, that a patent for each might stand, covering the whole machine as an entirely distinct and independent organization; . . . or they might stand, one being an improvement on the other. It is not therefore sufficient, in order to authorize the jury to find that one device, or a series of devices all operating to the same end, is or are mechanical equivalents for other devices, unless they effect the same substantial purpose by substantially the same mode of operation."

There can be no question that in

technical sense it signifies the interchangeability of agencies which are known in the arts to be capable of serving the same purpose as integral parts of some particular invention.² In this sense it is applicable to the elements or ingredi-

both these decisions the judges used "equivalent" in the sense of "identical;" and were comparing complete inventions as distinguished from integral parts. The doctrine here stated, however, is applicable, as we shall hereafter see (§ 254, *post*), to the elements of mechanical combinations, which cannot be equivalents unless they are identical both in function and in mode of operation.

Another distinction between "equivalence" as predicated of entire inventions, and "equivalence" as used in reference to elements and factors of inventions, is well stated in *Johnson v. Root* (1858), 1 Fisher, 351, by Sprague, J.: (363) "The term 'equivalent,' gentlemen, has two meanings as used in this class of cases. The one relates to the results that are produced, and the other to the mechanism by which those results are produced. Two things may be equivalent; that is, the one equivalent to the other as producing the same result when they are not the same mechanical means. Mechanical equivalents are spoken of as different from equivalents that merely produce the same result. A mechanical equivalent, I suppose, as generally understood, is where the one may be adopted instead of the other by a person skilled in the art from his knowledge of the art. Thus, an instrumentality is used in a mechanism; you wish to produce a pressure downward; it can be done by a spring, or it can be done by a weight. A machine is presented to a person conversant with machines. He sees that the force applied downward in the one before him is by a weight; from the knowledge of his art he can pass at

once to another force — the spring — to press it downward, and these are mechanical equivalents. But, gentlemen, there may be equivalents in producing the same results, each of which is an independent matter of invention, and in that sense they are not mechanical equivalents. To illustrate my meaning, suppose, in early days, the problem was to get water from a well to the surface of the earth. One man takes a rope made of grass, and draws up a pail of water; another would see that, as a mechanical equivalent, a rope of hemp would accomplish the same result. But suppose another person comes, and for the first time invents a pump. That is equivalent in the result of bringing the water to the surface of the ground; in that respect it is equivalent in producing that result to hauling it up by a rope, but is not mechanically equivalent; it brings into operation, as you know, very different powers and forces, and would require invention to introduce it."

That an "equivalent" is the identical art or device, see *May v. County of Fond du Lac* (1886), 27 Fed. Rep. 691; *Cahoon v. Ring* (1859), 1 Fisher, 397; 1 Clifford, 592.

That whether two arts or devices are "equivalent" is a question of fact for the jury, see *May v. County of Fond du Lac* (1886), 27 Fed. Rep. 691; *Tatham v. Le Roy* (1852), 2 Blatch. 474; *Blanchard's Gunstock Turning Factory v. Warner* (1848), 1 Blatch. 258.

² In the second sense equivalents are defined as "obvious and customary" interchanges, see *Smith v. Downing* (1850), 1 Fisher, 64.

ents by whose union in one art or instrument the inventor has embodied his idea of means. It does not indicate identity either in essential character or individual function, but merely the ability to produce the same effects when brought into connection with the other elements in the invention. It is in this sense that the word is used in speaking of the "Doctrine of Equivalents."

§ 247. "Equivalent" in Form, Defined.

An equivalent is therefore any act or substance which is known in the arts as a proper substitute for some other act or substance employed already as an element in an invention, and whose substitution for that other act or substance does not in any manner vary the idea of means.¹ Thus it possesses three characteristics: (1) It must be capable of performing the same office in the invention as the act or substance whose place it supplies;² (2) It must relate to the form of embodiment alone and not affect in any degree the idea of means; and (3) It must have been known in the arts, at the date of the patent, as endowed with this capability, or have subsequently become so known without the further exercise of inventive skill.³ Each of these requisites demands a more extended explanation.

§ 248. Equivalence Depends on Capability of Substitution in the Concrete Invention.

The first essential attribute of an equivalent is its capability of serving as a substitute for the act or substance in whose

§ 247. ¹ That the substitution of equivalents does not vary the idea of means, see *Hobbie v. Smith* (1886), 27 Fed. Rep. 656; *Adams v. Bellaire Stamping Co.* (1886), 28 Fed. Rep. 360; 36 O. G. 567; *Brighton v. Wilson* (1883), 18 Fed. Rep. 378; *Putnam v. Hutchinson* (1882), 11 Bissell, 240; 12 Fed. Rep. 131. See also §§ 253-255, *post*.

² That a device must perform the same function, in order to be an equivalent, see *Piper v. Shedd* (1885), 26 Fed.

Rep. 151; 35 O. G. 256. See also §§ 248-252, *post*.

³ That one thing is an equivalent for another when a skilful workman from one would have known the other, see *May v. County of Fond du Lac* (1886), 27 Fed. Rep. 691; *Carter v. Baker* (1871), 4 Fisher, 404; 1 Sawyer, 512.

That equivalence must have been known at the date of the patent, see *Gould v. Rees* (1872), 15 Wall. 187; 6 Fisher, 106; 2 O. G. 624. See also § 256, *post*.

place it is employed. The existence of this capability cannot be ascertained by an examination of the alleged equivalent alone, nor by comparing the two acts or substances in their separated state. It depends entirely upon the relation which each occupies toward the invention into which they enter, and on the manner in which each co-operates in the invention with the other acts or substances to which it is there united. Equivalence can therefore be determined only by contrasting the two acts or substances when associated with the other elements of the invention, and engaged in the performance of the functions which they are intended to discharge. If, when subjected to this test, it is discovered that each so operates in the invention as to perform the precise function of the other, each is, in reference to that particular invention, the equivalent of the other, provided it effects no alteration in the idea of means, and had become known in the arts as such equivalent before the patent for the invention had been granted, or afterwards became known without the exercise of inventive skill.¹

§ 248. ¹ In *American Whip Co. v. Lombard* (1878), 4 Clifford, 495, Clifford, J.: (505) "By an equivalent in such a case, it is meant that the element or ingredient substituted for the one withdrawn performs the same function as the other, and that it was well known at the date of the patent in question as a proper substitute for the one omitted in the patented combination." 3 Bann. & A. 598 (604); 14 O. G. 900 (902).

In *Carter v. Baker* (1871), 1 Sawyer, 512, Sawyer, J.: (516) "When in mechanics, one device does a particular thing, or accomplishes a particular result, every other device known and used in mechanics which skilful and experienced workmen know will produce the same result, or do the same particular thing, is a known mechanical substitute for the first device mentioned for doing that thing, or accomplishing that result, although the first device may never before have been detached from its work

and the second one put in its place. It is sufficient to constitute known mechanical substitutes that, when a skilful mechanic sees one device doing a particular thing, he knows the other devices, whose uses he is acquainted with, will do the same thing." 4 Fisher, 404 (409).

In *Foss v. Herbert* (1856), 1 Bissell, 121, Drummond, J.: (126) "The question whether one thing is a mechanical equivalent for another is a question of fact, depending on the testimony of experts, on an inspection of the machines; and it is an inference to be drawn from all the circumstances of the case, by attending to the consideration whether the contrivance used by the defendant is used for the same purpose, performs the same functions, or is applicable to the same object as the contrivance used by the patentee." 2 Fisher, 31 (36).

That an equivalent is such by the effect which it produces as an element in the invention, see *Wilt v. Grier* (1881),

§ 249. **Equivalence not Dependent on Identity of Individual Attributes.**

Hence it is evident that similarity in individual character does not create, nor does diversity in individual character destroy, equivalence between such acts and substances as are thus capable of substitution for each other.¹ However unlike in name, shape, size, capacity, proportions, arrangement, or material they may appear to be, when studied only in connection with each other, if when brought into their position in the art or instrument their interchangeability is manifest, these individual variations become of no importance. Equivalence resides in use, not in intrinsic attributes; and similarity of use alone is necessary to make one act or substance the equivalent of another.

§ 250. **Equivalence not Dependent on Capability of Substitution in other Inventions.**

Nor is it of the slightest consequence that in reference to some different invention, of which one of these acts or substances is an essential element, this interchange would be impossible. The function of an act or substance depends not

19 O. G. 427 ; 5 Fed. Rep. 450; *Clarke v. Johnson* (1880), 4 Fed. Rep. 437 ; 18 O. G. 1276 ; 18 Blatch. 450 ; *Smith v. Marshall* (1876), 10 O. G. 375 ; 2 Bann. & A. 371; *Storrs v. Howe* (1876), 10 O. G. 421 ; 4 Clifford, 338.

That nothing can be an equivalent if its substitution produces a substantial change in the result, see *Clarke v. Johnson* (1880), 4 Fed. Rep. 437 ; 18 O. G. 1276 ; 18 Blatch. 450.

§ 249. ¹ In *Blake v. Rawson* (1873), Holmes, 200, Shepley, J.: (203) "It is not always enough to prove that two combinations of elements are equivalent to show that each element of the combination in one may be regarded under some circumstances as the equivalent of the corresponding element in the other, when the elements are separately considered. If the mechanical combina-

tion of the members of the two machines be such that the action and mode of operation differ in the two machines, then one is something more than a mere mechanical equivalent for the other." 3 O. G. 122 (123) ; 6 Fisher, 74 (80).

That a device, as used in a combination, may be an equivalent for one formerly used, although out of the combination it may be entirely unlike the device for which it is substituted, see *Cochrane v. Deener* (1876), 94 U. S. 780 ; 11 O. G. 687 ; *Foster v. Moore* (1852), 1 Curtis, 279.

That equivalence resides in use, not in name, see *Graham v. Mason* (1869), 5 Fisher, 1.

That equivalents may differ in shape, see *Graham v. Geneva' Lake Crawford Mfg. Co.* (1880), 21 O. G. 1536 ; 11 Fed. Rep. 138.

merely on its individual character and mode of operation, but also on the character and operation of the elements with which it is associated, and hence with every change in the association the function of each element may likewise change. Thus where an act or substance is employed in different inventions and fulfils in each a different purpose, the acts and substances which, as to one of these inventions, are its true equivalents, cease to be such when it has been transferred from this invention to another, and a new class of acts or substances become its obvious and customary substitutes. Equivalence resides therefore not only in the use, but in the use in a particular invention, and similarity or diversity of use in one is consequently of little service in determining the interchangeability of use in others.

§ 251. Equivalence Possible though One of the Equivalents Performs Additional Functions.

Again, equivalence is not affected by the fact that the new element performs in the invention some function in addition to the old.¹ While it is necessary that the entire service rendered by the act or substance, whose place another occupies, should be discharged, it is not essential that the operation of the substitute should be confined within the same limits as the former. It is sufficient that it serves the same use; if it serves others also, or better serves the old, it is no less an

§ 251. ¹ In *Atlantic Giant Powder Co. v. Goodyear* (1877), 13 O. G. 45, Shepley, J.: (46) "The books are full of cases proving that when a substitute is used for one ingredient in a patented combination which has every property and performs every function of the original in the combination, it does not cease to be an equivalent because in addition it does something more and better." 3 Bann. & A. 161 (164).

See also *Loercher v. Crandall* (1881), 11 Fed. Rep. 872; 20 Blatch. 106; 21 O. G. 863; *Wilt v. Grier* (1881), 5 Fed. Rep. 450; 19 O. G. 427; *Crouch v. Roemer* (1880), 103 U. S. 797; 19 O. G. 1067; *Maynadier v. Tenney* (1877), 2 Bann. & A. 615; *Holtbrook v. Small* (1876), 2 Bann. & A. 396; 10 O. G. 508; *Carstaedt v. U. S. Corset Co.* (1876), 2 Bann. & A. 331; 13 Blatch. 371; 10 O. G. 3; *Kendrick v. Emmons* (1875), 2 Bann. & A. 208; 9 O. G. 201; *Fisher v. Craig* (1874), 3 Sawyer, 69; 1 Bann. & A. 365; *Sarven v. Hall* (1873), 4 O. G. 666; 11 Blatch. 295; 6 Fisher, 495; *Converse v. Cannon* (1873), 2 Woods, 7; 9 O. G. 105; *Sarven v. Hall* (1872), 1 O. G. 437; 9 Blatch. 524; 5 Fisher, 415; *Wheeler v. Clipper Mower & Reaper Co.* (1872), 10 Blatch. 181; 6 Fisher, 1; 2 O. G. 442; *Foss v. Herbert* (1856), 2 Fisher, 31; 1 Bissell, 121.

equivalent than if the entire functions of each, as elements in the invention, were identical. One act or substance may thus be the equivalent of another, although the latter, if the former had been first employed, could not have been regarded by itself alone as its complete and perfect substitute in the invention. Yet as to the one use which both alike subserve, they stand on the same footing as if no other use were possible to either, and as to that are interchangeable equivalents.

§ 252. **Equivalence not Dependent on the Number of the Substituted Parts.**

For this reason any single act or substance may be an equivalent for two or more already used in the invention; and, on the contrary, two or more acts or substances may be together capable of substitution for and so become equivalents of a single one.¹ In both these cases neither member of the group of elements is a perfect substitute for the one element whose function they unitedly perform, although that single element is an entire equivalent for each as well as all the members of the substituted group. Yet, as in each case precisely the same service must be rendered and the same purposes fulfilled, both by the single element and by the group of elements, in spite of the numerical diversity and the want of exact separate correspondence, the essential characteristics of equivalence are still preserved. The same is true of every other possible diversity; if it does not affect the use of the acts or substances in the invention, it has no bearing on the question of equivalence, and furnishes no criterion of interchangeability.

§ 252. ¹ That two acts or substances may be the equivalent of one, see *Strobridge v. Lindsay* (1881), 6 Fed. Rep. 510; 19 O. G. 1285.

That one act or substance may be the equivalent of two or more, see *Brooks v. Norcross* (1851), 2 Fisher, 661; *Heath v. Unwin* (1852), 2 Web. 236; *Martin & Keating's Patents* (1848), 2 Web. 195, n.

That while a single cam may be the equivalent of a single wedge, two cams may not be the equivalent of two wedges, see *Gray v. Bangs* (1887), 31 Fed. Rep. 342.

That a compound may be an equivalent for its elements and *vice versa*, see *Heath v. Unwin* (1852), 2 Web. 236; *Martin & Keating's Patents* (1848), 2 Web. 195, n.

§ 253. Equivalency Impossible when the Idea of Means is Changed.

The second essential requisite in an equivalent is that its use in the invention must not involve a change in the idea of means. A change in the idea of means is a change of substance, demanding an operation of the creative faculties, and producing either a new invention or an improvement on the old. The substitution of equivalents is, on the contrary, a mere change of form, involving no inventive skill, but suggested by the invention itself to every person familiar with the art to which the invention appertains.¹ Any act or substance, therefore, however accurately it performs the function of the element whose place in the invention it supplies, is not a mere equivalent if in addition it has also introduced a new idea or a development of the old idea of means.² While an equivalent may actually accomplish more, or operate to better purpose than the former, its excess of action must be consistent with the unity and identity of the idea embodied in the original invention.

§ 253. ¹ In *Foster v. Moore* (1852), 1 Curtis, 279, Curtis, J. : (291) "I do not think the doctrine respecting the use of mechanical equivalents is confined by the Patent Law to those elements which are strictly known as such in the science of mechanics. In the present advanced state of that science there are different well-known devices, any one of which may be adopted to effect a given result according to the judgment of the constructor. And the mere substitution of one of these for another cannot be treated as an invention. It does not belong to the subject of invention, but of construction. One constructor may adopt a spring-catch, another a catch and spring; but whether he takes one or the other is matter of judgment in construction, as long as both are designed to accomplish the same end, and both are in common use to accomplish it."

² That where no inventive skill is involved in the substitution, the thing

substituted is an equivalent, see *Coes v. Collins Co.* (1882), 9 Fed. Rep. 905; 20 Blatch. 221; 22 O. G. 417; *Crouch v. Roemer* (1880), 103 U. S. 797; 19 O. G. 1067; *Whittlesey v. Ames* (1880), 9 Bissell, 225; 18 O. G. 357; 5 Bann. & A. 96; 13 Fed. Rep. 893; *Schumacher v. Cornell* (1877), 96 U. S. 549; *Smith v. Marshall* (1876), 10 O. G. 375; 2 Bann. & A. 371; *Fisher v. Craig* (1874), 3 Sawyer, 69; 1 Bann. & A. 365; *Westlake v. Cartter* (1873), 6 Fisher, 519; 4 O. G. 636; *King v. Louisville Cement Co.* (1873), 6 Fisher, 336; 4 O. G. 181; *Taylor v. Garretson* (1871), 5 Fisher, 116; 9 Blatch. 156; *Case v. Brown* (1864), 2 Wall. 320; *Burden v. Corning* (1864), 2 Fisher, 477; *Johnson v. Root* (1858), 1 Fisher, 351; *Tatham v. Le Roy* (1852), 2 Blatch. 474; *Blanchard's Gunstock Turning Factory v. Warner* (1848), 1 Blatch. 258; *Heath v. Unwin* (1845), 2 Web. 223.

§ 254. **Equivalence in Combinations.**

In examining alleged equivalents with reference to this second attribute, it is important that the radical distinction between a combination and a simple invention should be constantly remembered; for the same apparent change which, in a simple invention, would be but a substitution of equivalents might, in a combination, introduce a new idea of means. A combination is not a mere union of integral parts into a single art or instrument; it is a grouping of subordinate means, each perfect in itself, each retaining its own individuality of character and function, and each performing its own function by its own peculiar mode of operation, under a common law of action, in obedience to which all the members of the group co-operate in the production of a given result; and its identity depends upon the presence of each one of those specific elemental means, and upon the obedience of all to that co-operative law. The essential nature of this co-operative law being determined by and dependent upon the specific methods in which the individual elements perform their several functions, any variation in the mode in which an individual element operates must produce corresponding variations in the mode in which all co-operate, and must, consequently, subject them to a new co-operative law. Hence the removal of a single one of these subordinate means destroys the combination, and the substitution for the one removed of any element which differs from it in essential character, as a means, is the introduction not only of a different element but of a different co-operative law, and the creation of a new invention. In reference, therefore, to such elements in any combination as constitute its subordinate means, no other elements can be equivalent unless they are equivalent inventions; that is, unless they not merely perform the same functions but perform them by applying the same force to the same object through the same mode of application;¹ in other words,

§ 254. ¹ In the *Goodyear Dental Vulcanite Company v. Davis* (1880), 102 U. S. 222, Strong, J.: (230) "When a product arrived at by certain defined stages or processes is patented, only those things can be considered

equivalents for the elements of the manufacture which perform the same function in substantially the same way." 19 O. G. 543 (545).

That combination equivalents must not only perform the same function, but

unless they differ from the elements whose place they occupy only in the form in which their several ideas of means have

also perform it in the same way, see *Schmidt v. Freese* (1882), 12 Fed. Rep. 563; 21 O. G. 1876; *Singer Mfg. Co. v. Stewart Mfg. Co.* (1881), 8 Fed. Rep. 920; 20 O. G. 524; *Merriam v. Van Nest* (1878), 13 O. G. 597; *Maynadier v. Tenny* (1877), 2 Bann. & A. 615; *Westlake v. Cartter* (1873), 4 O. G. 636; 6 Fisher, 519; *Roberts v. Roter* (1872), 5 Fisher, 295; *Crompton v. Belknap Mills Co.* (1869), 3 Fisher, 536; *Roberts v. Harnden* (1865), 2 Clifford, 500; *Eames v. Godfrey* (1863), 1 Wall. 78; *Conover v. Rapp* (1859), 4 Fisher, 57; *Cahoon v. King* (1859), 1 Fisher, 397; 1 Clifford, 592.

The reason for this distinction is stated in *Crompton v. Belknap Mills* (1869), 3 Fisher, 536, to be as follows: that in a combination the mode of operation of the combination as a whole is not covered by the patent, — only the union of certain elements in a mode of operation; and that the substitution of a different element, though in the same mode of operation, affects the substance of the invention, not its mere embodiment, as in the case of a machine whose mode of operation as a whole is covered.

Notwithstanding the clearness of this doctrine, both on principle and on authority, cases are to be found in which this peculiarity of combination equivalents is not noticed, even by judges who in other cases have distinctly recognized it. But this omission evidently results from an incompleteness of the definition attempted, not from a difference in doctrine. For instances of this see *Potter v. Stewart* (1881), 19 O. G. 997; 7 Fed. Rep. 215; 18 Blatch. 561; *Babcock v. Judd* (1880), 17 O. G. 1351; 1 Fed. Rep. 408; 5 Bann. & A. 127; *American Whip Co. v. Lombard* (1878), 14 O. G. 900; 4 Clifford, 495; 3 Bann. & A. 598; *Webster v. New Brunswick*

Carpot Co. (1874), 5 O. G. 522; 1 Bann. & A. 84; *Welling v. Rubber Coated Harness Trimming Co.* (1874), 1 Bann. & A. 282; 7 O. G. 606; *Rees v. Gould* (1872), 15 Wall. 187; 2 O. G. 624; 6 Fisher, 106; *Sands v. Wardwell* (1869), 3 Clifford, 277. In several of these cases the courts speak of a "new" device as not an equivalent, and also say that, to be an equivalent, the device must have been known at the date of the patent. If "new" is not synonymous with "not before known," in these instances it may mean "essentially different," and thus put even these cases in harmony with the true doctrine.

In applying this doctrine to compositions of matter, however, a new difficulty arises. These are always true combinations, of which the ingredients are the constituent elements; and hence it should be true of these also that no element can be the equivalent of another unless it performs the same function in the same way. But in most chemical compositions, and in some mechanical ones, it is impossible to ascertain by what methods the elements do perform their respective functions; and the courts are compelled either to regard them as non-equivalents — for want of sufficient proof of identity of method, even although each is a well-known substitute for the other — or to accept the fact that each fulfils the same office as proof that the methods in which they fulfil it are the same. In this dilemma the latter mode has been adopted, and it is held that in such combinations elements are equivalents if they discharge the same function and were so known at the date of the patent, — thus returning in such cases to the practical rule which governs simple inventions.

This exception to the law of combination equivalents is admirably dis-

been expressed. But other changes, not affecting the identity of these subordinate means, such as the changes in their own

cussed by Pollock, C. B., in *Stevens v. Keating* (1847), 2 Web. 181. He says: (188) "It has been said that this borax which the defendant uses is a chemical equivalent. I may say that I do not quite go along with the doctrine of equivalents in chemistry, applied in the same way as in mechanics and those matters to which you can apply the principles of the exact sciences. If a man discovers a machine that can be successfully used to produce any effect, whether to print a newspaper, to make a stucco, to light an apartment, or to do any process whatever, it is well known that if he uses a crank there are two or three substitutes for a crank; if he uses one mode of changing the direction of motion there are three or four perfectly well-known means of doing that; and if he puts in a specification, describing his machine, and somebody comes and instead of a crank substitutes something else; or if instead of a pulley to change motion he substitutes a wheel or some adaptation of wheels to change the motion, — everybody will at once see that to be an evasion of the patent, and for this plain reason, that all these equivalents are perfectly well known; they are just as well known as that 10 added to 6 makes 16, and that 3 added to 8 makes also 16. In the mechanical sciences, or wherever you can apply the exact sciences, you can frequently predict the results without the slightest difficulty, and with the same certainty as that with which a skilful arithmetician can tell you what will be the amount of certain numbers added together, and that a certain other set of numbers apparently differing from them altogether will, when added together, produce the same result. With precisely the same certainty a skilful mechanic will tell you that such and such

a combination will produce a result, and that such and such another combination, to the ordinary eye apparently totally different, will produce precisely the same result, but looked at with the experienced eye of a mechanic he would say, Yes, there appears to be a great difference; here is a lever instead of an inclined plane, a pulley instead of two wheels to change the motion, and so on; but a skilful mechanic will say, The general expression in all these might be put down as exactly the same; so that, however different they may appear to the eye, they are to the mind precisely the same. I do not think that doctrine applies altogether to the case of chemistry, because, although you can predict with confidence in mechanics in some instances, and in some cases where mathematics can be applied, in chemistry you almost entirely fail. You cannot, because sulphuric acid will succeed, tell at all that nitric acid will succeed, or that any other acid will succeed until you have tried. They do not exist in any relation to each other as numbers do, or as mechanical science presents to you the different mechanical powers. You cannot anticipate the result, — it is a mere question of result upon experiment."

In this country the same exception has been admitted, in reference to chemical compositions, in *Tyler v. Boston* (1868), 7 Wall. 327.

But that as to mechanical compounds, in which the mode of operation of the elements can be detected, the general rule of combination equivalents is adhered to, see *Atlantic Giant Powder Co. v. Dittmar Co.* (1881), 9 Fed. Rep. 316; 20 O. G. 1380; *Atlantic Giant Powder Co. v. Mowbray* (1876), 12 O. G. 111; 2 Bann. & A. 442.

In some cases the courts have en-

integral parts or in the non-essential elements of the combination, follow the usual rule, and are but substitutions of equivalents if the same functions are performed by both.

§ 255. *Equivalence in Simple Inventions.*

In simple inventions, on the other hand, identity depends only upon the mode of operation of the art or instrument considered as a whole, and any change in the integral parts consistent with the preservation of this mode of operation is only change of form. The function of these individual parts,

endeavored to draw a distinction between combinations of old elements and combinations in which the elements themselves are new, and to make this distinction the basis of another difference in the application of the doctrine of combination equivalents. See *Sands v. Wardwell* (1869), 3 Clifford, 277; *McCormick v. Talcott* (1857), 20 Howard, 402, etc. From such an endeavor only confusion is likely to result. Every combination, considered as a combination, occupies precisely the same legal status, whether its elements are new or old. It is a complete invention, an entirety, a unit; and its unity is destroyed by any substitution of elements not performing the same office in the same way, while the substitution of elements which do fulfil the same purpose in the same manner does not affect the substance of the invention, but its form only. If the elements are old, and such of their individual characteristics as are involved in the performance of their functions were well known, the scope of the inventive act is limited to the union of these elements under their co-operative law. But if the elements are wholly new, or if although old in themselves their qualities which are now serviceable in the combination have been discovered and applied by the combiner, an additional inventive act has been performed, which, if properly claimed, should be protected by a patent. Still, as inventions, these are

distinct from the combinations in which they are now united; and any subsequent inventor, who produces acts or substances discharging the same functions in the same manner, must be regarded as a mere imitator and infringer of the former. Now, when the courts undertake to establish one rule of equivalents where the elements are old, and another where the elements are new, what is it but an endeavor to protect the rights of the inventor of the new element in an indirect manner, instead of requiring him to protect himself by claiming the new element in his patent in the usual mode? And if by describing and not claiming it he has abandoned it to the public, has he not reduced himself to the position of the inventor of an ordinary combination (that is, of the union of certain elements under a co-operative law); and how can he, under color of equivalents, reclaim the idea of means embodied in the element abandoned? The symmetry and precision of the law can be preserved only by keeping things distinct which are legally or naturally independent of each other. The combination is an invention by itself. Its essence is the union of several elemental means in one co-operating means; and whether the inventor of the combination is the inventor of the elemental means or not cannot vary any of the rules by which the identity of the combination is to be determined.

therefore, alone becomes important, and everything which performs in the same function when incorporated into the invention conduces equally to the attainment, through the same method, of the ultimate result. The field of equivalents is thus far wider in regard to these inventions than with reference to combinations. In these a substitute, in order to escape equivalence, must differ in its function, not merely as a means, and must subvert or modify the principle of the entire invention, while any substitution in the essential elements of a combination which affects either the means or function of the single element passes beyond the region of equivalents into the sphere of substantive invention.

§ 256. Equivalence Impossible if the Alleged Equivalent has been Invented since the Original Invention was Patented.

The third essential attribute of an equivalent is that it must have been known as such at the date of the patent, or have since become known without the exercise of inventive skill.¹

§ 256. ¹ In *Crompton v. Knowles* (1881), 7 Fed. Rep. 199, Lowell, J.: (203) "That doctrine [known substitutes], first announced by Mr. Justice Clifford, and often applied by him, is that one who has invented and patented a new combination, however small and easy, if it be patentable at all, may treat as an infringement anything which is a purely colorable variation of his invention, obtained by substituting one well-known part or ingredient for another equally well-known, and fully understood, by persons skilled in the art, to be exchangeable in similar combinations for the part or ingredient which it replaces. It is a doctrine of very limited application, and as a formula, is perhaps rather misleading. The true question always is whether the defendant uses anything which the plaintiff invented."

In *Imhaeuser v. Buerk* (1879), 101 U. S. 647, Clifford, J.: (656) "Patentees of an invention consisting merely of a combination of old ingredients are entitled to equivalents; by which is meant

that the patent in respect to each of the respective ingredients comprising the invention covers every other ingredient which, in the same arrangement of the parts, will perform the same function, if it was well known as a proper substitute for the one described in the specification at the date of the patent." 17 O. G. 795 (795).

In *Gill v. Wells* (1874), 22 Wall. 1, Clifford, J.: (15) "Old ingredients known at the date of letters-patent granted for an invention consisting of a new combination of old ingredients, if also known at that date as a proper substitute for one or more of the ingredients of the invention secured by the letters-patent, are the equivalents of the corresponding ingredients of the patented combination. Such old ingredients, *so known* at the date of the letters-patent granted, are the equivalents of the ingredients of the patented combination, and no others; and it may be added that *that*, and that only, is what is meant by the rule that inventors

The substitution of one equivalent for another is a change in the form of embodiment only; and as all forms of embodiment

of a new combination of old ingredients are as much entitled to claim equivalents as any other class of inventors." 6 O. G. 881 (881).

In *Unwin v. Heath* (1854), 5 H. L. 505, Williams, J.: (523) "Though the use of a chemical or mechanical substitute which is a known equivalent to the thing pointed out by the specification and claimed as the invention amounts to an infringement of the patent, yet if the equivalent were not known to be so at the time of the patent and specification, the use of it is no infringement." Parke, B.: (538) "The specification must be read as persons acquainted with the subject would read it at the time it was made; and if it could be construed as containing any chemical equivalents, it must be such as are known to such persons at that time; but those which are not known at the time as equivalents, and afterwards are found to answer the same purpose, are not included in the specification. They are new inventions." Pollock, L. C. B.: (541) "The patent . . . covers and protects not only the process actually specified, but any process with chemical equivalents known as such at the date of the patent, but not chemical equivalents discovered afterwards; for this would be giving the patentee not only the benefit of his own discovery, but the benefit of the discoveries of other persons subsequently to the date of the patent. The process used by the defendant was not known as a chemical equivalent at the date of the patent. . . . Then assuming it to be a chemical equivalent . . . it is not a chemical equivalent that was known to scientific persons at the date of the patent, and it stands, therefore, on the footing of an entirely new discovery."

In *Heath v. Unwin* (1852), 2 Web. 236, Coleridge, J.: (243) "The specifica-

tion, to be perfect, must be taken to specify impliedly all the chemical equivalents of those chemical means expressly stated for producing the promised result which were at the time of specifying known to ordinarily skilled chemists or to the patentee himself. . . . (244) If that equivalent were known at the date of the specification . . . then it is within the specification, and the use of it is an infringement. If not, the contrary conclusion follows, and the use of it is an improvement in virtue of a new discovery; and the knowledge I speak of is, of course, . . . the knowledge that the component parts thus applied were equivalents to the thing itself, applied according to the specification for producing the desired result." . . . In the same case Alderson, B.: (245) "But it may be that there are equivalents, mechanical or chemical, existing, but previously unknown to ordinarily skilful mechanics or chemists. These are not included in the specification but must be expressly stated therein. These are, in fact, new discoveries, in themselves wholly independent of the specification which omits them, and for these there is no specification or patent at all. They may be used by all persons without infringing the patent. . . . (246) If the equivalent be not before known, he who discovers *de novo* the equivalent, if it be better than the original for which it was the equivalent, has by the use of the equivalent improved upon, not infringed, the original invention."

That the equivalent must have been known as such at the date of the patent, see also *Rowell v. Lindsay* (1885), 113 U. S. 97; 31 O. G. 120; *Kuhl v. Mueller* (1884), 21 Fed. Rep. 510; 28 O. G. 541; *Rowell v. Lindsay* (1881), 19 O. G. 1565; 10 Bissell, 217; 6 Fed. Rep. 290; *Babcock v. Judd* (1880), 17 O. G.

known in the arts are presumed to have been also known to the inventor and to have been open to his selection, his choice of one and its employment points out the mode of using all the rest, and thus renders every other an imitation of his own. But acts and substances which have been invented, or whose availability for the embodiment of his idea of means has been discovered and applied by the exercise of additional inventive skill, since he completed his invention and bestowed it on the public by his patent, are not imitations of the elements in which he has embodied his idea. Their creation or discovery, and their adaptation to the purposes of his invention have resulted from a subsequent and separate inventive act, -- an act performed after the completion and publication of his invention, and hence, though capable of exact substitution for the acts or substances he has employed, they are not true equivalents whose use causes a mere diversity of form, but new inventions expressing a diversity of substance. The attribute of knowledge, at the point of time when the inventor's right received the positive sanction of the law, thus enters into the character of an equivalent. If then known as a substitute, the substitution is an alteration in the form of the embodiment, a simple equivalent and nothing more. If then unknown, its subsequent creation and adaptation to the invention, by the exercise of inventive skill, if not resulting in an essential alteration in the idea of means, is at least a development of that idea, and constitutes an improvement.²

1851; 1 Fed. Rep. 408; 5 Bann. & A. 127; *Wicke v. Ostrum* (1880), 103 U. S. 461; 19 O. G. 867; *Colgate v. Law Telegraph Co.* (1880), 5 Bann. & A. 437; *Fuller v. Yentzer* (1876), 94 U. S. 299; 11 O. G. 597; *Welling v. Rubber Coated Harness Trimming Co.* (1874), 7 O. G. 606; 1 Bann. & A. 282; *Smith v. Woodruff* (1874), 4 O. G. 635; 1 MacArthur, 459; 6 Fisher, 476; *King v. Louisville Cement Co.* (1873), 4 O. G. 181; 6 Fisher, 336; *Gould v. Rees* (1872), 15 Wall. 187; 2 O. G. 624; 6 Fisher, 106; *Woodward v. Morrison* (1872), Holmes, 124; 5 Fisher, 357;

2 O. G. 120; *Heath v. Unwin* (1852), 2 Web. 236.

In a very few cases doubt has been expressed whether the date at which the equivalent must have been known is not the date of the invention rather than that of the patent (see *Goodyear Dental Vulcanite Co. v. Preterre* (1878), 14 O. G. 346; 15 Blatch. 274; and cases there referred to). But on principle, as explained in the text, and on the authorities above cited, there can be no serious question but that the date of the patent is the true one.

² It may well be questioned whether

§ 257. **All Equivalents Covered by the Patent.**

As the substitution of equivalents works no variation in the substance of an invention, so all equivalents, whether

this portion of the doctrine of equivalents has not often been pressed far beyond its legitimate scope and been made the basis for conclusions which it does not justify. Its first appearance in the law was as a rule governing the construction of a patent; and it was then formulated in the proposition that a patentee, having specified certain acts or substances as capable of expressing his idea of means, might treat all other acts or substances then known in the arts to be equally capable of expressing that idea, as identical with those which he employed, and consequently as covered by his patent. This proposition is incontrovertible, and had the doctrine been limited to this, no doubt as to its truth could ever have arisen.

But, as has often happened in reference to other subjects, the courts assumed that an exclusive form of statement must be equally correct with the inclusive, and hence declared that no act or substance could be legally the same as that employed in the patented invention unless it were known in the arts as practically the same at the date of the patent. This proposition they supported partly on the ground that the new act or substance not being known when the patent was granted, it cannot be supposed to have been claimed by the patentee, and partly on the ground that the inventor of the new act or substance is entitled to its exclusive use and its protection by a patent. And hence they have inferred that the use of such new act or substance, as a substitute for those described in the patent, is not forbidden by that patent, and that the practice of the invention with such substitution is not an infringement.

Whatever judicial authority may be

urged in defence of these positions, they cannot stand the test of logical or scientific inquiry. Where an act or substance not known in the arts at the date of the patent afterwards becomes known, its introduction into the arts is either the result of an inventive act or the consequence of that gradual extension of human knowledge to whose exclusive benefits no individual can lay claim. In the first case the inventor of the new act or substance is entitled to protection in its use, even though in its use it is an exact substitute for acts or substances previously employed, and therefore the inventor of the invention in which the new act or substance could be thus substituted has no right to adopt it in the embodiment of his idea of means. But it does not thence follow that the inventor of the new act or substance, can appropriate to himself the idea of means conceived by the former inventor. Unless the substitution of the new act or substance essentially changes that idea of means, in which case there is no question of equivalence or substitution, it either develops that idea or leaves it wholly undisturbed. If it develops the idea the substitution is an improvement. If it leaves the idea wholly undisturbed the change is a mere change of form. But whether an improvement or a mere change of form, the substitution does not enlarge the privileges of the substitutor nor curtail those of the original inventor, and any use of the invention with the substitution, unless consented to by the original inventor, must be an infringement.

In the second case, where the new acts or substances are not inventions but become known through the gradual development of human information, the rights of the original inventor are no

actually known to the inventor or not, are covered by his patent.¹ To reproduce his idea, in an art or instrument

less extensive and secure. His idea of means is equally unaffected by any substitution of such acts or substances, and those who employ that idea expressed through the new acts or substances equally invade the exclusive privileges which his patent has conferred upon him. Though by such substitution that idea is carried forward to a wider application or more excellent result, the substitution is at best a mere improvement, and the improver, here as in the former case, is guilty of infringement if he uses the invention without the permission of the original inventor.

From these considerations it is evident that the second proposition is not correct either in its statement, or the grounds on which it rests, or the conclusions to which it has led. It is not correct in statement, because although such acts or substances as were not known at the date of the patent express a diversity of substance wherever they have resulted from an inventive act, if they have simply become known through the development of human information, and no inventive skill has been exercised in substituting them for the acts or substances formerly employed, the sole change that has taken place in the invention is a change of form, and the new act or substance is as truly an equivalent as if it had been known before the issue of the patent. It is not correct in the grounds on which it rests because, firstly, the patentee never claims nor does his patent cover any form of embodiment new or old, but the idea of means or essence of the invention in whatever acts or substances it may be capable of embodiment; and secondly, the right of the inventor of the new act or substance to the exclusive use of his invention can never be extended

to embrace the idea of means expressed in the original invention, nor so exercised as to restrict the rights of the original inventor. It is not correct in the conclusions to which it has led, because no change in the embodiment of an idea of means, whether the substituted acts or substances are new or old, or are new inventions or are mere discoveries, can evade the prohibition of the patent or enable an unauthorized employer of the idea of means to escape the penalty of his infringement.

The doctrine to which this inquiry leads, and which must sooner or later receive recognition from the courts, may be thus stated:—

I. That every act or substance which is known at the date of the patent as an obvious and customary substitute for any act or substance employed by the inventor for the expression of his idea of means is its true equivalent, whose use creates a mere diversity of form and not of substance.

II. That any act or substance which without the exercise of inventive skill subsequently becomes known as such substitute, and is introduced into the invention, is also a mere equivalent, producing only a diversity of form.

III. That where the new act or substance, or its introduction into the invention, is due to the exercise of the inventive faculties, its creator or introducer has effected an improvement in the original invention which can be protected by a patent.

IV. That neither the creation nor the introduction of the new act or substance confers upon its introducer or creator any right to use the original invention, or to apply its idea of means in any form of embodiment whatever.

§ 257. ¹ That all equivalents are covered by the patent, see *Reay v. Ray-*

composed of different integral parts, is no less imitation than if the tangible embodiment had been an exact copy

nor (1884), 22 Blatch. 13; 26 O. G. 1111; 19 Fed. Rep. 308; Clough v. Barker (1882), 106 U. S. 166; 22 O. G. 2157; Wilt v. Grier (1881), 5 Fed. Rep. 450; 19 O. G. 427; Babcock v. Judd (1880), 5 Bann. & A. 127; 1 Fed. Rep. 408; 17 O. G. 1351; Mograw v. Carroll (1880), 5 Bann. & A. 324; Ready Roofing Co. v. Taylor (1878), 15 Blatch. 94; 3 Bann. & A. 368; American Whip Co. v. Lombard (1878), 4 Clifford 495; 14 O. G. 900; 3 Bann. & A. 598; Union Metallic Cartridge Co. v. U. S. Cartridge Co. (1877), 11 O. G. 1113; 2 Bann. & A. 593; Storrs v. Howe (1876), 10 O. G. 421; 2 Bann. & A. 420; 4 Clifford, 388; Gould v. Rees (1872), 15 Wall. 187; 2 O. G. 624; 6 Fisher, 106; Sayles v. Chicago & Northwestern R. Co. (1871), 3 Bissell, 52; 4 Fisher, 584; Roberts v. Harnden (1865), 2 Clifford, 500; Burden v. Corning (1864), 2 Fisher, 477; Pitts v. Edmonds (1857), 2 Fisher, 52; 1 Bissell, 168; Ryan v. Goodwin (1839), 3 Sumner, 514; 1 Robb, 725; Bateman v. Gray (1853), Macrory's P. C. 93.

That the same rule obtains in patents for chemical combinations, see *Matthews v. Skates* (1860), 1 Fisher 602; and for combinations in general, see *Dederick v. Whitman Agricultural Co.* (1886), 26 Fed. Rep. 763; 36 O. G. 570; *Dederick v. Cassell* (1881), 20 O. G. 1233; 9 Fed. Rep. 306; *Gill v. Wells* (1874), 22 Wall. 1; 6 O. G. 881; *Rees v. Gould* (1871), 15 Wall. 187; 2 O. G. 624; 6 Fisher, 106.

That a pioneer combination patent covers all equivalent constructions producing the same results by using the same mechanical equivalents, see *Tarrant v. Duluth Lumber Co.* (1887), 39 O. G. 1425; 30 Fed. Rep. 830.

The patentee cannot, however, invoke the doctrine of equivalents beyond the

scope of his invention, as indicated by the character of the idea which it embodies. This idea may either be that of an entirely new means accomplishing an entirely new result, or an entirely new means producing an old result, or the improvement of an existing means. In the former the scope of the invention is the widest possible; in the latter, the narrowest; and equivalents in one, therefore, necessarily embrace a far broader field than in the other, although the tests by which equivalence is determined always remain the same. This difference is clearly stated in *Curtis v. Platt* (1863), cited in a note to *Adie v. Clark* (1870), L. R. 3 Ch. 134, where Woods, V. C., says: (136) "Where the thing is wholly novel and one which has never been achieved before, the machine itself which is invented necessarily contains a great amount of novelty in all its parts, and one looks very narrowly and very jealously upon any other machines for effecting the same object, to see whether or not they are merely colorable contrivances for evading that which has been before done. When the object itself is one which is not new, but the means only are new, one is not inclined to say that a person who invents a particular means of doing something that has been known to all the world long before has a right to extend very largely the interpretation of those means which he has adopted for carrying it into effect. Because otherwise that would be to say that the whole world is to be precluded from achieving some desirable and well-known object which everybody has had in view for years. In such a case it may be said that the means taken are simply mechanical equivalents for the means previously adopted for arriving at the same object. One looks more jealously

of his own. By his inventive act he has discovered and declared the usefulness, in his invention, of all industrial appliances which had been recognized before the granting of his patent as endowed with qualities enabling them to serve for the expression of some part of his idea; and the appropriation to him of the use of all, in this particular association, is justified by the same principles that warrant the protection of his exclusive rights in that idea.

§ 258. **Doctrine of Equivalents Applicable to all Inventions.**

The doctrine of equivalents applies alike to all classes of inventions, and to all inventions of whatever class. Equivalents in an art or process are such acts as, in accordance with preceding rules, are interchangeable with those which the inventor has himself employed. In a machine or manufacture, any known agency which can be substituted for one or more of the integral parts of which the instrument consists, without affecting the idea of means, is a mechanical equivalent.¹ In compositions of matter, substances which at the granting of the patent were known as capable of serving the same purpose in the composition as the ingredients actually employed become thereby their chemical equivalents. In a design, the use of other lines or images, impressing the eye in the same manner as the old when grouped with other elements in the design, and known as able to produce the same effect, are mere equivalents. And in improvements, any substitution of an act or substance which

at the claims of inventors seeking to limit the rights of the public at large for effecting that which has been commonly known to all the world long ago. Of course no patent can be taken out for effecting this as a new object, but only for effecting it by a new means."

See also *Singer v. Walmsley* (1860), 1 Fisher, 558.

§ 258. ¹ That a mechanical equivalent is any mechanical appliance which will produce the same effect in the invention, and was so well known at the

date of the patent that it would naturally have been applied to the same purpose by a person skilled in the art, without the exercise of his own inventive powers, see *Wilt v. Grier* (1881), 19 O. G. 427; 5 Fed. Rep. 450; *Smith v. Marshall* (1876), 10 O. G. 375; 2 Bann. & A. 371; *Burden v. Corning* (1864), 2 Fisher, 477; *Johnson v. Root* (1858), 1 Fisher, 351; *Blanchard's Gun Stock Turning Factory v. Warner* (1848), 1 Blatch. 258.

would be an equivalent if the improvement were an independent art or instrument will occupy toward it the same relation.²

SECTION IV.

OF THE NOVELTY OF INVENTIONS: IDENTITY: DIVERSITIES OF USE: THE DOCTRINE OF DOUBLE USE.

§ 259. Diversity of Use sometimes a Diversity of Substance, sometimes of Form.

The diversities heretofore discussed have arisen out of real or apparent variations in the art or instrument itself. There is, however, a diversity occasioned by the use of the invention under different circumstances, or in reference to different objects, which presents difficulties of a similar character and of equal moment.¹ To almost every operative

² That the doctrine of equivalents applies to improvements as well as to original inventions, see *Forbes v. Barstow Stove Co.* (1864), 2 Clifford, 379; *McCormick v. Talcott* (1857), 20 How. 402.

That the field of equivalents in an improvement is necessarily very narrow, and that any change introducing a different development of the original idea of means is not a mere substitution of equivalents, is self-evident. In the attempt to formulate this proposition it has sometimes been stated that the rule governing equivalents in improvements is different from the general rule. The true doctrine is nevertheless apparent even in these statements, as in the following example.

In *Morley Sewing Mach. Co. v. Lancaster* (1885), 23 Fed. Rep. 344, Colt, J.: (345) "When an invention is simply an improvement on a known machine by a mere change of form or combination of parts, the inventor is only entitled to the specific form of device which he produces, and he cannot

invoke the doctrine of equivalents to suppress other improvements which are not colorable invasions of his own. But where an inventor precedes all the rest, and his machine performs a function never performed by any earlier machine, the court will treat as infringers all who accomplish the same result by substantially the same, or substantially equivalent, means. In the one class of inventions slight differences may avoid infringement. In the other class there must be substantial difference to escape such a charge." Yet here the court apparently uses the word "equivalent" in its technical sense in reference to improvements, and in its general sense in reference to machines.

§ 259. ¹ The subject of "Double Use" may be considered from several points of view, most, if not all, of which may be reduced to two: viz. (1) The rights of the inventor of the invention used; and, subject to these, (2) The rights of the alleged inventor of the use. As to the first, it is an undisputed proposition that the discovery of new

means uses are possible which depart from the inventor's method of employing it in such essential particulars that

uses for a patented invention cannot under any circumstances confer upon their discoverer a right to use the invention without the consent of the patentee. This is the meaning of the *dicta* and decisions of the judges that "all uses of an invention belong to the inventor;" that "the inventor is entitled to all the benefits derivable from his invention, whether known or unknown to him," etc. Thus a machine devised for one purpose remains the same machine, no matter for what purpose it may be employed; and whoever uses it uses the invention of the creator of the machine, and if he does this without his consent is guilty of an infringement of his patent. The cases to this point are very numerous.

Thus see *Byerly v. Cleveland Linseed Oil Works* (1887), 81 Fed. Rep. 73; *Union Stone Co. v. Allen* (1882), 15 Phila. 508; 14 Fed. Rep. 853; *California Artificial Stone Paving Co. v. Perine* (1881), 20 O. G. 813; 7 Sawyer, 190; 8 Fed. Rep. 821; *Stow v. Chicago* (1881), 104 U. S. 547; 21 O. G. 790; *Eagleton Mfg. Co. v. West, Bradley & Cary Mfg. Co.* (1880), 17 O. G. 1504; 18 Blatch. 218; 2 Fed. Rep. 774; *Tinker v. Mower & Reaper Mfg. Co.* (1880), 1 Fed. Rep. 138; 5 Bann. & A. 92; *Woodbury Patent Planing Mach. Co. v. Keith* (1879), 4 Bann. & A. 100; *Stow v. Chicago* (1877), 8 Bissell, 47; 3 Bann. & A. 83; *Putnam v. Yerrington* (1876), 2 Bann. & A. 237; 9 O. G. 689; *Roberts v. Ryer* (1875), 91 U. S. 150; 10 O. G. 204; *Wells v. Jacques* (1874), 5 O. G. 364; 1 Bann. & A. 60; *Ingels v. Mast* (1873), 6 Fisher, 415; *McComb v. Brodie* (1872), 2 O. G. 117; 1 Woods, 153; 5 Fisher, 384; *Woodman v. Stimpson* (1866), 3 Fisher, 98.

And that this is true though the possibility of such uses were unknown to the inventor, see *Woodbury Patent Planing Mach. Co. v. Keith* (1879),

4 Bann. & A. 100; *Roberts v. Ryer* (1875), 91 U. S. 150; 10 O. G. 204; *Welling v. Rubber Coated Harness Trimming Co.* (1875), 7 O. G. 606; 1 Bann. & A. 282; *McComb v. Brodie* (1872), 1 Woods, 153; 5 Fisher, 384; 2 O. G. 117.

Conceding, then, that no discovery of a new use for an invention can confer the right to use it without the consent of its inventor, what are the rights, if any, of the discoverer of the use? Has he an exclusive right to the use which he has discovered, and can he protect it by a patent, or have others the same right to enjoy it as himself? This question is determined by the nature of the use as compared with other uses to which the invention was applied or was known to be applicable at the date of his discovery of the use. If the alleged new use so nearly resembles these that it might have been suggested by them to persons skilled in the art, the new use is regarded as resulting from an exercise of the imitative not the creative faculties, and hence is not an invention in which the discoverer can have an exclusive right. If, on the other hand, the new use is so unlike in its essential character to the preceding ones that it required an exercise of inventive skill to produce it, then the use is a new invention and is patentable. The courts and text-writers have expressed this distinction by the terms "analogous use" and "non-analogous use." An analogous use is one suggested by former uses; a non-analogous use is one not so suggested but originating in an inventive act. The former is the true double use, and of course is not an invention. The latter is not double use, but a new means, employing it is true a former means, but embodying new ideas and accomplishing either new results or old

they could only have originated in an inventive act distinct from and posterior to his, and thus, as uses, constitute sep-

results in an essentially different manner. Whether or not the use is analogous—that is, whether an inventive act was necessary to produce it—is to be ascertained in the same manner as in other cases of invention, as described in Sec. III. of Ch. I.

The authorities upon the points involved in this view of the subject are as follows:—

That an analogous use is one suggested by former uses:—

In *Penn v. Bibby* (1866), L. R. 2 Ch. Ap. 127, Chelmsford, L. C.: (136) “In every case of this description one main consideration seems to be whether the new application lies so much out of the track of the former use as not naturally to suggest itself to a person turning his mind to the subject, but to require some application of thought and study.”

In *Harrison v. Railway Co.* (1860), 6 Jur. N. s. 993, Cockburn, C. J.: (995) “Conceding that the authorities establish that a person cannot use the same mechanical contrivance for the same purpose, and that that principle is extended to the application of the same mechanical contrivance to purposes so nearly cognate and similar as that the application in the one case naturally leads to its application when required in some other, yet, if there be that which substantially is a distinct purpose, although it may have the appearance at first sight of being in some degree connected, the question must be one of the degree of affinity or similarity which exists between the two given purposes, and by that the question whether the invention is sufficiently meritorious to be deserving of a patent must be determined.”

See also *Vinton v. Hamilton* (1882), 104 U. S. 485; 21 O. G. 557; *Horton v. Mabon* (1862), 12 C. B. N. s. 437.

That a non-analogous use, or one requiring inventive skill, is not double use but a new invention, see the following:—

In *Orandal v. Watters* (1881), 20 Blatch. 97, Blatchford, J.: (102) “Almost all inventions at this day that become the subjects of patents are the embodiment and adaptation of mechanical appliances that are old. In that consists the invention. When the thing appears it is new and useful. No one saw it before, no one produced it before, it supplies a need, it is at once adopted, all in the trade desire to make and use it, yet it is said to have been perfectly obvious and not to have been patentable. Where an article exists in a given form and applied to a given use, and is taken in substantially the same form and applied to an analogous use, so as to make a case of merely double use, there is no invention. But it is very rarely that a thing of that kind secures a patent.” 21 O. G. 945 (946); 9 Fed. Rep. 659 (669).

In *Ex parte Arkell* (1879), 15 Blatch. 437, Shipman, J.: (439) “The application of an old contrivance to a new purpose is not patentable when the old and new purposes, and the objects to which the contrivance is applied, are merely analogous. If the use of an old contrivance produces a new effect, the new manufacture or process may be patentable, because the new use is not analogous to the former one; but if the new use is simply upon a new occasion, not producing a new effect, the use is analogous to what had been done before. . . . (440) If the effect of the old contrivance when applied to the new object is simply a better and therefore more useful accomplishment of the old effect, in an analogous object, by the use of precisely the same means,

arate inventions. And there are other uses, even more widely different from his in their appearance, which nevertheless

the application of the new use is not patentable." 4 Bann. & A. 80 (82).

See also *Strauss v. King* (1880), 2 Fed. Rep. 236; 18 Blatch. 88; 17 O. G. 1450; 5 Bann. & A. 338; *Wisner v. Grant* (1880), 5 Bann. & A. 215; 17 O. G. 447; 7 Fed. Rep. 485; *Megraw v. Carroll* (1880), 5 Bann. & A. 324; *Gottfried v. Philip Best Brewing Co.* (1879), 5 Bann. & A. 4; 17 O. G. 675; *Union Paper Collar Co. v. White* (1875), 2 Bann. & A. 60; 7 O. G. 698, 877; 11 Phila. 479; *Fuller v. Yentzer* (1874), 1 Bann. & A. 520; 6 Bissell, 208; *Minter v. Wells* (1884), 1 Web. 134; 2 Abb. P. C. 47.

That an analogous or cognate use of an invention is mere double use is affirmed in the following cases:—

In *Pennsylvania R. R. Co. v. Locomotive Truck Co.* (1884), 110 U. S. 490, Gray, J. : (494) "It is settled by many decisions of this court, which it is unnecessary to quote from or refer to in detail, that the application of an old process or machine to a similar or analogous subject, with no change in the manner of application and no result substantially distinct in its nature, will not sustain a patent, even if the new form of result has not before been contemplated." 27 O. G. 207 (208).

See also *Celluloid Mfg. Co. v. Noyes* (1885), 25 Fed. Rep. 319; *Royer v. Chicago Mfg. Co.* (1884), 20 Fed. Rep. 853; *Collins Co. v. Coes* (1884), 28 O. G. 1010; 21 Fed. Rep. 38; *Spill v. Celluloid Mfg. Co.* (1884), 21 Fed. Rep. 631; 22 Blatch. 441; *Howe Mach. Co. v. National Needle Co.* (1884), 21 Fed. Rep. 630; *American Iron Co. v. Anglo-American Roofing Co.* (1883), 21 Blatch. 324; 24 O. G. 1274; 16 Fed. Rep. 915; *Slawson v. Grand St., Prospect Park, & Flatbush R. R. Co.* (1883), 107 U. S. 649; 24 O. G. 99;

Pahnenbing v. Buchholz (1882), 23 O. G. 622; 13 Fed. Rep. 672; *Gottfried v. Crescent Brewing Co.* (1882), 22 O. G. 497; 9 Fed. Rep. 762; *Vinton v. Hamilton* (1881), 104 U. S. 485; 21 O. G. 557; *Crandal v. Watters* (1881), 20 Blatch. 97; 21 O. G. 945; 9 Fed. Rep. 659; *Western Electric Mfg. Co. v. Ansonia Brass & Copper Co.* (1881), 20 Blatch. 170; 9 Fed. Rep. 706; *Judd v. Babcock* (1881), 8 Fed. Rep. 605; 23 O. G. 92; *Rowell v. Lindsay* (1881), 6 Fed. Rep. 290; 10 Bissell, 217; 19 O. G. 1565; *Knox v. Quicksilver Mining Co.* (1880), 4 Fed. Rep. 809; *Adams v. Loft* (1879), 4 Bann. & A. 495; *Couse v. Johnson* (1879), 4 Bann. & A. 501; 16 O. G. 719; *Jordan v. Moore* (1866), L. R. 1 C. P. 624; *Brooks v. Aston* (1859), 5 Jur. N. S. 1025; *Patent Bottle Envelope Co. v. Seymer* (1858), 5 C. B. N. S. 164; *North v. Williams* (1870), 17 Grant Ch. (Can.), 179; *Abell v. McPherson* (1870), 17 Grant Ch. (Can.), 23; *Waterous v. Bishop* (1869), 20 C. P. (Can.) 29.

For particular applications of these doctrines to specific inventions, see also the following:—

I. The Use a New Invention:—

That where inventive skill is exercised the use is not double use, see *Penn. Salt Mfg. Co. v. Thomas* (1871), 5 Phila. 144; 5 Fisher, 148.

That a new use not analogous to the old is a new invention, see *Union Paper Collar Co. v. White* (1875), 11 Phila. 479; 7 O. G. 698, 877; 2 Bann. & A. 60.

That to put an old process or device into use in such a manner as to accomplish a result which could not have been accomplished by using the same process or device in any manner heretofore known is not double use but invention, see *Campbell v. Mayor of New York* (1881), 20 O. G. 1817; 20 Blatch.

are, in their essence, merely imitations of his own, and therefore are embraced in his invention. This latter class

67 ; 9 Fed. Rep. 500 ; *Colgate v. Western Union Telegraph Co.* (1878), 14 O. G. 943 ; 15 Blatch. 365 ; 4 Bann. & A. 36 ; *Roberts v. Dickey* (1871), 1 O. G. 4 ; 4 Fisher, 532 ; 4 Brews. 260.

That though new means is used in carrying out an old process its discoverer has no right to use the process if patented, see *Tilghman v. Mitchell* (1864), 2 Fisher, 518.

That the use of a device may be new though the device itself be old, and is then a new application of a known force, see *Dunbar v. Mardon* (1842), 13 N.H. 311.

That to use the same article in a different situation may be invention, see *Nickels v. Ross* (1849), 8 C. B. 679.

That the application of old devices with alterations and adaptations may be a new invention, see *Crandal v. Watters* (1881), 21 O. G. 945 ; 20 Blatch. 97 ; 9 Fed. Rep. 659.

That to use an old device as before used is double use, but to rearrange and connect it so as to adapt it for use as an element may be a new invention, see *Mundy v. Lidgerwood Mfg. Co.* (1884), 27 O. G. 718 ; 20 Fed. Rep. 114.

That the use of old materials with a new effect is a new invention, see *Geiger v. Cook* (1842), 3 Watts & Serg. 266.

II. The Use a Double Use :—

That the use for all purposes like the old to which the invention can be applied is mere double use, see *Blake v. San Francisco* (1885), 113 U. S. 679 ; 81 O. G. 380.

That the application of an old invention to an analogous use with no change in the mode of applying it and no new result, is double use, though the result be in a form never before contemplated, see *Miller v. Foree* (1885), 116 U. S. 22 ; 33 O. G. 1497 ; *Pennsylvania R. R. Co. v. Locomotive Engine Safety Truck Co.* (1884), 110 U. S. 490 ; 27 O. G. 207.

That where no new mode of adapting the old invention to the new use is employed, the use is double, see *Smith v. Elliott* (1872), 1 O. G. 381 ; 9 Blatch. 400 ; 5 Fisher, 315 ; *Merriam v. Drake* (1872), 9 Blatch. 336 ; 5 Fisher, 259.

That a use may be analogous though it improve the thing to which it is applied, or carry the use beyond any formerly known, see *Putnam v. Yerrington* (1876), 9 O. G. 689 ; 2 Bann. & A. 237 ; *Roberts v. Ryer* (1875), 91 U. S. 150 ; 10 O. G. 204 ; *Horton v. Mabon* (1862), 12 C. B. N. s. 437.

That to apply an old process to an old material to obtain an old result, is double use, see *Gardner v. Herz* (1882), 22 O. G. 683 ; 20 Blatch. 538 ; 12 Fed. Rep. 491.

That the use of an old process in the same way, or on the same subject, and with the same result, is double use, see *Western Electric Co. v. Ansonia Co.* (1885), 114 U. S. 447 ; 31 O. G. 1375.

That the new use of an old process is double use even if the new form of result was never before contemplated, see *Spill v. Celluloid Mfg. Co.* (1884), 22 Blatch. 441 ; 21 Fed. Rep. 631.

That to apply the same plan to the same purpose, though varying the details of the process, is mere double use, see *Sewall v. Jones* (1875), 91 U. S. 171 ; 9 O. G. 47.

That to use an old process or device, without material change in a way which, though not heretofore employed, is well known, is not a new invention, see *Couse v. Johnson* (1879), 16 O. G. 719 ; 4 Bann. & A. 501 ; *Dunbar v. Myers* (1876), 94 U. S. 187 ; 11 O. G. 35 ; *Brown v. Piper* (1875), 91 U. S. 37 ; 10 O. G. 417 ; *Roberts v. Ryer* (1875), 91 U. S. 150 ; 10 O. G. 204.

That to apply an old form of a

of uses long ago received the name of "Double Uses;" and the rules by which they are distinguished from the former are known as the "Doctrine of Double Use."

§ 260. Diversity of Use is not Diversity in the Invention Used.

In the opinions of the courts, as well as in the dissertations of text-writers, this doctrine is needlessly confused by the introduction of language applicable only to diversities in the art or instrument, whose use alone is properly the matter for consideration. All those decisions which declare, in any form of words, that double use does not consist in such employment of the invention as indicates a change in its idea of means are foreign to this subject.¹ A new effect, depend-

hand tool to a corresponding machine is double use, see *Busell Trimmer Co. v. Stevens* (1886), 28 Fed. Rep. 575; 37 O. G. 1249.

That to discover that a particular advantage may be obtained by using a known thing in a known way is not invention, but mere double use, see *Tetley v. Easton* (1857), 2 C. B. N. S. 706.

That a patent for the use of an article already known and used in the same manner, is void, see *Brown v. Texas Cactus Hedge Co.* (1885), 64 Tex. 396.

That the mere use of a known substance in a known form for any purpose is not invention, see *Tarr v. Webb* (1872), 2 O. G. 568; 10 Blatch. 96; 5 Fisher, 593.

That the application of an old material to an analogous use is not invention, see *Palmenbing v. Buchholz* (1882), 13 Fed. Rep. 672; 23 O. G. 632.

That the use of an old material in an old way to accomplish an old result, is double use, see *Celluloid Mfg. Co. v. Tower* (1885), 26 Fed. Rep. 451.

That the doctrine of double use applies to designs, see *Western Electric Mfg. Co. v. Odell* (1883), 18 Fed. Rep. 321; *Neidringhaus v. Com.* (1875), 2 MacArthur, 149; 8 O. G. 279.

From this sketch of the practical side of the subject it is apparent that the doctrine of double use is simple enough when its several propositions are logically arranged, and their distinctions apprehended. In the text I have endeavored to go deeper and present the ultimate reasons on which the doctrine is based, and from which all the tests in cases of novel application must be drawn. The practical view is, however, as might be expected, the one most fully occupying the attention of the courts, and hence most largely discussed in the decisions.

§ 260. ¹ As many of the difficulties which have surrounded the doctrine of double use and its application have arisen from the inconsiderate adoption, as rules of law, of the casual expressions of former judges, it may serve a useful purpose to examine some of the principal decisions in detail, in order to discriminate between the principles announced and the misleading *dicta* in which the errors have originated.

In *Bean v. Smallwood* (1843), 2 Story, 408, the claim of the patent was for the application to a chair of an apparatus which had long been in use in other articles for similar purposes. The facts make a clear case of double or an-

ent on substantial variation in the art or instrument itself, cannot result from any use of the original invention, whether

analogous use. Judge Story, in deciding the case, said: (411) "Now I take it to be clear that a machine or apparatus, or other mechanical contrivance, in order to give the party a claim to a patent therefor, must in itself be substantially new. If it is old and well known, and applied only to a new purpose, that does not make it patentable. A coffee-mill applied for the first time to grind oats or corn or mustard, would not give a title to a patent for the machine. A cotton-gin applied without alteration to clean hemp, would not give a title to a patent for the gin as new. A loom to weave cotton yarn would not, if unaltered, become a patentable machine as a new invention by first applying it to weave woollen yarn. A steam-engine if ordinarily applied to turn a grist-mill, would not entitle a party to a patent for it if it were first applied by him to turn the main wheel of a cotton factory. In short, the machine must be new, not merely the purpose to which it is applied. A purpose is not patentable, but the machinery only, if new, by which it is to be accomplished. In other words, the thing itself which is patented must be new, and not the mere application of it to a new purpose or object." 2 Robb, 133 (135).

This statement evidently embraces two propositions: (1) That the new use of an invention does not make the invention itself new; (2) That a new use is not of itself the subject-matter of a patent. The first proposition is undoubtedly correct. The latter is as evidently false unless qualified by the condition that the new use, as in the case at bar, is analogous to former uses. The last two sentences of the opinion, as quoted, are therefore wrong. A purpose in the sense of a use may be pat-

entable as a process; and the mere application of a thing to a new purpose or object, if the application involve inventive skill, does constitute a new invention.

In *Conover v. Roach* (1857), 4 Fisher, 12, the court had occasion to discuss this doctrine, and said *per* Hall, J.: (16) "In connection with this question of invention it is proper to state to you, that the mere application of an existing machine or organization to a new use is not the subject-matter of a patent. If a party finding a machine calculated and intended for the accomplishment of one purpose, discovers or conceives that it is able to accomplish another purpose, and that purpose can be accomplished by the organization which has before been produced, he can have no patent for the application of this old machine to a new use. In other words the invention patented, when a patent is taken out for a machine, is the machine itself—the mechanical means and devices by which certain results in the operation of the machine can be obtained; and when the inventor has obtained a patent for his invention he is entitled to the exclusive use of it, if that invention is a machine, for all the uses and purposes to which that machine, without the exercise of any inventive power, can be usefully applied. In other words, when he patents a machine he cannot patent either a purpose or an effect, but the mechanical means, devices, and organization which his machine embodies, and when these means, devices, and organization are patented, the patentee is entitled to the exclusive use of this mechanical organization, device, or means, for all the uses and purposes to which they can be applied, to every function, power, and capacity of his patented machine, with-

the use itself be new or old. It will assist us in our own investigation of this doctrine to remember: (1) That in all

out regard to the purposes to which he supposed originally it was most applicable, or to which he supposed it was solely applicable, if such were his original view."

In this passage the learned judge confuses the two opposite points of view from which, as we have seen in the note to § 259, the doctrine of double use may be regarded. So much as states that the inventor of a patented machine has the sole right to use it for any purpose is true. So much as states that the application of an old machine to a new use is not patentable is not true, unless qualified in the manner previously indicated. But in the second and third sentences he treats these two propositions as synonymous, as if the declaration that "the application of an old machine to a new use is not patentable," were equivalent to the declaration that "an inventor of a machine is entitled to all the uses which can be made of it," which is clearly wrong. In the latter part of the third sentence, however, there is a single clause which may have been intended to, and if understood in a proper sense, certainly does make the whole statement correct. He says "he is entitled to the exclusive use of it . . . for all the uses and purposes to which that machine, *without the exercise of any inventive power*, can be usefully applied." If by this he meant inventive power *exercised upon the machine*, changing its character as an operative means, the error before pointed out is still inherent in the statement. If he referred to inventive power *exercised in applying the existing machine to the new purpose*, the passage, though obscure for want of separation between its different ideas, is on the whole correct.

In *Bray v. Hartshorn* (1860), 1 Clif-

ford, 538, Clifford, J. : (540) "Invention or discovery is required as the proper foundation of a patent, and where both are wanting the applicant cannot legally secure the privilege. Consequently where the claim rests merely upon the application of an old machine to a new use or to a new purpose, or upon the application of an old process to a new result, the patent cannot be sustained, because the patentee under those circumstances has not invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter not known or used by others, for which alone a patent can be legally granted. Judge Story held, nearly twenty years ago, in *Bean v. Smallwood*, 2 Story, 408, that the application of an old machine to a new purpose was not patentable; and the same principle has since been adopted in the highest court in England, and by the Supreme Court of the United States. *Kay v. Marshall*, 8 Cl. & Finn. 245; *Phillips v. Page*, 24 How. 167. New contrivances, though applied to old objects, are patentable; but old contrivances, whether the objects to which they are applied are new or old are not patentable, because the mere application of the contrivance, without more, involves neither invention nor discovery, and when both those elements are wanting, no patent issued under existing laws can have any validity. Particular changes, however, may be made in the construction and operation of an old machine so as to adapt it to a new and valuable use not known before, and to which the old machine had not and could not be applied without those changes; and under these circumstances and conditions, if the machine as changed and modified produces a new

cases turning on diversity of use it is assumed that the identity of the invention used remains entirely undisturbed ;

and useful result, it may be patented and upheld under existing laws. *Losh v. Hague*, Web. Pat. Cas. 207; *Hindm. on Pat.* 95. Such change in an old machine may consist alone of a new and useful combination of the several parts of which it is composed, or it may consist of a material alteration or modification of one or more of the several devices which enter into its construction, or it may consist in adding new devices; and whether it be one or another of the suggested modifications, if the change of construction and operation actually adapt the machine to a new and valuable use, not known before, and to which the machine had not been applied, and without the change suggested was not in any degree fitted to be applied, and actually produces a new and useful result, then the case falls within the rule already laid down, and a patent may be granted for the same and be upheld."

Taken as it reads, this decision denies the patentability of new applications of existing inventions *in toto*. It places the denial on the ground that "the mere application of the contrivance, without more, involves neither invention or discovery," etc., and then declares that only by some change in the existing invention itself, producing a new result, can inventive skill be manifested and patentability attained. Here again the error is in the use of too general language, though the qualifying phrase "without more," hints at the possession by the learned judge of a perception of the true limits of his statement, had he seen fit to express them. But his assertion that "the application of an old machine to a new use or to a new purpose," or "the application of an old process to a new result," is not a "new and useful art," etc., is neither correct in principle

nor borne out by the cases cited. What the decision of Judge Story in *Bean v. Smallwood* really was, we have already seen, as well as that his *dictum* was too broad in itself, and went altogether beyond the requirements of his case. In *Kay v. Marshall* it was not held that an application of an old machine to a new purpose was not patentable, but that such an application did not change the essential character of the machine and render it patentable as a new machine; and in discussing this question it was distinctly stated that the new process growing out of the new use of the machine was patentable. (See note to § 266, *post.*) In *Losh v. Hague* (1837), 1 Web. 202; 2 Abb. P. C. 501, the English court fell into numerous errors of language, if not of doctrine, although in some respects its opinion, as a whole, was extraordinarily luminous and correct in view of the general confusion then existing in regard to this subject. (See note to § 271, *post.*) But the opinion, truly understood, does not sustain the position of Judge Clifford in denying the patentability of a new use, however it may support his affirmation that a change in the machine itself may render it a new invention. The state of learning and opinion in this country in reference to double use, at the date of this decision (1860), is rather remarkable, when in this English case (decided in 1838) Lord Abinger had clearly announced the true principle, "that you cannot have a patent for applying a well-known thing . . . to an operation which is exactly analogous to what was done before;" and Mr. Webster, in a note on page 229 of the volume referred to by the American judge, gives numerous instances in which a new, or non-analogous, use was regarded as patentable, and declares that "the novelty or invention will then

and (2) That the real question is, whether the changed employment of the unchanged invention involves an exercise of

consist in the simple use and application of that substance." See note to § 200, *post*. As examples of the more recent statements by our own courts the following are cited :—

In *Gottfried v. The Phillip Best Brewing Co.* (1879), 17 O. G. 675, Dyer, J. : (684) "It is an elementary principle that the mere application of an old thing to a new use is not patentable, or, as the court says in *Smith v. Nichols* (21 Wall. 119), 'A mere carrying forward or new or more extended application of the original thought ; a change only in form, proportions, or degree ; the substitution of equivalents doing substantially the same thing in the same way by substantially the same means, with better results, — is not such invention as will sustain a patent.' And again, in *Roberts v. Ryer* (1 Otto, 157) it is said : 'It is no new invention to use an old machine for a new purpose, and the inventor of the machine is entitled to the benefit of all the uses to which it can be put, no matter whether he had conceived the idea of the use or not.' It is not understood, however, that these principles are to be so applied as to deny patentability to improvements which disclose inventive skill and produce new and useful results. It is true, it may be said, that the several parts which make up complainant's mechanism are old ; but as is stated by the court in *Strong v. Noble* (3 Fish. 589), 'There is scarcely a patent granted that does not involve the application of an old thing to a new use, and that does not, in one sense, fail to involve anything more ; but the merit consists in being the first to make the application, and the first to show how it can be made, and the first to show that there is utility in making it.' . . . And again, with reference to the application of old means to a new use, as is stated in one case cited on the argument :

'Particular changes may be made in the construction and operation of an old machine, so as to adapt it to a new and valuable use not known before, and to which the old machine had not and could not be applied without those changes ; and under these circumstances and conditions, if the machine as changed and modified produces a new and useful result, it may be patentable and upheld under existing laws.'" 5 Bann. & A. 4 (33, 34).

Here the court seems inclined to modify the sweeping statements indulged in by its predecessors and to bring their general assertions within the proper limits by applying to all cases the infallible test of the presence or absence of inventive skill. Though the precision of the rule given by the English bench, and at this date (1879) adopted and fully explained by the leading American authority (*Curtis* §§ 55-66), is not observed, it is evident that the incorrectness of the older decisions was perceived and the true doctrine substantially defined.

In *Dunbar v. Albert Field Tack Co.* (1879), 4 Bann. & A. 518, Lowell, J. : (519) "If an old machine or process is put to a new use, invention is positively excluded, although the new use may apparently be very remote from the old, requiring experiment to ascertain its practicability ; and though the actual operation of the machine or process may not be exactly the same in the new as in the old application, provided no new means are, in fact, employed." 4 Fed. Rep. 543 (544).

This language is accurate only when understood as applying to the process or machine employed, and not to the art resulting from a new use of such process or machine. No use of the old invention, however remote, can change the character of the invention itself.

the creative powers, and introduces a new idea of means, not into the art or instrument itself, but into the manner of its use, and so makes the new mode of its employment a new and separate invention. The answer to this question must be sought by applying to the use of the invention the same principles in which we have already found a solution for so many interesting and important problems.

§ 261. *Distinction between an Invention and its Use.*

And in the first place it is necessary to clearly draw the line between an invention and its use. This is sometimes extremely difficult, even in mental contemplation, but becomes still more so when the art or instrument itself is submitted to immediate inspection. It is, however, the only method by which diversity of use, as distinguished from diversity of means, can be made the subject of investigation; and by descending into those fundamental truths which underlie the idea of means we shall probably be able to discover where the means ceases and the use begins. The

This is a proposition axiomatically correct. But that any use of it, apparently near or remote, which on account of the novelty of the force which it employs, or the object to which it is applied, involves the exercise of inventive skill in the discovery of the qualities of such force or object and the application thereto of the old invention, is a new and independent invention is a proposition equally established. Thus the same judge alludes to the true rule, though in somewhat doubtful phraseology, in *Moffitt v. Rogers* (1881), 8 Fed. Rep. 147, (148) "I am not aware that a patent has ever been sustained for a process or method which consisted of employing an old machine for the very purpose for which it was made. If any person discovers how to use an old machine to the best advantage, he is only a skilful workman not an inventor. . . . (149) I do not mean to say that a patent cannot possibly be supported for a process or method which consists only of applying an old machine to a new use. Many

of the ablest writers and jurists assert that such a claim is possible. I have never seen a case in which a patent of this sort has been sustained, and there are some in which it has been rejected. If one is ever supported, it will be when the new use is so remote from the old use that a court or jury can say that a new idea has been discovered."

The cases here discussed are not, by any means, all that are open to criticisms of the same general character. But they show the current of opinion and expression on this subject, and are sufficient to indicate the sources from which mistakes have originated, and to point out the dangers which are encountered in following too closely the language of judges, who viewing a doctrine from one side only make statements which are erroneous when considered from a different standpoint. They afford another illustration of the necessity of studying cases in the light of the law rather than the law in the light of the cases.

same research will demonstrate that this line is differently drawn in different inventions, enlarging or contracting the sphere of use, and correspondingly increasing or diminishing the scope of the invention.

§ 262. Essential Differences between a "Force Applied," a "Mode of Application," and a "Specific Treatment of a Specific Object."

Every idea of means embraces three subordinate factors, — the force, the object, and the mode of application. The inventive act which results in the conception of that idea consists either in the discovery of a force and its adaptation to an existing object through an existing mode of application, or in the discovery of a mode of application and its adaptation to an existing force and object, or in the discovery of an object and its adaptation to an existing force and mode of application, or in two or more of these discoveries and adaptations.¹ Inventions, when regarded from this point of view, are of three classes: (1) Where the force is new, the object and the mode of application being new or old; (2) Where the mode of application is new, the force and object being new or old; (3) Where the object is new, the force and mode

§ 262. ¹ It will be observed that in each of these three groups of inventions one factor, to wit, the mode of application, is always present. It may embrace the entire concrete invention, as in the second class; or may be joined with a specific force, as in the first; or with a specific force and object, as in the third. This factor is the most tangible and apparent to the sense of any contained in the invention. In a process it is expressed by the act or instrument through which the force is applied. In many machines and manufactures it is alone represented in the substantive invention itself. In compositions of matter it resides in the physical compound in which the chemical or mechanical forces inhere. This element is thus a constant quantity, incapable of material variation without destroying the essence of the invention. Other forces may be applied through it to other objects without changing its character as a mode of application, and hence, in inventions of the second class, without disturbing the identity of the invention. But in itself the mode of application can never be subjected to essential alteration without a departure from the original idea of means and the introduction of new elements requiring a new exercise of the inventive powers. In determining whether any given diversity is a diversity of invention or a diversity of use, this element is the first, therefore, to be examined, and often settles the whole question without further inquiry.

For a discussion of the matters stated in this paragraph, see also §§ 91–108, *ante*.

of application being new or old. In the first class the aim of the inventor is to utilize his new force; and when he has found for it a mode of application, his invention is complete without reference to the object upon which it acts. In the second class it is his purpose to discover and adapt a mode of application or an intermediate agency by which forces may be united to their objects; and when he has brought his mode of application into practice in connection with one force and object, his invention is complete as to all other forces and their objects. In the third class the sole endeavor of the inventor is to render useful to himself and to the public some object of whose properties he is the first discoverer, by so directing force upon it as to develop or employ its newly recognized susceptibilities; and his invention is complete when he has subjected this object to the action of some specific force in such a manner as to render its new properties available. The first invention is a force applied; the second is a mode of application; the third is the subjection of a specific object to a specific application of specific forces, producing in the object a certain specific result.

§ 263. Dividing Line between Invention and Use Different in Each of these Three Groups of Inventions.

In each of these three classes the character of the use is indicated by the scope of the invention. As in the first class the invention is a force applied, so the direction of that force to any object upon which it can act through this mode of application is the use of the invention. Thus, for example, in a chemical composition, in which a specific force inheres and through which it acts, the use consists in bringing any substance upon which the composition can exert its force within its sphere of operation. Or in a process, where certain forces are applied through certain acts or instruments, the invention passes from inaction into use when any object upon which it can operate is submitted to its influence. In the second class, as the invention is a mode of application, its use consists in bringing any force into connection with any object through its means. Thus in some machines and manufactures the invention is the same by whatever force it is im-

pelled and on whatever object it may act; and hence its union with any force or any object belongs to the domain of use, and not of invention. In the third class, as the invention consists in the subjection of a specific object to the influence of a specific force acting through a specific mode of application, there is no use which can be severed, even in thought, from the invention. Thus in those processes where the entire art consists in treating some particular material in some special method, the inherent qualities of the object, as well as the specific force and the specific mode of application, are essential to the existence of the idea of means, and the invention cannot be conceived of otherwise than as effecting its specified result. In each of these three classes the scope of use is, therefore, widely different. Inventions of the third class are incapable of any use except the one to which they were originally applied by their inventor, unless employed as elements in a new combination. Those of the second are available for as many different uses as there are forces which can operate through them, or objects upon which the operation of such forces can be directed. While an invention of the first class occupies an intermediate position, and may be used in as many different methods as there are objects upon which its inherent force can, through its peculiar mode of application, be determined.

§ 264. Four Diversities of Use Possible: Use with Different Force; Use with Different Object; Use in a Different Combination; Use out of Combination.

With these distinctions between inventions and their uses clearly understood it becomes far less difficult to separate the uses which involve inventive skill from those which are mere imitations or double uses. In each of the three groups of inventions the mode of application is an essential factor, and hence no substitution of one mode of application for another can ever be a mere diversity of use, but must destroy the identity of the invention. The only possible diversities of use are, therefore, these: (1) Use with a different force; (2) Use with a different object; (3) Use in a different combination; (4) Use out of combination. Each of these four

diversities of use is related to the three groups of inventions in a different manner.

§ 265. Use with New Force can be Diversity of Use only in Reference to a "Mode of Application:" When Double Use.

It is apparent that in no invention either of the first class or the third can the first diversity be a diversity of use alone. In such inventions the specific force employed by the inventor is of the essence of the invention, and any variation of that force destroys the identity of the invention, and substitutes for it a different means.¹ Inventions of the second class are, however, capable of this diversity of use. Being mere modes of application, any force which can be directed through them may be substituted for the one employed by the inventor, thereby introducing an apparently new use of the invention without affecting its essential character. Whether or not the use is really new depends upon the nature of the substituted force, and its relation in the arts to that whose place it fills. If its capability of application through this intermediate agency were first discovered and employed by him who makes the substitution, the use is new; for the union of the old mode of application with this new force involves an exercise of creative skill, expresses a new idea of means in which the mode of application, still unchanged, becomes an element, and constitutes, therefore, a new invention belonging to the first class, or a force applied. But if the force

§ 265. ¹ In *Foote v. Silsby* (1851), 2 *Blatch.* 260, *Nelson, J.* : (264) "Where a party has discovered a new application of some property in nature never before known or in use, by which he has produced a new and useful result, the discovery is the subject of a patent, independently of any peculiar or new arrangement of machinery for the purpose of applying the new property in nature, and hence the inventor has a right to use any means, old or new, in the application of the new property to produce the new and

useful result to the exclusion of all other means."

In *Househill Co. v. Neilson* (1843), 1 *Web.* 673, *Hope, J.* : (690) "Even if the principle had been a known principle, still if it is for the first time applied by mechanical contrivance and apparatus to certain processes, in which it had not been previously used as an agent, the patent would be good."

See also *Jenkins v. Walker* (1872), 1 *O. G.* 359; *Holmes*, 120; 5 *Fisher*, 347; *Poillon v. Schmidt* (1869), 6 *Blatch.* 299; 3 *Fisher*, 476; 37 *How. Pr.* 77.

were known in the arts before the substitution, as capable of union with its objects through this mode of application, the force is not new; the use of the invention for directing it demands no other than constructive skill, is a mere imitation of its use by the inventor, and falls within the definition of a double use.

§ 266. Use with New Object can be Diversity of Use only in Reference to a "Force Applied" and a "Mode of Application:" When Double Use.

The second diversity of use is impossible in all inventions of the third class. In these inventions the object is an essential part of the idea of means, and the substitution for it of a different object is a substantial change in the invention. If the inventor has employed a single object in the original invention, all other objects which are known in the arts as susceptible in the same manner to this specific application of this specific force are identical with the original object; and their employment, therefore, does not vary either use or means. If a new object is discovered, or some new qualities in an existing object which render it susceptible to the same application, the union of this force and mode of application with this new object is a new inventive act, and produces, not a change of use, but a new and independent means. But in the first and second classes this diversity of use often appears.¹ One object may be substituted for another with-

§ 266. ¹ That a new use constituting a new invention may consist in the novelty of the object upon which, in the new use, the old invention is employed, is clearly recognized in *Harwood v. Railway Co.* (1865), 11 H. L. 654. The patent was for the use of "fishes and fishjoints" for connecting the rails of railways. The fishes themselves were old. It was conceded that they had been used for various purposes before; but that their use for this purpose originated with the patentee. The case was tried in the Queen's Bench, then in the Court of Exchequer Chamber, and finally in the House of Lords.

The patent was held invalid on the ground of double use. All the judges concur in the statement of the doctrine of double use as follows, — in the words of Blackburn, J. : (667) "A mere application of an old contrivance in the old way to an analogous subject without any novelty or invention in the mode of applying such old contrivance to the new purpose, is not a valid subject-matter of a patent." See opinions of Channel, J. (673), of Westbury, L. C. (682), of Lord Cranworth (684), and of Lord Wensleydale (686). Double use thus exists wherever the invention used is old, the mode of use is old, and the ob-

out affecting the idea of means embodied in the old invention, though creating an apparent variation in its use; a

ject upon which it is used is old, -- that is, known as susceptible to such use from its analogy to other objects on which the same invention has been already used in the same manner. *Per contra*, a new use exists when a known invention is applied in a known manner to an object not heretofore known to be susceptible to such application from its analogy to other objects, but whose susceptibility has been discovered by the inventor of the use.

One of the most instructive cases on this subject is the "Spent-Madder Case," so called, or *Steiner v. Heald* (1851), 6 Exch. 607. In this case the invention used was old, and the only novelty possible was in the object to which the invention was applied. In reference to the patentability of such an application, Patterson, J., says: (620) "Here is no new contrivance, for the process used under the plaintiff's patent with 'spent madder' is the same as that previously used with 'fresh madder;' neither is the product new, for the garancine produced from the one and the other appears to have precisely the same qualities. If, therefore, the patent be good, it must be on account of the old contrivance being applied to a new object, under such circumstances as to support the patent. Now 'spent madder' might be a very different thing from 'fresh madder' in its properties, chemical or otherwise. Or it might be, in effect, the same thing as 'fresh madder' in its properties, chemical and otherwise, with the difference only that part of its coloring-matter had been already extracted. Again, the properties, chemical and otherwise, of both might or might not have been known to chemists and other scientific persons, so that they could tell whether 'fresh madder' and 'spent madder' were dif-

ferent things, or substantially the same thing. These points appear to us to be questions of fact, and materially to affect the validity or invalidity of the patent."

In the argument of this case, Watson, with whom was Webster, to an objection by Maule, J., that this was nothing but a double use of an old process, replied: "Where the process is old, but the combination of the materials upon which the process is brought to bear is new, the patent is sustainable. Here the plaintiff has introduced a new element;" and instanced *Crane v. Price* (1 Web. 377); *Cornish v. Keene* (1 Web. 501); and *Hill v. Thompson* (1 Web. 232).

In another case -- *Muntz v. Foster* (1844), 2 Web. 96 -- the inventor had discovered that plates composed of an alloy of zinc and copper in certain proportions, if applied to the sheathing of vessels, answered an important purpose, since the oxidation which then took place upon the surface of the plates kept the bottom of the vessel free from impurities. The plates themselves were old, but the application to vessels was new. It was held that the application to this new object was a new use of the plates, developing new utility therein and constituting a new invention. Thus Tindal J.: (103) "I look upon it that there is as much merit in discovering the hidden and concealed virtue of a compound alloy of metal, as there would be in discovering an unknown quality which a natural earth or stone possessed. We know by the cases that have been determined that where such unknown qualities have, from the result of experiments, been applied to useful purposes of life, that such application has been considered as the ground and a proper ground of a patent; and there-

variation which is merely double use when the substituted object was known in the arts as capable of subjection to

fore, when . . . they seek to show this is not so because these metal plates have been invented before, — that is, persons have used them before, — in my judgment it will not go far enough, unless they can show there has been some application of them before to this very useful purpose." Was not this invention really the discovery of a new *force*, and thus a "force applied" through an old mode of application?

The case of *Kay v. Marshall* (1835), 2 Web. 36, has sometimes been regarded as having a reference to the doctrine of double use, and as confirming the position that the application of an old contrivance to a new object is not patentable. Kay had discovered a process by which flax could be treated in a manner hitherto unknown, with results vastly beneficial to the trade. His process consisted in macerating the flax and spinning it at a reach of two and a half inches. Maceration, as a process, was old. Spinning was old also. The machine employed by him was well known, was capable of adjustment at different reaches, and had been used to spin at various distances. But Kay was the first to discover that flax possessed such peculiar properties that if macerated and spun at this exact distance certain effects could be produced. Thus his real invention was the application of a known force, through a known mode, to a new object, — that is, to an object in which new susceptibilities had been discovered. This was a true process, and was patentable as such. But in his patent Kay declared the nature of his invention (34) "to consist in new machinery for macerating flax and other similar fibrous substances previous to drawing and spinning it, which process I call preparing it; and also in improved machinery for spinning the

same after having been so prepared." In claiming his invention he covered only the macerating-vessels, a trough for holding the rovings, and the adjustment of the spinning machine at a certain reach. The specification was evidently drawn under the impression that the patent must be for some vendible substance, to wit, for the machinery employed in the process or for the product resulting from the process (neither of which was the true invention here), and the draughtsman chose the former. The court properly decided that no new invention was claimed and protected by the patent, since the new use of old machinery does not constitute a new machine. In the trial at law, Parke, B., perceived the real nature of the invention, and held that the discovery of these properties of flax and the application of the machinery to flax for the purpose of rendering its properties available was new and patentable, reserving the validity of the patent for the consideration of the court above. The judgment there was adverse to the patent, on the ground before mentioned. Finally, in the House of Lords, the same view of the patent was taken, and its validity denied for the reason that the invention was not an improved machine.

In a note to this case, on p. 84, Mr. Webster says that the judgment of the court is an authority to show that "the spinning of macerated flax by known machinery would have been the subject-matter of valid letters-patent, if the title and specification had been properly adapted thereto;" and that "the flax so spun would be a new manufacture both in respect of the method and result; spun flax had not been obtained in that manner, even if spun flax of similar properties and quality had been

the operation of the means, but which becomes a new use and a substantive invention if the object, or its capability

obtained before." Then he proceeds: "The invention in such cases is the special manufacture, by means of the use of the particular machine or substance, and is clearly distinguishable from cases which are not any manner of manufacture, as the new use of a medicine to cure diseases for which it had not been previously adopted, or the use of a paint to a new cement, or the use of a broom to sweep a new description of carpet or tapestry, or the use of a spoon to eat a particular description of food; applications or uses of the latter class have never been supposed to constitute any manner of manufacture, whereas applications and uses of the former class are the essence of the greatest improvements in the manufactures of the country."

To avoid the danger of being misled by these illustrations, not entirely apt to the subject illustrated, it must be remembered that Mr. Webster, as well as the judge from whom he borrows them, assumes that the above uses were strictly analogous. Suppose a method of curing diseases and alleviating pain were patentable (see *per contra* *Morton v. N. Y. Eye Infirmary*, 5 Blatch. 116; 2 Fisher, 320), can it be doubted that one who discovered that consumption might be cured by existing remedies could patent the use of these remedies for that purpose, although the remedies were already covered by a patent? Such a use of the remedies is not a double or analogous use, — its non-patentability rests on entirely different grounds. So with the discoverer that a species of carpet or tapestry hitherto believed to be unsweepable could be swept with a broom if used in a specific, though not necessarily a new, manner; or one who has contrived or adapted a method of eating with a spoon certain articles of

food previously unknown as possessing that susceptibility (if such an invention is supposable); is there not in each case an exercise of the inventive faculties, perceiving new attributes in the object, and rendering them available by adapting to them some existing force and mode of application; and wherever the law undertakes to protect such classes of inventions are they not truly patentable? The logical position would be to deny their patentability on the ground that the statute did not include inventions of this nature, not on the ground that they were double uses, and therefore not the products of inventive skill.

Instances in which the application of an old contrivance to a new object was recognized by the courts as a substantive invention were quite numerous in the earlier history of the Patent Law. Mr. Webster, in a note to Hill's Patent, (1 Web. 229), thus refers to several: "They would appear to be more appropriately described as the use and application of a known substance for a specific purpose; which general description is in practice limited and defined by the condition of novelty which is essential to and implied in the term 'invention.' The substance itself may be old and well known; the manner in which it is used and applied also old and well known; the specific result or purpose old and well-known; the novelty or invention will then consist in the simple use and application of that substance. Of this class are Dudley's, for the use of pit or sea coal instead of charcoal in the manufacture of iron; Mansell's, for the use of coal instead of wood in the manufacture of glass; Hall's, for the use of gas in singeing lace; Derosne's, for the use of charcoal in filtering sugar; Crane's, for the use of anthracite in the

of use, is first discovered by the alleged inventor of the use.

manufacture of iron, . . . instead of other coal or coke; . . . Hartley's, for the use of iron plates to prevent fire; Forsyth's, for the application of detonating powder in the discharge of fire-arms; Neilson's, for the hot blast; . . . Buck's, for melting down iron and other metals with stone coal and other coals, without charking, etc." As to most of these inventions Mr. Webster concedes patentability on the ground of the novelty and utility of the vendible substance in which they result, but admits that as to some, for instance to Hartley's, Forsyth's, and Neilson's, this test will not apply. He also adopts concerning them the description given by Lord Eldon in *Hill v. Thompson* (1 Web. 229), and affirmed by Tindal, C. J., in *Crane v. Price* (1 Web. 393), which classes them among combinations of materials. But is it not evident that all these new inventions were true arts or processes; that the inventive act consisted in applying an existing human contrivance to an object whose susceptibilities to the action of this old contrivance had just been discovered; that the old contrivance was a force applied, now united with an object hitherto unknown as capable of being subjected to its operation; and that the new invention was an art consisting of the application of a known force through a known mode of application to a new object? Thus in Dudley's patent, the old contrivance was the process of smelting iron in a blast furnace; the object in which new susceptibilities had been perceived was pit or sea coal; the utility was in the saving of the wood formerly consumed in making charcoal for the same purpose. In Mansell's, the old contrivance was the process of making glass; the new discovery was that pit or sea coal had the same quali-

ties as wood in reference to this particular manufacture; and the utility, here as in Dudley's patent, was the saving of the wood. Not to multiply words, was not the new object in Hall's patent the lace, now for the first time found capable of treatment by the Argand gas flame; in Crane's, the anthracite whose susceptibility to the action of the hot blast he had discovered; in Neilson's, the contents of the smelting-furnace, by him found to be subject to the action of the long-known heated air? Numerous other examples, in addition to those given by Mr. Webster, might be cited in which, in spite of the loose language and false theories of the courts, the character of the invention, and the true ground of its patentable merit become apparent the moment it is placed before the eye as the discovery of new susceptibilities in the object, made available by directing upon them known forces through well-known modes of application, which, though a use of the old contrivance in the same manner as of old, is not a double or analogous use, because requiring an inventive act for its production.

The following are selected from among the numerous cases confirming and illustrating the proposition that the discovery of new objects or new susceptibilities in old objects, and subjecting them to the action of old inventions is not double use:

In *Union Paper Collar Co. v. White* (1875), 11 Phi. 479, McKennan, J.: (479) "It is true that paper and muslin or linen cloth were before united, and used as a fabric for maps, etc.; but this was not analogous to the use to which Hunt adapted them, nor was it in any wise suggestive of his invention. He was the first to discover the adaptability of this material to a use not cognate to

§ 267. Use in Combination a True Diversity of Use: never Double Use.

The third diversity of use arises where the entire invention is employed as a subordinate means in a true combination.

any to which it had before been applied, and by appropriate manipulation, to give it a useful and practical form. He thus not only supplied the public with a new article of manufacture, but he demonstrated unknown susceptibilities of the material out of which it was made. This is something more than the mere application of an old thing to a new purpose. It is the production of a new device, by giving a new form to an old substance, and by suitable manipulation making its peculiar properties available for a use to which it had not before been applied, thereby distinguishing it from all other fabrics of the class to which it belongs. This seems to me to involve an exercise of the inventive faculty, and in view of the great practical benefits resulting from it, to invest the product with special patentable merit." 2 Bann. & A. 60 (61); 7 O. G. 698 (698), 877 (877).

That unless inventive skill is necessary to apply an old invention to a different object, the application is not an invention, see *Reed v. Reed* (1874), 12 Blatch. 366; 8 O. G. 193; 1 Bann. & A. 515; *Gallahue v. Butterfield* (1872), 10 Blatch. 232; 6 Fisher, 203; 2 O. G. 645; *Bray v. Hartshorn* (1860), 1 Clifford, 538; *Ames v. Howard* (1833), 1 Sumner, 482; 1 Robb, 689.

That to apply an old process to a different object, producing a new result in that object, is invention, see *Whitney v. Mowry* (1867), 2 Bond, 45; 3 Fisher, 157.

That to apply the same process to the same materials for a different purpose is invention, though the former purpose be incidentally accomplished, see *Higgs v. Goodwin* (1858), E. B. & E. 529.

That the new application of an old process with a new result, dependent on newly discovered susceptibilities in the object, is not double use, see *Cary v. Wolff* (1885), 32 O. G. 257; 23 Blatch. 92; 24 Fed. Rep. 130.

That to discover that an invention can be applied to other and different machines may be a new invention, see *Holmes v. Plainville Mfg. Co.* (1881), 20 Blatch. 123; 9 Fed. Rep. 757.

That to discover unknown susceptibilities of a material and make it useful by old appliances is invention, see *Union Paper Collar Co. v. White* (1875), 2 Bann. & A. 60; 7 O. G. 698, 877; 11 Phila. 479.

That putting a known material to a known use is not double use, if its capability of use in that way depends on its possession of newly discovered qualities, see *Celluloid Mfg. Co. v. Tower* (1885), 26 Fed. Rep. 451; *Celluloid Mfg. Co. v. Pratt* (1884), 21 Fed. Rep. 313.

That the use of a substance whose properties were heretofore unknown in reference to this particular use is invention, see *Dalton v. Nelson* (1876), 2 Bann. & A. 225; 13 Blatch. 357; 9 O. G. 1112.

That to so improve on an existing material as to adapt it to a new use, and then apply it to that new use, is invention, see *Hoffman v. Aronson* (1871), 8 Blatch. 324; 4 Fisher, 456.

That to apply a known process to a known material to make a known article, is not invention, though the material was never before used for the same purpose, see *Hotchkiss v. Greenwood* (1850), 11 How. 248; *Rushton v. Crawley* (1870), L. R. 10 Eq. 522.

That the use of the same material, in

Here the original use of the invention remains unchanged, but it is made to serve additional uses in its influence upon the action of the other members of the combination or in its co-operation with them on their common object. In this diversity there can be no question of an imitative or double use. The union of this invention with the others, and the new uses to which it is thereby devoted, are the result of an inventive act, producing a new means essentially distinct from each and all of the subordinate inventions from whose combination it arises.

the same manner, for another and analogous purpose, is not invention, see *Jordan v. Moore* (1866), L. R. 1 C. P. 624.

That though the user of an old material may have discovered some new value (not new property) in it, yet if used in the same way for the same purpose it is not invention, see *The Bailey Washing & Wringing Machine Co. v. Lincoln* (1871) 4 Fisher, 379.

That when an old material is used for a new purpose, it may be an invention, see *Jenkins v. Walker* (1872), Holmes, 120; 5 Fisher, 347; 1 O. G. 359.

That to apply the general principles of mechanics to a manufacture to which they had not before been applied, for a particular purpose and with a beneficial result, is invention, see *Dangerfield v. Jones* (1865), 13 L. T. Rep. n. s. 142.

That the use of a well-known substance whose capability of such use was hitherto unknown is invention, see *Walton v. Potter* (1841), 1 Web. 597.

That to ascertain by experiment that certain well-known materials, if subjected to certain known processes, will yield useful products is invention, see *Young v. Fernie* (1864), 4 Giffard, 577.

But that to apply an old contrivance to an object to which it was never before applied, there being no novelty either in the object or the mode of application, is not invention, see *Pow v. Taunton* (1845), 9 Jur. 1056.

That a new use, without new means

or new effect, is only double use, see *Sawyer v. Bixby* (1872), 1 O. G. 165; 9 Blatch. 361; 5 Fisher, 283.

The cases cited under § 243 in reference to change of material may also be consulted. Such as relate to variations in the materials of which the invention used is composed are not germane to the present subject. Such as discuss the effect upon patentability of a change in the material upon which the invention is employed are directly in point. But in examining these, especially the earlier cases, caution is required in distinguishing between the rule laid down and its application to the facts; the latter being often erroneous even where the language of the former is correct. An example may be found in *Howe v. Abbott* (1842), 2 Story, 190, 2 Robb, 99, where the invention claimed was the application to palm-leaf of a process formerly in use in preparing hair for mattresses, etc. Judge Story assumed that the use was analogous, and decided the question from that point of view. But the real issue was one of fact, whether the application to palm-leaf was an analogous use; that is, whether the applier had discovered some new susceptibility in palm-leaf and made it available through the use upon it of this known process,—an issue which should have gone to the jury as in *Steiner v. Heald*, *ante*, and other cases. See a similar avoidance of the question in *Klein v. Russell* (1873), 19 Wall. 433.

§ 268. **Use out of Combination a True Diversity of Use: never Double Use.**

The fourth diversity of use occurs when the original invention is a combination, capable of separation into several independent means. Whatever be the uses which these members serve in their co-operation with each other, the use of less than all must be a different use from that which they performed in the original invention. Here also there can be no question of a double use. The severed element or elements, acting apart from any of their previous associations, become different means; their independent use, when not suggested by their use in combination, involves a separate inventive act; and though this act, in practice, usually precedes the one in which the combination has its origin, it is always possible that the inventor of the combination may not have perceived the character of the subordinate means which he employs, or the co-operative capabilities of a less number than the whole, and that he thus has left new fields of invention open among the very elements which he has combined. Hence to break up existing combinations into independent means, or into lesser combinations, is a new use of their subordinate elements, and when for the first time performed, becomes a new invention.

§ 269. **Diversity of Use when a New Invention.**

To sum up the results of this investigation we may formulate the following rules:—

I. Where an invention consists of a specific force applied in a specific manner to a specific object, no diversity of use is possible, except when the invention is employed as an element in a new combination, and if diversity of use apparently exists, the real diversity is in the invention.

II. Where an invention consists of a specific force applied in a specific manner, but without reference to specific objects, diversity of use may arise from a change of objects, the diversity being double use if the substituted object were already known as capable of substitution, but being a new invention if this susceptibility of that object were first discovered by its user.

III. Where an invention consists only of a mode of application, without reference to specific forces or specific objects, diversity of use is possible both in regard to forces and to objects,—being a double use when the substituted force or substituted object was previously known as capable of such substitution, but a new use, and hence a new invention, when the capabilities of either force or object were first discovered by the alleged inventor of the use.

IV. The use of an invention as an element in a new combination, or the separate use of an invention previously known only as a member of a combination, is not double use, but the creation of a new and independent means.

§ 270. **New Inventions consisting in Diversity of Use Belong to what Classes of Inventions.**

The new invention resulting from diversity of use is often of a different species from the original invention in whose employment it consists. If the original invention is a force applied, to whichever of the five species of inventions it belongs, the new invention created by its use is generally a process. Thus an art applied to a new object is still an art, although a different one from the old; but the new use of a machine or manufacture, when they express the idea of a force applied, or of a composition of matter in which a specific force always resides, is not a new composition, or a new manufacture or machine, but a new process for effecting in the new object some desired result.¹ When the original inven-

§ 270. ¹ As the third class of inventions, namely, the subjection of a new object to an old force applied in a known manner, is incapable of any diversity of use except by introduction into or severance from a combination, its legal character and that of its use must always be the same. But in the other two classes, while the new mode of use does not affect the character of the invention used, so neither does the character of the invention used determine that of the new invention which con-

sists in this new use. To this effect are various decisions.

Thus that the application of an old device to a new use does not constitute a new device, see *Yuengling v. Johnson* (1877), 3 Bann. & A. 99; 1 Hughes, 607; *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.* (1874), 1 Bann. & A. 177; 6 O. G. 34; 10 Phila. 227.

See also §§ 259, 260, and notes, *ante*.

That a new mode of using old instru-

tion is a mode of application the same consequences follow; whether it be an art, or manufacture, or machine, its employment in connection with new forces or new objects is usually an act applying force or influencing objects, and not another instrument.² But in diversities of use, created by combining elements or by disrupting combinations, the result is different. Here the new invention does not vary in its species. The union or the severance of arts produces only arts; the combination or the dissociation of instruments brings forth new instruments of the same order as the old.

§ 271. **Doctrine of Double Use Unnecessarily Confused.**

From this discussion of the principles which underlie the doctrine of double use it is obvious that the subject in itself is not obscure, and that its difficulties have arisen mostly from the failure to distinguish properly between inventions and their uses, and between the different diversities of use which are possible to different classes of inventions.¹ If the decis-

ments may be a new art, see *Lawther v. Hamilton* (1888), 42 O. G. 487; *Roberts v. Dickey* (1872), 4 Brews. (Pa.) 260; 1 O. G. 4; 4 *Fisher*, 532; *Smith v. Frazer* (1872), 3 Pittsb. 397; 5 *Fisher*, 543; 2 O. G. 175.

That a new use of a composition of matter is not a new composition of matter, see *U. S. & Foreign Salamander Co. v. Haven* (1875), 3 Dillon, 131; 9 O. G. 253.

² That a new use of old instruments may result in a new manufacture, see *Judd v. Babcock* (1881), 8 Fed. Rep. 605; 23 O. G. 92; *Union Paper Collar Co. v. White* (1875), 2 Bann. & A. 60; 7 O. G. 698, 877; 11 Phila. 479.

§ 271. ¹ In *Boulton v. Bull* (1795), 2 H. Bl. 463, the origin of many of the difficulties which have attended the doctrine of double use may be traced to that erroneous idea of the real nature of "a manufacture" from which so many other perplexities have also arisen. If an invention must be a vendible sub-

stance, — that is, either a machine for making or a thing made, — it is evident that no use of an invention can ever be the subject of a patent. Every use, therefore, to which an invention can be put, without changing its essential character and thus creating a different substance, must be an analogous or double use, whether the new mode of use require inventive skill either in itself or in its adaptation of the invention to the newly discovered qualities of the object acted on. This doctrine is stated by Buller, J., in his opinion in this case, illustrating his argument by reference to medical compounds, and declaring that any new use of such compounds, though involving the highest skill and productive of the greatest benefit, could not be a new invention. Thus he says: (487) "The medicine is the manufacture, and the only object of a patent; and as the medicine is not new, any patent for it, or for the use of it, would be void." He also instances the water-tabbies, where the

ions of the courts are examined in the light of these principles, it will be found that in most cases the result arrived

patentee had discovered that by mixing water with oils and colors in a certain manner peculiar effects could be produced, but had patented only certain vendible substances obtained by that method, and continues: (488) "Suppose painted floor-cloths to be produced on the same principle, yet as the floor-cloth and the tabby are distinct substances, calculated for distinct purposes, and were unknown to the world before, a patent for one would be no objection to a patent for another;" the statement of another strange doctrine, though a true logical result of his fundamental proposition, that when a mere method of producing a thing is invented each separate vendible substance produced in that method may, if a new substance, be patented. Thus every application of a method to a new object is a new use of the method, resulting in a new patentable substance. But no application of a patented substance to a new object, though producing new effects therein, can be the subject of a patent unless the object so affected becomes also a new substance. 1 Abb. P. C. 59 (82, 83).

The same idea is expressed in *Bush v. Fox* (1852-6), Macrory's P. C. 152, where Pollock, C. B., in directing the jury denies that any application of an old invention can be patented, and affirms that if a new application results in a new product, the new product only is the subject of a patent. Thus he says: (163) "An invention must be a production of something that can be used or sold or made use of for some purpose, or some method which results in something of the same sort. And I think that a man cannot, if he has applied . . . an old invention . . . to a new purpose, obtain a patent for such an application. Now if [this contriv-

ance] is to be looked upon as old, and the object of the patent is for applying it to a new purpose, that is not a manufacture, and the application is such an operation . . . that nothing new which results from it can, I think, be the subject of a patent." In the Exchequer Chamber, this direction was held correct, taking into consideration the evidence in the cause, and was affirmed on the same ground in the House of Lords (5 H. L. 707).

In *Losh v. Hague* (1838), 1 Web. 202, Abinger, C. B.: (207) "The learned counsel has stated to you, and very properly, and it is a circumstance to be attended to, that Mr. Losh has taken out his patent to use his wheels on railways. Now, he says, the wheels made by Mr. Paton, or by the other workmen who were called as witnesses, were never applied to railways at all. That opens this question whether or not a man who finds a wheel ready made to his hand, and applies that wheel to a railway, shall get a patent for applying it to a railway. There is some nicety in considering that subject. The learned counsel has mentioned to you a particular case, in which an argand lamp burning oil having been applied for singeing gauze, somebody else afterwards applied a lamp supplied with gas for singeing lace (*Hall's Patent*, 1 Web. 97), which was a novel invention, and for which an argand lamp is not applicable because gas does not burn in the same way as oil in an argand lamp. But a man having discovered by the application of gas he could more effectually burn the cottony parts of the gauze by passing it over the gas, his patent is good. That was the application of a new contrivance to the same purpose; but it is a different thing when you take out a patent for applying a new contrivance to an

at has been in the main correct; and if their language be amended by excluding all phrases which confound diversity

old object, and applying an old contrivance to a new object; that is a very different thing; if I am wrong, I shall be corrected. In the case the learned counsel put, he says, 'If a surgeon goes into a mercer's shop and sees the mercer cutting velvet or silk with a pair of scissors with a knob to them, he seeing that would have a right to take out a patent, in order to apply the same scissors to cutting a sore, or a patient's skin.' I do not quite agree with that law. I think if the surgeon had gone to him and said, 'I see how well your scissors cut,' and he said, 'I can apply them instead of a lancet by putting a knob at the end,' that would be quite a different thing, and he might get a patent for that; but it would be a very extraordinary thing to say that, because all mankind have been accustomed to eat soup with a spoon, that a man could take out a patent because he says you might eat peas with a spoon. The law on the subject is this; that you cannot have a patent for applying a well-known thing, which might be applied to fifty thousand different purposes, for applying it to an operation which is exactly analogous to what was done before. Suppose a man invents a pair of scissors to cut cloth with; if the scissors were never invented before, he could take out a patent for it. If another man found he could cut silk with them, why should he take out a patent for that? I must own, therefore, that it strikes me if you are of opinion this wheel has been constructed according to the defendant's evidence, by the persons who have been mentioned, long before the plaintiff's patent, that although there were no railroads then to apply them to and no demand for such wheels, yet that the application of them to railroads afterwards by Mr. Losh will not give

effect to his patent, if part of that which is claimed as a new improvement by him is in fact an old improvement invented by other people and used for other purposes." 2 Abb. P. C. 501 (508).

As this case, and the propositions above quoted from the learned judge who presided at its trial, may perhaps be regarded as the first clear recognition and explanation of the doctrine of double use, it deserves a careful examination; but especially from the fact that in the language of the judge are found the seeds of several of the most important errors and mistakes that have arisen in reference to this doctrine. The statement that "you cannot have a patent for applying a well-known thing . . . to an operation *which is exactly analogous* to what was done before," is undoubtedly correct. Such an application can, in the nature of things, be nothing but a repetition and imitation of some previous application, and necessarily excludes the exercise of any inventive skill in the applier, as well as any novelty in the application. But in referring the facts in the case at bar to this rule, the judge assumes that the use, for railroad purposes, of an old wheel invented before railroads were known, must be an analogous use, without directing the jury to inquire whether the patentee had been the first to discover the requirements of a successful railroad-wheel, to perceive in this wheel a capability of satisfying those requirements, and to adapt the wheel to its more recent uses; but leaving them to decide the cause upon the question whether or not the wheel itself was new, thus making all uses of an instrument analogous where the instrument itself remains unchanged. This error resulted, in part at least, from the old idea, not yet entirely expunged

of use with diversity of means, they would become, almost without exception, intelligible and harmonious.

from the English mind, that a patentable invention must have some tangible, permanent manifestation, — either being in itself a vendible substance or resulting in the production of a vendible substance; the court here perceiving that the only vendible substance was the wheel, and presuming that if this were old nothing could be new. Mr. Webster, in a note to this part of the decision, says: (208) “It is at once evident that applications of this nature cannot be said to be ‘any manner of new manufacture;’ they may be called inventions, in one sense of the term, inasmuch as something may be said to have been found out, some discovery may be said to have been made; but they are not such as can be the subject-matter of letters-patent. Suppose any one to have discovered that a medicine known as a valuable specific in one class of complaints, fevers for instance, had also great efficacy for curing consumptions, the application of that medicine to such a new purpose would not be the subject-matter of letters-patent. The medicine is a manufacture, and the making or compounding it might be the subject of a patent; but the medicine being known, the discovery of any new application is not any manner of manufacture. Cases of this kind are well described by the term ‘double use;’ and under such circumstances it is truly said there cannot be a patent for a double or new use of a known thing, because such use cannot be said to lead to any manner of new manufacture. There is, however, a large class of cases in which a new use of a known thing is the substance or essence of the invention, as the use of gas in improving lace, or the use of charcoal in filtering sugar; but in all these and similar cases a new manufacture is the result, and if the invention or discovery be examined according

to this test, no difficulty can arise in determining whether the new case is such as can be protected by letters-patent.”

As stated by the court in the case at bar, and explained in Mr. Webster's note, the new use of a known thing is thus an analogous or double use when it does not result in a new vendible substance, and is not an analogous or double use when it does result in a new vendible substance. The use itself may be as new in the one case as in the other; it may require as much invention, and may be as beneficial to the public; but whether it is “analogous” and “double” depends not on its similarity or dissimilarity to any former use, but on the patentability of its result as a “new manner of manufacture.” In other words, the character of the use is determined not by anything in the use itself, nor in the nature of its effect, but by its capability of being classified under either of the species of inventions mentioned in the statute. The absurdity of this position is evident, and its adoption can be accounted for only by remembering the ease with which even the legal mind falls into confusion when fundamental distinctions are once ignored. To have said that an analogous use is a use similar to and suggested by the old, — as the illustrations given by Lord Abinger clearly show, — and to have held, that even a new use is not patentable unless producing a new vendible substance, would have been a position consistent with itself although erroneous in law, and would have preserved subsequent generations of jurists from innumerable perplexities.

An instance of the facility with which mistakes in the use of language have been made and propagated in the history of Patent Law occurs in the same

SECTION V.

OF THE NOVELTY OF INVENTIONS: TESTS OF IDENTITY IN SIMPLE INVENTIONS AND IN COMBINATIONS.

§ 272. Identity a Question of Fact.

Subject to the foregoing rules the question of the identity or diversity of two inventions is a question of fact, to be determined by industrial research and discrimination.¹ Every controversy in reference to inventions relates not only to their legal *status* but to their actual *status* in the arts, and is decided by the application both of principles of law and principles of science. The decisions of the courts in cases of this character therefore serve two important purposes. They declare the doctrines of the law concerning inventions in general; they also propound and explain those scientific truths in view of which the doctrines of the law must be applied to individual inventions. Having examined them in both these aspects, and formulated our results in certain rules, it now becomes

decision and in reference to the same subject. The learned judge says: "It is a different thing when you take out a patent for applying a new contrivance to an old object, and applying an old contrivance to a new object." Here note the equivocal use of the word "new." In reference to "contrivance," it means "newly invented," "never before known;" in reference to "object," it means "another" simply, not "newly invented" or "hitherto unknown." All the examples cited by the court show this, and on principle the statement is correct only when these different meanings are given to the word in its different connections; since it is as truly an invention to apply a known contrivance to an object whose susceptibilities are just discovered, as to apply a newly invented contrivance to a known object, — both standing on the same footing as results of an inventive

act. Yet without distinguishing this double meaning of the adjective, this proposition has been taken as declaring that every application of an old contrivance to any object, whether old or new, was necessarily a "double use," devoid alike of inventive skill and patentable merit; and has thus been a stumbling-block to lawyers, authors, and judges during the past fifty years. See Coryton, 66; Lund, 17; Norman, 13; Curtis, §§ 55, etc.

§ 272. ¹ That where two inventions are identical in fact they are also identical in law, see *In re Merrill* (1874), 1 MacArthur, 301; 5 O. G. 120.

That identity is a question of fact, see *Tillotson v. Ramsay* (1878), 51 Vt. 309; *Stevens v. Fierpont* (1875), 42 Conn. 360; *Morgan v. Seaward* (1835), 1 Web. 167; 2 Abb. P. C. 113.

necessary to discuss those rules in their application to concrete arts and instruments.

§ 273. Two Inventions are either Identical, or Diverse, or related as an Original and an Improvement.

Whenever two inventions are compared, they are seen to occupy toward each other one of three relations: either (1) They are identical, each possessing every essential characteristic of the other, and the later thus a reproduction of the earlier; or (2) They are entirely independent, differing in the ideas of means which they express, and tracing their origin to separate inventive acts; or (3) The later is an improvement on the earlier, identical with it up to a certain point beyond which a new exercise of the creative faculties has developed the original idea, making the difference a new and substantive invention. To ascertain in which of these relations the inventions stand is the purpose both of science and the law.

§ 274. Identity of Inventions Impossible without Identity of Function.

The first decisive test to be applied is that afforded by the functions performed by the inventions. As diversity of ends cannot result from uniformity of means, if the functions of the two inventions are essentially distinct the inventions also must be independent of each other, and the question of identity is thus immediately settled. But if their functions are essentially the same, the question is still open, since similar effects may be accomplished by the use of very different means.¹ In this event additional tests, derived from an examination of each invention as an operative means, are necessary.

§ 275. Identity of Inventions Independent of Diversities of Form.

In order to apply these further tests, each of the two inventions must be contemplated as the embodiment of its idea of means, and as that alone. Formal diversities of every kind must be excluded from consideration. The equivalence of different elements must be detected. Essential variances in

¹ § 274. That identity of function (1886), 29 Fed. Rep. 214. See also does not show identity of inventions, §§ 117, 236, and notes, *ante*. see *Bruff v. Waterbury Buckle Co.*

employment must be distinguished from mere double use, and the intrinsic character of each invention, stripped of all adventitious attributes, be made apparent to the mental vision. This being done, the two inventions are in a position to be accurately compared in respect to those essential qualities in which the identity of each consists.

§ 276. Identity of Inventions is Identity of Essential Factors.

The qualities essential to an invention depend on the relation of the inventive act to its subordinate ideas. This principle has already been sufficiently considered, and in connection with the present subject may be disposed of in a single proposition: Where the inventive act has been concerned in the discovery and adaptation of a force, an object, a mode of application, or two or more of these, the essential qualities of such new force or object or mode of application thereby become essential qualities of the invention, and any difference in this respect between the two inventions is a difference in the idea of means. In applying this principle, and in considering the identity of force with force, of object with object, and especially of one mode of application with another, it will avoid confusion to examine separately each of the six species of inventions. And since in every species there are combinations whose essential qualities are controlled by rules which are peculiar to themselves, and at the same time are additional to those which govern simple arts and instruments, the explanation of these rules will naturally precede an inquiry into the individual characteristics of particular species, and being apprehended here will simplify the questions then to be discussed.

§ 277. Identity of Combinations, how Tested.

A combination is a group of elements united in a method of co-operation. In its identity two subordinate identities concur: identity of elements; identity in the mode of their co-operation.¹ The essential qualities of a combination thus include the essential qualities of each of its constituent ele-

§ 277. ¹ That combinations are identical only when their elements and modes of combination are the same, see *Signal Co.* (1885), 114 U. S. 87; 31 O. G. 515; *Gill v. Wells* (1874), 22 Wall. 1; *Gould v. Rees* (1872), 15 Electric R. R. *Signal Co. v. Hall R. R.* Wall. 187; 6 Fisher, 106; 2 O. G.

ments, the essential qualities of their method of co-operation, and the essential qualities resulting from the union of these elements under this co-operative law. Hence in determining the identity of a combination the investigator meets, and is required to answer, the four following questions: (1) What are its constituent elements? (2) What are the essential qualities of each? (3) What is the nature of its co-operative law? and (4) What are the new intrinsic attributes resulting from the combination of the old?

§ 278. Identity of Combinations: "Elements of Combination" Defined.

The constituent elements of a combination are those subordinate arts or instruments by whose co-operation the functions of the combination are performed.¹ A combination may, and often does, embrace other substances or acts, whose presence is not necessary to its integrity; but these are accidents of

624; *Seymour v. Osborne* (1870), 11 Wall. 516; *Prouty v. Ruggles* (1842), 16 Pet. 336; 2 Robb, 92.

That combinations composed of the same or equivalent elements, combined in the same way and operating in the same manner, are identical, see *American Box Mach. Co. v. Day* (1887), 32 Fed. Rep. 585. See also cases cited in § 155, note 2, *ante*.

§ 278. ¹ That such parts of any combination as are not essential to the performance of its functions, according to the method of co-operation devised by its inventor, are immaterial and may be discarded without changing the character of the combination, see *McWilliams Mfg. Co. v. Blundell* (1882), 11 Fed. Rep. 419; 22 O. G. 177; *Stow v. Chicago* (1877), 8 Bissell, 47; 3 Bann. & A. 83; *Smith v. Fay & Co.* (1873), 6 Fisher, 446; *Carlton v. Bokee* (1873), 17 Wall. 463; 6 Fisher, 40; 2 O. G. 520; *Waterbury Brass Co. v. Miller* (1871), 5 Fisher, 48; 9 Blatch. 77; *Rich v. Close* (1870), 8 Blatch. 41; 4 Fisher, 279; *Hale v. Stimpson* (1865), 2 Fisher, 565; *Sellers v. Dickinson* (1850), 5 Exch. 312.

That all elements which aid in producing the general result enter into the combination, see *Shaver v. Skinner Mfg. Co.* (1887), 41 O. G. 232.

That though the product while in the machine aids the machine in performing some special functions, it does not thereby become an element in the combination constituting the machine, see *Dederick v. Cassell* (1881), 20 O. G. 1233; 9 Fed. Rep. 306.

That a part not indispensable, though serviceable, is not an element, see *Bradley v. Dull* (1884), 27 O. G. 625; 19 Fed. Rep. 913.

Where a combination has been patented, and in the patent is described and claimed as consisting of certain elements, each of such elements is thereby made an essential feature of the combination, whether necessary to the performance of its functions or not, and cannot be repudiated by the patentee. Hence in comparing a patented combination with an infringing or prior combination, the comparison must not be instituted between the two concrete inventions as they actually exist in the

construction, not embodiments of an idea. Among these are those parts of the invention which have no special function to discharge, those tributary devices which do not influence the operation of the constituent elements, and those objects upon which the combination acts when practically employed although they aid the combination in its operations. Diversity in these does not affect the identity of the combination, and they must, therefore, be excluded from the mind whenever its essential qualities become the subject of investigation.

§ 279. Identity of Combinations: Subcombinations to be Resolved into Elements.

In order that the essential qualities of a constituent element may be discovered, it is necessary that this element should be a simple means. An element itself is sometimes a combination, formed by the union of subordinate arts or instruments under its own peculiar method of co-operation. The intrinsic character of such an element or sub-combination depends upon the nature of its integral elements and of their co-operative law; and it must, therefore, be resolved into its several members, and if these members are true combinations still further resolution must occur, until each element can be examined as a simple art or instrument, expressing a distinct idea of means.¹ When this reduction is accomplished, the

arts, but between the prior or infringing combination and the description and claims of the patent. Under this rule the patent may, of course, fail to protect the invention of the patentee, or may be held invalid on account of the apparent, though unreal, identity of his invention with the prior combination. But the fault is his own, and by its consequences he must abide. See *Royer v. Schultz Belting Co.* (1886), 28 Fed. Rep. 850; *Fay v. Cordesman* (1883), 109 U. S. 408; *Coolidge v. McCone* (1874), 2 Sawyer, 571; 5 O. G. 458.

§ 279. ¹ It is essential to the idea of a combination that its elements should be, in themselves, operative means, and hence that their identity should depend, not merely upon the function which

they perform, but upon the manner in which they perform it. This is exemplified in the doctrine of combination-equivalents, § 254, *ante*, and in many other propositions having reference to this class of inventions. When, therefore, an element in a combination is itself a combination, its character cannot be determined by its mere function (except in chemical compositions), but the method in which it performs its functions must also be examined. This necessitates an inquiry into the nature of its elements and of their co-operative law. It is not until each element is thus reduced to its simplest terms that the identity of one element with another can be safely asserted or denied.

simple elements, whether subordinate or principal, may be subjected to a final and decisive scrutiny, in which the force, the object, and the mode of application which each represents become apparent, and the essential qualities of each are thus disclosed.

§ 280. **Identity of Combinations: "Co-operative Law" Defined.**

The co-operative law of a combination is incapable of definition, or even of exact description. It embodies a complete idea of means, embracing the subordinate ideas of force, of object, and of mode of application. Its force includes all the forces employed by each of the constituent elements, not united into a new and homogeneous force, but remaining separate from each other as though the elements were still distinct. Its object comprehends every constituent element whose natural activities are influenced by the forces of the other elements, as well as that remoter substance toward which the energies of the whole combination are directed. Its mode of application is that method of arrangement, that adjustment of each element with reference to every other, by which the force of each is enabled so to act upon the others and their common object that the intended functions of the combination are performed. Thus in a chemical composition, for example, the co-operative law expresses the idea of the forces represented by the properties of each ingredient, operating upon the properties of every other ingredient, as well as on the substances to which the combination is to be applied, through that mode of application which is adopted when the several ingredients are intermingled in such order, method, and proportions, as permits the exercise of this reciprocal and joint activity. Thus, also, in a process, it is that relation of each art toward the others which is created by performing every art in a specific time and method, whereby the force of each acts in a certain manner on the forces of the others and on the common fabric or material. This co-operative law is sometimes ascertainable from an immediate inspection of the combination, and sometimes from the permanent effects which follow its employment, but far more accurately and reliably from an examination of it while in actual opera-

tion, when its subordinate forces are applied to its subordinate objects in that degree or measure which produces its peculiar ultimate results.

§ 281. Identity of Combinations: Essential Attributes of Combinations.

A combination, as a whole, possesses attributes distinct from those of its constituent elements and of their co-operative law. It represents an independent and original idea of means. Its force is a resultant from the union of the individual forces of its elements. Its object is the material on which its functions are performed. Its mode of application is the method in which the co-operating action of its elements directs its force upon their common object. The inventive act by which it is created may manifest itself in the production of a new force by the union of the old, as in a chemical combination; or in the subjection of a new object to the co-operative forces of its elements, as in some special arts; or in the contrivance of a new method for applying these united forces to their object, as in many forms of manufactures and machines. But on whichever one of these subordinate ideas the genius of the inventor is exerted, each is, in its relation to the combination, distinct from the corresponding ideas which underlie the individual elements or their co-operative law; and the essential qualities of each, whether they differ from or are identical with those out of whose union they arise, are equally essential to the identity of the combination. These are the substance of the combination, taken as a whole, — the attributes by which it is enabled to perform its functions in the mode designed by its inventor, and which results from the possession, by its elements and by its co-operative law, of their particular and individual qualities.

§ 282. Identity of Combinations Requires Identity of Elements, of Co-operative Law, and of Essential Attributes.

This method of investigation discloses those essential characteristics of the two combinations, by a comparison of which their identity or diversity is to be determined. Assuming that their functions are the same, since without this no iden-

tity is possible, the mode in which each combination performs these functions, or its intrinsic attributes when taken as a whole, first demand attention. If the forces, objects, or modes of application which constitute the essential factors of the two combinations are evidently different, the combinations must be distinct inventions; if evidently the same, the constituent elements of each combination and their co-operative laws must be examined. When every element in one is represented by an equivalent element in the other, so that a complete interchange of elements would work no alteration in the functions of the combination or in its co-operative law, the elements of both combinations are identical; but otherwise the elements are diverse and the combinations are independent inventions.¹ When all the elements are the

§ 282. ¹ As a combination is the union of certain specific elements under one law of co-operation, two combinations cannot be identical unless the elements united in each are the same. This does not require, however, that the elements should be the same concrete inventions, for all elements are the same in reference to the combination if each is a true substitute for the other, according to the doctrine of equivalents. Nor is it necessary that the elements be the same in number, for one may be the equivalent of two or more, or two or more may be substituted in the place of one. But it is essential that when all immaterial parts are excluded, and the true constituent elements of each combination alone remain, these elements in each should be equivalents for all those in the other; and this is what is meant by the proposition that to drop an element, or to add an element, makes the result a different combination. Thus in *Royer v. Schultz Belting Co.* (1886), 28 Fed. Rep., 850, Treat, J. : (851) "The ordinary doctrine in law concerning patents is that if a party insists on a patent for a combination of devices (whether new or old is immaterial), each element of the combination

is an essential element; so that one who uses a combination in some respects, but omits one of the elements that the patentee chooses to describe as essential, the supposed infringer does not infringe. The patentee is supposed to describe clearly and fully all the elements which he thinks essential to produce the result desired. If he chooses to crowd his supposed inventions or combinations with elements that have no functions whatsoever, and a party chooses to use a like contrivance, omitting some of those elements, he does not infringe. The reason of the rule, as explained by the Supreme Court very frequently, is this: that, first, a party claiming the patent should not encumber the combination or device with matters that are wholly unessential, and thereby block the path of improvement or invention. If he chooses to put such in his contrivance, he must abide by the result."

In *Rowell v. Lindsay* (1881), 6 Fed. Rep., 290, Dyer, J. : (293) "It is a settled rule of law that where a patent is for a combination of known parts, it is not infringed by the use of any number of the parts less than the whole; for the patent, in every such case, is for

same, identity depends upon identity of co-operative law. The co-operative laws of two combinations can scarcely differ

that identical combination, and nothing else, and a combination of any less number of parts is a different thing. . . . (205) The combination is an entirety. Unless it is maintained as such, the whole of the invention fails. If one of the elements is given up the thing claimed disappears. . . . The different parts may perform more or less important functions, but each and all are essential to make the thing which the patentee has claimed as his invention." 10 Bissell, 217 (220, 222); 19 O. G. 1565 (1565).

In *Waterbury Brass Co. v. Miller* (1871), 5 Fisher, 48, Woodruff, J.: (69) "In any proposed application of this principle it should be borne in mind that, in a certain sense, nearly all new machines are but combinations of old devices; that is to say, they do, or may, combine frames, bolts, screws and nuts, rods and pulleys, cranks and wheels, levers and pins, nails and boards, and, as the case may be, various other and more complicated devices, none of which, regarded singly or separately, are new; and yet the machine formed by the combination is new as a structure, new in its operation, and new in the effect produced. The patent, in such case, is not for a mere combination under the rule above referred to; and another machine, having the like construction, operation, and effect, in all that constitutes the principle of the machine, and the efficient means of its operation, is an infringement of the patent, notwithstanding it may be moved by a less number of wheels, or be held together by a less number of clamps, screws or nails, bolts or keys, and notwithstanding drum and pulley may be substituted for cog-wheels or other gear, or bolts for screws and nuts, or like changes be made in other devices em-

ployed to construct the machine. Such machine, notwithstanding such changes, is substantially the same in its patentable characteristics, and would be, within the terms of the specification, 'substantially as described.'" 9 Blatch. 77 (98).

In *Rich v. Close* (1870), 8 Blatch. 41, Woodruff, J.: (44) "It is true that inventions in general involve combinations of old devices. No machine is made that does not, in various of its parts, require for its construction the use of what is known and open to the use of all the world. Hence, when a machine is patented as an aggregate, third parties may not deny an infringement on the ground that they omit immaterial parts, or use fewer of the original old elements or substitute equivalents. The question will still recur: Is the alleged infringement substantially the same machine?" 4 Fisher, 279 (283).

In *Roberts v. Harnden* (1865), 2 Clifford, 500, Clifford, J.: (504) "Where all the elements of a machine are old, and the invention consists solely in the combination by which a new and useful result is effected, as compared with the old machine on which the improvement is made, no one can be held as an infringer who does not use all of the elements of the new combination. The reason of the rule is that others as well as the first patentee may improve the old machine; and if they do so by the use of a substantially different combination they are not infringers, although they may have used all of the elements of the first invention, except one, and their machine may perform substantially the same functions."

In *Hill v. Thompson* (1818), 1 Web. 239, Dallas, J.: (242) "It is a patent for a combination of processes, altogether new, leading to one end; and this being the nature of the alleged discovery, any

when, all their elements being identical, the union of these elements has resulted in combinations performing the same

use made of any of the ingredients singly, or any use made of such ingredients in partial combination, some of them being omitted, or any use of all or some of such ingredients in proportions essentially different from those specified, and yet producing a result equally beneficial (if not more so) with the result obtained by the proportions specified, will not constitute an infringement of the patent." 1 Abb. P. C. 304 (308).

That to omit one element of a combination destroys that combination, see *Royer v. Schultz Belting Co.* (1886), 28 Fed. Rep. 850; *Schillinger v. Cranford* (1885), 4 Mackay, 450; 37 O. G. 1349; *Abbott v. Hoole Mfg. Co.* (1885), 31 O. G. 1561; *Travers v. Palmer* (1885), 31 O. G. 382; 23 Fed. Rep. 511; *Hayes v. Bickelhaupt* (1885), 32 O. G. 133; 23 Fed. Rep. 183; *Arnold v. Phelps* (1884), 29 O. G. 538; *Pacific Submarine Co. v. United States* (1884), 19 Ct. of Claims, 234; *Gould v. Spicers* (1884), 20 Fed. Rep. 317; *Gage v. Herring* (1883), 107 U. S. 640; 23 O. G. 2119; *Howe v. Neemes* (1883), 18 Fed. Rep. 40; *Matteson v. Caine* (1883), 17 Fed. Rep. 525; 8 Sawyer, 498; *Cotter v. New Haven Copper Co.* (1882), 23 O. G. 740; 13 Fed. Rep. 284; *New v. Warren* (1882), 22 O. G. 587; *Schmidt v. Freese* (1882), 21 O. G. 1876; 12 Fed. Rep. 563; *Tod v. Wick Bros.* (1881), 36 Ohio St. 370; *Cross v. Livermore* (1881), 21 O. G. 139; 9 Fed. Rep. 607; *American Ballast Log Co. v. Barnes* (1881), 21 O. G. 1029; 9 Fed. Rep. 465; 4 Hughes, 278; *Rowell v. Lindsay* (1881), 10 Bissell, 217; 6 Fed. Rep. 290; 19 O. G. 1565; *Faurott v. Hawes* (1880), 3 Fed. Rep. 456; *Gale Mfg. Co. v. Prutzman* (1880), 5 Bann. & A. 154; 17 O. G. 743; *Dittmar v. Rix* (1880), 5 Bann. & A. 240; 17 O. G. 973; 1 Fed. Rep.

342; *Sharp v. Tiff* (1880), 17 O. G. 1282; 18 Blatch. 132; 2 Fed. Rep. 607; 5 Bann. & A. 399; *Water Meter Co. v. Desper* (1879), 101 U. S. 332; *Burdett v. Estey* (1879), 16 Blatch. 105; 4 Bann. & A. 141; *Miller v. Bridgeport Brass Co.* (1877), 3 Bann. & A. 20; 14 Blatch. 282; 12 O. G. 607; *Stow v. Chicago* (1877), 3 Bann. & A. 83; 8 Bissell, 47; *Schumacher v. Cornell* (1877), 96 U. S. 549; *Smith v. Marshall* (1876), 2 Bann. & A. 371; 10 O. G. 375; *Sanford v. Merrimac Hat Co.* (1876), 4 Clifford, 404; 2 Bann. & A. 408; 10 O. G. 466; *Storrs v. Howe* (1876), 2 Bann. & A. 420; 10 O. G. 421; 4 Clifford, 388; *Dunbar v. Meyers* (1876), 94 U. S. 187; 11 O. G. 35; *Fisher v. Craig* (1874), 1 Bann. & A. 365; 3 Sawyer, 69; *Craig v. Smith* (1874), 1 Bann. & A. 556; 4 Dillon, 349; *Coolidge v. McCone* (1874), 2 Sawyer, 571; 5 O. G. 458; *Smith v. Woodruff* (1874), 1 MacArthur, 459; 4 O. G. 635; 6 Fisher, 476; *Westlake v. Cartter* (1873), 4 O. G. 636; 6 Fisher, 519; *Brown v. Hinkley* (1873), 3 O. G. 384; 6 Fisher, 370; *Bridge v. Brown* (1873), Holmes, 205; 3 O. G. 121; *King v. Louisville Cement Co.* (1873), 6 Fisher, 336; 4 O. G. 181; *Sarven v. Hall* (1872), 1 O. G. 437; 9 Blatch. 524; 5 Fisher, 415; *Gould v. Rees* (1872), 15 Wall. 187; 6 Fisher, 106; 2 O. G. 624; *Wallace v. Holmes* (1871), 1 O. G. 117; 5 Fisher, 37; 9 Blatch. 65; *Waterbury Brass Co. v. Miller* (1871), 9 Blatch. 77; 5 Fisher, 48; *Carter v. Baker* (1871), 1 Sawyer, 512; 4 Fisher, 404; *Watson v. Cunningham* (1871), 4 Fisher, 528; *Seymour v. Osborne* (1870), 11 Wall. 516; *Rich v. Close* (1870), 8 Blatch. 41; 4 Fisher, 279; *Stimpson v. Woodman* (1869), 10 Wall. 117; *Crompton v. Belknap Mills* (1869), 3 Fisher, 536; *Nicholson Pave-*

functions in the same manner; still this test is not infallible, and only an analysis of that law itself, as manifested in each

ment Co. v. Hatch (1808), 4 Sawyer, 692; 3 Fisher, 432; Blanchard v. Puttman (1867), 2 Bond, 84; 3 Fisher, 186; Mabie v. Haskell (1865), 2 Clifford, 507; Roberts v. Harnden (1865), 2 Clifford, 500; Hale v. Stimpson (1865), 2 Fisher, 565; Eames v. Godfrey (1863), 1 Wall. 78; Vance v. Campbell (1861), 1 Black, 427; Dodge v. Card (1860), 1 Bond, 393; 2 Fisher, 116; Leo v. Blandy (1860), 1 Bond, 361; 2 Fisher, 89; Smith v. Higgins (1860), 2 Fisher, 97; Latta v. Shawk (1859), 1 Fisher, 465; 1 Bond, 259; Bell v. Daniels (1858), 1 Fisher, 372; 1 Bond, 212; McCormick v. Talcott (1857), 20 How. 402; Foss v. Herbert (1858), 2 Fisher, 31; 1 Bissell, 121; Pitts v. Wemple (1855), 6 McLean, 558; Pitts v. Wemple (1855), 2 Fisher, 10; 1 Bissell, 87; McCormick v. Manny (1855), 6 McLean, 539; Brooks v. Fiske (1853), 15 How. 212; Silsby v. Foote (1852), 14 How. 218; Smith v. Downing (1850), 1 Fisher, 64; Parker v. Haworth (1848), 4 McLean, 370; 2 Robb, 725; Root v. Ball (1846), 4 McLean, 177; 2 Robb, 513; Brooks v. Bicknell (1845), 4 McLean, 70; Brooks v. Bicknell (1844), 3 McLean, 432; Prouty v. Ruggles (1842), 16 Peters, 336; 2 Robb, 92; Prouty v. Draper (1841), 1 Story, 568; 2 Robb, 75; Barrett v. Hall (1818), 1 Mason, 447; 1 Robb, 207; Harrison v. Anderson Foundry Co. (1876), L. R. 1 App. 574; Clark v. Adie (1875), L. R. 10 Ch. Ap. 667; Booth v. Kennard (1856), 1 H. & N. 527.

In quite a number of the foregoing cases the courts distinguish between combinations of old elements and combinations consisting entirely or in part of new elements, and apply this doctrine in its fulness only to the former. It was their real desire to announce that new elements and sub-combinations were

protected by the patent for the combination as a whole, though not specifically claimed therein; and being unable to assume this position without violence to accepted rules of interpretation, they endeavored to attain the same result by declaring that the new combination itself is used whenever any of its new elements are employed. This is manifestly inconsistent with any true theory of the nature of a combination, which can exist only where all its elements are present and co-operate in the mode devised by its inventor. See also § 254, note 1, *ante*.

That a combination of three elements is a different invention from a combination of two of them, see *Bernard v. Heimann* (1881) 21 O. G. 140; 20 Blatch. 21; 9 Fed. Rep. 400.

That the omission of one element in a combination, if its function is not performed by the remaining elements, makes a different combination, see *Tobey Furniture Co. v. Colby* (1885), 26 Fed. Rep. 100; 34 O. G. 1276.

That less than all the elements make a different combination, though the former was suggested by the latter, see *Snow v. Lake Shore & M. S. R. R. Co.* (1883), 18 Fed. Rep. 602; 25 O. G. 1280.

That where a combination has heretofore been used in connection with a certain element, it does not become a new combination by dropping that element, if the function and effect of the combination remain unchanged, the abandoned element being thus shown to have been immaterial, see *Stow v. Chicago* (1877), 8 Bissell, 47; 3 Bann. & A. 83; *Smith v. Fay & Co.* (1873), 6 Fisher, 446; *Carlton v. Bokee* (1873), 17 Wall. 463; 2 O. G. 520; 6 Fisher, 40; *Waterbury Brass Co. v. Miller* (1871), 5 Fisher, 48; 9 Blatch. 77;

combination, and an examination of the force, the object,

Hale v. Stimpson (1865), 2 Fisher, 565.

That the rejection of superfluous parts from a combination does not always require inventive skill, nor the union of the remaining parts constitute a new patentable combination, see *McClain v. Ortmyer* (1888), 42 O. G. 724; *Smith v. Fay & Co.* (1873), 6 Fisher, 446.

That to dismember an old combination and use some of the elements for the same function they performed while in the combination, may produce a different combination, but not a new and patentable one, see *Stow v. Chicago* (1877), 3 Bann. & A. 83; 8 Bissell, 47.

That where there is already a combination of certain elements, the selection of the most useful among their equivalents and uniting these into a combination of the same character for the same purpose, though better performed, is not invention, but mere mechanical skill, see *Welling v. Crane* (1882), 14 Fed. Rep. 571; 23 O. G. 189.

That combinations differ if any of their parts are substantially different, see *Norton v. Haight* (1884), 22 Fed. Rep. 787.

That where one element is new the combination must be new, see *Temple Pump Co. v. Goss Pump & Rubber Bucket Mfg. Co.* (1887), 39 O. G. 467; 30 Fed. Rep. 440.

That the substitution of a new element, producing an additional result, makes a different combination, see *Smith v. Murray* (1886), 27 Fed. Rep. 69.

That the substitution of a new element may make a different combination, though the new was suggested by the old, see *American Ballast Log Co. v. Barnes* (1881), 21 O. G. 1029; 9 Fed. Rep. 465; 4 Hughes, 278.

That to add to an existing combination some new constituent element is to

create another combination, see *Rowell v. Lindsay* (1881), 6 Fed. Rep. 290; 10 Bissell, 217; 19 O. G. 1565; *Babcock v. Judd* (1880), 1 Fed. Rep. 408; 17 O. G. 1351; 5 Bann. & A. 127; *Sanford v. Merrimac Hat Co.* (1876), 4 Clifford, 404; 10 O. G. 466; 2 Bann. & A. 408; *Robertson v. Hill* (1873), 4 O. G. 132; 6 Fisher, 465; *Gallahue v. Butterfield* (1872), 10 Blatch. 232; 6 Fisher, 203; 2 O. G. 645; *Le Roy v. Tatham* (1859), 22 How. 132.

But that the former combination still remains the same in itself though used as an element in the new one, see *Pitts v. Wemple* (1855), 6 McLean, 558.

And that the inventor of the new combination obtains no right to claim or use the old as against its patentee, see *Williams v. Boston & Albany R. R. Co.* (1879), 17 Blatch. 21; 16 O. G. 906; 4 Bann. & A. 441; *Howes v. Nute* (1870), 4 Clifford, 173; 4 Fisher, 263; *Evans v. Eaton*, (1822), 7 Wheaton, 356; 1 Robb, 336.

That where the elements of a combination are found in different prior inventions, composing combinations to effect the same result, and could have been selected and combined as at present by mechanical skill alone, there is no new invention, see *Saxby v. Gloucester Waggon Co.* (1881), L. R. 7 Q. B. 305.

That the use of a combination in a different machine does not change the combination, see *La Rue v. Western Electric Co.* (1886), 28 Fed. Rep. 85; 36 O. G. 453.

That the rule concerning equivalents applies equally to combinations as to simple inventions is evident from the cases cited under §§ 253, 254, etc., *vide*. That in mechanical combinations at least, the characteristics of an equivalent differ from those of an equivalent in simple inventions is apparent from § 254,

and the mode of application which it represents, can finally

ante, and cases there referred to. This difference has led to some general statements that the doctrine of equivalents is not fully applicable to combinations. Thus in *Sands v. Wardwell* (1869), 3 Clifford, 277, Clifford, J.: (282) "Technical equivalents do not belong to a mere combination of old elements. Such a combination is regarded merely as an improvement upon what was before known, and which, without such new combination, would have belonged to the public. Inventors of such improvements, if their rights are secured by letters-patent, may treat all others as infringers who make, use, or vend to others to be used, any and every subsequent combination of those elements not substantially different; and no such subsequent combination is substantially different merely because the person constructing a machine under it employs a different device for one of the elements, provided such device was, at the date of the first patent, a well-known substitute for such omitted element. Other inventors may secure valid patents for subsequent combinations of the same elements, provided the combination is substantially different and the invention produces a new and useful result; but no person can be treated as an infringer who does not use all of the elements of the first combination, unless the change is merely formal or colorable, as every subsequent combination is which is not substantially different; and no subsequent change can be regarded as substantially different merely because it drops one of the elements of the one patented and employs in its stead another, which, though different in form, was well known at the date of the patent as a common substitute for the element so dropped."

In *Roberts v. Harnden* (1865), 2 Clifford, 500, Clifford, J.: (504) "The property of the first inventor consists in

the new combination he has made, and to that and its result he is fairly and fully entitled, but he cannot invoke the doctrine of equivalents to suppress any other improvement which does not embrace his improvement, and which is substantially different. Formal differences or colorable evasions, however, are not sufficient to confer any right as against the first patent, but the patentee and all those claiming under him will treat all such as culpable infringements."

All this class of statements, nevertheless, recognize that equivalent elements in combination are legally the same elements. For further cases to the same effect, see *Williams v. Boston & Albany R. R. Co.* (1879), 16 O. G. 906; 17 Blatch. 21; 4 Bann & A. 441; *Fuller v. Yentzer* (1876), 94 U. S. 288; 11 O. G. 551; *Locomotive Engine Safety Truck Co. v. Erie Railway Co.* (1872), 10 Blatch. 292; 3 O. G. 93; 6 Fisher, 187; and cases cited under §§ 254, 258, *ante*.

That any substantial change in the character of the elements of a combination makes the combination a different invention, see *Hale v. Stimpson* (1865), 2 Fisher, 565.

The effects of various changes in the elements of a combination is well described by Shepley, J., in *Maynadier v. Tenney* (1877), 2 Bann. & A. 615. The learned judge says: (616) "Under these circumstances this being [a combination], it was competent for any person to do three things: He might, in the first place, dispensing with one of the elements of that combination in its precise form, introduce into it a known equivalent, . . . equivalent in the sense that in that combination it was the use of another well-known device, performing the same operation in the same way. That would be a naked infringement. It was competent, secondly, for a person

exhaust the field of inquiry by reaching a result as certain as physical science can attain.²

to make the change in the machine by introducing, in the place of any one of the elements of that combination, another device not known before as an equivalent device; that would not be an infringement under the decisions of the Supreme Court, which say it is not an infringement where the device substituted was not a known equivalent at the date of the patent. It was competent, in the third place, for a party desiring to change the features of the machine, to substitute for one of the elements in the combination features which should accomplish the same result by the same mode of operation that this element accomplished; and which, in addition to it, should perform some other function which was novel and useful. That, without being a naked infringement, would be the subject of a patent for an improvement, in consequence of the additional new features which it introduced, but would still be subject to the original patent, having embodied in it that which was novel and useful in the original combination."

² That one combination of elements is not identical with another combination of the same elements, see *Otis Bros. Mfg. Co. v. Crane Bros. Mfg. Co.* (1886), 27 Fed. Rep. 550; *Pattee v. Moline Plow Co.* (1881), 22 O. G. 173; 10 Bissell, 377; 9 Fed. Rep. 821.

That unless the co-operative laws of two combinations are the same, the combinations are distinct, notwithstanding the identity of their elements, see *Dederick v. Cassell* (1881), 9 Fed. Rep. 306; 20 O. G. 1233; *Pattee v. Moline Plow Co.* (1881), 10 Bissell, 377; 9 Fed. Rep. 821; 22 O. G. 173; *Detroit Lubricator Mfg. Co. v. Renchard* (1881), 9 Fed. Rep. 293; *Habeman v. Whitman* (1880), 5 Bann. & A. 530; *Lyman Ventilating & Refrigerator Co. v. Lalor*

(1874), 12 Blatch. 303; 6 O. G. 642; 1 Bann. & A. 403; *Murray v. Clayton* (1872), L. R. 7 Ch. Ap. 570.

That the arrangement of the same elements under a different co-operative law, though producing the same results, is a different combination, see *Railway Register Mfg. Co. v. Third Avenue R. R. Co.* (1887), 42 O. G. 379.

That a mere difference in the relative position of the elements may produce a new combination, by creating a difference in their mode of co-operation, see *Fitch v. Bragg* (1881), 20 O. G. 1589; 8 Fed. Rep. 588; *Habeman v. Whitman* (1880), 5 Bann. & A. 530; *Adams v. Joliet Mfg. Co.* (1877), 12 O. G. 93; 3 Bann. & A. 1; *Fuller v. Yentzer* (1876), 94 U. S. 288; 11 O. G. 551; *Gilbert & Barker Mfg. Co. v. Walworth Mfg. Co.* (1876), 9 O. G. 746; 2 Bann. & A. 271; *Carstaedt v. U. S. Corset Co.* (1875), 13 Blatch. 119; 9 O. G. 151; 2 Bann. & A. 119; *Calkins v. Bertraud* (1875), 6 Bissell, 494; 9 O. G. 795; 2 Bann. & A. 215; *Gilbert & Barker Mfg. Co. v. Tirrel* (1874), 12 Blatch. 144; 1 Bann. & A. 315; 8 O. G. 2; *Woodward v. Dinsmore* (1870), 4 Fisher, 163.

That changes in the arrangement of the elements do not change the combination unless they also change its function or the function of an element, see *Flippis v. Yost* (1886), 26 Fed. Rep. 447; *Dederick v. Whitman Agricultural Co.* (1886), 26 Fed. Rep. 755; 36 O. G. 571.

That where the ideas of means embodied in two combinations are the same, the combinations are identical whatever other differences exist, see *Howe v. Williams* (1863), 2 Clifford, 245; 2 Fisher, 395.

The principal questions in which a comparison of two or more combinations is involved are three: (1) Whether a

SECTION VI.

OF THE NOVELTY OF INVENTIONS: IDENTITY OF ARTS, MACHINES, MANUFACTURES, COMPOSITIONS OF MATTER, DESIGNS, AND IMPROVEMENTS.

§ 283. Identity of Inventions of Particular Classes.

With the exception of compositions of matter, inventions of every species may be either simple or compound; and

given combination is anticipated by a prior combination; (2) Whether a patented combination is infringed by a later combination; (3) Whether, in view of previously existing combinations, a new combination has originated in inventive skill. Each of these questions requires the consideration of the identity of two or more combinations, and to that extent all are answered in the same manner. But each also requires the consideration of matters peculiar to itself, and in reference to these matters the answers may be widely different. It is essential, in reading the decisions in which the identity of combinations is discussed, to remember that the declarations of the courts in one class of cases are not always applicable to the others.

1. A combination is anticipated by another whenever the same elemental means or their known equivalents, united under the same co-operative law, have been in prior use in this country or have been patented or described in a printed publication either at home or abroad. In this case it is immaterial whether the prior combination was patented or not, or whether it existed as a separate and independent means, or merely as a subordinate part of a larger combination; the possession of it by the public in any form recognizable by them, deprives the later combination of that legal novelty

which is essential to the issue of a patent.

2. A combination is infringed whenever the elements described in the patent, or their known equivalents, united under the co-operative law also therein described, are made, used, or sold, without the permission of the patentee. In this case the real nature of the combination as an invention is of no consequence. Only the exact combination described and claimed in the patent is capable of infringement, and any variation in the elements or the co-operative law which leaves the claimed combination unappropriated does not invade the rights of the patentee. The use of less than all the elements, or the union of the same elements under a different co-operative law, is not the employment of the patented combination; but if the patented combination be taken as a member of new combinations, or be in any manner added to or varied, while still preserving its own means coacting under its own law, the patent is infringed, however great is the improvement in the arts, and however different in other respects the new combination may appear to be.

3. No combination can be a new invention and patentable as such unless it is the fruit of inventive skill. A substantial difference between combinations does not, therefore, show that the later

as in these the indications of identity and the methods of examination are dissimilar, the first point to be ascertained in any given case is whether the art or instrument is a simple invention or a combination. In considering each species in detail we shall therefore contemplate it both as simple and combined; and since the characteristics of the simple constitute the characteristics of the elements of the combined, they are entitled to the foremost place in our discussion.

§ 284. Identity of Simple Arts.

A simple art is a single act or operation. As the result of an inventive act it is essentially distinct from and independent of the concrete agencies by which it is performed, and can be accurately apprehended only by abstracting it from these, and contemplating it as an idea embodied in an act alone. If we regard the means from the view-point of the end, this act is the first step beyond the proximate effect, and is thus intermediate between the function and the tangible instrument employed in its production. It differs from the function only in that the latter cannot be conceived by the mind apart from some effect actually produced in the object acted on, while the idea of the former is complete when the effect is apprehended as producible by the application to the object of the agencies employed. For this reason, as we have previously seen, an art is the most comprehensive of all species of inventions; and except in the single instance where the act or operation can be performed only by some specific instrument it is superior to all exterior agencies, and may indifferently employ them as its own subsidiary means.

combination is a true invention. Whether the new combination is formed by dropping elements from known combinations, or by adding new elements, or by rearranging existing elements, the question of invention and of patentability is still to be determined by the application of the same tests to which all other supposed inventions are subjected. If the later combination is suggested by the former, or has been arrived at by the gradual development

of mechanical knowledge, it is not a patentable invention, however useful or different it may be. And on the other hand, if actually requiring the exercise of the creative faculties for its production it is a new invention, without reference to its degree of deviation from the old. See further on these topics §§ 153-156, 168, 176, 185, 193, 205, 217, 254, 465, 472, 496, 523-528, 670-672, 922-924, and notes.

§ 285. Identity of Simple Arts is Identity of their Essential Factors.

The idea of a simple art includes the subordinate ideas of a force, an object, and a mode of application; and any given art may belong to either one of those three great classes of inventions whose differences depend on the relation of the inventive act to each of these subordinate ideas. As the most comprehensive of inventions, an art may either be a force applied, a mode of application, or a specific force directed in a specific manner toward a specific object; and the attributes essential to its identity vary in character and number according to the class in which it is embraced. Thus arts which are mere modes of application, capable of employing various forces and of producing their effects on various objects, have few essential attributes, sometimes perhaps but one, and hence are wider in their scope, and of more universal adaptation than any other operative means. An art which is a force applied, employing a particular force in a particular manner, has more essential attributes, and therefore is of narrower scope and a more limited utility. And one consisting in the application of a specific force in a specific manner to a specific object possesses the most numerous essential qualities, and hence is more restricted in its scope and usefulness than any other species of invention. To ascertain the essential characteristics of an art, it is therefore necessary, first of all, to determine to which of these three great classes it belongs; thus fixing the number and nature of those attributes which have resulted from the inventive act and are embraced in its idea of means. If it be found to be an act applying force, without reference to particular forces or particular objects, its characteristics must be sought only in the method in which it is performed, in the degree, direction, or order in which through it the forces are applied. If it prove to be a force applied, its attributes include, not merely the essential qualities of the mode of application, but those of the force also, as employed in that peculiar operation. And if it be the application of specific forces in a specific manner to specific objects, those qualities of the object which render it susceptible to this specific influence, as well as those of the

force and application, become essential qualities of the invention, no one of which can be removed without destroying its identity.¹

§ 286. Identity of Simple Arts Determined by Relegating Each to its Proper Group and Comparing their Essential Factors.

The method of comparing simple arts with one another is thus clearly indicated. The exact idea embodied in each art is first to be distinguished by excluding from the mind every conception which pertains merely to the concrete instrument on one side, or to the function of the means upon the other. Each art is then to be referred to its appropriate class, as denoted by that one or more of its subordinate factors in whose discovery the inventive faculties have been employed. If the two arts belong in separate classes, they are essentially distinct, though one may be included in the other. If both are of the same class, a comparison of the subordinate ideas, in which the essential qualities of each reside, is necessary. In one class the two arts will be the same when the same act is performed in the same manner, whatever be the nature of the force or object.¹ Arts of another class will be identical only when both apply the same force by the same methods to their several objects. And in the third class, unless they direct the same force on the same object through the same mode of application, they differ in their substance and each is a complete and separate invention.

§ 285. ¹ That in a process a similar substance is one which acts or is acted on in the same way, see *American Wood Paper Co. v. The Fibre Disintegrating Co.* (1868), 3 Fisher, 362; 6 Blatch. 27.

§ 286. ¹ That when an inventor has discovered that the obstacles encountered in a chemical process are due to certain impurities present in the ingredients, and has devised a method of removing

them, any other method of removing the same impurities from the ingredients is the same improvement in the chemical process, see *United Nickel Co. v. Harris* (1878), 17 O. G. 325; 15 Blatch. 319; 3 Bann. & A. 627.

That the identity of two processes may be inferred from the chemical identity of their results, see *Pickhardt v. Packard* (1884), 22 Fed. Rep. 530.

See also §§ 107, 170, and notes, *ante*.

§ 287. Identity of Combination Arts.

An art may be a combination of two or more simple arts.¹ In that case its identity depends on the identity of its constituent elements, on the identity of their co-operative law, and on the identity of the essential characteristics of the combination taken as a whole. The identity of its constituent arts is ascertained according to the method described in reference to simple arts. The essential qualities of its co-operative law are indicated by the effect produced by each constituent art upon the function of the others and upon their common object. The attributes of the combination, taken as a whole, are manifested by the mode in which it operates upon the common fabric or material in the production of the ultimate result.

§ 288. Identity of Combination Arts Determined by Comparing their Elements, Co-operative Laws, and Essential Attributes.

The comparison of two compound arts thus consists in ascertaining whether both are constituted by the union of the same elemental arts, or their equivalents, under the same co-operative law, and operate in the same manner to produce the same results. Diversity in either of these three particulars is fatal to the identity of the arts compared.¹ The

§ 287. ¹ That a new process may consist of a combination of old processes, see *Wallace v. Noyes* (1882), 13 Fed. Rep. 172; 21 Blatch. 83; 23 O. G. 435; *Cannington v. Nuttall* (1871), L. R. 5 H. L. 205; *Bovill v. Keyworth*, (1857), 7 El. & B. 725.

§ 288. ¹ That a process from which one element of another and otherwise identical process is omitted is a different process, see *Lawther v. Hamilton* (1888), 42 O. G., 487; *Arnold v. Phelps* (1884), 29 O. G. 538; *Hammerschlag v. Garrett* (1882), 10 Fed. Rep. 479; 21 O. G. 1199; *Dittmar v. Rix* (1880), 17 O. G. 973; 1 Fed. Rep. 342; 5 Bann. & A. 240; *Booth v. Kennard* (1856), 1 H. & N. 527.

That any substantial difference between any of the subordinate arts em-

braced in two otherwise identical processes makes them essentially different processes, see *Cotter v. New Haven Copper Co.* (1882), 13 Fed. Rep. 234; 23 O. G. 740.

That a difference in the proportions of ingredients used in two chemical processes does not make the processes different, if the ingredients discharge the same functions and accomplish the same results in both processes, see *Rumford Chemical Works v. Lauer* (1872), 10 Blatch. 122; 5 Fisher, 615; 3 O. G. 349.

That an art may be the same, though the order of its acts varies, and its apparatus is changed, see *Hammerschlag Mfg. Co. v. Bancroft* (1887), 32 Fed. Rep. 585.

See also § 170, and notes, *ante*.

omission from one combination of a single art which is a constituent element in the other; or any change in the degree or order or direction of any elemental art by which a variation is introduced into the co-operative law; or the addition of a new art performing functions not discharged by any in the old; or the substitution of new elements which are not true equivalents for those whose place they seem to occupy, — renders the arts essentially dissimilar, requiring for each its own inventive act.

§ 289. **Identity of Simple Machines.**

A simple machine is a machine composed of parts which are not, in themselves, complete machines. The idea which it embodies necessarily includes the subordinate ideas of a force, an object, and a mode of application; but the inventive act by which it is created usually relates only to the latter, and in such cases the concrete machine expresses that idea alone. Still there may be machines which generate the force that they apply, and others, possibly, which represent the specific application of a specific force to a specific object. These would be, however, rather arts than mere machines, involving the invention of something more than the mechanical apparatus by which the force and object were connected, and never could be fully covered by a patent for the instrument employed, unless by that instrument alone the force could be united with its object. But to whichever of these classes an individual machine belongs, it may be properly considered as a mode of operation embodied in tangible materials, and its essential characteristics are those by which it is enabled to perform its functions according to the structural law imposed on it by its inventor. To ascertain these it is only necessary to exclude from contemplation every part of the machine which is not indispensable to the performance of its functions, and by observing what remains in actual operation, determine at once the number and the nature of its integral parts, and the attributes and limitations of its structural law.

§ 290. Identity of Simple Machines Determined by Identity of Essential Parts and of Structural Laws.

Practically difficult as the comparison of two machines may be, even to persons who possess the widest experience and the highest industrial skill, the rules which govern this comparison and its results are easily intelligible. The first subject for examination is the function of each machine, and if diversity be here discovered the conclusion that the two machines are not the same becomes inevitable.¹ If their functions prove to be identical two points remain to be considered; the number and the nature of their essential parts, and the character of their respective structural laws. If the integral parts of each are interchangeable with those of the other without disturbance of its functions, these parts are mere equivalents, and therefore legally identical; and being thus identical, if each essential part of each machine performs its office in the same order and direction and degree as its equivalent in the other, the structural law of each must also be the same.² The

§ 290. ¹ In *Gottfried v. The Phillip Best Brewing Co.* (1879), 17 O. G. 675, Dyer, J.: (684) "In *Rice v. Heald* (13 Pac. L. R. 34), the court said that no machine can be an anticipation of the patented invention which could not be made to produce, without altering its construction, substantially the same results as were produced by the patented machine. Any prior machine which would not produce substantially the same results as the one patented could not be substantially the same machine, no matter how strongly the prior machine may resemble the patented machine in its construction." 5 Bann. & A. 4 (34).

Further, that difference of function or effect indicates substantial difference in the machines, see *Barber v. Hallett* (1879), 20 O. G. 449; 10 Fed. Rep. 130; *Johnson v. Root* (1858), 1 Fisher, 351; *Brooks v. Bicknell* (1844), 3 McLean, 432.

That differences in the excellence, rapidity, or economy of the action of

two machines may denote essential differences in their real character, see *Gallahue v. Butterfield* (1872), 2 O. G. 645; 10 Blatch. 232; 6 Fisher, 203; *Seymour v. Marsh* (1872), 6 Fisher, 115; 9 Phila. 380; 2 O. G. 675; *Johnson v. Root* (1858), 1 Fisher, 351.

That whether the new result arises from a change in the parts of the machines, or in their mode of operation, it still indicates substantial difference in the machines, see *Cornell v. Downer & Bemis Brewing Co.* (1877), 7 Bissell, 346; 11 O. G. 331; 2 Bann. & A. 514; *Turrill v. Illinois Central R. R. Co.* (1867), 3 Bissell, 66; 3 Fisher, 330.

But that the new result must be produced by changes in the machine itself, not by mere difference in its mode of use, see *Boston Elastic Fabrics Co. v. East Hampton Rubber Thread Co.* (1874), Holmes, 372; 5 O. G. 696; 1 Bann. & A. 222.

² That where the same or equivalent parts operate in the same manner in the two machines to produce the same ef-

determination of either of these points assists in the decision of the other. Where two machines, the integral parts of each of which are equivalents for those of the other, perform the same function, it is measurably certain that the structural laws of both will be the same; and conversely, when two machines perform the same functions and are governed by the same structural law, their integral parts are almost always, if not always, interchangeable, however widely they appear to differ from each other.

§ 291. Identity of Combination Machines.

A compound machine consists of two or more simple machines united under a co-operative law. Its identity is conditioned upon the employment of the same elemental machines in the same co-operative union, with the same function and the same ultimate effect.¹ Hence, the withdrawal of any one of these constituent machines, or the substitution for it of another which is not its true equivalent, or an alteration in it which changes its essential character as an operative means, or the addition of a new subordinate machine, — destroys the former combination and creates another and a different ma-

fect, the two machines are the same, see *Holly v. Vergennes Mach. Co.* (1880), 4 Fed. Rep. 74; 18 Blatch. 327; 18 O. G. 1177; *Blanchard v. Puttman* (1867), 3 Fisher, 186; 2 Bond, 84; *Cahoon v. Ring* (1859), 1 Fisher, 397; 1 Clifford, 592; *Sickels v. Borden* (1856), 3 Blatch. 535; *Foss v. Herbert* (1856), 1 Bissell, 121; 2 Fisher, 31; *Blanchard v. Beers* (1852), 2 Blatch. 411; *Parker v. Stiles* (1849), 5 McLean, 44; *Brooks v. Bicknell* (1844), 3 McLean, 432.

On the contrary, that a substantial difference, either in structure or in mode of operation, shows that the two machines are essentially distinct, see *Stebbins Hydraulic Elevator Mfg. Co. v. Stebbins* (1880), 17 O. G. 1348; 4 Fed. Rep. 445; *Wicke v. Ostrum* (1880), 103 U. S. 461; 19 O. G. 837; *Clarke Patent Steam & Fire Regulator Co. v.*

Copeland (1862), 2 Fisher, 221; *Tatham v. Le Roy* (1852), 2 Blatch. 474.

§ 291. ¹ That a machine combination is the same when it embodies the same idea, though it be different to the eye, see *Smith v. Higgins* (1859), 1 Fisher, 537.

See also §§ 173–175, 178, 179, and notes, *ante*.

That where the elements, their function, mode of operation, and result remain the same, no change in form or proportion can change the essence of the combination, see *Storrs v. Howe* (1876), 4 Clifford, 388; 10 O. G. 421; 2 Bann. & A. 420; *Case v. Brown* (1864), 2 Wall. 320; *Howe v. Williams* (1863), 2 Fisher, 395; 2 Clifford, 245; *Foss v. Herbert* (1856), 2 Fisher, 31; 1 Bissell, 121; *Winans v. Denmead* (1853), 15 How. 330; *O'Reilly v. Morse* (1853), 15 How. 62.

chine. So also when, although the elements remain the same in substance, their rearrangement or some formal variation in themselves disturbs their previous relations to each other, and thus introduces a new co-operative law; or where, if this can be mechanically possible, with unchanged elements and the same co-operative law the combination as a whole assumes a different character and performs different functions or the same functions in a different manner, the conditions of identity are defeated and the combination is itself destroyed.

§ 292. Identity of Combination Machines Determined by Comparing their Elements, Co-operative Laws, and Essential Attributes.

In comparing two compound machines whose functions are identical, the mode of operation of each combination as a whole is first to be examined. If these are found to be the same, the elements of each and their co-operative laws are next to be considered. If one embraces more constituent machines than does the other, or if their elements are not equivalent according to the rule which governs these in combinations, or if the influence which each exerts upon the rest in one is not the same which it exerts upon them in the other, whether this difference results from differences in the size, capacity, material, or arrangement of the elements themselves, the two machines are not identical.

§ 293. Identity of Simple Manufactures.

A manufacture is any instrument other than a machine, a composition of matter, or a design. It may be either simple or compound. If it is simple, the parts of which it is composed, although each in its separate state may be a complete and operative instrument, lose their identity of character and function when united in the manufacture, and exist only as integral members of its one idea of means.¹ In a simple manu-

¹ § 293. This attribute of a simple manufacture has sometimes been overlooked by the courts, and patentability thus denied to meritorious inventions on the ground that the parts of which they were composed did not coact in the production of a unitary result. It cannot be assumed that every assemblage of parts, even though each part in its separate state be an operative means,

facture, therefore, no qualities are essential except those without which the idea of means embodied in it could not be expressed; and the presence of these qualities is often found consistent with the widest diversities in shape, size, capacity, arrangement, and materials, as well as in the method of its use and the perfection with which it accomplishes its results. The exclusion of these merely formal variations, and the consequent reduction of the concrete instrument to its necessary attributes, at once determines its real character and defines the scope of the inventive act from which it sprang.

§ 294. **Identity of Simple Manufactures: Manufacture generally a "Mode of Application."**

Although the inventor of a manufacture must necessarily have conceived the three ideas of force, of mode of application, and of object, yet rarely, if ever, does his complete invention represent a new idea of either force or object. A true manufacture is generally, perhaps always, a mere mode of application. The force which it applies is derived from sources exterior to itself, and may be independently varied, both in character and quantity, without affecting the nature of the instrument through which it operates. The objects upon which its functions are performed also lie outside the scope of the invention, and however they may differ among themselves, neither require nor indicate a change in the essential attributes of the instrument to which they are subjected.

purports to be a combination; and hence that it is not to be regarded as a true invention unless it endures the tests applied to patentable combinations. Where the several parts still perform their individual functions, the union constitutes either a combination or an aggregation; the former if they co-operate; the latter if their operation is several and distinct. But where the different parts cease, when united, to perform their individual functions, and become merged in the manufacture as a whole, the patentability of the instrument is not to be judged by the rules governing

combinations but by the novelty and utility of the instrument itself and the inventive skill employed in its production. The arrangement of numerous tools upon a single handle may thus be an invention, if new and useful and resulting from inventive skill, though no two of the tools can be used at once or for the same purpose, — the real invention consisting, not in the "combination of functions," but in the shape or proportions of the handle, and the mode in which the tools are located thereon.

When an inventor has discovered that specific forces may be made available through a specific instrument, or that the qualities of a specific object render it susceptible to certain forces when applied through a specific article, his real invention is an art, not a mere manufacture, by whatever name he may himself entitle or describe it. If his instrument is old, its new use does not change its nature nor endow it with new properties; if it is new, his use of it is one invention and the instrument itself another, unless the use and instrument are so related that by no other instrument the same use could be served.

§ 295. Identity of Simple Manufactures : Danger of Being Misled by Diversity of Use.

In comparing simple manufactures with each other, care, therefore, must especially be taken lest the examiner be misled by a diversity of use, as well as by the formal differences which the two instruments present. All manufactures are identical which, when used in connection with the same force and in reference to the same object, produce the same effect upon the object by the same method of applying the force. That one is customarily employed upon a different class of objects, or as a medium for a different class of forces, from the other indicates no essential distinction between them, if without alteration in the instrument itself, or by mere formal variations in its size, capacity, or other attributes, each could employ the forces and perform the functions usually regarded as peculiar to the other. Beneath these accidents of tangible embodiment always lies the substance of the invention, — that idea among whose essential characteristics nothing is embraced which is not indispensable to the production of the desired effect through this specific method of applying force. And while this principle is as correct and true in reference to machines as to manufactures, yet in considering the latter it should be particularly remembered, since, being not only mere modes of application but also destitute of structural law, they are of wider scope than any other class of instruments, having the fewest necessary attributes, and consequently are most liable to be mistaken for each other.

§ 296. Identity of Simple Manufactures Determined by Comparing their Integral Parts.

Whenever, having reconciled these differences of customary use and excluded formal variations, the functions of two simple manufactures are perceived to be the same, their identity or diversity may be determined by comparing their integral parts and the office which they fill in each invention. This comparison consists principally in an application of the doctrine of equivalents. If the integral parts of each instrument are the equivalents of those which constitute the other, the instruments themselves must be the same. A simple manufacture is either a single substance, or a group of substances whose members are so collocated that the whole is capable of being used for certain purposes, according to the will of its employer. Having no *modus operandi*, no intrinsic structural law, its identity resides solely in those qualities of its constituent substances which are involved in the performance of their functions, and which have been so brought together in the invention as to unite in the one quality or set of qualities by which its ultimate effects are produced. Hence when a manufacture is composed of a single substance, any other substance having the same qualities is its equivalent and constitutes the same invention. And in a group of substances, any change which removes some of its constituent members and replaces them with others, manifesting in the same collocation the same operative attributes, is a mere substitution of equivalents, and leaves the individuality of the invention undisturbed. When the apparent differences between two manufactures can be thus accounted for, their identity may be regarded as established.

§ 297. Identity of Simple Manufactures: Slight Differences Important.

Where each of the two manufactures consists of a single substance, diversities, otherwise formal, are sometimes of the most essential character. In such cases the idea itself may be, and often is, expressed by the mere shape given to the substance by the inventor, or by the proportions of one part to another, or even by the nature or the quality of the ma-

terials of which it is composed. Slight differences in these respects may thus indicate an entire difference in the method of applying force, and hence a radical distinction between the two inventions. In a less, but still a great, degree this is true of simple manufactures composed of several substances. As these, when united, constitute, for nearly all the purposes of the complete invention, but a single substance, the method in which they perform their functions usually depends, to a considerable extent, on their possession of those qualities which, in most other species of inventions, are regarded as pertaining not to substance but to form.

§ 298. **Identity of Combination Manufactures.**

A compound manufacture consists of two or more simple manufactures united under a co-operative law. Practically, most manufactures, however simple in appearance, are really combinations, — each elemental instrument preserving in the compound instrument its distinctive character and performing its distinctive function, though co-operating with the others in producing the common result. The identity of such a combination resides in the identity of the simple manufactures of which it consists, in the identity of its co-operative law, and in the identity of the resultant qualities inhering in the combination as a whole. Hence, as in other combinations, the withdrawal or substantial alteration of any one of its constituent elements, or the addition of an element which introduces a new function or performs the old by operations essentially distinct from those by which it has been previously accomplished, or the rearrangement of existing elements under a different co-operative law, or any variation in the combination as a whole which changes its method of applying force to the common object, is fatal to its identity, and brings into existence a different invention.

§ 299. **Identity of Combination Manufactures : Determined by Comparing their Elements, Co-operative Laws, and Essential Attributes.**

The comparison of two manufactures, each of which is a combination performing the same functions by the same

method of applying force, requires, first, an examination of their elemental manufactures; and second, the detection of their co-operative laws. To analyze a compound manufacture, and distinguish its essential elements from one another, is a task often attended with much difficulty; partly because so many manufactures, apparently the most simple, are in reality combinations; partly because its individual elements, being characterized by no inherent *modus operandi*, or structural law, depend for their identity upon the presence of qualities which as to other species of inventions would be merely formal. An equal difficulty is experienced in the endeavor to discover their co-operative law. When several arts or machines are brought together and set in operation by the application of the impelling force, it is generally easy to determine whether each performs only its appropriate function according to its own interior law, or whether in addition it so influences the action of the others that new modes of operation and new functions are created. But in a manufacture not only the impelling force but the directing law lies outside of the instrument itself; and the true question is not simply whether, when employed in one mode or for one purpose, the different elements coact upon each other or their common object, but whether they are capable of any use in which this mutual co-operation is developed. In other words, whether a manufacture composed of other manufactures is a true combination, or a mere aggregation having no co-operative law, is not to be decided by the mere inspection of the instrument itself, either when idle or employed in one or more especial occupations, but by referring it to all the uses of which it is capable, and ascertaining if in any one of these the instrument, though as to all the others destitute of a co-operative law, is as to this a unit or a simple aggregation. But when these difficulties are removed, the comparison of two compound manufactures is readily accomplished. If all the elements in each are the equivalents of those in the other, and are so arranged in each as to be subject to the same co-operative law, the manufactures are the same, not otherwise. And here, as elsewhere, the inference is almost irresistible that, given the same elements and the same characteristics in each combination taken as a

whole, the methods of interior co-operation are the same ; and on the other hand, that where the combinations exhibit the same methods of applying force, and their constituent elements are under the control of the same co-operative law, the elements themselves must be identical.¹

§ 300. Identity of Compositions : Compositions Governed by Peculiar Rules.

A composition of matter, though generally regarded as a combination, is governed by rules peculiar to itself. It is composed of ingredients each of which, in its separate state, is an operative means, and its own properties are the result of the co-operation of these elemental means upon each other and upon the objects to which, while united in the composition, they may be applied. But when thus intermingled, the individuality of these constituent elements, though not so far destroyed as to be irrecoverable by mechanical or chemical analysis, is in most cases removed from human observation, and it becomes impossible to ascertain whether, while in the composition, each ingredient operates according to its individual law, and in addition thereto performs new functions in connection with, or in consequence of its association to, the others, or whether its entire original properties are for the time being lost, and the new composition thus becomes a simple substance endowed with properties resulting from the mixture of these separate elements in one. While, therefore, since a composition of matter is formed by uniting certain existing well-known elements which in themselves are operative means, the rules which govern it must in some respects resemble those controlling ordinary combinations ; in others, on account of the impossibility of pushing any method of analysis far enough to determine the real character of its constituent elements or the true mode of their co-operation with each other in the composition, these rules are similar to those which are applied to simple arts and instruments.¹

§ 299. ¹ See § 184-189, and notes, *ante*, as to the various points involved in the identity of simple and combination manufactures.

§ 300. ¹ See §§ 192-195, 254, 282, and notes, *ante*.

§ 301. Identity of Compositions Depends on Identity of Elements, of Co-operative Laws, and of Essential Attributes.

A composition of matter is a force applied. The existence of this force depends upon the union and co-operation of certain other forces which are manifested through the properties of the individual ingredients. The inventive act by which the composition is created thus consists in the discovery of the ability of these elemental forces to unite in the production of the new force, and the contrivance of such a method of commingling them as will develop the new force desired. The scope of this inventive act indicates the scope of the invention. The invention is not the resulting composition alone, without reference to the ingredients from which it is compounded or to the method of their intermixture. Nor is it solely the group of elements, without regard to the mode by which they are united or the characteristics of the substance in which they result. Nor is it the mere process of commingling, apart from the ingredients employed and the nature of the compound thus produced. The invention is a substance possessing certain properties and formed by uniting certain other substances in a peculiar manner. Its identity depends upon the identity of its constituent elements, upon the identity of their co-operative law, and upon the identity of the properties exhibited in the composition as a whole.¹ In this respect it

§ 301. ¹ That where one composition of matter contains ingredients which are neither present nor represented by equivalents in the other, the two are essentially different, see *Rogers v. Ennis* (1878), 14 O. G. 601; 15 Blatch. 47; *Tarr v. Folsom* (1874), 1 Bann. & A. 24; 5 O. G. 92; *Holmes*, 312.

But that the absence from one of substances which are included in the other, but perform therein no ingredient function, does not make the compositions distinct, see *Klein v. Russell* (1873), 19 Wall. 433.

That though the substances of which two compositions are composed are different in themselves, yet if they serve the same purposes in the two compositions, the compositions may be the

same, see *Francis v. Mellor* (1871), 5 Fisher, 153; 1 O. G. 48.

That a composition of matter consisting of certain substances of a given quality, intermixed in a specific manner and possessing certain properties, is not identical with a composition formed of the same ingredients without reference to quality or mode of intermixture, and not possessing the same properties, see *Muntz v. Foster* (1843), 2 Web. 93, 96.

That where the same or equivalent ingredients are united under the same co-operative law, and the resulting compositions have the same properties, these compositions are the same, see *Goodyear v. Berry* (1868), 2 Bond, 189; 3 Fisher, 439.

See also § 196, and notes, *ante*.

resembles a true combination; and like other combinations, its identity is lost by the removal or substantial change of any of its elements, or by the introduction of a new ingredient which calls into activity some elemental force hitherto absent or inoperative, or by the union of its present elements under a new co-operative law.

§ 302. Identity of Compositions: Identity of Elements Assumed when their Functions are Identical.

But when the question of the identity of its constituent elements and of their co-operative law arises, the rule of combinations can be no longer strictly followed. Elements of a combination are identical only when, in their individual character, they are the same operative means; not merely furnishing to the combination the same subordinate function, but performing this by the same mode of operation. But in a composition of matter such a test is not always practicable. In some mechanical compositions, the individuality of whose ingredients is not wholly obscured, and which on that account might more properly be regarded as manufactures than compositions, the method in which each ingredient performs its office in the combination is discernible; and in such cases the identity of their constituent elements depends both on identity of function and identity of means. In other mechanical and all chemical compositions, however, the individuality of the ingredients is lost, and though it may be known that each ingredient furnishes to the compound a specific elemental force, the essential character of the ingredient as an operative means, and the method by which it performs its functions in the combination, may be entirely undiscernible. In cases of this character, the rule that elements are to be regarded as the same only when they serve the same purpose in the combination, by the same method of applying force, would be both useless and unreasonable. The law requires no further certainty than science can afford, and when no evidence of the identity of two ingredients can be obtained, except that they perform the same function in the composition, this evidence is accepted as sufficient and the ingredients are held to be the same. The doctrine of equivalents, in reference

to compositions of matter, thus differs according to the nature of the composition and the state of scientific knowledge. In compositions, where the mode in which the individual ingredients furnish to the composition the required elemental force is ascertainable, equivalence is determined by the rule which governs other combinations; otherwise, the rule followed is that applied to simple arts and instruments, and all ingredients are equivalents which, at the date of the patent, were known as possessing properties that in the given composition make them interchangeable.¹

§ 303. Identity of Compositions : Identity of Co-operative Laws Assumed when Effect of Combining Elements is Identical.

The same diversity of rule obtains in reference to their co-operative law. In compositions where the mode of action of the individual ingredients can be detected after their union in the combination, the law of their co-operation is also usually perceptible and can be considered as an independent factor in determining the identity of the composition as a whole. But in those compositions where the individuality of the ingredients vanishes in the intermixture, and their mode of action can be ascertained only through the functions they perform, nothing is able to be known concerning their co-operative law, except that when grouped in a certain manner they will co-operate in the production of a given result; and the co-operative law must therefore be regarded as the same in every grouping of the same ingredients which manifests the same resultant force. In compositions of the former class, although the ingredients remain unchanged and the entire composition still possesses the same properties, by some change in the

§ 302. ¹ That one ingredient in a chemical combination is the equivalent of another when each fulfils the same office in the combination, and was known as such at the date of the patent, see *Bridgeport Wood Finishing Co. v. Hooper* (1880), 5 Fed. Rep. 63; 18 Blatch. 459; 20 O. G. 156; *Wonson v. Gilman* (1877), 2 Bann. & A. 590; 11 O. G. 1011; *Roots v. Hyndman* (1873), 6 Fisher, 439; 4 O. G. 29; *Woodward v. Morrison* (1872), 2 O. G. 120; Holmes, 124; 5 Fisher, 357; *Rumford Chemical Works v. Lauer* (1872), 10 Blatch. 122; 5 Fisher, 615; 3 O. G. 349; *Poppenhusen v. Falke* (1862), 2 Fisher, 213; 5 Blatch. 46; *Matthews v. Skates* (1860), 1 Fisher, 602; *Goodyear v. The Railroad* (1853), 2 Wall. Jr. 356; 1 Fisher, 628.

processes of intermixture a variation may take place in their co-operative law, and a new composition thus be substituted for the old. But in the latter class no alteration in the method of co-operation can be contemplated. Though possible, it is not practically ascertainable, and therefore is regarded as impassible; and hence no change in the proportions of ingredients or in their mode of union can disturb the identity of the composition as a whole, while its resultant properties remain unchanged.

§ 304. **Identity of Compositions Determined by Comparing their Elements, Co-operative Laws, and Essential Attributes.**

In comparing one composition of matter with another, inquiry is first directed to the characteristic properties of each composition as a whole. If these are found to differ the compositions are of course distinct; when they are the same the question as to the identity of their constituent elements is next considered. If the two compositions are of such a character that the mode in which their individual ingredients perform their several functions is discernible, the elements of each are identical with those of the other only when their action and effect are both the same. But in compositions of a different character, the mode of action of their elements being undiscernible, these elements are regarded as identical if known as interchangeable without affecting the essential properties of the entire composition. When the ingredients of both compositions prove to be the same, their co-operative laws are then to be compared. Ingredients and result being identical, a variation here becomes improbable, but cannot be regarded as impossible except in compositions where if it exists it must be undiscoverable, and where on that account its identity is conclusively presumed from the identity of the ingredients and their result. If the ingredients coact in different methods through differences in proportions or in modes of intermixture, a difference in the character of the inventive act is indicated, and the two compositions are two separate inventions. But if, either through research in the former cases or through presumption in the latter, the co-operative laws of both compositions are shown

to be identical, the identity of the two compositions is established.

§ 303. Identity of Designs: Designs Subject to Peculiar Rules.

A design is also subject to peculiar rules. The ultimate end proposed by its inventor is the production of a certain impression on the mind through the eye. The proximate end, or function, is the formation on the retina of a certain image. The means employed is such a configuration or ornamentation, imparted to an exterior physical substance, as will reflect light in a certain manner and thus produce the desired image in the eye.¹ In this species of invention there is no room for variety either in the end, the function, or the means. Every configuration, every ornament, which can perform the function, necessarily performs it by precisely the same mode of operation. No matter how diverse in details or arrangement the design may be, if it produces the same image on the retina it does so by directing light upon it in exactly the same manner; and nothing is essential to the performance of its functions except those attributes by which the required directions and reflections of the rays of light can be produced. All variations in a design are, therefore, merely formal, unless they change its character as a director and reflector of light, — that is, unless they change the image which it forms within the eye;² and hence the function and the means become the exact measures of each other, neither being capable of alteration without a corresponding alteration in the other, and the identity of one establishing the identity of the other. Furthermore, the image formed upon the retina becomes known only through the impression thereby made upon the mind; and thus the ultimate effect becomes the measure of the function, as the function is the measure of the means. Whatever, then, may be the intrinsic attributes of the shape

§ 305. ¹ That a design is the appearance imparted to a substance, and is distinct from the means by which such appearance is produced, see *Gorham Mfg. Co. v. White* (1871), 14 Wall. 511; 2 O. G. 592; 6 Fisher, 94; and cases cited under §§ 201, 203, *ante*.

² That designs may be identical though their elements differ, see *Ex parte Pope* (1883), 25 O. G. 290.

That a slight variation in a design does not destroy its identity, see *Lehnbeuter v. Holthaus* (1882), 105 U. S. 94; 21 O. G. 1783.

given to the object to which the design adheres, the essential character of the design itself can be determined only by examining its ultimate effect, and the sole test of its identity thus resides in the impression which it makes upon the mind.

§ 306. Identity of Designs Determined by Comparing their Effect on the Minds of Observers.

In consequence of these peculiarities, whenever two designs are to be compared, the first duty of the observer is to disregard all those particulars of the invention which, in other species, he considers most important. Neither the elements of the design nor their co-operative law, not even their functions, occupy his thoughts. Excluding those, his attention is directed to their ultimate effects alone, and these are studied as the design produces them, not merely in his own mind but within the minds of others,—a task of some uncertainty, but still the only mode to be pursued.¹ If in this method, he dis-

§ 306. ¹ In *Foster v. Crossin* (1885), 23 Fed. Rep. 400, Carpenter, J. : (402) "Design, of course, relates solely to the appearance of the article to the ordinary purchaser, and when the question is whether a difference of design be substantial and valuable, surely there can be no test better than the practical test which is furnished by observing the effect of the two designs on the appreciating observation of the purchasing public."

In *Tomkinson v. Willets Mfg. Co.* (1884), 23 Fed. Rep. 895, Coxe, J. : (896) : "It is by no means necessary that the patented thing should be copied in every particular. If the infringing design has the same general appearance, if the variations are slight, if to the eye of an ordinary person the two are substantially similar, it is enough. It is of no consequence that persons skilled in the art are able to detect differences. Those who have devoted time and study to the subject, who have spent their lives in dealing in articles similar to those in controversy,

may see at a glance features which are wholly unimportant, and unobserved by those whose pursuits are in other directions, and who are attracted only by general appearances. If the resemblance is such that a purchaser would be deceived, it will not aid the infringer to show that he has deviated slightly from a straight line in one place, and from a curved line in another, or that he has added or omitted something which an expert can discover." 32 O. G. 382 (383) ; 31 O. G. 918 (918).

In *Dryfoos v. Friedman* (1884), 18 Fed. Rep. 824, Wheeler, J. : (826) "As this patent, as before mentioned, does not cover the patterns, the improvements would consist in the design of the arrangement of them on the fabric, advantageously to be divided, for the fabric was not intended for use whole, but only by cutting the patterns apart. The spaces for seams and lines in them to divide by were prominent and important. The appearance of the pieces of fabric, with and without these spaces and lines, might be so nearly the same

covers that the impressions made by the inventions are substantially distinct, the inventions must essentially differ from each other. If, on the contrary, the impressions are the same, the conclusion is inevitable that the inventions are identical.

§ 307. Identity of Improvements: Depends partly on the Character of the Original Invention.

Hitherto we have discussed this question of identity only in reference to generic inventions, — to arts, machines, manufactures, compositions, and designs, which are wholly new or wholly old. Compared with the entire body of inventions these are practically few in number, most inventions being superstructures raised on old foundations, improvements made upon existing means. In these the concrete art or instrument embodies both the old and the new idea of means, the old originating in the inventive act by which the generic invention

that the difference would not attract the attention of a disinterested observer, but it would at once be noticeable to ordinary purchasers or users of such material. The differences in designs necessary to take away their identity in law are understood to be such appearances as would attract the attention of an ordinary observer, giving such attention as a purchaser usually gives. *Gorham Co. v. White*, 14 Wall. 511. This, of course, means purchasers of the articles in question for the purposes for which they were intended and are purchased. A purchaser of these fabrics would ordinarily be a person intending to cut them up and make them into skirts or sell them to others to make into skirts. A purchaser of ordinary observation with that intention would notice at once these prominent facilities for accomplishing those purposes. To such a person the design patented and that used by the defendant would be quite different." 21 Blatch. 563 (565).

That two designs are identical when they present the same appearance to the

eyes of ordinary observers, no matter what may be their differences of detail, see *Dobson v. Dornan* (1886), 118 U. S. 10; 35 O. G. 750; *Untermeyer v. Jeannot* (1884), 20 Fed. Rep. 503; *Jennings v. Kibbe* (1882), 22 O. G. 331; 10 Fed. Rep. 669; 20 Blatch. 353; *Wood v. Dolby* (1881), 7 Fed. Rep. 475; 19 Blatch. 214; 20 O. G. 523; *Miller v. Smith* (1880), 5 Fed. Rep. 359; 18 O. G. 1047; *Cone v. Morgan Envelope Co.* (1879), 4 Bann. & A. 107; *Perry v. Starrett* (1878), 3 Bann. & A. 485; 14 O. G. 599; *McCrea v. Holdsworth* (1870), L. R. 6 Ch. Ap. 418. See also §§ 201-207, and notes, *ante*.

That the court may determine the identity of designs by inspection, see *Western Electric Mfg. Co. v. Odell* (1883), 18 Fed. Rep. 321; *Jennings v. Kibbe* (1882), 22 O. G. 321; 10 Fed. Rep. 669; 20 Blatch. 353.

§ 307. ¹ In *Mills v. Scott* (1849), 6 U. C. Q. B. 205, *Robinson, C. J.* (206) defines an improvement as "an improvement in the principle of something which had before been patented."

was created, the new developed from the old by a subsequent exercise of inventive skill.¹ To place before the mind the exact limits of the inventive act by which the later idea was evolved, and thence to ascertain its nature and identity, it thus becomes essential to determine the true character and scope of the original invention, as it stood at the date of this later exercise of the inventor's powers.

§ 308. Identity of Improvements; Whole State of the Art to be Considered.

To ascertain the extent to which the fundamental idea of the invention was developed before this later forward step was taken requires a knowledge of the whole state of the art to which the invention belongs. The inventor of an improvement must be assumed to have possessed this knowledge, and to have contemplated from the point of view afforded by it, not only the end to be accomplished, but the function and the mode of operation of his means. From the same point of view must the examiner consider the improvement, if he would comprehend its purpose and its character, and accurately define the place it fills in the development of the industrial art in which it is embraced.

§ 309. Identity of Improvements: Improvements of Two Classes: in the Means as a Whole; in its Integral Parts.

The end proposed by the inventor of an improvement may reside either in the ultimate effect produced by the invention on its object, or in the method by which the invention operates in the attainment of its usual results. When he endeavors to produce a better ultimate result, all changes which he introduces into the function or the mode of operation of the old invention relate to his development of the idea of means, and if not merely formal, represent his new improvement. When he endeavors to produce the same result in a more economical or speedy manner, all changes in the function or the mode of operation of the old invention are included in the end, and only those alterations in the invention by which these changes in the function or the mode of operation are effected are embraced in his idea of means. Thus in

regard to all generic arts and instruments, two fields for improvement are open to inventors: in one of which the whole idea of the original invention is carried forward, resulting in a wider or more perfect ultimate effect; in the other some subordinate idea alone is developed, creating not a change in the condition of the product, but a change in the condition of the means.¹ To one of these two classes all improvements must belong, and the first step in ascertaining the real character of an improvement is to refer it to its proper class, and thus determine the true scope of its idea of means.

§ 310. Identity of Improvements: Distinctions between Substance and Form.

The end proposed by the inventor of an improvement being ascertained, the examiner should next attempt to discover the essential attributes of his invention, and to distinguish that which is included in its substance from that which relates only to its form. The principle of distinction is the same here as elsewhere. Whatever qualities of the invention are indispensable to the attainment of its end, according to the method of attainment conceived by its inventor, are included in its essence. If he accomplishes a better ultimate effect, every change in the function or the mode of operation which is necessary to the fulfilment of his purpose as he endeavors to fulfil it belongs to the substance of his invention, and the sum of all these changes constitutes his improvement. If he achieves merely a speedier or cheaper mode of operation in the means, only those changes in the details of the art or instrument which are essential to its operation in the speedier or cheaper mode are of the substance of his invention. Hence if two separate inventors, each attempting to produce the same change in the ultimate effect, accomplish it by introducing different changes into the function or the mode of operation of the original means, although both are improvements in the same art or instrument and both improvements fulfil the same purpose, yet as improvements they are separate

§ 309. ¹ That an improvement may be made in the structure of an invention as well as in its entire operation, see *Sinclair v. Backus* (1880), 17 O. G. 1503; 4 Fed. Rep. 539; 5 Bann. & A. 81.

inventions. Hence, also, when two variations in the same integral parts, or in the arrangement of integral parts, increase the speed or the economy of the original means, they will be different inventions unless the variations are substantially the same.

§ 311. Identity of Improvements: Improvements how Effected; not Mere Diversities of Use.

The nature of the variations by which an improvement is effected depends upon the species of invention to which the original belongs. An improvement in an art consists in some change in the act or acts of which it is composed, or in the order in which they are performed. Improvements in a simple instrument are made by altering the shape, size, or material of its integral parts, or by a rearrangement of such parts among themselves.¹ Improvements in a compound instrument are introduced by modifying its constituent elements or their co-operative law.² But in examining these changes as they are produced in any species of inventions, its fundamental character, as determined by that one or more of its subordinate factors on which the inventive act that gave it birth was exercised, must never be forgotten. To whatever species it belongs, a mode of application cannot be improved by adopting it as the connecting link between another force and object, nor is a force applied improved by a mere change of objects. If these new uses are the fruit of an inventive act and thus escape the limits of a double use, they become new and independent means, and not mere improvements in the means employed. Inventions are improved only by a

§ 311. ¹ That an improvement may be made in a machine by merely altering the shape of one or more of its parts, see *Williams v. Barker* (1880), 18 O. G. 243; 2 Fed. Rep. 649.

² That an improvement may be made in a combination by changing the shape or capacity of the elements, or modifying their arrangement, see *Sharp v. Tift* (1880), 17 O. G. 1282; 2 Fed. Rep. 697; 18 Blatch. 132; 5 Bann. & A. 399; *Whitney v. Emmett* (1831),

Baldwin, 303; 1 *Robb*, 567; *Foxwell v. Bostock* (1864), 12 W. R. 723; 10 L. T. Rep. N. S. 144.

But that if any change is made either in the essential character of the elements or in their co-operative law, the result is not an improvement, but a new combination, see *Bliss v. City of Brooklyn* (1873), 3 O. G. 269; 10 Blatch. 521; 6 *Fisher*, 289; *Hale v. Stimpson* (1865), 2 *Fisher*, 565.

development of the original idea of means, — that is, by carrying forward the same inventive act from which the original invention sprang; and this occurs only when the process of discovery is further exercised upon the same subordinate factor, whether it be the force, the object, or the mode of application.

§ 312. Identity of Improvements: Character of an Improvement Depends on the Nature and Effect of the Variation in the Old Invention.

The character of an improvement, as an invention, is thus determined by the nature of the variations which produce it when viewed in their relations to the end proposed. A variation in the acts or in their order in an art, affecting only its own mode of operation, is not the same improvement as a variation producing better ultimate effects, however nearly the two variations may resemble one another. And changes in an instrument whereby simply the speed or cheapness of its action is increased, though differing but slightly from the changes which enable it to furnish better products, are not the same improvement as that by which the latter object is attained. This distinction is but another application of the axiom that different effects can only be produced by different means.

§ 313. Identity of Improvements Determined by Comparing their Classes, their Mode of Operation, and their Effect.

Wherefore, in comparing two improvements on the same original invention, the first point for investigation is the class to which they severally belong. If they are of different classes, contemplating and achieving different ends, — the one securing a better ultimate effect, the other only a better mode of operation in the means, — the improvements must necessarily be distinct. If they are of the same class, the precise effect produced by each is then to be considered; for though both are directed toward the ultimate result or toward the mode of operation of the means, the changes which they accomplish in either may be different, and thus a true diversity of ends may still exist, proving a true diversity of means. When in this respect also

the improvements coincide, the variations which they introduce into the idea of the original invention, so far as these are necessary to the fulfilment of their common purpose, require attention, and if these variations are in each substantially the same, the improvements are to be regarded as identical.¹

§ 314. **Identity of Inventions Practically a Subject of Great Difficulty.**

The duty of determining the identity or the diversity of inventions, according to the principles discussed in this and the foregoing sections, pertains rather to the expert than to the lawyer or the judge; still, neither judge nor lawyer can properly discharge the functions of his office in connection with inventions unless his own industrial skill and knowledge are sufficient to enable him to understand and follow the inquiries and reasonings of experts, and argue or decide intelligently upon their conclusions. This is the region where nearly all the difficulties of the subject are encountered. It is the field in which originates the greater proportion of contested cases, and which furnishes perennial crops of new and puzzling questions as science and the arts advance together to subdue the earth. In the investigation of the novelty or relative priority of inventions, it proves often a veritable "Slough of Despond;" but when it is once safely crossed, and the identity of the competing arts or instruments is established, all other questions become comparatively easy and their solution definite and sure.¹

§ 313. ¹ That one improvement to an invention may not be identical with another though both produce the same effect, see *Otis Bros. Mfg. Co. v. Crane Bros. Mfg. Co.* (1886), 27 Fed. Rep. 550. See also as to improvements §§ 210-218, and notes, *ante*.

§ 314. ¹ In *Butterworth v. Hoe* (1884), 112 U. S. 50, Matthews, J.: (59) "The questions of fact arising in this field find their answers in every department of physical science, in every branch of mechanical art; the questions of law necessary to be applied in the

settlement of this class of public and private rights have founded a special branch of technical jurisprudence. The investigation of every claim presented involves the adjudication of disputed questions of fact, upon scientific or legal principles, and is, therefore, essentially judicial in its character, and requires the intelligent judgment of a trained body of skilled officials, expert in the various branches of science and art, learned in the history of invention, and proceeding by fixed rules to systematic conclusions."

SECTION VII.

OF THE NOVELTY OF INVENTIONS : PRIORITY : PRIOR USE.

§ 315. **Novelty, as between Identical Inventions, Determined by Priority.**

The identity of two inventions having been established, the legal novelty of either depends upon the state of public knowledge, at the date of its invention, concerning the existence and the nature of the other. If one existed in a manner accessible to the public when the other was invented, the latter is not new to the public, whatever it may be to the inventor;¹ and, on the other hand, though the earlier were a complete art or instrument at the date of the invention of the later, yet if it were concealed and inaccessible, so that the public had derived no benefit from its invention, the later, if first introduced to public use, becomes in reference to them a new invention, entitling the inventor from whom they receive it to a patent.

§ 316. **Priority Evidenced by Use, by Publication, and by Patent.**

The law has recognized three methods in which inventions may be made accessible to the public: by use, by publication, and by patent.¹ In each of these three methods it requires

§ 315. ¹ In *Patterson v. Gas Light & Coke Co.* (1877), L. R. 3 App. 239, Lord Blackburn : (244) "The consideration for a patent is the communication to the public of a process that is new. In *Hindmarch on Patents* (1st ed., 1846, p. 33) it is laid down that 'if the public once becomes possessed of an invention by any means whatever, no subsequent patent for it can be granted, either to the true or first inventor himself or any other person; for the public cannot be deprived of the right to use the invention, and a patentee of the invention could not give any consideration to the

public for the grant, the public already possessing everything that he could give.' This is, in my opinion, a correct statement of the law. It is not necessary that the invention should be used by the public as well as known to the public. If the invention and the mode in which it can be used has been made known to the public by a description in a work which has been publicly circulated, . . . or in a specification duly enrolled, . . . it avoids the patent, though it is not shown that it ever was actually put in use."

§ 316. ¹ In *Plimpton v. Malcolmson*

the presence of certain qualities before it will receive them as sufficient evidence of public knowledge. The use, the publi-

(1875), L. R. 3 Ch. 531, Jessel, M. R. : (556) "When you say a thing is known to the public and part of common knowledge, of course you do not mean that every individual member of the public knows it. That would be absurd. What is meant is that if it is a manufacture connected with a particular trade, the people in the trade shall know something about it; if it is a thing connected with a chemical invention, people conversant with chemistry shall know something about it. And it need not go so far as that. You need not show that the bulk, or even a large number, of those people know it. If a sufficient number know it, or if the communication is such that a sufficient number may be presumed, or assumed, to know it, that will do. Now how are they to know it? They are to know it by being told of it, or informed of it in some way. You may show that they knew it, by showing that the trade had commonly used it. That is the best evidence you can have. You may show the thing was known because it was used and brought into practice. . . . But you may show they knew it in another way, — that it was published or made known to the public. . . . How made known to the public? It has been held that if it is in a specification, certainly in a modern specification, which had been enrolled in the Patent Office, and not published besides, that will do. And it has also been held that, as a common rule, if the description has been printed in England, and published in England, in a book which circulates in England, that will do. But after all, it is a question of fact. The judge must decide, from the evidence brought before him, whether it has in fact been sufficiently published to come within the definition of being made known

within the realm. The cases cited [Househill Co. v. Neilson, 1 Web. 673; Stead v. Williams, 2 Web. 126; Stead v. Anderson, 2 Web. 147; Heurteloupe's Patent, 1 Web. 553; Lang v. Gisborne, 31 Beav. 133] may be rather used as illustrations of what will amount to sufficient evidence than as deciding anything in principle beyond this, that it must be sufficiently known." See also, *Muntz v. Foster* (1844), 2 Web. 96.

That under the patent laws of the United States there can be no prior knowledge of the invention except by use in this country, or by publication or by patent, see *Searls v. Bouton* (1882), 12 Fed. Rep. 140; 21 O. G. 1784; 20 Blatch. 426; *Judson v. Bradford* (1878), 3 Bann. & A. 539; 16 O. G. 171.

That mere knowledge without prior use, patent, or publication is no bar, see *Judson v. Bradford* (1878), 3 Bann. & A. 539; 16 O. G. 171.

That prior use in this country will bar a patent, see *Kelleher v. Darling* (1878), 4 Clifford, 424; 14 O. G. 673; 3 Bann. & A. 438; *Roemer v. Simm* (1874), 5 O. G. 555; *Hiatt v. Twomey* (1836), 1 Dev. & Bat. Eq. 815.

That the same effect follows under the law of England, see *Card's Patent*, (1848), 2 Web. 161.

That "prior use intimates prior knowledge and shows prior invention," see *Househill Co. v. Neilson* (1843), 1 Web. 673 (699).

That such use must be affirmatively proved, see *American Bell Telephone Co. v. People's Telephone Co.* (1884), 29 O. G. 1029; 22 Fed. Rep. 309; 22 Blatch. 531; *Washburn & Moen Mfg. Co. v. Haish* (1880), 10 Bissell, 65; 4 Fed. Rep. 900.

That knowledge of a general property of matter does not prevent a patent for

cation, or the patent must have attained a specified degree both of completeness and publicity, and it must have existed at the date of the invention of the art or instrument whose novelty is called in question. The consideration of each of the three methods thus involves an examination of both of these essential qualities. And first, of Prior Use.

§ 317. **Prior Use : its Essential Requisites.**

An invention becomes accessible to the public through its use, only when it is employed in such a manner as to disclose fully to the public the idea of means which it embodies.¹ To this end it is necessary: (1) That the invention be complete and operative; (2) That it be practically employed; and (3) That its employment be in public. Unless the invention is complete and operative it does not, in the eye of the law, as yet exist, and therefore is incapable of use. Unless it is practically employed it does not, as a general rule, clearly exhibit its idea of means. Unless employed in public it does not confer upon the public such a knowledge as places the invention fully in their reach. Thus, when either of these requisites is wanting, the use does not destroy the novelty of subsequent inventions.

the application of that property to a particular use, see *Hills v. Gas Light Co.* (1860), 5 H. & N. 312.

§ 317. ¹ In *Walton v. Bateman* (1842), 1 Web. 613, Cresswell, J. (616): "With respect to this not being a new invention, the nature of that objection is distinct and clear upon the face of it. It involves two questions for your consideration. First, was any article made before, answering the purposes and having the properties of that which the plaintiff has made and claims as the patent? . . . They must show that the article made before had the same properties as that in respect of which the patent was granted. . . . Now, if it had not, it cannot be put in competition with this; if it had, then was it known and in use? That would involve another question. Now in the

first place was it known as an article having those properties? Did any person know what he was buying? . . . (619) Then even supposing that that article did embody the principle of the plaintiffs, so as to present to persons using it the properties, qualities, and advantages in principle of that article which the plaintiff makes, the question for you will be, whether that user is not to be considered rather in the nature of an experiment than of any public use of the article."

That unless the use of the invention so discloses its character that it can be made by any person skilled in the art, from a mere inspection or use of it, it is not prior use, see *Hancock v. Somerville*, (1851), 39 New. L. J. 158. See also § 324, and notes, *post*.

§ 318. **Prior Use: Prior Invention must have been Complete and Practically Available.**

To constitute a prior use the identical idea of means expressed in the present invention must have been reduced to practice and made available for immediate use.¹ Neither a sketch of the projected art or instrument as the inventor has conceived it, nor drawings whether with or without verbal

§ 318. ¹ In *Worswick Mfg. Co. v. Steiger* (1883), 17 Fed. Rep. 250, Welker, J. : (251) "It will be noticed that the claim of this patent is a combination claim consisting of several elements that co-operate together to produce the device claimed. This device, then, can only be anticipated by a prior device, having identically the same elements, or the mechanical equivalents of those that are not used. It will not do to find in older devices a portion of these elements in one machine, another portion in a second machine, another in a third, and so on, and then say that this device is anticipated."

That there can be no prior use unless the device used were identical with the present invention, see *Judson v. Bradford* (1878), 16 O. G. 171; 3 Bann. & A. 539; *Ellithorp v. Robertson* (1859), 4 Blatch. 307; 2 Fisher, 83; *Livingston v. Jones* (1859), 1 Fisher, 521; *Pitts v. Wemple* (1855), 1 Bissell, 87; 2 Fisher, 10; *Foot v. Silsby* (1851), 2 Blatch. 260; *Parker v. Stiles* (1849), 5 McLean, 44; *Woodcock v. Parker* (1813), 1 Gallison, 438; 1 Robb, 37. See also note 4, *post*.

That what would infringe if later will anticipate if earlier, see *Peters v. Active Mfg. Co.* (1884), 21 Fed. Rep. 319; 28 O. G. 1102. This is not true unless both inventions are of the same class and scope.

That the size of the prior invention is immaterial, see *Peters v. Active Mfg. Co.* (1884), 21 Fed. Rep. 319; 28 O. G. 1102.

That apparatus does not anticipate a

process, see *Everest v. Buffalo Lubricating Oil Co.* (1884), 20 Fed. Rep. 848; 28 O. G. 1101.

That a prophetic intimation is not prior use, see *Celluloid Mfg. Co. v. Chrolithion Collar & Cuff Co.* (1885), 25 Blatch. 205; 23 Fed. Rep. 397; 31 O. G. 519.

That accidental operations not discovered at the time are not prior use, see *Boyd v. Cherry* (1883), 4 McCrary, 70.

That the prior use of all the elements of a combination does not anticipate the combination itself, see *Kelleher v. Darling* (1878), 3 Bann. & A. 438; 14 O. G. 673; 4 Clifford, 424.

That the prior invention must have been complete and operative, see *Allis v. Buckstaff* (1882), 13 Fed. Rep. 879; 22 O. G. 1705; *Stephenson v. Brooklyn Cross-Town R. R. Co.* (1881) 19 Blatch. 473; 14 Fed. Rep. 457; *Judson v. Bradford* (1878), 16 O. G. 171; 3 Bann. & A. 539; *Shoup v. Henrici* (1876), 2 Bann. & A. 249; 9 O. G. 1162; *Lyman Ventilating & Refrigerator Co. v. Chamberlain* (1876), 2 Bann. & A. 433; 10 O. G. 588; *Johnson v. McCullough* (1870), 4 Fisher, 170; *Woodman v. Stimpson* (1866), 3 Fisher, 98; *Ellithorp v. Robertson* (1859), 4 Blatch. 307; 2 Fisher, 83; *Cahoon v. Ring* (1859), 1 Fisher, 397; 1 Clifford, 592; *Sickels v. Borden* (1856), 3 Blatch. 535; *Winans v. N. Y. & Harlem R. R. Co.* (1855), 4 Fisher, 1; *Pitts v. Wemple* (1855), 1 Bissell, 87; 2 Fisher, 10; *Lang v. Gisborne* (1862), 31 Beav. 133. See also cases cited in note 3, *post*.

description, nor any model other than a practical and working instrument, nor even an application for a patent, can fulfil this requirement, since each or all of these can be produced without the existence of an operative and available invention.² Mere experiments, if unsuccessful, however nearly they approach to the complete invention, and even although patented,³

² That neither written description nor drawing constitutes prior use, see *Detroit Lubricator Mfg. Co. v. Renchard* (1881), 9 Fed. Rep. 293; *Lyman Ventilating & Refrigerator Co. v. Lalor* (1874), 6 O. G. 642; 12 Blatch. 303; 1 Bann. & A. 403; *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.* (1874), 6 O. G. 34; 10 Phila. 227; 1 Bann. & A. 177; *Reeves v. Keystone Bridge Co.* (1872), 1 O. G. 466; 5 Fisher, 456; 9 Phila. 368; *Ellithorp v. Robertson* (1859), 4 Blatch. 307; 2 Fisher, 83; *Winans v. N. Y. & Harlem R. R. Co.* (1855), 4 Fisher, 1; *Lewis v. Marling* (1829), 1 Web. 490; 1 Abb. P. C. 417.

That the construction of a model is not prior use, see *Union Paper Bag Mach. Co. v. Pultz & Walkley Co.* (1879), 16 Blatch. 76; 4 Bann. & A. 181; *Kelleher v. Darling* (1878), 14 O. G. 678; 4 Clifford, 424; 3 Bann. & A. 438; *Stilwell & Bierce Mfg. Co. v. Cincinnati Gas Light & Coke Co.* (1875), 7 O. G. 829; 1 Bann. & A. 610; *Johnson v. McCullough* (1870), 4 Fisher, 170; *Cahoon v. Ring* (1859), 1 Fisher, 397; 1 Clifford, 592; *Lewis v. Marling* (1829), 1 Web. 490; 1 Abb. P. C. 417.

That an application for a patent does not show prior use or knowledge unless it be also shown that the invention was then complete and operative, see *Adams v. Howard* (1884), 26 O. G. 825; 19 Fed. Rep. 317; *Howes v. McNeal* (1878), 15 Blatch. 103; 15 O. G. 608; 3 Bann. & A. 376; *Barker v. Stowe* (1878), 14 O. G. 559; 15 Blatch. 49; 3 Bann. & A. 337; *Lyman Ventilating & Refrigerator Co. v. Newell* (1876), 10 O. G.

588; 2 Bann. & A. 433; *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.* (1874), 6 O. G. 34; 10 Phila. 227; 1 Bann. & A. 177; *Case v. Brown* (1862), 1 Bissell, 382; 2 Fisher, 268.

³ In *Gottfried v. The Phillip Best Brewing Co.* (1879), 5 Bann. & A. 4, Dyer, J.: (24) "It will be admitted that, to justify the court in overthrowing a patent granted for what appears to be a new and useful invention or improvement, on the ground that the device has been anticipated by another and earlier invention, the court should be well satisfied by clear and credible testimony that the alleged earlier invention actually existed; that it was a perfected device, capable of practical use; that it was embodied in distinct form, and carried into operation as a complete thing, and was not of such a character as to entitle it only to be regarded as an unperfected or abandoned experiment." 17 O. G. 675 (681).

In *Coffin v. Ogden* (1873), 18 Wall. 120, Swayne, J.: (124) "If the thing were embryotic or inchoate, if it rested in speculation or experiment, if the process pursued for its development had failed to reach the point of consummation, it cannot avail to defeat a patent founded upon a discovery or invention which was completed, while in the other case there was only progress, however near that progress may have approximated to the end in view. The law requires not conjecture, but certainty. If the question relates to a machine, the conception must have been clothed in substantial forms, which demonstrate at

the union of all parts of the invention for a different purpose, or the production of an art or instrument embody-

once its practical efficacy and utility." 5 O. G. 270 (271).

In *Wayne v. Holmes* (1856), 2 Fisher, 20, Leavitt, J.: (23) "And proof of prior experiments on the principle of this invention, if not carried on to completion, does not make out the fact of prior knowledge or use, within the meaning of the patent laws. The machine or structure alleged to be similar to that patented must have been so far perfected as to be of practical utility. And if abandoned after experimental trials as useless, a presumption would arise that the alleged invention was not identical with one subsequently patented to another person, the merits and utility of which are proved by its general use, and admitted superiority over all others." 1 Bond, 27 (35).

In *Howe v. Underwood* (1854), 1 Fisher, 160, Sprague, J.: (166) "The patent law goes undoubtedly upon the ground that when a man, by his knowledge and skill, has made and perfected a machine, the public are then put in possession of the invention, and have the benefit, in some form, of that knowledge and skill; and that the man who comes afterward cannot deprive the public of that benefit, though he may be an original inventor of the machine. He has not given the consideration for an exclusive privilege, because the public had it before; and although he may have the merit of invention, he cannot have the right to take from the community that which they possess by the invention of another. A machine, therefore, in order to anticipate any subsequent discovery, must be perfected; that is, made so as to be of practical utility, and not to be merely experimental and end in experiment. The terms 'being an experiment,' and 'ending in experiment,' are used in contradistinction to

the term 'being of practical utility.' Until of practical utility the public attention is not called to the invention; it does not give to the public that which the public lays hold of as beneficial. If it is an experiment only, and ends in experiment, and is laid aside as unsuccessful, however far it may have been advanced, however many ideas may have been combined in it which, subsequently taken up, might, when perfected, make a good machine, still, not being perfected, it has not come before the public as a useful thing, and is therefore entirely inoperative as affecting the rights of those coming afterward. This is important to be understood, because the idea has been carried all along, that if a prior inventor has gone to a certain extent, although he fall short of making a complete machine, practically useful, those who come after him have no right to secure to themselves the advantage of their invention. That is not the law."

In *Galloway v. Bleadon* (1839), 1 Web. 521, Tindal, C. J.: (525) "The law is undoubtedly now understood to be this:— a mere experiment, or a mere course of experiments, for the purpose of producing a result which is not brought to its completion, but begins and ends in uncertain experiments—that is not such an invention as should prevent another person, who is more successful, or pursues with greater industry the chain in the line that has been laid out for him by the preceding inventor, from availing himself of it and having the benefit of it. . . . (526) The question you are to determine is whether on the evidence the thing itself was complete, so as to be used, or whether only a series of experiments were going on. Up to this time the model had been shown, but not any actual

ing the same ideas but in a lower state of development, are equally insufficient, — neither being an invention whose employ-

paddle-wheel made; much less up to the time we are now discussing had any one been applied to any real practical use. . . . (529) That there had been many experiments made upon the same line, and almost tending, if not entirely, to the same result, is clear from the testimony you have heard; and that these were experiments known to various persons; but if they rested in experiment only, and had not attained the object for which the patent was taken out, mere experiment, afterwards supposed by the parties to be fruitless, and abandoned because they had not brought it to a complete result, that will not prevent a more successful competitor, who may avail himself as far as his predecessors have gone of their discoveries, and add the last link of improvements, in bringing it to perfection."

In *Jones v. Pearce* (1832), 1 Web. 122, Patterson, J.: (124) "If on the whole of this evidence . . . it appeared this wheel [in prior use] was a wheel on the same principles and in substance the same wheel as the other for which the plaintiff has taken out his patent, and that was used openly in public so that everybody might see it, and had continued to use the same thing up to the time of taking out the patent, undoubtedly then that would be a ground to say that the plaintiff's invention is not new . . . but if, on the other hand, you are of opinion that [the alleged prior invention] was an experiment, and that [its inventor] found it did not answer, and ceased to use it altogether, and abandoned it as useless, and nobody else followed it up, and that the plaintiff's invention which came afterwards was his own invention and remedied the defects, . . . then there is no reason for saying the plaintiff's patent is not good." 1 Abb. P. C. 472 (475).

That abandoned experiments are not prior use, see *American Bell Telephone Co. v. Molecular Telephone Co.* (1885), 32 Fed. Rep. 214; 23 Blatch. 253; *Fay v. Allen* (1885), 24 Fed. Rep. 804; 32 O. G. 1355; *Celluloid Mfg. Co. v. Chrolithion Collar & Cuff Co.* (1885), 23 Blatch. 205; 23 Fed. Rep. 397; 31 O. G. 519; *Phillips v. Carroll* (1885), 23 Fed. Rep. 249; 31 O. G. 265; *Miller v. Pickering* (1883), 25 O. G. 89; 16 Fed. Rep. 540; 16 Phila. 533; *Sheridan v. Latus* (1883), 25 O. G. 501; *Allis v. Buckstaff* (1882), 13 Fed. Rep. 879; 22 O. G. 1705; *Davis v. Brown* (1881), 19 Blatch. 263; 9 Fed. Rep. 647; 20 O. G. 1021; *Putnam v. Hollender* (1881), 19 Blatch. 48; 6 Fed. Rep. 882; 19 O. G. 1423; *Roberts v. Schrieber* (1880), 5 Bann. & A. 491; 18 O. G. 125; 2 Fed. Rep. 855; *Whittlesey v. Ames* (1880), 13 Fed. Rep. 893; 9 Bissell, 225; 5 Bann. & A. 96; 18 O. G. 357; *Union Paper Bag Mach. Co. v. Pultz & Walkley Co.* (1879), 15 Blatch. 160; 16 Blatch. 76; 4 Bann. & A. 181; *Kelleher v. Darling* (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438; *Albright v. Celluloid Harness Trimming Co.* (1877), 2 Bann. & A. 629; 12 O. G. 227; *La Baw v. Hawkins* (1874), 1 Bann. & A. 428; 6 O. G. 724; *Wood Paper Patent* (1874), 23 Wall. 566; *Corn Planter Patent* (1874), 23 Wall. 181; 6 O. G. 392; *Aultman v. Holley* (1873), 11 Blatch. 317; 6 Fisher, 534; 5 O. G. 3; *Decker v. Grote* (1873), 10 Blatch. 331; 3 O. G. 65; 6 Fisher, 143; *Smith v. O'Connor* (1873), 4 O. G. 633; 2 Sawyer, 461; 6 Fisher, 469; *Blake v. Rawson* (1872), 3 O. G. 122; 6 Fisher, 74; *Holmes*, 200; *Murphy v. Eastham* (1872), 2 O. G. 61; *Holmes*, 113; 5 Fisher, 306; *Roberts v. Dickey* (1871), 1 O. G. 4; 4 Fisher, 532; 4 Brews. 260; *Sayles v. Chicago & N. W.*

ment, under any circumstances, can confer upon the public such an acquaintance with the new idea of means as will

R. R. Co. (1871), 3 Bissell, 52 ; 4 Fisher, 584 ; Wood v. Cleveland Rolling Mill Co. (1871), 4 Fisher, 550 ; Turrill v. Illinois Central R. R. Co. (1867), 3 Bissell, 66 ; 3 Fisher, 330 ; Union Sugar Refinery v. Matthiesson (1865), 3 Clifford, 639 ; 2 Fisher, 600 ; White v. Allon (1863), 2 Fisher, 440 ; 2 Clifford, 224 ; Union Mfg. Co. v. Lounsbury (1863), 2 Fisher, 389 ; Hayden v. Suffolk Mfg. Co. (1862), 4 Fisher, 86 ; Matthews v. Skates (1860), 1 Fisher, 602 ; Singer v. Walmsley (1860), 1 Fisher, 558 ; Ellithorp v. Robertson (1859), 4 Blatch. 307 ; 2 Fisher, 83 ; Judson v. Moore (1859), 1 Bond, 285 ; 1 Fisher, 544 ; Latta v. Shawk (1859), 1 Bond, 259 ; 1 Fisher, 465 ; Cahoon v. Ring (1859), 1 Fisher, 397 ; 1 Clifford, 592 ; Bell v. Daniels (1858), 1 Bond, 212 ; 1 Fisher, 372 ; Pitts v. Edmonds (1857), 1 Bissell, 168 ; 2 Fisher, 52 ; Wayne v. Holmes (1856), 1 Bond, 27 ; 2 Fisher, 20 ; Ransom v. Mayor of New York (1856), 1 Fisher, 252 ; Allen v. Hunter (1855), 6 McLean, 303 ; Winans v. N. Y. & Harlem R. R. Co. (1855), 4 Fisher, 1 ; Howe v. Underwood (1854), 1 Fisher, 160 ; Many v. Sizer (1849), 1 Fisher, 17 ; Parkhurst v. Kinsman (1849), 1 Blatch. 488 ; Many v. Jagger (1848), 1 Blatch. 372 ; Murray v. Clayton (1872), L. R. 7 Ch. Ap. 570 ; Daw v. Eley (1867), L. R. 3 Eq. 496 ; Stead v. Williams (1843), 2 Web. 126 ; Gibson v. Brand (1841), 1 Web. 627 ; Cornish v. Keene (1835), 1 Web. 501 ; 2 Abb. P. C. 139 ; Jones v. Pearce (1832), 1 Web. 121 ; 1 Abb. P. C. 472.

That an unsuccessful experiment was patented does not indicate prior use, see Hitchcock v. Tremaine (1871), 8 Blatch. 440 ; 4 Fisher, 508 ; Whitely v. Swayne (1868), 7 Wall. 685.

As to what constitutes an unsuccessful experiment : —

That a rude machine, made for experiment and then abandoned, is an unsuccessful experiment, see Hoyt v. Slocum (1886), 26 Fed. Rep. 329 ; Gottfried v. Phillip Best Browing Co. (1879), 17 O. G. 675 ; 5 Bann. & A. 4.

That a partial embodiment of the idea, but wanting the qualities necessary to make it operative, is an unsuccessful experiment, see Roberts v. Schriober (1880), 18 O. G. 125 ; 2 Fed. Rep. 855 ; 5 Bann. & A. 491 ; Richardson v. Noyes (1876), 10 O. G. 507.

That to make one article, use it in one situation without subjecting it to the tests required to demonstrate its practicability in general use, and then throw it away, is an unsuccessful experiment, see Putnam v. Hollender (1881), 19 O. G. 1423 ; 19 Blatch. 48 ; 6 Fed. Rep. 882 ; Swift v. Whison (1867), 2 Bond, 115 ; 3 Fisher, 343.

That to bring together all the parts of an invention, but to fail in accomplishing the desired result from want of knowledge how to use them, is an unsuccessful experiment, see Campbell v. Mayor of N. Y. (1881), 20 O. G. 1817 ; 9 Fed. Rep. 500 ; 20 Blatch. 67.

That experiments made with the abandoned and unsuccessful devices of others are still unsuccessful experiments, see Latta v. Shawk (1859), 1 Fisher, 465 ; 1 Bond, 259.

That the throwing aside of an invention does not *ipso facto* show that it was an unsuccessful experiment, see Brush v. Condit (1884), 20 Fed. Rep. 826 ; 22 Blatch. 246 ; 28 O. G. 451 ; Pickering v. McCullough (1878), 13 O. G. 818 ; 3 Bann. & A. 279 ; Snow v. Tapley (1878), 13 O. G. 548.

That the abandonment of an experiment shows that it was unsuccessful, see Fay v. Allen (1885), 24 Fed. Rep. 804 ; 32 O. G. 1355 ; Brush v. Condit,

enable them to apply it practically in the arts.⁴ Yet the invention used, if embodying the same idea, need not, in all respects, be as mechanically perfect, nor perform its operations with the same degree of excellence, as that which it anticipates. For though formal diversities exist, and though by the application of industrial skill the later may have been made more serviceable or attractive than the earlier, the earlier may still exhibit the complete idea of the invention in the same stage of development.

(1884), 20 Fed. Rep. 826; 22 Blatch. 246; 28 O. G. 451; *American Bell Telephone Co. v. People's Telephone Co.* (1884), 29 O. G. 1029; 22 Fed. Rep. 309; 22 Blatch. 531.

That the want of success with the public indicates that the invention was a mere experiment, see *Hicks v. Otto* (1884), 29 O. G. 365; 22 Blatch. 94; 19 Fed. Rep. 749.

That long neglect of an invention (seventeen years) may show that it was an unsuccessful experiment, see *Yale Lock Mfg. Co. v. Berkshire Nat. Bank* (1885), 26 Fed. Rep. 104.

That lost and disused inventions may be regarded as abandoned experiments, see *Adams & Westlake Mfg. Co. v. Rathbone* (1886), 26 Fed. Rep. 262.

That the prior invention must have been reduced to practice, see *Roberts v. Reed Torpedo Co.* (1869), 3 Brews. 558; 3 Fisher, 629.

That a device not put in practical use nor claimed, though afterwards embodied in other articles, is an abandoned experiment, see *Hutchinson v. Everett* (1885), 26 Fed. Rep. 531; 35 O. G. 1110.

That any use which shows that the article is practically available is prior use, see *Brush v. Condit* (1884), 20

Fed. Rep. 826; 22 Blatch. 246; 28 O. G. 451.

⁴ That the union of all the parts of the invention for a different purpose is not prior use, see *Campbell v. Mayor of N. Y.* (1881), 20 O. G. 1817; 20 Blatch. 67; 9 Fed. Rep. 500.

That however nearly the device in prior use approached the present invention, it cannot anticipate it unless it were in every essential respect the same, see *Livingston v. Jones* (1859), 1 Fisher, 521.

That no prior use existed unless the prior inventor had attained to such a clear idea of the invention as would enable him to bestow it on the public, see *Boyd v. Cherry* (1883), 4 McCrary, 70; *Minter v. Mower* (1835), 1 Web. 138; 2 Abb. P. C. 178.

That a device does not anticipate when radical changes would be necessary to enable it to perform the work of the patented invention, see *Consolidated Bunting Apparatus Co. v. Woerle* (1887), 29 Fed. Rep. 449; 38 O. G. 1015.

That it is no defence in a suit for infringement that a prior machine might have been modified so as to do the work of the plaintiff's invention, see *Wood v. Cleveland Rolling Mill Co.* (1871), 4 Fisher, 550.

§ 319. **Prior Use: Prior Invention must have been Practically Employed.**

The earlier invention having been complete and operative, the idea which it embodies must have been manifested through its practical employment. Possibly there are cases where an instrument itself discloses the essential attributes of its idea of means as fully as if it had been practically used, and in these cases actual use of the invention may not be essential.¹ But, as a general rule, the invention must be practically employed. To conceive the idea and to embody it, or to embody an idea by chance without conceiving or perceiving it, is not enough. The idea, as it lies in the mind of the inventor, must not only be completely expressed in his invention, but must be fully and intelligibly communicated through it; and though his art or instrument be perfect in itself, if it is not applied in practice in such a manner as to demonstrate that it accomplishes the end for which it was created, and to indicate the method by which it attains that end, the idea is not within the actual possession of the public.² Still, on the other hand,

§ 319. ¹ Mr. Webster (1 Web. 719, n.) referring to evidence contradicting novelty, remarks: "The third class of evidence is the production of a machine or article of manufacture with or without proof of actual user anterior to the date of the patent. On the authority of the above case [*Househill Co. v. Neilson*, 1 Web. 673] it would appear that the production of such a machine or article of manufacture, without actual proof as to its use, or any evidence as to whence it originally came, or as to its mode of manufacture, would vitiate subsequent letters-patent for such a machine or article of manufacture, as negating the grantee of such letters-patent being the true and first inventor. With reference to this head two distinct cases may occur: the one in which the machine or article of manufacture so produced shows at once its mode of manufacture; the other in which the machine or article of manufacture does not present any

means of knowledge to the public so as to enable any person to reproduce the same. . . . An arrangement of material parts, as a simple combination of the elements of machinery, discloses its mode of manufacture to the eye on inspection, but with respect to a paint, or a dye, or a medicine, and many other inventions, a mere inspection of the result attained will convey no information as to the mode of manufacture." See also *Sayles v. Chicago & Northwestern R. R. Co.* (1871), 3 Bissell, 52; 4 Fisher, 584; *Parker v. Ferguson* (1849), 1 Blatch. 407.

² In *Andrews v. Carman* (1876), 13 Blatch. 307, Benedict, J.: (323) "A chance operation of a principle, unrecognized by any one at the time, and from which no information of its existence, and no knowledge of a method of its employment is derived by any one, if proved to have occurred, will not be sufficient to defeat the claim of him who

the law does not require extensive practical employment. A single instance of efficient use suffices, although the art or instrument be thenceforth abandoned.³ Nor is it necessary that the earlier invention have been used for the same purpose as the later, nor that it pass beyond the region of experiment if the experiment were evidently successful, nor that it be under a patent, nor if under a patent that the patent should be valid.⁴

first discovers the principle, and, by putting it to a practical and intelligent use, first makes it available to man." 2 Bann. & A. 277 (292); 9 O. G. 1011 (1016). See also *Maxheimer v. Mayor* (1881), 20 Blatch. 17; 9 Fed. Rep. 460; 20 O. G. 1162.

Thus that where an invention embodies two distinct ideas of means its use as one is not prior use as to the other if the latter is not thereby disclosed, see *Clough v. Barker* (1882), 106 U. S. 166; 22 O. G. 2157; *Minter v. Mower* (1835), 1 Web. 138; 2 Abb. P. C. 178.

That to construct the invention is not necessarily prior use, see *Parker v. Hulme* (1849), 1 Fisher, 44; *Lewis v. Marling* (1829), 1 Web. 490; 1 Abb. P. C. 417.

That prior invention does not constitute prior use, see *Colt v. Massachusetts Arms Co.* (1851), 1 Fisher, 108.

That sale of the invention is not necessary, — use in the country of itself defeats the subsequent invention, — see *Betts v. Neilson* (1868), L. R. 3 Ch. Ap. 429.

That sale to any one who desires to purchase evidences prior use, see *Gibson v. Brand* (1841), 1 Web. 627.

That the prior existence of a similar machine, without use, does not show a want of novelty, unless the later invention was derived from the former, see *Butch v. Boyer* (1871), 8 Phila. 57.

³ That a single instance of prior use will prove a want of novelty, see *Brush v. Condit* (1884), 22 Blatch. 246; 28 O. G. 451; 20 Fed. Rep. 826; *Miller*

v. Force (1882), 9 Fed. Rep. 603; 21 O. G. 947; *Boston Elastic Fabrics Co. v. East Hampton Rubber Thread Co.*, (1876), 2 Bann. & A. 268; 9 O. G. 745; *Rice v. Garnhart* (1874), 34 Wis. 453; *Sayles v. Chicago & Northwestern R. R. Co.* (1871), 3 Bissell, 52; 4 Fisher, 584; *Sayles v. Chicago & Northwestern R. R. Co.* (1865), 1 Bissell, 468; 2 Fisher, 523; *Rich v. Lippincott* (1853), 2 Fisher, 1.

That the abandonment of the invention after its successful use does not prevent this use from operating as prior use, see *McNish v. Everson* (1880), 5 Bann. & A. 484; 17 O. G. 1506; 2 Fed. Rep. 899; *Shoup v. Henrici* (1876), 2 Bann. & A. 249; 9 O. G. 1162; *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.* (1874), 6 O. G. 34; 1 Bann. & A. 177; 10 Phila. 227; *Evans v. Hettick* (1822), 7 Wheaton, 453; 1 Robb, 417; *Evans v. Hettick* (1818), 3 Wash. 408; 1 Robb, 166.

⁴ That the prior use need not have been for the same purpose, see *Stephenson v. Brooklyn Cross-Town R. R. Co.* (1881), 19 Blatch. 478; 14 Fed. Rep. 457.

That its use in combination with other things, if its real character is thereby disclosed, is prior use, see *Carpenter v. Smith* (1841), 1 Web. 530.

That the use is prior use, though only experimental, if the experiment were successful, see *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.* (1874), 6 O. G. 34; 1 Bann. & A. 177; 10 Phila. 227; *Rice*

For any use of an invention whereby the end proposed by the inventor is practically accomplished, by the employment of the means which he devised in order to attain it, discloses his idea as fully as if the operation of his art or instrument were indefinitely prolonged.

§ 320. **Prior Use: Prior Invention must have been Practically Employed in Public.**

But even the practical employment of a complete and operative art or instrument does not confer the invention on the public, unless the use of the invention be in public. A use *in* public is not necessarily a use *by* the public. It is distinguished, not from an individual, but from a secret use. It is a use which places the invention in such a relation to the public that if they choose to be acquainted with it, they can do so.¹

v. Garnhart (1874), 34 Wis. 453 ; *Watson v. Bladen* (1826), 4 Wash. 580 ; 1 Robb, 510.

That though the prior user may not have employed the invention with the same skill and profit as the present inventor, the latter cannot have a patent, see *Waterman v. Thompson* (1863), 2 Fisher, 461.

That whether a prior inventor in this country succeeded in patenting his invention or not is immaterial, if known and used it defeats any subsequent inventor's right to a patent, see *Coffin v. Ogden* (1873), 18 Wall. 120 ; 5 O. G. 270 ; *Whipple v. The Baldwin Mfg. Co.* (1858), 4 Fisher, 29 ; *Colt v. The Massachusetts Arms Co.* (1851), 1 Fisher, 108.

§ 320. ¹ In *Perkins v. Nashua Card & Glazed Paper Co.* (1880), 2 Fed. Rep. 451, Lowell, J.: (452) "The law desires to encourage inventors to make their discoveries known for the improvement of the art, and to discourage an extension of the monopoly beyond the statutory period. For these reasons, and because of the difficulty of ascertaining the amount of knowledge which

may have been derived from the exhibition, publication, or use of the invention, it has always been held that when the public have had means of knowledge they have had knowledge of the invention. Thus if a book has been published describing the invention, it is not important that no one has read it. *Stead v. Williams*, 7 M. & G. 818. If a pier has been placed in the bed of a river, or a pipe under ground, it is conclusively presumed to be known to all men. It has been intimated that a use in a workshop, where the workmen are pledged to secrecy, may not be a public use. *Kendall v. Winsor*, 21 How. 322, charge of Curtis, J.; *Bevin v. Easthampton Bell Co.*, 9 Blatch. 50; *Heath v. Smith*, 3 Ell. & B. 255. In the last of these cases it is held that if the invention has been worked in the ordinary way, without an injunction of secrecy, the use is public. In *McClurg v. Kingsland*, 1 How. 202, it is said by Mr. Justice Baldwin, *obiter*, that use in a factory is a public use. A use very trifling in amount, or a publication purely technical, or a single sale, have often been held to deprive an inventor of his patent,

Thus while a use by the inventor in the seclusion of his private laboratory or workshop, as a secret of his trade, does

without evidence that any one interested to acquire knowledge of the invention had acquired it. *Henry v. Prov. Tool Co.*, 14 O. G. 855; *Egbert v. Lippman*, *Ib.* 822; *McMillan v. Barelay*, 5 Fisher, 189; *Re Adamson's Patent*, 6 De G. M. & G. 420; *Patterson v. Gas Light Co.*, 3 App. Cas. 239; *Lang v. Gisborne*, 31 Beav. 133. . . . Taking these decisions together, I understand the law to be, that actual knowledge of the invention need not have been derived by any one interested to practise it; it is enough that any one or more persons, not under a pledge of secrecy, saw the invention practised, or even might have seen it if they had used their opportunities, provided it was in fact practised in the ordinary way after being completed. And it must be held either that the workmen and visitors were a part of the public, or that they were persons from whom the public might have acquired the art without a breach of trust." 5 Bann. & A. 395 (396); 17 O. G. 1285 (1286).

In *Carpenter v. Smith* (1841), 1 Web. 530, Abinger, C. B.: (534) "The plaintiff's counsel has referred to the words of the statute to show that the words 'public use and exercise,' formed a part of the patent, from which he desires you to take the definition of what he calls the legal meaning of the word 'new;' and he draws this inference, that unless it has been in public use and in public exercise before, it is new. . . . Now I differ altogether from the learned counsel in that respect; and I think what is meant by 'public use and exercise,' as has been held by my predecessors before (and I think one's own common sense leads one to adopt that definition), is this, — a man is entitled to a patent for a new invention, and if his invention is new and useful he shall

not be prejudiced by any other man having invented that before and not made any use of it, because the mere speculations of ingenious men, which may be fruitful of a great variety of inventions, if they are not brought into actual use, ought not to stand in the way of other men equally ingenious, who may afterwards make the same inventions and apply them. . . . So that the meaning of the words 'public use' is this, — that a man shall not, by his own private invention, which he keeps locked up in his own breast, or in his own desk, and never communicates it, take away the right that another man has to a patent for the same invention. Now 'public use' means this — that the use of it shall not be secret, but public. . . . (535) Therefore if a man invents a thing for his own use, whether he sells it or not, if he invents a lock and puts it on his own gate and has used it for a dozen years, that is a public use of it. If it were otherwise, see what the consequence would be. . . . If that was not a public use of it which prevented a man from taking out a patent, any man might go and take a model of that lock, and get a patent for it. How can he be the inventor of it? Because, to obtain a patent, a man must be the inventor; and if it has been once in public use (that is, used in a public manner, not used by the public), yet, if it has been used by half a dozen individuals, or one, in a public manner, any man having access to it, how can he be said to be the inventor, if by merely gaining access to that he takes out a patent? . . . (539) Gentlemen, in my opinion, if you believe the witness, that the lock was on Mr. Davis's gate sixteen years ago, and that he saw it every day of his life, and repaired it twelve years ago, and has brought it here and described it to you

not show public knowledge,² the practical employment of the invention by others than the inventor, in their trade or profession, though in concealment from the general public, is, in the present sense, a use in public.³ But foreign use, at least un-

now, it appears to me, if you are of that opinion, that that was a public use of the invention. The application and the practical utility of that before the eyes of the public comes within the meaning of the words, as I understand them, of this patent, and it is only used in contradistinction of a public use and exercise, to which the public has no access."

This case came up in the exchequer on motion for a new trial on this instruction, the plaintiff claiming that the use of an invention in such a manner that a particular portion of the public in a particular locality may have access to it without its being sold or brought into market, does not defeat a subsequent patent. In giving the opinion of the court the judges held as follows: Alderson, B.: (542) "I think there ought to be no rule in this case. I have not the least doubt that that is the right construction of the law which my lord has put upon it. Public use means a use in public, so as to come to the knowledge of others than the inventor, as contradistinguished from the use of it by himself in his chamber." Gurney, B., concurred. Abinger, C. B.: (543) "The public use and exercise of an invention means a use and exercise in public, not by the public."

Mr. Webster, in a note to this case, p. 543, criticises the decision on the ground that the lock, being possibly of secret construction, did not by its mere use disclose to the public the method of making it; and compares it to a chemical compound of unknown ingredients and preparation. Doubtless the true rule in all cases is this, that the article used must render the invention embraced in its construction accessible to the public; and this principle is recognized by

Abinger, C. B., in various parts of the above opinion, especially where he supposes that "any man might go and take a model of that lock and get a patent for it."

That no use can be prior use unless it existed in a manner accessible to the public, see *Bullock Printing Press Co. v. Jones* (1878), 13 O. G. 124.

That to make and sell an article without secrecy in the realm, for the purpose of exporting and use abroad, is use in public and prior use, see *Carpenter v. Smith* (1841), 1 Web. 530.

² In *Stead v. Williams* (1843), 2 Web. 126, Cresswell, J., speaking of the former use of the invention, says: (136) "That appears to have been . . . used by him in public; not concealed; no secrecy about it; made known to all persons who came to his house, so far as their ocular inspection could make them. It was intended to be public, not to be made a matter of merchandise certainly, but merely for his own private use; but the knowledge of it exposed to the public an article in public use, and continued to be used down to the time in question. . . . Whether it had been used by one or used by five, I do not think it makes any difference."

That secret use is not prior use, see *Smith v. Davidson* (1857), 19 C. S. 691; *Carpenter v. Smith* (1842), 1 Web. 540; *Carpenter v. Smith* (1841), 1 Web. 530.

³ In *Cornish v. Keene* (1835), 1 Web. 501, Tindal, C. J.: (508) "If this [invention] was at the time these letters-patent were granted in any degree of general use; if it was known at all to the world publicly and practised openly, so that any other person might have the means of acquiring the knowledge

der the provisions of our present statutes, does not communi-
of it as well as this person who obtained the patent, then the letters-patent are void ; on the other hand, if it were not known and used at the time in England, then as far as this question is concerned the letters-patent will stand. Now, it will be a question for you, gentlemen, to say, whether upon the evidence which you have heard you are satisfied that the invention was or was not in use and operation, public use and operation, at the time the letters-patent were granted. It is obvious that there are certain limits to that question ; the bringing it within that precise description which I have just given must depend upon the particular facts that are brought before a jury. A man may make experiments in his own closet for the purpose of improving any art or manufacture in public use ; if he makes these experiments and never communicates them to the world, and lays them by as forgotten things, another person who has made the same experiments, or has gone a little further, or is satisfied with the experiments, may take out a patent, and protect himself in the privilege of the sole making of the article for fourteen years ; and it will be no answer to him to say that another person before him made the same experiments, and therefore that he was not the first discoverer of it ; because there may be many discoverers starting at the same time, many rivals that may be running on the same road at the same time, and the first which comes to the crown and takes out a patent, it not being generally known to the public, is the man who has a right to clothe himself with the authority of the patent and enjoy its benefits. That would be an extreme case on one side ; but if the evidence that is brought in any case, when properly considered, classes itself under the description of experiment only, and unsuccessful experiment, that would be no answer to the validity of the patent. On the other hand, the use of an article may be so general as to be almost universal. In a case like that, you can hardly suppose that any one would incur the expense and trouble of taking out a patent. That would be a case where all mankind would say, ' You have no right to step in and take that which is in almost universal use, for that is, in fact, to create a monopoly to yourself in this article, without either giving the benefit to the world of the new discovery, or the personal right to the value of the patent to which you would be entitled from your ingenuity and from your application.' Therefore it must be between those two (if I may so call it) limits that cases will range themselves in evidence, and it must be for a jury to say whether, supposing those points to be out of the question in any particular case, evidence which has been brought before them convinces them to their understandings that this subject of the patent was in public use and operation at that time—at the time when the patent itself was granted by the crown. If it was in public use and operation, then the patent is a void patent. . . . if it was not, the patent stands good. . . . (512) I am not aware that by going more fully into it I can make you better acquainted with the discovery than you must be already. I would only observe that it must not be such a practice of it as is only referable to mere experiments for the purpose of making a discovery, or something secret, or confined to the party who was making it at the time ; but that it must be, in order to set aside the patent, a case where it was in public use and operation among persons in that trade and likely to know it." 2 Abb. P. C. 139 (171, 177).

In *Dollon's Case* (1766), cited in

cate to the public, in this country, any knowledge of the invention.⁴

Boulton v. Bull (1795), 2 H. Bl. 470, it was held, as *per* Buller, J.: "The objection to Dollond's patent was, that he was not the inventor of the new method of making object-glasses, but that Dr. Hall had made the same discovery before him. But it was holden that as Dr. Hall had confined it to his closet, and the public were not acquainted with it, Dollond was to be considered as the inventor." 1 Abb. P. C. 9.

That if the invention has been actually practised by others than the inventor, though in private, it is prior use, see *Reed v. Cutter* (1841); 1 Story, 590; 2 Robb, 81.

In *Tennant's Case* (1798), cited 1 Web. 125, n., the same invention had been used in the course of trade, but concealed from the outside world, before the patent. This was held to invalidate the patent.

That sales to any one who wishes to buy indicate prior use, see *Gibson v. Brand* (1841), 1 Web. 627.

⁴ In *Doyle v. Spaulding* (1884), 19 Fed. Rep. 744, Nixon, J. : (746) "After a careful consideration of the provisions of the three sections of the Patent Act which bear upon the subject (sections 4886, 4920, 4923, Rev. St.), we are of the opinion that the use or a knowledge of the use of an invention in a foreign country by persons residing in this country will not defeat a patent which has here been granted to a *bona fide* patentee who, at the time, was ignorant of the existence of the invention or its use abroad." 27 O. G. 300 (301).

That foreign use is not prior use, see *McFarland v. Spencer* (1885), 23 Fed. Rep. 150; 32 O. G. 893; 23 Blatch. 155; *Cornely v. Marckwald* (1883), 17 Fed. Rep. 83; 24 O. G. 498; 21 Blatch.

367; *Worswick Mfg. Co. v. Steiger* (1883), 17 Fed. Rep. 250; *Schillinger v. Greenway Brewing Co.* (1883), 24 O. G. 495; 17 Fed. Rep. 244; *Illingworth v. Spalding* (1881), 9 Fed. Rep. 611; *Adams v. Loft* (1879), 4 Bann. & A. 495; *Rocmer v. Simon* (1877), 95 U. S. 214; 12 O. G. 796; *Rocmer v. Simm* (1874), 5 O. G. 555; *Jones v. Sowall* (1873), 3 O. G. 630; 3 Clifford, 563; 6 Fisher, 342; *Swift v. Whisen* (1867), 2 Bond, 115; 3 Fisher, 343; *Judson v. Cope* (1860), 1 Bond, 327; 1 Fisher, 615; *Hays v. Sulsor* (1859), 1 Bond, 279; 1 Fisher, 532; *Bartholomew v. Sawyer* (1859), 1 Fisher, 516; 4 Blatch. 347; *Furbush v. Cook* (1857), 2 Fisher, 668; *O'Reilly v. Morse* (1853), 15 How. 62; *Parker v. Stiles* (1849), 5 McLean, 44; Opinion Atty. Gen. (1843), 5 Op. At. Gen. 18; *Lewis v. Marling* (1829), 1 Web. 490.

That if the person claiming a patent derived his knowledge of the invention from such prior foreign use, his claim must be denied on the ground that it is not his own invention, see the above cases also.

That under the act of 1793, prior use in any part of the world was a bar, see *Evans v. Eaton* (1818), 3 Wheaton, 454; 1 Robb, 243; *Evans v. Hettick*, (1818), 3 Wash. 408; 1 Robb, 166; *Evans v. Eaton* (1816), 1 Pet. C. C. 322; 1 Robb, 68; *Dawson v. Follen* (1808), 2 Wash. 311; 1 Robb, 9; *Reutgen v. Kanowrs* (1804), 1 Wash. 168; 1 Robb, 1.

That prior use in Scotland is no bar to a patent in England, see *Haworth v. Hardcastle* (1833), 1 Abb. P. C. 485; *contra*, *Brown v. Annandale* (1842), 1 Web. 433; *Roebuck v. Stirling*, (1774), 1 Web. 45, 451, n.; 1 Abb. P. C. 12.

That the phrase "within the realm" in the stat. Jac. I. includes the colo-

§ 321. **Prior Use : Knowledge thence Derived must be in Possession of Public at Date of Later Invention : Lost Arts.**

The point of time at which the earlier invention must be in possession of the public in order to destroy the novelty of the later, is the date of the invention of the later.¹ It is entirely

nies, see *Brown v. Annandale* (1842), 1 Web. 433.

But not if the colony has a separate patent system, see *Rolls v. Isaacs* (1881), L. R. 19 Ch. 268.

That knowledge in this country of use abroad is not prior use and knowledge, see *Doyle v. Spaulding* (1884), 19 Fed. Rep. 744 ; 27 O. G. 300 ; *Illingworth v. Spaulding* (1881), 9 Fed. Rep. 611.

That foreign patents, even after issued two years, do not show prior knowledge in the United States, see *Florence Sewing Mach. Co. v. Grover & Baker Sewing Mach. Co.* (1872), 110 Mass. 70.

§ 321. ¹ That prior use must be prior to the invention of the later art or instrument in order to defeat a patent for it, see *McWilliams Mfg. Co. v. Blundell* (1882), 11 Fed. Rep. 419 ; 22 O. G. 177 ; *Brodie v. Ophir Silver Mining Co.* (1867), 4 Fisher, 137 ; 5 Sawyer, 608 ; *Whitney v. Emmett* (1831), Baldwin, 303 ; 1 Robb, 567 ; *Treadwell v. Bladen* (1827), 4 Wash. 703 ; 1 Robb, 531.

That the date of the invention to which the use must be prior is the date of the embodiment of the idea, or its expression in writing or in drawings, see *Byerly v. Cleveland Linseed Oil Works* (1887), 31 Fed. Rep. 73.

That prior use dates back to the patent covering the invention used, though the patent may not be set up in defence, see *Atlantic Works v. Brady* (1882), 107 U. S. 192 ; 23 O. G. 1330.

Prior use, like prior publication and prior patent, has a bearing upon two requisites of a patentable invention :

(1) The performance of an inventive act by the alleged inventor ; (2) The legal novelty of the invention. In reference to the first, the existence of prior use, or patent, or publication is material only when it precedes the conception of the idea of means by the inventor. In that case he is presumed to have derived his idea from such prior use, etc., and not to have performed an independent inventive act. But if his conception precedes the use, etc., no such presumption exists, and his inventive act may be evidenced in any proper manner. In this phase of the subject the date of his reduction to practice or of his application for a patent is of no importance. In reference to the second, or legal novelty of the invention, prior use, etc., must, in the language of the statute, precede its "invention or discovery." The date of "invention or discovery" is that on which the inventive act was completed and the inventor became able to confer his new art or instrument upon the public. Now an inventor, has completed his inventive act, and is in a position to bestow the invention on the public, only when he has embodied his conception in a practically operative art or instrument. Before this reduction of his idea to practice he has nothing to offer to the public. The idea as it lies in his mind may be fully conceived and comprehended by him, yet it may prove, on embodiment, to be impracticable or already anticipated by others. The law cannot regard it as an invention of which novelty is predicable, until it is in a condition for communication to the public and has either been put to practical tests or in some other manner shows

possible that an art or instrument, once fully known and understood, should be abandoned and so totally forgotten that

its efficiency and value. Upon the question of the legal novelty of the invention, therefore, the date of reduction to practice, or of such exterior expression of the idea of means as demonstrates its character and availability, is the date prior to which the use or publication, etc., must have occurred; and if the art or instrument had then been in prior use or made known through a patent, or a printed publication, the claim of its inventor to a patent must be denied on the ground that his invention was not new.

But though this rule is sound in principle and could be practically applied if uncomplicated with any other rule affecting the rights of the inventor, yet under the American theory that the chief merit of invention resides in the conception of the idea of means, a further qualification becomes necessary. It is our law that an inventive act is an indivisible act, and that where the conceiver of an idea of means uses reasonable diligence in reduction to practice, the whole act relates back to and dates from the time of the conception of the idea, and thus the earliest conceiver, if a diligent reducer, is entitled to a patent for the invention, although between his actual conception and reduction others may have invented, used, described, or patented the same invention. It will be observed that this doctrine bears upon the personality of the patentee, not upon the novelty of the invention itself, and answers the question, Who is entitled to the monopoly? not, Is the invention the subject of a monopoly? As far as the invention itself is concerned it cannot be new to the public if at the time the present inventor was ready to confer it, they were already cognizant of its existence and essential attributes. But when the invention has been placed

before the public subsequently to its conception by the present inventor, and the question is whether he shall be thereby defeated of his monopoly, either in favor of a rival inventor or of the public, the policy of our law awards him the patent on the ground of prior conception, if his diligence in reducing the idea to practice has been reasonable. That this rule introduces an apparent inconsistency into the law is certain, since it departs from the general doctrine as to one patentable requisite in order to preserve our interpretation of another. But as no court would now hesitate to protect the conceiver of an idea against the surreptitious publication of his conception by one to whom he had in confidence imparted it, so with equal justice he may be secured in his rights as first conceiver against rivals who innocently anticipate his bestowal of the invention on the public. Hence though certain decisions (*Webb v. Quintard* (1872), 1 O. G. 525; 9 Blatch. 352; etc.) seem to require that reduction to practice must precede the publication or prior patent in order to render the later patent valid, these should properly be restricted to the pure question of legal novelty alone, and not be considered as determining the exclusive rights of the earliest conceiver though he is the latest patentee. See also §§ 370-391, 963, 1026-1028 and notes *post*.

The rules deducible from these principles may be thus stated: (1) The prior use, publication, or patent must precede the reduction of the idea to practice by the present inventor; (2) If the prior use, etc., precede such reduction, the present inventor may connect his act of reduction with his act of conception by showing that he exercised reasonable diligence in the reduction,

the public are as destitute of any practical and useful knowledge of the subject as if it never had existed; and instances have repeatedly occurred where most valuable and wonderful inventions have thus been completely lost to man. In all such cases, one who re-invents precisely the same art or instrument, and communicates it to the public of his day, confers upon them the same benefit, and is entitled to the same reward, as if the invention never were before produced. Hence, though it may be evident that the same invention now presented to the public has been, at some past time, not only in existence but employed for the same purpose, yet if at the date of the invention of the later it had become a lost art and has thus been truly re-created, the later invention is still new and is not, on that account, deprived of the protection of a patent.²

and thus establish his claim to the patent notwithstanding the possession of the invention by the public before its complete embodiment by him; (3) If the prior use, etc., precede his conception of the idea, his invention is not only not new in any aspect, but he is conclusively presumed not to have performed in reference to it any inventive act.

See § 132 and note, *ante*.

² In *Househill Co. v. Neilson* (1843), 1 Web. 673, Lyndhurst, L. C. : (709) "If it is proved distinctly that a machine of the same kind was in existence, and was in public use, that is, if use or if trials had been made of it in the eye and in the presence of the public, it is not necessary that it should come down to the time when the patent was granted. If it was discontinued, still that is sufficient evidence in support of the prior use so as to invalidate the letters-patent. . . . (710) If it is discontinued, provided it has been once in public use, and the recollection of it has not been altogether lost, if it has been once publicly used, it will be sufficient to invalidate the letters-patent, although the use may be discontinued at the time

when the letters-patent were granted." Again : (717) "It must not be understood that your lordships, in the judgment you are about to pronounce, have given any decision upon this state of facts, namely, if an invention had been formerly used and abandoned many years ago, and the whole thing had been lost sight of. That is a state of facts not now before us. Therefore it must not be understood that we have pronounced any opinion whatever upon that state of things. It is possible that an invention may have existed fifty years ago, and may have been entirely lost sight of, and not known to the public. What the effect of this state of things might be it is not necessary for us to pronounce upon." Lord Brougham : "It becomes like a new discovery."

That an invention once practised and then abandoned and forgotten is a lost art, and is no bar to a subsequent invention and patenting of the same device, see *Taylor v. Wood* (1875), 12 Blatch. 110; 8 O. G. 90; 1 Bann. & A. 270; *Haselden v. Ogden* (1868), 3 Fisher, 378; *Cahoon v. Ring* (1859), 1 Clifford, 592; 1 Fisher, 397; *Rich v. Lippincott* (1853), 2 Fisher, 1.

§ 322. Prior Use: "Lost Art" Defined.

An invention, once in use, is considered as inaccessible to the public when it has been abandoned and forgotten, and can no longer be completely known, by persons skilled in the art to which it belongs, from anything which still remains in the possession of the public.¹ If from the analysis of existing

§ 322. ¹ In *Gayler v. Wilder* (1850), 10 How. 477, Taney, C. J.: (496) "The act of 1836, ch. 357, § 6, authorizes a patent where the party has discovered or invented a new and useful improvement, 'not known or used by others before his discovery or invention.' And the 15th section provides that, if it appears on the trial of an action brought for the infringement of a patent that the patentee 'was not the original and first inventor or discoverer of the thing patented,' the verdict shall be for the defendant. Upon a literal construction of these particular words, the patentee in this case certainly was not the original and first inventor or discoverer, if the Conner safe was the same with his, and preceded his discovery. But we do not think that this construction would carry into effect the intention of the legislature. It is not by detached words and phrases that a statute ought to be expounded. The whole act must be taken together, and a fair interpretation given to it, neither extending or restricting it beyond the legitimate import of its language, and its obvious policy and object. And in the 15th section, after making the provision above-mentioned, there is a further provision, that if it shall appear that the patentee at the time of his application for the patent believed himself to be the first inventor the patent shall not be void on account of the invention or discovery having been known or used in any foreign country, it not appearing that it had been before patented or described in any printed publication. In the case thus provided for, the party who invents is

not, strictly speaking, the first and original inventor. The law assumes that the improvement may have been known and used before his discovery. Yet his patent is valid if he discovered it by the efforts of his own genius, and believed himself to be the original inventor. The clause in question qualifies the words before used, and shows that by knowledge and use the legislature meant knowledge and use existing in a manner accessible to the public. If the foreign invention had been printed or patented, it was already given to the world and open to the people of this country, as well as of others, upon reasonable inquiry. They would, therefore, derive no advantage from the invention here. It would confer no benefit upon the community, and the inventor, therefore, is not considered to be entitled to the reward. But if the foreign discovery is not patented, nor described in any printed publication, it might be known and used in remote places for ages, and the people of this country be unable to profit by it. The means of obtaining knowledge would not be within their reach; and as far as their interest is concerned, it would be the same thing as if the improvement had never been discovered. It is the inventor here that brings it to them, and places it in their possession. And as he does this by the effort of his own genius, the law regards him as the first and original inventor, and protects his patent, although the improvement had in fact been invented before, and used by others. So too, as to the lost arts. It is well-known that centuries ago discoveries were made in

products the processes by which they were produced can be discovered, or if through the effects resulting from the employment of an instrument the essential character of the instrument itself can be determined, the instrument or process is now within the public reach, however long disused or lost to public memory.² But when connecting links like these are

certain arts the fruits of which have come down to us, but the means by which the work was accomplished are at this day unknown. The knowledge has been lost for ages. Yet it would hardly be doubted, if any one now discovered an art thus lost, and it was a useful improvement, that, upon a fair construction of the act of Congress, he would be entitled to a patent. Yet he would not literally be the first and original inventor. But he would be the first to confer on the public the benefit of the invention. He would discover what is unknown, and communicate knowledge which the public had not the means of obtaining without his invention. Upon the same principle and upon the same rule of construction, we think that Fitzgerald must be regarded as the first and original inventor of the safe in question. The case as to this point admits that, although Conner's safe had been kept and used for years, yet no test had been applied to it, and its capacity for resisting heat was not known; there was no evidence to show that any particular value was attached to it after it passed from his possession, or that it was ever afterwards used as a place of security for papers; and it appeared that he himself did not attempt to make another like the one he is supposed to have invented, but used a different one. And upon this state of the evidence, the court put it to the jury to say whether this safe had been finally forgotten or abandoned before Fitzgerald's invention, and whether he was the original inventor of the safe for which he obtained the patent; directing them, if they found these two

facts, that their verdict must be for the plaintiff. We think there is no error in this instruction. For if the Conner safe had passed away from the memory of Conner himself, and of those who had seen it, and the safe itself had disappeared, the knowledge of the improvement was as completely lost as if it had never been discovered. The public could derive no benefit from it until it was discovered by another inventor. And if Fitzgerald made his discovery by his own efforts, without any knowledge of Conner's, he invented an improvement that was then new, and at that time unknown; and it was not the less new and unknown, because Conner's safe was recalled to his memory by the success of Fitzgerald's. . . . And if the jury found the fact to be so, and that Fitzgerald again discovered it, we regard him as standing upon the same ground with the discoverer of a lost art, or an unpatented and unpublished foreign invention, and like him entitled to a patent. For there was no existing and living knowledge of this improvement, or of its former use at the time he made the discovery. And whatever benefit any individual may derive from it in the safety of his papers, he owes entirely to the genius and exertions of Fitzgerald." McLean, J. dissenting, Daniel and Grier, JJ. also.

² As to lost arts, Mr. Webster (1 Web. 720, n.), says in substance this: Suppose an article of manufacture . . . to have been manufactured at a certain period in this country in secret, or if not in secret that the whole knowledge of the art was lost, and some man

wanting, and no industrial skill could reproduce the old invention, its revival by the present inventor must depend wholly on his own creative act and possess all the attributes of a new invention.

§ 323. Prior Use: Invention Abandoned before Known to Public a Lost Art.

The length of time for which an invention has been lost, and the degree of public ignorance which may prevail, are of no consequence, provided only that it be actually lost out of the practical knowledge of the public. Thus if an art or instrument has been invented and employed in this country within the present generation and then has been abandoned and forgotten, though its re-invention recalls it to the memory not only of its first inventor but of others who were once familiar with its use, it is a new invention, and is now conferred upon the public as truly as if never known before.¹ Even although the original instrument were not destroyed, but meanwhile has remained disused and unremembered, and since the publication of the later has been recovered and employed, and manifests the same idea of means, it cannot negative the claim of the inventor of the later to have produced a new invention, and to have been the true and only benefactor of the public.²

discovered a mode by which apparently the same article could be produced, could he obtain a patent? The knowledge of the fact of the existence of the article, or its daily use, cannot be the knowledge and use of the art by which it is produced. If the article or its use convey at once the requisite information as to its mode of manufacture, the case is different. What has once been given to the public cannot be resumed; the public being in possession of any species of knowledge, there is no consideration for the exclusive privileges granted by subsequent letters-patent.

§ 323. ¹ That if a machine be the only one, and be destroyed, never given

to the public, and now remembered by the inventor only because reminded of it by the new invention, it was a lost art, and is no bar to a patent, see *Cahoon v. Ring* (1859), 1 Clifford, 592; 1 Fisher, 397.

² That an abandoned and forgotten machine, though still in existence, does not show prior use, see *Hall v. Bird* (1869), 6 Blatch. 438; 3 Fisher, 595.

That the completion of a machine, and testing it, is not prior use if it be afterward taken to pieces and not reconstructed for use till after the patentee's invention is put on the market, see *Fay v. Allen* (1885), 24 Fed. Rep. 804.

§ 324. Prior Use Tested by the Knowledge it Confers on the Public.

It is thus evident that the real test of prior use is the degree of knowledge it confers upon that public to whom the last inventor has communicated his ideas, and from whom he endeavors to obtain his recompense. What knowledge he himself derived from the inventions and experiments of others has reference to another question, not to this. If his examination of their efforts has suggested to him his entire idea, that fact may defeat his claim to any exercise of his inventive faculties, and show that, whether his invention be new or old in reference to the public, he is not entitled to a patent for it as his own.¹ But on the question of the legal novelty of his art or instrument itself, the sources of his personal knowledge are not to be considered. Here his rights stand or fall according to the state of public knowledge; and his invention is a new one to the public, unless, at the date of its creation, it was accessible to them as fully as his inventive act has made it.²

§ 324. ¹ That a prior use, as well as a prior patent or publication, defeats the claim of a patentee for two reasons,— (1) By showing that he is not a true inventor; (2) By showing that the invention is not new, — see *Muntz v. Foster* (1844), 2 Web. 96.

That if, as a matter of fact, the patentee had knowledge of such prior use or publication, he could not have performed the inventive act, see *Stead v. Williams* (1843), 2 Web. 126.

That whether a patentee is chargeable with knowledge of every lost and forgotten machine in the line of his art, and must therefore prove that his invention anticipated all such, is doubted, see *Sinclair v. Backus* (1880), 17 O. G. 1503; 4 Fed. Rep. 539; 5 Bann. & A. 81.

That his knowledge of the invention as in foreign use before his own inven-

tion is a bar, see *Adams v. Loft* (1879), 4 Bann. & A. 495; *Roemer v. Simon* (1877), 95 U. S. 214; 12 O. G. 796; *Roemer v. Simm* (1874), 5 O. G. 555; *Hays v. Sulzor* (1859), 1 Bond, 279; 1 Fisher, 532; *Bartholomew v. Sawyer* (1859), 1 Fisher, 516; 4 Blatch. 347; *Furbush v. Cook* (1857), 2 Fisher, 668; *O'Reilly v. Morse* (1853), 15 How. 62; *Parker v. Stiles* (1849), 5 McLean, 44; *Lewis v. Marling* (1829), 1 Web. 490; 1 Abb. P. C. 417.

That knowledge by the patentee, at the date of his application, that the invention had been made before his own discovery thereof, is a bar, see *Singer v. Walmsley* (1860), 1 Fisher, 558.

² That where prior use has made the same means accessible to the public there can be no novelty in the later invention, see *Holden v. Curtis* (1819), 2 N. H. 61.

SECTION VIII.

OF THE NOVELTY OF INVENTIONS: PRIORITY: PRIOR PUBLICATION.

§ 325. Prior Publication : its Essential Requisites.

The second method recognized by law in which an earlier invention may be made accessible to the public is by Prior Publication.¹ To have this effect the publication must

§ 325. ¹ In *Reeves v. The Keystone Bridge Co.* (1872), 5 Fisher, 456, McKennan, J. : (467) "Section 15 of the patent act of 1836 — and it has been incorporated in the act of 1870 — provides that a patent may be successfully opposed by showing that the thing patented 'had been described in some public work anterior to the supposed discovery thereof by the patentee.' It is obvious that this provision requires, first, a description of the alleged invention ; second, that it shall be contained in a work of a public character and intended for the public ; and third, that this work was made accessible to the public by publication, before the discovery of the invention by the patentee." 1 O. G. 466 (470) ; 9 Phila. 368 (374).

In *Soames's Patent* (1843), 1 Web. 729, Lord Campbell states that publication in a foreign journal, whether known in England or not, may be considered upon the question of the extension of a patent, but that to defeat a patent the publication must have been known in England. In a comment on this *dictum* (1 Web. 719), Mr. Webster says : "The distinction thus made between the legal effect of a publication in an English and in a foreign book would appear to establish this important doctrine, that it is a question for the jury whether such foreign work was known in England at the time the letters-patent were granted ; or the

question would rather appear to be, whether the inventor derived his knowledge from such source, or whether the work was so known that the inventor must be presumed to have derived his knowledge from that source."

In *Stead v. Williams* (1844), 2 Web. 137, Tindal, C. J. : (142) "If the invention has already been made public in England, by a description contained in a work — whether written or printed — which has been publicly circulated, in such case the patentee is not the first and true inventor within the meaning of the statute, whether he has himself borrowed his invention from such publication or not ; because we think the public cannot be precluded from the right of using such information as they were already possessed of at the time the patent was granted. It is obvious that the application of this principle must depend upon the particular circumstances which are brought to bear on each particular case. The existence of a single copy of a work, though printed, brought from a depository where it has long been kept in a state of obscurity, would afford a very different inference from the production of an encyclopædia or other work in general circulation."

Mr. Webster (1 Web. 718, n.) says : "With respect to the legal effect of the publication in a book, — on the principle . . . that knowledge and the means of knowledge on the part of the public are the same, and that the pub-

be: (1) A work of public character, intended for general use; (2) Within reach of the public; (3) Published before the date of the later invention; (4) A description of the same complete and operative art or instrument; and (5) So precise and so particular that any person skilled in the art to which the invention belongs can construct and operate it without experiments and without further exercise of inventive skill. Unless a publication possesses all these characteristics it does not place the invention in the possession of the public, nor defeat the claim of its re-inventor to a patent.

§ 326. Prior Publication: Publication must be a Printed Document Intended for General Use.

A work of public character is such a book or other printed document as is intended and employed for the communication of ideas to persons in general, as distinguished from particular individuals.¹ Private communications, although printed, do not come under this description, whether designed for the use of single persons or of a few restricted groups of persons.² But though the subject of the publication may be highly technical, and therefore interesting only to a single

lic has acquired little or nothing by the specification which it did not possess before, — it has been generally assumed that the production of a book which was in the hands of the public before the date of the patent will negative the title of the patentee as the true and first inventor."

§ 326. ¹ That a written but unpublished description is not a publication, see *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.* (1874), 6 O. G. 34; 1 Bann. & A. 177; 10 Phila. 227.

That a picture or drawing without printed text is not a publication, see *New Process Fermentation Co. v. Koch* (1884), 21 Fed. Rep. 580; 29 O. G. 535; *Reeves v. Keystone Bridge Co.* (1872), 1 O. G. 466; 5 Fisher, 456; 9 Phila. 368; *Judson v. Cope* (1860), 1 Bond, 327; 1 Fisher, 615.

² In *New Process Fermentation Co. v. Koch* (1884), 21 Fed. Rep. 580, Brown, J.: (587) "It has been held generally, and perhaps universally, that business circulars which are sent only to persons engaged or supposed to be engaged in the trade, are not such publications as the law contemplates in § 4886. *Pierson v. Colgate*, 24 O. G. 203; *In re Atterbury*, 9 O. G. 640; *Judson v. Cope*, 1 Fisher, 615; *Reeves v. Keystone Co.*, 5 Fisher, 456; *Seymour v. Osborne*, 11 Wall. 555." 29 O. G. 535 (538).

That a catalogue showing features of the invention is not a publication, see *Forschner v. Baumgarten* (1886), 26 Fed. Rep. 858; 35 O. G. 137.

See also *Pennock v. Dialogue* (1825), 4 Wash. 538; 1 Robb, 466.

class of individuals, yet if prepared for general circulation in that class, it is a public, not a private work.³ Thus the application for a patent, although printed, unless intended, as in England, as a method of communicating the invention to the world, is not a publication.⁴

§ 327. Prior Publication : Publication must be Put into Circulation.

The publication must not only be intended for the public ; it must also have been placed within their reach. In other words, it must have been actually published in such a manner that any one who chooses may avail himself of the information it contains.¹ It is not necessary that many copies of the

³ That a journal devoted to a special science, printed in German, and deposited in the library of the Patent Office, and in the library of the Institute of Civil Engineers, — a society of 3000 members, — and there accessible to them, and catalogued under the head of "Journals" only, though proved to have been read by but one person, is a sufficient publication, see *United Telephone Co. v. Harrison, Cox-Walker, & Co.* (1882), L. R. 21 Ch. 720.

⁴ That a description in an application for a patent, filed in the Patent Office, is not a publication, see *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.* (1874), 6 O. G. 34; 1 Bann. & A. 177; 10 Phila. 227; *Lyman Ventilating and Refrigerator Co. v. Lalor* (1874), 6 O. G. 642; 12 Blatch. 303; 1 Bann. & A. 403; *Corn Planter Patent* (1873), 23 Wall. 181; 6 O. G. 392.

That a printed English provisional specification is a publication when once published, see *Cohn v. U. S. Corset Co.* (1874), 6 O. G. 259; 12 Blatch. 225; 1 Bann. & A. 340.

But not unless full and specific, see *Goff v. Stafford* (1878), 3 Bann. & A. 610; 14 O. G. 748.

That an English specification is not a publication till completed and published, see *Coburn v. Schroeder* (1882),

11 Fed. Rep. 425; 22 O. G. 419; 20 Blatch. 392.

§ 327. ¹ In *Cottier v. Stimson* (1884), 10 Sawyer, 212, Deady, J. : (217) "But something besides printing is required. The statute goes upon the theory that the work has been made accessible to the public, and that the invention has been thereby given to the public, and is no longer patentable by any one. Publication means put into general circulation or on sale where the work is accessible to the public." 20 Fed. Rep. 906 (910).

In *Rumpff v. Köhler* (1882), 23 O. G. 1831, Marble, Com. : (1831) "In all the cases which I have been able to find the word 'patented' has been given its ordinary construction, — that is, *made known*. An invention cannot be considered as *made known* or patented until a complete description of it is given. The testimony, in order to be material, should be such as would prevent the issuance of a patent to another party. Under the section above quoted it is not sufficient that the invention has been known or used in a foreign country; it must have been patented, — that is, *made known*, or it must have been described in some printed publication in such country, in order to make it a bar to the issuance of the patent here."

In *Stead v. Williams* (1844), 2 Web.

work should have been printed, nor that its distribution should have been extensive; for the deposit of a single copy in a library to which the public have or can obtain admission places the work within the reach of all. Nor is it requisite that any person should have read or seen it, since the accessibility of knowledge, and not its actual possession, is all that any inventor can secure. And even though the information be so intermingled with discussions relative to other subjects that it may easily escape attention, and would require some skill and patience to extricate it, the publication will still be sufficient.

§ 328. Prior Publication : Publication must be Put into Circulation before Date of Later Invention.

The publication must precede the date of the invention of the later art or instrument, since otherwise the public could not already be possessed of that which its inventor is now able to bestow.¹ The date of the publication, however, is not

137, Tindal, J. : (143) "The existence of a single copy of a work, though printed, brought from a depository where it has long been kept in a state of obscurity, would afford a very different inference from the production of an encyclopædia or other work in general circulation. The question will be, whether upon the whole evidence there has been such a publication as to make the description a part of the public stock of information."

That a book placed in a bookstore for sale, and sold to several persons, is sufficiently published, see *Lang v. Gisborne* (1862), 31 Beav. 133.

But that a book received at a public library, there mislaid and never catalogued nor made known to the librarian, and, so far as known, never seen by any one except an assistant-librarian, is not thereby made accessible to the public, see *Plimpton v. Spiller* (1877), L. R. 6 Ch. 412; *Plimpton v. Malcolmson* (1876), L. R. 3 Ch. 531.

In *Plimpton v. Spiller* (1877), L. R.

6 Ch. 412, Brett, L. J., stating the doctrine still more emphatically, said : (435) "I cannot agree . . . that it is sufficient to show that the thing has been printed in a book, and that that book has been so placed that it might have been known to the public. It must not only be printed in a book, but that book must be placed in such a position and so used that you may fairly infer or assume that the contents of the book have become known to a sufficient number of people."

§ 328. ¹ In *Ex parte Palmer* (1881), 21 O. G. 1111, Marble, Com. : (1111) "As the statute requires, in order to defeat the grant of a patent, that a publication shall be made before the invention or production of the subject-matter thereof, it does not appear how the previous mechanical patent can have such effect. If the design was invented by the patentée at all it must have been invented before the filing of the application for the mechanical patent in which it is shown, and hence a publication, to be

necessarily the same as that of the printing of the work, nor is it conclusively indicated by any allegation in the work itself.² Its publication is its issue to the public, — a fact the date of which may be established by any evidence sufficient for the purpose; and if the date, so proved, precede the date of the invention in dispute, the latter cannot be a new invention.

§ 329. Prior Publication: Publication must Describe the same Invention.

The invention described in the publication must be identical in all respects with that whose novelty it contradicts.¹

a bar, must have been made before the invention of the mechanism embodying the design.”

In *Bartholomew v. Sawyer* (1859), 4 Blatch. 347, Ingersoll, J. : (352) “It is claimed that the time referred to by the terms ‘having been before known or used in any foreign country’ is the time when the application for the patent was made; and that the terms ‘had been before patented or described in any printed publication’ refer also to the time when such application was made, and not to the time when the original invention or discovery was made. If there be any doubt as to the construction which this proviso should receive, when considered by itself, the true construction of it is free from doubt when it is considered in connection with other sections and with the whole scope of the act. Viewed in such connection, it must be held that the time referred to by the terms above recited is the time when the original invention or discovery of the patentee was made, and not the time when he presented his application to the Commissioner.” 1 Fisher, 516 (521).

But see *Kelleher v. Darling* (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438.

That the date of the invention described in the publication is presumed

to be that of the publication itself, see *Bates v. Coe* (1878), 98 U. S. 31; 15 O. G. 337.

That the date of the later invention is the date of its reduction to practice, see *Webb v. Quintard* (1872), 1 O. G. 525; 9 Blatch. 352; 5 Fisher, 276.

That the reduction to practice must precede the publication, see *Byerly v. Cleveland Linseed Oil Works* (1887), 31 Fed. Rep. 73; *National Spring Co. v. Union Car Spring Mfg. Co.* (1874), 6 O. G. 224; 12 Blatch. 80; *Webb v. Quintard* (1872), 1 O. G. 525; 9 Blatch. 352; 5 Fisher, 276.

See also § 321 and notes, and § 132 and note, *ante*, and § 334 and notes, *post*.

That the publication need not have taken place two years before the date of the invention, see *Parks v. Booth* (1880), 102 U. S. 96; 17 O. G. 1089.

² That the date of printing is only *prima facie* the date of publication, see *Reeves v. Keystone Bridge Co.* (1872), 5 Fisher, 456; 1 O. G. 466; 9 Phila. 368.

§ 329. ¹ In *Gottfried v. The Phillip Best Brewing Co.* (1877), 17 O. G. 675, Dyer, J. : (681) “In the case of the *Clark Patent Steam and Fire Regulator Co. v. Copeland* (1862), 2 Fisher, 222, it was held that in order to find an invention anticipated in a prior printed publication, it must be found from the evidence that the description embodied

The same idea of means, in the same stage of development, as that which the inventor of the later has embodied, must be thereby communicated to the public. The invention thus described must also have been a complete and operative art or instrument, ready for immediate employment by the public.² And it must be described, not as a mere hypothesis either in method or in possibility, but as an existing fact already known.³

§ 330. Prior Publication: Publication must Fully Communicate the Invention to the Public.

Finally, the description must place the invention in the possession of the public as fully as if the art or instrument itself had been practically and publicly employed.¹ In order to ac-

substantially the same organized mechanism, operating substantially in the same manner as that described in the patent claimed to have been anticipated." 5 Bann. & A. 4 (22).

See also *Cohn v. U. S. Corset Co.* (1874), 12 Blatch. 225; 1 Bann. & A. 340; 6 O. G. 259; *Brooks v. Bicknell* (1843), 3 McLean, 250; 2 Robb, 118.

² In *Seymour v. Osborne* (1870), 11 Wall. 516, Clifford, J. : (555) "Whatever may be the particular circumstances under which the publication takes place, the account published, to be of any effect to support such a defence, must be an account of a complete and operative invention, capable of being put into practical operation."

³ Mr. Webster (1 Web. 719, n.), remarks: "Whatever may be the peculiar circumstances under which the publication takes place, the account so published, to be of any effect in law as a publication, must . . . be an account of a complete and perfected invention, and published as such. If the invention be not described and published as a complete, perfected, and successful invention, but be published as an account of some experiment, or by way of

suggestion and speculation, as something which peradventure might succeed, it is not such an account as will vitiate subsequent letters-patent."

That a prior publication must describe the invention as a practical art or instrument, not as a mere scientific experiment, see *United Nickel Co. v. California Electrical Works* (1885), 25 Fed. Rep. 475.

That a prior publication must do more than describe speculations and suggestions of scientific writers, never practically tested and demonstrated, see *Jensen v. Keasbey* (1885), 24 Fed. Rep. 144; *Celluloid Mfg. Co. v. Chrolithion Collar & Cuff Co.* (1885), 23 Fed. Rep. 397; 31 O. G. 519; 23 Blatch. 205.

§ 330. ¹ In *Cahill v. Brown* (1878), 15 O. G. 697, Clifford, J. : (699) "Inventions patented here cannot be superseded by the mere introduction of a foreign patent or publication, though of prior date, unless the description or drawings contain and exhibit a substantial representation of the patented improvement in such full, clear, and exact terms as to enable any person skilled in the art or science to which it appertains, without the necessity of resorting to experiments, to make, con-

comply with this, it must be so particular and definite that from it alone, without experiment or the exertion of his own inven-

struct, and practise the invention as he would be enabled to do from a prior patent for the same invention." 3 Bann. & A. 580 (587).

In *Seymour v. Osborne* (1870), 11 Wall. 516, Clifford, J. : (555) "Patented inventions cannot be superseded by the mere introduction of a foreign publication of the kind, though of prior date, unless the description and drawings contain and exhibit a substantial representation of the patented improvement, in such full, clear, and exact terms as to enable any person skilled in the art or science to which it appertains to make, construct, and practise the invention to the same practical extent as they would be enabled to do if the information was derived from a prior patent. Mere vague and general representations will not support such a defence, as the knowledge supposed to be derived from the publication must be sufficient to enable those skilled in the art or science to understand the nature and operation of the invention, and to carry it into practical use."

In *Plimpton v. Malcolmson* (1876), L. R. 3 Ch. 531, Jessel, M. R. : (567) "What is required as regards prior description? I should have thought, independently of authority, that no prior description ought to invalidate a patent, unless you could make the thing from the description, — I mean unless a person of ordinary skill in the trade could make it from the description. But it has been alleged that something less will do. As I read the authorities that is not so. The question has been before the House of Lords in the case of *Neilson v. Betts* (L. R. 5 H. L. 1). The judgments of Lord Westbury and Lord Colonsay come to this — that the description in the book must be equivalent to a specification.

. . . Now what is the meaning of it being a sufficient specification? Upon that there has been a very great deal of authority. Judges have stated it in different ways, no doubt, but I do not think there is much difference in substance. In the first place, it is plain that the specification of a patent is not addressed to people who are ignorant of the subject-matter. It is addressed to people who know something about it. But there are various kinds of people who know something about it. If it is a mechanical invention, as this is, you have, first of all, scientific mechanics of the first class, — eminent engineers; then you have scientific mechanics of the second class, — managers of great manufactories, great employers of labor, persons who have studied mechanics — not to the same extent as the first class, the scientific engineers, but still to great extent — for the purpose of conducting manufactories of complicated and unusual machines, and who therefore must have made the subject a matter of very considerable study; and in this class I should include foremen, being men of superior intelligence, who like their masters would be capable of invention, and like the scientific engineers would be able to find out what was meant even from slight hints, and still more from imperfect descriptions, and would be able to supplement, so as to succeed even from a defective description, and even more than that, would be able to correct an erroneous description. That is what I would say of the two first classes, which I will call the scientific classes. The other class consists of the ordinary workman, using that amount of skill and intelligence which is fairly to be expected from him, — not a careless man, but a careful man, though not possessing that

tive skill, any person versed in the art to which it appertains could construct and use it. But this requirement relates only to the precise idea expressed in the invention. If, for example, this should be a manufacture, the method of producing it forms no part of the invention and therefore need not be described.²

great scientific knowledge or power of invention which would enable him by himself, unaided, to supplement a defective description, or correct an erroneous description. Now, as I understand, to be a good specification it must be intelligible to the third class I have mentioned, and that is the result of the law. It will be a bad specification if the first two classes only understand it, and if the third class do not. I do not think, when the cases come to be examined, there is really any difference between the judges on this point. Their language differs, but I do not think the cases differ."

That the description in the publication must so describe the invention that those skilled in the art could construct and practise the invention from the description alone, see *Eames v. Andrews* (1887), 122 U. S. 40; 39 O. G. 1319; *Cary v. Lovell Mfg. Co.* (1887), 31 Fed. Rep. 344; *Adams v. Bellaire Stamping Co.* (1886), 28 Fed. Rep. 360; 36 O. G. 567; *Hood v. Boston Car Spring Co.* (1884), 21 Fed. Rep. 67; *Downton v. Yeager Milling Co.* (1883), 108 U. S. 466; 25 O. G. 697; *Miller v. Pickering* (1883), 16 Phila. 533; 25 O. G. 89; 16 Fed. Rep. 540; *Nathan v. Elevated R. R. Co.* (1880), 5 Bann. & A. 280; 2 Fed. Rep. 225; *Bignall v. Harvey* (1880), 18 O. G. 1275; 18 Blatch. 353; 4 Fed. Rep. 334; *Parks v. Booth* (1880), 102 U. S. 96; 17 O. G. 1089; *Atlantic Giant Powder Co. v. Parker* (1879), 16 O. G. 495; 16 Blatch. 281; *Goff v. Stafford* (1878), 14 O. G. 748; 3 Bann. & A. 610; *Cohn v. U. S. Corset Co.* (1876), 93 U. S. 366; 11 O. G. 457; *Westinghouse v. Gardner*

& *Rawson Air Brake Co.* (1875), 2 Bann. & A. 55; 9 O. G. 538; *McMillin v. Barclay* (1872), 5 Fisher, 189; *Roberts v. Dickey* (1871), 1 O. G. 4; 4 Fisher, 532; 4 Brews. (Pa.) 260; *Seymour v. Osborne* (1870), 11 Wall. 516; *Hays v. Sulsor* (1859), 1 Bond, 279; 1 Fisher, 532; *Parker v. Stiles* (1849), 4 McLean, 44; *Plimpton v. Malcolmson* (1876), L. R. 3 Ch. 531; *Woodcroft's Patent* (1846), 2 Web. 18.

That the description must be sufficient at the time when it is published, not merely in the light of subsequent discoveries, see *Betts v. Neilson* (1868), L. R. 3 Ch. Ap. 429.

That the publication must describe the invention as fully as does the patent to which it is offered as a bar, see *New Process Fermentation Co. v. Koch* (1884), 21 Fed. Rep. 580; 29 O. G. 535; *Downton v. Yeager Milling Co.* (1883), 108 U. S. 466; 25 O. G. 697; *Hills v. Evans* (1862), 6 L. T. N. s. 90.

That an invention can be described by compiling extracts from various books is not enough, — the publication must give by itself a full account of the invention, — see *Van Heyden v. Neustadt* (1880), 42 L. T. N. s. 300.

² That the publication need not describe the method by which the invention is produced, provided the description of the invention itself is sufficient to enable others to make it, see *Cohn v. U. S. Corset Co.* (1876), 93 U. S. 366; 11 O. G. 457.

That the sufficiency of the publication is a question for the jury, see *Adams v. Bellaire Stamping Co.* (1886), 28 Fed. Rep. 360; 36 O. G. 567.

SECTION IX.

OF THE NOVELTY OF INVENTIONS : PRIORITY : PRIOR PATENT.

§ 331. Prior Patent: its Essential Requisites.

The third method in which the knowledge of an invention can be communicated to the public is by the issue of a patent. In effect, this method is merely another form of the second; the idea embodied in the invention being, here as there, exhibited in words and not through any art or instrument in actual operation.¹ Like that, the patent must be: (1) A public document; (2) Accessible to the public; (3) Issued before the date of the later invention; (4) For the same operative means; and (5) Sufficient to place the idea of the inventor fully in the possession of the public. Such differences as exist in the details of the two methods will be made apparent as we proceed in this discussion of the third.

§ 331. ¹ In *Cornish v. Keene* (1835), 1 Web. 501, Tindal, C. J. : (510) "Undoubtedly if you could show under the hand of the plaintiff, or any body's hand, that the secret had been publicly communicated to the world, which was intended to be covered by the subsequent patent, there is an end of that patent; if the world at large had been informed by this specification of the color, fabric, and manufacture which is intended to be effected by the subsequent patent, the subsequent patent must fall to the ground." 2 Abb. P. C. 139 (175).

Mr. Webster, in a note to *Househill Co. v. Neilson*, 1 Web. 718, says: "The specification of a prior patent . . . has always been held sufficient of itself to invalidate subsequent letters-patent for the invention therein described, without any evidence of user." In support of this proposition he refers to *Huddart v.*

Grimshaw, 1 Web. 85, and gives as the reasons underlying it: (1) That knowledge and the means of knowledge are the same thing; (2) That a patent being a public record, the public are bound to take notice of it; (3) That it negatives the claim of the patentee to be the true and first inventor; and (4) That the granting of the patent is conclusive evidence that the invention is complete and available for public use. Not all these reasons are now recognized as valid.

That a prior patent and a prior publication stand on the same ground, see *Webb v. Quintard* (1872), 9 Blatch. 352; 5 Fisher, 276; 1 O. G. 525.

That a prior patent defeats a patent for an invention subsequently made, see *Kelleher v. Darling* (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438; *Muntz v. Foster* (1844), 2 Web. 96.

§ 332. **Prior Patent: Patent must be a Public Document.**

A patent becomes a public document when duly granted by the state and issued to the patentee. Prior to that event, whatever be the character of the proceedings, it is but a private matter between the government and the inventor, with which the public, as such, have no immediate concern. Thus a mere application although known to many, or printed matter such as notes of evidence, briefs of counsel, or interlocutory decisions of the Patent Office and the courts, however fully they describe the invention or however widely circulated, are no part of the patent, nor can they, unless they fulfil the usual requirements of a printed publication as recited in the last section, be regarded as bestowing the invention on the public.¹ Nor is the patent, although issued to the patentee, a complete public document, in the sense here intended, unless it contains or has annexed to it the specification of the patented invention.² Where, as in this country, the law requires the specification to be made part of the patent, the patent is a public document from the moment of its issue. But if the letters-patent constitute a separate document and the specification is subsequently given to the world, the patent is complete, for the present purpose, only when the publication of the full description has been made.³

§ 332. ¹ That description in a prior specification, the patent not having been issued, is no bar, see *Graham v. McCormick* (1880), 10 Bissell, 39; 11 Fed. Rep. 859; 21 O. G. 1533; 5 Bann. & A. 244; *Barker v. Stowe* (1878), 14 O. G. 559; 15 Blatch. 49; 3 Bann. & A. 337; *Lyman Ventilating & Refrigerator Co. v. Chamberlain* (1876), 10 O. G. 588; 2 Bann. & A. 433; *Corn Planter Patent* (1874), 23 Wall. 181; 6 O. G. 392.

That this is true though the prior specification were filed by the same inventor, see *Graham v. McCormick* (1880), 10 Bissell, 39; 11 Fed. Rep. 859; 21 O. G. 1533; 5 Bann. & A. 244.

² That an English patent is not issued until the complete specification is en-

rolled, see *Ex parte Mann* (1880), 17 O. G. 330.

That an English patent dates from the filing of the specification, see *Lorillard v. Dohan* (1881), 20 O. G. 1587; 20 Blatch. 63; 9 Fed. Rep. 509; *Bell v. Brooks* (1881), 19 O. G. 290; *American Diamond Rock Boring Co. v. Sheldon* (1879), 17 Blatch. 303; *Chambers v. Duncan* (1876), 9 O. G. 741.

That a Canadian patent dates from its date and issue, not from its delivery, see *Bate Refrigerating Co. v. Gillett* (1882), 22 O. G. 1205; 13 Fed. Rep. 553.

³ That a provisional specification in England is not a publication until published, and not then unless it completely describes the invention, see *Co-*

§ 333. **Prior Patent: Patent must be Accessible to the Public.**

Moreover, the patent must have been accessible to the public. This generally occurs as soon as the patent issues to the patentee. But if, for any cause, the patent is kept secret in the archives of the government, as in some foreign countries may be done in certain cases, it has no effect as a prior patent or publication.¹ The same is true as long as any portion of the patent, essential to its integrity, remains concealed; but when once completely published, no matter in how distant a community or how great a period of time must intervene before it can be known in other nations, it is regarded as accessible to all.²

§ 334. **Prior Patent: Patent must be Issued before the Date of the Later Invention.**

In order to anticipate an alleged later invention, the prior patent, like other forms of publication, must be completely issued before the inventor of the later has reduced his own idea to practice.¹ But the duration of the intermediate

burn v. Schroeder (1882), 11 Fed. Rep. 425; 22 O. G. 419; 20 Blatch. 392; Goff v. Stafford (1878), 3 Bann. & A. 610; 14 O. G. 748.

That an English patent becomes complete as a prior patent only when the specifications are filed in the office of the Great Seal, see *Lorillard v. Dohan* (1881), 20 O. G. 1587; 20 Blatch. 63; 9 Fed. Rep. 509; *Smith v. Goodyear Dental Vulcanite Co.* (1876), 93 U. S. 486; 11 O. G. 246; *Howe v. Morton* (1860), 1 Fisher, 586; *Cornish v. Keene* (1836), 1 Web. 513; 2 Abb. P. C. 406.

§ 333. ¹ That a patent, though issued, is no bar while kept secret, see *Schoerken v. Swift & Courtney & Beecher Mfg. Co.* (1881), 19 O. G. 1493; 7 Fed. Rep. 469; 19 Blatch. 209.

² That a foreign patent takes effect as such only from the period of its enrolment, see *Willimantic Linen Co. v. Clark Thread Co* (1879), 4 Bann. & A. 133.

That "patented," in Sec. 4886, means "made known," and this is not true of a British patent until the completed specification is filed, see *Rumpf v. Köhler* (1882), 23 O. G. 1831; *Howe v. Morton* (1860), 1 Fisher, 586.

§ 334. ¹ That the date of the later invention is the date of its reduction to practice, see *National Spring Co. v. Union Car Spring Mfg. Co.* (1874), 6 O. G. 224; 12 Blatch. 80; *Webb v. Quintard* (1872), 1 O. G. 525; 9 Blatch. 352; 5 Fisher, 276.

That the date of the invention described in the prior patent is the date of the patent, see *Rumpf v. Köhler* (1882), 23 O. G. 1831, 1832; *Ex parte Lanfrey* (1881), 20 O. G. 892; *Bell v. Brooks* (1881), 19 O. G. 290; *De Florez v. Reynolds* (1880), 17 O. G. 503; 17 Blatch. 436; 8 Fed. Rep. 434; 5 Bann. & A. 140; *Kelleher v. Darling* (1878), 3 Bann. & A. 438; 4 Clifford, 424; 14 O. G. 673; *Bates v. Coe* (1878), 98 U. S. 31;

period is immaterial. The patent being fully published the invention passes at once into the possession of the public and can no longer be conferred upon them by another. Under the American law, however, the rights of an actual prior conceiver are protected against the public as well as the prior patentee, if he has diligently reduced his own ideas to practice.²

§ 335. **Prior Patent: Patent must Cover the Same Invention.**

Again, the patent must be issued for the same complete and operative means. Unless the alleged earlier invention were an operative art or instrument the patent would not only, in itself, be void, but its descriptions would be merely speculative, and not the statement of existing facts. The patent, also, must relate to an invention of the same intrinsic character, and cover the exact idea of means which the inventor of the later has conceived.¹ Hence, where the same device

15 O. G. 337; *Elizabeth v. Pavement Co.* (1877), 97 U. S. 126; *Cochrane v. Deener* (1876), 94 U. S. 780; 11 O. G. 687; *White v. Allen* (1863), 2 Fisher, 440; 2 Clifford, 224; *Howe v. Morton* (1860), 1 Fisher, 586.

That unless the date of the reduction to practice of the later invention precedes the date of the publication of the alleged prior patent, such patent will be a bar, see *Byerly v. Cleveland Linseed Oil Works* (1887), 31 Fed. Rep. 73; *National Spring Co. v. Union Car Spring Mfg. Co.* (1874), 6 O. G. 224; 12 Blatch. 80; *Webb v. Quintard* (1872), 1 O. G. 525; 9 Blatch. 352; 5 Fisher, 276.

That a prior patent, issued by the United States, does not defeat a patent the application for which was filed before the filing of the application for such prior patent, see *Allen v. City of New York* (1879), 17 O. G. 1281; *Singer v. Braunsdorf* (1870), 7 Blatch. 521.

That a prior patent, in order to defeat a later one, need not have been issued two years before the date of re-

duction to practice by the later patentee, see *Parks v. Booth* (1880), 102 U. S. 96; 17 O. G. 1089.

That in a defence of prior patent the question is whether the plaintiff made his invention before the date of the patent, not before the inventive act of the alleged patentee, see *Tyler v. Crane* (1880), 7 Fed. Rep. 775; 19 O. G. 128.

² That to avoid the effect of an alleged prior patent an inventor may show the date of his conception if he has diligently reduced to practice, see *Bates v. Coe* (1878), 98 U. S. 31; 15 O. G. 337; *Kelleher v. Darling* (1878), 3 Bann. & A. 438; 4 Clifford, 424; 14 O. G. 673.

See §§ 132, 321, 328, and notes, *ante*.

§ 335. ¹ That the prior patent must be for the same invention, see *Cohn v. U. S. Corset Co.* (1874), 12 Blatch. 225; 6 O. G. 259; 1 Bann. & A. 340; *Clark Patent Steam & Fire Regulator Co. v. Copeland* (1862), 2 Fisher, 221; *Brooks v. Bicknell* (1843), 3 McLean, 250; 2 Robb, 118.

That the prior patent must cover the

embodies two distinct ideas of means, but is so patented that only one of these is made accessible to the public through the patent, the same device, as the embodiment of the other, still remains unknown, and when discovered and completed is a new invention.² So when the inventor of the patented invention has included in his art or instrument some act or part, without perceiving its significance, and thus in patenting it fails to specifically describe such part or act, although if his invention had been practically employed such act or part might have become known to the public, his patent does not place it in their reach, nor, if reissued after the later inven-

whole of the invention, not merely a part of it, see *Frearson v. Loe* (1878), L. R. 9 Ch. 48; *Stoner v. Todd* (1875), L. R. 4 Ch. 58. But see *Florsheim v. Schilling* (1886), 26 Fed. Rep. 256; 35 O. G. 1435.

That a prior patent for a device does not defeat a patent for a combination of which such device forms one element, see *McMillin v. Rees* (1880), 17 O. G. 1222; 1 Fed. Rep. 722; 5 Bann. & A. 269.

That several prior patents for the several devices afterward employed as elements of a new combination cannot defeat the patent for such combination, see *Bates v. Coe* (1878), 98 U. S. 31; 15 O. G. 337.

That two separate patents, though taken together they would cover the invention, cannot defeat a patent for it as a whole, see *Munson v. Gilbert & Barker Mfg. Co.* (1878), 3 Bann. & A. 595; 18 O. G. 194.

But that where a prior patent covers a whole, no subsequent patent can be issued for any part which is included in such whole and is so described, see *Stow v. Chicago* (1877), 3 Bann. & A. 83; 8 Bissell, 47.

That where a prior patent describes a class of substances when only certain ones of the class can answer the purposes of the invention, it does not de-

feat a patent for the discovery of the particular substances which will answer, see *Hills v. Gas Light Co.* (1860), 5 H. & N. 312.

That a patent suggesting a result is no bar to a patent for the means by which the result is produced, see *Graham v. Gammon* (1877), 3 Bann. & A. 7; 7 Bissell, 490.

That a prior patent for one means of producing a result does not defeat a patent for a different means of producing the same result, see *Hullett v. Hague* (1831), 2 B. & Ad. 370; 2 Abb. P. C. 453. See also § 90 and notes, *ante*.

² That a prior patent for a design does not defeat a patent for the same substance in the same form as a device, the ideas of means being distinct, see *Collender v. Griffith* (1880), 2 Fed. Rep. 206; 18 O. G. 241; 18 Blatch. 110. This could be true only where the mechanical idea of means was not apparent on the face or from the use of the invention as a design, but was the result of subsequent discovery.

That a prior patent for a manufacture is no bar to a patent to the same inventor for the same matter as a design, unless there has been an abandonment by two years' public use or sale, see *Ex parte Palmer* (1881), 21 O. G. 1111. See also § 360 and notes, *post*.

tion is perfected, can it, as a mere publication by a prior patent, bar the last inventor's right.³ The patent, as it stands at the date of the later invention, must give to the world the same idea, in the same state of completeness, as the later, or the novelty of the later cannot thereby be defeated.

§ 336. **Prior Patent: Patent must Fully Communicate the Invention to the Public.**

The rules which govern the sufficiency of the description in the prior patent are the same as in regard to other forms of publication. It must place the invention in the possession of the public as fully as an examination of the practically operative art or instrument could do.¹ It must describe every essen-

³ That a prior patent not *describing* an invention subsequently patented, but after the issue of the later patent re-issued in such a manner as to embrace it, cannot defeat the later *as a prior patent*, see *Vogler v. Semple* (1877), 11 O. G. 923 ; 7 Bissell, 382 ; 2 Bann. & A. 556.

That no reissue of a prior patent can affect the plaintiff's patent unless the original did so, see *Hitchcock v. Tremaine* (1872), 5 Fisher, 537 ; 1 O. G. 633 ; 9 Blatch. 550.

§ 336. ¹ That the invention described in the patent must be complete and practical, see *Downton v. Yaeger Milling Co.* (1880), 1 Fed. Rep. 199 ; 1 McCrary, 26 ; 17 O. G. 906 ; 5 Bann. & A. 112 ; *Betts v. Menzies* (1857), 3 Jur. N. S. 357. See also §§ 318, 329, and notes, *ante*.

That the prior patent must contain a full and precise description of the entire invention, see *Hammerschlag v. Scamoni* (1881), 20 O. G. 1449 ; *Nathan v. N. Y. Elevated R. R. Co* (1880), 2 Fed. Rep. 225 ; 5 Bann. & A. 280 ; *Parks v. Booth* (1880), 102 U. S. 96 ; 17 O. G. 1089 ; *Atlantic Giant Powder Co. v. Rand* (1879), 4 Bann. & A. 263 ; 16 Blatch. 250 ; 16 O. G. 87 ; *Cahill v. Brown* (1878), 3 Bann. & A. 580 ;

15 O. G. 697 ; *Vogler v. Semple* (1877), 11 O. G. 923 ; 7 Bissell, 382 ; 2 Bann. & A. 556 ; *Cohn v. U. S. Corset Co.* (1876), 93 U. S. 366 ; 11 O. G. 457 ; *Cohn v. U. S. Corset Co.* (1874), 12 Blatch. 225 ; 6 O. G. 259 ; 1 Bann. & A. 340 ; *Woodman v. Stimpson* (1866), 3 Fisher, 98 ; *Cornish v. Keene* (1836), 1 Web. 513 ; 2 Abb. P. C. 406.

That the prior patent must have been sufficient to enable the invention to be practised from it alone, at the date of the patent, not merely in the light of subsequent discoveries, see *Betts v. Neilson* (1868), L. R. 3 Ch. Ap. 429.

That where the invention is a product, the prior patent need not have described the method of producing it, see *Cohn v. U. S. Corset Co.* (1876), 93 U. S. 366 ; 11 O. G. 457 ; *Cohn v. U. S. Corset Co.* (1874), 12 Blatch. 225 ; 6 O. G. 259 ; 1 Bann. & A. 340.

That a prior patent, which varies from the one in question only in matters not requiring inventive skill, may anticipate it, see *Sax v. Taylor Iron Works* (1887), 40 O. G. 118.

That if a prior foreign patent so far suggests the invention that any skilled workman could make it, the anticipation is established, see *United States Bung Mfg. Co. v. Independent Bung*

tial element of the invention so clearly and completely that any person skilled in the art could construct and use it from the directions given in the patent, without experimenting or exerting his inventive powers.

§ 337. **Prior Patent: Patent has the same Effect to Whomsoever Issued.**

To whom the prior patent has been issued is a matter of no consequence. If to a different inventor, the public are indebted to him, not to the present claimant, for the benefits conferred by the invention, and he, if either, is entitled to a patent. If to the present claimant, although the merit of discovery and publication may be his alone, yet having once completed the invention and given it to the world by his prior patent, he cannot re-invent it nor present it as a new invention, nor again justly seek for and obtain such recognition.¹ His former patent has assured him all the compensation which was legally his due, and any effort to prolong the period of

& Bushing Co. (1887), 31 Fed. Rep. 76. See also § 330 and notes, *ante*.

§ 337. ¹ In *Mathews v. Flower* (1885), 25 Fed. Rep. 830, Brown, J. : (830) "If it were true that complainants had previously obtained a patent for the same invention secured to them by the patent in suit, and that this prior patent had expired, it would doubtless be a complete answer to this bill, since a man cannot have two patents for the same invention. *James v. Campbell*, 104 U. S. 356; *Suffolk Co. v. Hayden*, 3 Wall. 315; *Morris v. Huntington*, 1 Paine, 348."

In *James v. Campbell* (1882), 104 U. S. 356, Bradley, J. : (382) "It is hardly necessary to remark that the patentee could not include in a subsequent patent any invention embraced or described in a prior one granted to himself any more than he could an invention embraced or described in a prior patent granted to a third person. Indeed, not so well; because he might

get a patent for an invention before patented to a third person in this country if he could show that he was the first and original inventor, and if he should have an interference declared." 21 O. G. 337 (344).

See also *McMillin v. Rees* (1880), 5 Bann. & A. 269; 1 Fed. Rep. 722; 17 O. G. 1222; *Corn Planter Patent* (1873), 23 Wall. 181; 6 O. G. 392.

That an invention described but not claimed in a former patent to the same inventor may be patented in a later patent unless abandoned, see *Vermont Farm Mach. Co. v. Marble* (1884), 22 Blatch. 32; 19 Fed. Rep. 307; 27 O. G. 621.

That an inventor and patentee of a combination may afterward obtain a patent for a sub-combination unless it has been abandoned, see *Cahn v. Wong Town On* (1884), 9 Sawyer, 630; 27 O. G. 299; 19 Fed. Rep. 424.

See also §§ 352, 460-467, 506, and notes, *post*.

his monopoly by embracing his old discovery in a new patent, whether alone or in connection with improvements, is in vain. A single exception to this latter rule arises where the inventor, having taken out a foreign patent for the same invention, endeavors to secure exclusive rights in this country by applying for a patent within two years after the introduction of his invention into actual use in the United States. The prior foreign patent is in such a case no bar.²

² Rev. Stat., 1874, § 4887.

That a prior foreign patent to the same inventor is not a bar unless there has been two years' public use in this

country under Sec. 4887, Rev. Stat., see *Vogelely v. Noel* (1884), 18 Fed. Rep. 827. See also § 461 and notes, *post*.

CHAPTER IV.

OF THE UTILITY OF INVENTIONS.

§ 338. Utility Essential to Patentability.

In order that an invention may be patentable it must not only be bestowed upon the public by its inventor, but when bestowed it must confer on them a benefit. The invention must therefore be useful as well as new.¹ No recompense can properly be made to one from whom the community re-

§ 338. ¹ In *Morgan v. Seaward* (1837), 1 Web. 187, Parke, B. : (197) "A grant of a monopoly for an invention which is altogether useless may well be considered as 'mischievous to the State, to the hurt of trade, or generally inconvenient,' within the meaning of the statute of Jac. I., which requires, as a condition of the grant, that it should not be so; for no addition or improvement of such an invention could be made by any one during the continuance of the monopoly, without obliging the person making use of it to purchase the useless invention; and on a review of the cases, it may be doubted whether the question of utility is anything more than a compendious mode, introduced in comparatively modern times, of deciding the question whether the patent be void under the Statute of Monopolies." 2 Abb. P. C. 419 (431).

In speaking of the common-law patents, before the stat. Jac. I., Webster says: "The utility of the invention is distinctly recognized in all of them as part of the motive or consideration; but this condition would appear to differ from the others, in admitting of degrees. If an invention be totally useless, the

purposes and object of the grant would fail, and such grant would consequently be void, not only on the ground of false suggestion and failure of consideration, but also on the ground of its being prejudicial, as having a tendency to stop improvement." 1 Web. 8, n.

That utility is necessary, see *Page v. Ferry* (1857), 1 Fisher, 298; *Earle v. Sawyer* (1825), 4 Mason, 1; 1 Robb, 491; *Langdon v. De Groot* (1822), 1 Paine, 203; 1 Robb, 433; *Lowell v. Lewis* (1817), 1 Mason, 182; 1 Robb, 131.

That utility in an improvement will support a patent for the improvement whether the original were useful or not, see *Lewis v. Davis* (1829), 1 Web. 488; 1 Abb. P. C. 406.

In *Lewis v. Marling* (1829), 1 Web. 493, it was stated that utility was not required by the stat. Jac. I.; but that it is essential under that statute as interpreted by the courts, see *Bovill v. Moore* (1816), Dav. P. C. 361; 1 Abb. P. C. 231; *Manton v. Manton* (1815), Dav. P. C. 333; 1 Abb. P. C. 189.

That utility is a question of fact for the jury, see *Losh v. Hague* (1838), 1 Web. 202; 2 Abb. P. C. 501.

ceives no consideration ; and hence no patent can be granted for a worthless art or instrument, nor, although granted, can it be sustained after the uselessness of the invention is established.

§ 339. Utility Means Industrial Value.

Utility, as predicated of inventions, means industrial value ; the capability of being so applied in practical affairs as to prove advantageous in the ordinary pursuits of life, or add to the enjoyment of mankind.¹ But a mere curiosity, a scientific process exciting wonder yet not producing physical results, or any frivolous or trifling article or operation not aiding in the progress nor increasing the possessions of the human race, whatever be its novelty, and whatever skill has been in-

§ 339. ¹ In *Rowe v. Blanchard* (1864), 18 Wis. 441, Dixon, J. : (442) "The 'practical uses' to which the invention may be applied, or of which 'it shall be capable,' we understand to be the uses intended by the patentee, and named in the patent. Upon the question of its practicability in this case, there was a conflict of testimony. It was a question to be decided by the jury, under proper instructions from the court. *Park v. Little*, 1 Robb's Cases, 17 (3 Wash. 196.) If it was practically useless, then there was no consideration for the notes. *Dickinson v. Hall*, and *Lester v. Palmer*, *supra*. The defendant's counsel asked the court to give the jury the following instruction, which was refused : 'If you find from the testimony that this harrow is impracticable to be used for the purpose for which it was patented, then the defense of want or failure of consideration is established.' This was error. The instruction should have been given." See also *Parkhurst v. Kinsman* (1849), 1 Blatch. 488.

That an invention is useful if available for one of the purposes proposed by the inventor, though not for others, see *Phillips v. Risser* (1885), 26 Fed. Rep. 308 ; *Morgan v. Seaward* (1837), 1 Web.

187 ; 2 Abb. P. C. 419 ; *Haworth v. Hardcastle* (1834), 2 Abb. P. C. 19.

That utility is absence of frivolity and mischievousness, and utility for some beneficial purpose, see *McComb v. Ernest* (1871), 1 Woods, 195 ; *Crompton v. Belknap Mills* (1869), 3 Fisher, 536 ; *Cox v. Griggs* (1861), 1 Bissell, 362 ; 2 Fisher, 174 ; *Wintermute v. Redington* (1856), 1 Fisher, 239 ; *Parker v. Stiles* (1849), 5 McLean, 44 ; *Dunbar v. Marden* (1842), 13 N. H. 311 ; *Dickinson v. Hall* (1833), 14 Pick. 217 ; *Whitney v. Emmett* (1831), Baldwin, 303 ; 1 Robb, 567 ; *Kneass v. Schuylkill Bank* (1820), 4 Wash. 9 ; 1 Robb, 303 ; *Lowell v. Lewis* (1817), 1 Mason, 182 ; 1 Robb, 131 ; *Bedford v. Hunt* (1817), 1 Mason, 302 ; 1 Robb, 148.

That if a design is attractive it is useful, see *Ex parte Norton* (1882), 22 O. G. 1205.

That in an ornament superior beauty indicates utility, see *Magic Ruffle Co. v. Douglass* (1863), 2 Fisher, 330.

That cheapness is not utility, see *Cornish v. Keene* (1835), 1 Web. 501 ; 2 Abb. P. C. 139.

That an invention is useful where it increases the salability of an article, see *Newbury v. Fowler* (1886), 28 Fed. Rep. 454 ; 36 O. G. 817.

volved in its production, does not fall within the class of useful inventions nor become the subject-matter of a patent.

§ 340. **Utility Absent if the Invention is Immoral or too Dangerous for Use.**

Inventions which accomplish definite practical results may nevertheless possess such attributes as destroy the benefits that otherwise they would bestow upon the public. Inventions whose chief or only value resides in the facilities which they afford to men to perpetrate some wrongful injury either by fraud or violence against each other are thus regarded as destitute of true utility.¹ For the same reason arts or instruments which if completed and in actual use might be of benefit to their employer are sometimes held to be devoid of real utility on account of the great risks incurred in their construction.² The courts, in their consideration of this subject, must necessarily contemplate the entire effects of the invention, as well upon the maker and the operator as upon the consumer; and if the net result to the community at large is not a benefit, the inventor has no claim upon the public.

§ 341. **Degree of Utility Immaterial.**

When actual utility exists, its degree is unimportant.¹ However slight the advantage which the public have received from

§ 340. ¹ That an invention which is useful only to commit fraud has no patentable utility, see *Klein v. Russell* (1873), 19 Wall. 433.

That an invention which can be used only for immoral purposes is not patentable, see *Dunbar v. Marden* (1842), 13 N. H. 311; *Lowell v. Lewis* (1817), 1 Mason, 182; 1 Robb, 131.

² In *Mitchell v. Tilghman* (1873), 19 Wall. 287, Clifford, J. : (396) "It cannot be held that the invention is useful if it appears that the operator, in using the described means, is constantly exposed to imminent danger, either from the explosive tendency of the substance to be used, or from the liability

of the vessel to burst which is required to be employed as a means of accomplishing the patented result. . . . as it is quite clear that Congress, in making provision to secure to inventors the exclusive right to their discoveries, never intended to promote any such as were in their nature constantly dangerous to the operator in employing the described means to accomplish the described result." 5 O. G. 299 (305).

§ 341. ¹ In *Morgan v. Seaward*, (1836), 1 Web. 170, Alderson, B. : (172) "It is not for you to consider to what extent the thing is useful. If it is a useful invention, then it is a subject to be protected by patent, and if,

the inventor, it offers a sufficient reason for his compensation; and as he could withhold this slight advantage if he chose, his surrender of it to the public places him on the same plane of merit with every other inventor. Nor is it necessary that this advantage, whether great or small, should flow directly from his art or instrument, considered by itself. For though it is a mere improvement upon pre-existing arts or instruments, or is incapable of serving any purpose except as an integral part or element of some different invention, or embodies an idea of means whose highest value can be realized only by advancing it to a more perfect state of development, it still has an inherent usefulness which satisfies this requirement of the law.²

on the other hand, it is of no use, then it is no subject to be protected by patent. The issue is, whether it is of any use at all."

That the degree of utility is not material, see *Gibbs v. Hoefner* (1884), 22 Blatch. 36; 19 Fed. Rep. 323; *Crouch v. Speer* (1874), 6 O. G. 187; 1 Bann. & A. 145; *Westlake v. Cartter* (1873), 4 O. G. 636; 6 Fisher, 519; *Smith v. O Connor* (1873), 4 O. G. 633; 2 Sawyer, 461; 6 Fisher, 469; *Whitney v. Mowry* (1867), 2 Bond, 45; 3 Fisher, 157; *Hoffheins v. Brandt* (1867), 3 Fisher, 218; *Rowe v. Blanchard* (1864), 18 Wis. 441; *Tilghman v. Werk* (1862), 1 Bond, 511; 2 Fisher, 229; *Vance v. Campbell* (1859), 1 Fisher, 483; *Johnson v. Root* (1858), 1 Fisher, 351; *Bierce v. Stocking* (1858), 11 Gray, 174; *Wintermute v. Redington* (1856), 1 Fisher, 239; *Dunbar v. Marden* (1842), 13 N. H. 311.

That an invention is useful if it is capable of any beneficial use, see *Tod v. Wick Bros.* (1881), 36 Ohio St. 370; *Gillett v. Bate* (1881), 86 N. Y. 87; 10 Abb. N. C. 88,

² In *Wheeler v. The Clipper Mower & Reaper Co.* (1872), 10 Blatch. 181, *Woodruff, J.*: (185) "On the other hand, if it be meant that no device is patentable which has not in itself, apart

from any connection with, or application to, other known devices or instrumentalities, capacity to produce practically useful results, then the proposition is not true. Patents for simple devices, and patents for parts of machines, are almost numberless, of which it may be truly said that it is only by connection with other devices or instrumentalities, to which they are intended to be applied, that they can be made to produce any result whatever. True, the patentee is bound to disclose a mode in which they may be rendered practically useful, and it may be one of many modes, and it may necessarily involve the use of many other known devices which are required in order to the useful result. Patents may be granted for combinations in which some of the parts are old and some are new, and whatever in the several parts is new may be separately secured to the inventor; and yet it may be true that only in the combination described, or in some similar combination, is the new part thus secured to the inventor of any practical use whatever." 2 O. G. 442 (443); 6 Fisher 1 (17).

See also *Williams v. Boston & Albany R. R. Co.* (1879), 17 Blatch. 21; 16 O. G. 906; 4 Bann. & A. 441; *Wells v. Jacques* (1874), 1 Bann. & A. 60;

§ 342. **Utility Actual, not Comparative.**

The existence of utility in an invention is not determined by comparing it with other arts or instruments.¹ It is not essential to its patentability that an invention should supersede or be superior to others theretofore employed for the same purpose; nor is it inconsistent with its usefulness that it should, in its turn, have been displaced by subsequent inventions. It must be useful in itself, in some degree, at the date of its bestowal on the public. This being true, it is a sufficient consideration for the grant of an exclusive right, although the value of that right to the inventor may depend almost entirely on the relative superiority of his invention when compared with others.

5 O. G. 364; *Morgan v. Seaward* (1837), 1 Web. 187; 2 Abb. P. C. 419.

That an invention is useful if capable of such development as to render it practically useful, see *Wheeler v. Clipper Mower & Reaper Co.* (1872), 10 Blatch. 181; 6 Fisher, 1; 2 O. G. 442; *Gray v. James* (1817), 1 Peters C. C. 476; 1 Robb, 140.

That an invention may be useful though susceptible of great improvement, see *Neilson v. Harford* (1841), 1 Web. 295.

That a patent is valid if the invention serves any use though it will not apply to all the uses claimed for it, see *Phillips v. Risser* (1885), 26 Fed. Rep. 308.

§ 342. ¹ In *Cook v. Ernest* (1872), 2 O. G. 89, Woods, J. : (92) "All the law requires as to utility is that the invention shall not be frivolous or dangerous. It does not require any degree of utility. It does not exact that the subject of the patent shall be better than anything invented before or that shall come after. If the invention is useful at all that suffices." 5 Fisher, 396 (405).

In *Roberts v. Ward* (1849), 4 McLean, 565, Per Curiam: (566), "In as-

certaining its usefulness, it is not important that it should be more valuable than other modes of accomplishing the same result; but it must be a practicable method of doing the thing designed, in which its utility will more or less consist." 2 Robb, 746 (748).

That an invention has utility even though it does not excel all other means for the same end, see also *Shaw v. Colwell Lead Co.* (1882), 20 Blatch. 417; 11 Fed. Rep. 711; *Adams v. Lofft* (1879), 4 Bann. & A. 495; *Miller & Peters Mfg. Co. v. Du Brul* (1877), 2 Bann. & A. 618; 12 O. G. 351; *Crouch v. Speer* (1874), 1 Bann. & A. 145; 6 O. G. 187; *Doherty v. Haynes* (1874), 1 Bann. & A. 289; 4 Clifford, 291; 6 O. G. 118; *McComb v. Ernest* (1871), 1 Woods, 195; *Seymour v. Osborne* (1870), 11 Wall. 516; *Rowe v. Blanchard* (1864), 18 Wis. 441; *Wilbur v. Beecher* (1850), 2 Blatch. 132; *Many v. Jagger* (1848), 1 Blatch. 372; *Dunbar v. Marden* (1842), 13 N. H. 311; *Tetley v. Easton* (1852), *Macrory's P. C.* 48.

That utility at date of patent is enough, though the invention be afterward superseded, see *Poppenhusen v. N. Y. Gutta Percha Comb Co.* (1858), 2 Fisher, 62.

§ 343. Utility how Ascertained.

The utility of an invention may be ascertained by an inspection of the art or instrument itself, or of the place it fills in that particular department of human industry to which it belongs. But these do not afford the only, or perhaps the most conclusive, evidence. Where an invention passes into general use, and is sought after and employed by those to satisfy whose needs it was invented, its use and sale supply the strongest proof that the public welfare is advanced by its existence, and that the inventor has conferred substantial benefits upon mankind.¹

§ 344. Utility as Evidence of Inventive Skill: of Novelty.

The utility of an invention is often properly considered by the courts in their investigation of two different topics, with which otherwise it has no connection. First, upon the question whether or not a given art or instrument was produced by the exercise of inventive as distinguished from mechanical skill, the actual utility of the invention may become important. If its utility is very great, as evidenced by its extensive use and sale, and if it satisfies an ancient and well-recognized necessity, it is presumed that if mechanical skill alone could have derived it from any means already known, it would have

§ 343. ¹ That use and sale indicate utility, see *Niles Tool Works v. Betts Mach. Co.* (1886), 27 Fed. Rep. 301; *Goodyear Dental Vulcanite Co. v. Smith* (1874), Holmes, 354; 5 O. G. 585; 1 Bann. & A. 201; *Smith v. Prior* (1873), 2 Sawyer, 461; 6 Fisher, 469; 4 O. G. 633; *Robertson v. Secombe Mfg. Co.* (1873), 6 Fisher, 268; 3 O. G. 412; *Magic Ruffle Co. v. Douglass* (1863), 2 Fisher, 330; *Dunbar v. Marden* (1842), 13 N. H. 311; *Cornish v. Keene* (1835), 1 Web. 501; 2 Abb. P. C. 139.

That the extensive use of the simplest device shows its utility, see *Lorillard v. McDowell* (1877), 13 Phila. 461; 11 O. G. 640; 2 Bann. & A. 531.

That want of public recognition indicates want of utility, see *In re Hughes'*

Patent (1879), L. R. 4 App. 174; *In re Herbert's Patent* (1867), L. R. 1 P. C. 399; 4 Moore P. C. n. s. 300; *In re Allan's Patent* (1867), L. R. 1 P. C. 507; 4 Moore P. C. n. s. 443; *In re Pinkus' Patent* (1848), 12 Jur. 233; *Morgan v. Seaward* (1836), 1 Web. 170.

That it is assumed that a useful invention, when once known, will be in demand, see *In re Simister's Patent* (1842), 1 Web. 721.

That experiment is the only test of utility, and until tested the patent is *prima facie* evidence thereof, see *Case v. Morey* (1818), 1 N. H. 347.

That the value of an invention can often be determined only by its results, see *Roberts v. Dickey* (1872), 1 O. G. 4; 4 Fisher, 532; 4 Brews. (Pa.), 260.

long ago been brought into existence; and, hence, that it could now have originated only in an inventive act.¹ Second, upon the question of novelty, where doubt arises concerning

§ 344. ¹ In *Washburn & Moon Mfg. Co. v. Haish* (1880), 19 O. G. 173, Drummond and Blodgett, J.J.: (175) "In the absence of any other test the courts have seemed to assume that the fact of the acceptance of a new device or combination by the public and putting it into extensive use, was evidence that it was the product of invention; or as one of the counsel for plaintiff expressed it, 'utility is suggestive of originality.'" 4 Fed. Rep. 900 (907).

In *Smith v. Goodyear Dental Vulcanite Co.* (1876), 93 U. S. 486, Strong, J.: (495) "Undoubtedly the results or consequences of a process or manufacture may in some cases be regarded as of importance when the inquiry is whether the process or manufacture exhibits invention, thought, and ingenuity. Webster, on the subject-matter of patents, page 30, says: 'The utility of the change, as ascertained by its consequences, is the real practical test of the sufficiency of an invention; and since the one cannot exist without the other, the existence of the one may be presumed on proof of the existence of the other.' . . . We do not say the single fact that a device has gone into general use, and has displaced other devices which had previously been employed for analogous uses, establishes in all cases that the later device involves a patentable invention. It may, however, always be considered, and when the other facts in the case leave the question in doubt, it is sufficient to turn the scale.'" 11 O. G. 246 (248).

In *Eppinger v. Richey* (1877), 14 Blatch. 307, Shipman, J.: (312) "Without giving to the general use of the invention, as a test of its patentability, any greater importance than the Supreme Court in the case of *Smith v. Goodyear*

Dental Vulcanite Co., 3 Otto, 486, indicate should be given to this circumstance, I am of opinion that the facts in the case fully establish the conclusions: (1) That however simple the change in the method of manufacture apparently may have been, yet it was a change which required invention for its accomplishment; (2) That the improvement resulting from the changed method of manufacture has been so great that the article which is produced is, within the meaning of the patent acts, a new and useful article of manufacture." 12 O. G. 714 (716); 3 Bann. & A. 69 (74).

In *Stanley Works v. Sargent* (1871), 8 Blatch. 344, Shipman, J.: (346) "Utility is not an infallible test of originality. The Patent Law requires a thing to be new as well as useful in order to entitle it to the protection of the statute. To be new in the sense of the act it must be the product of original thought or inventive skill, and not a mere formal or mechanical change of what was old and well known. But the effect produced by a change is often an appropriate, though not a controlling, consideration in determining the character of the change itself." 4 Fisher, 443 (445).

Curtis on Patents, cited with approval in *Roberts v. Dickey* (1871), 1 O. G. 4, by Strong, J., speaking of inventions of recognized utility says: (§ 36) "It is obvious that the results in such cases furnish a complete test of the sufficiency of invention, because the importance of the result shows that, whether actually exercised or not, the possibility of the exercise of thought, design, ingenuity, and skill is not excluded."

Webster on Patents, 30, also cited in the same case, remarks: "Whenever

the identity of two inventions, and whether the apparent diversities between them are formal or substantial, the superior utility of one may be sufficient to remove the doubt. For though the apparent difference be small, the difference in the usefulness of their results may be great enough to demonstrate that, notwithstanding all external similarities, such variations must exist between their modes of operation that the ideas which they embody cannot be the same.² The relation

the utility is proved to exist in any great degree, a sufficiency of invention to support the patent must be presumed."

That utility often indicates patentability, see *Penn. Salt Mfg. Co. v. Thomas* (1871), 8 Phila. 144; 5 Fisher, 148.

That utility is evidence of inventive skill, see *Hill v. Biddle* (1886), 27 Fed. Rep. 560; *Wallace v. Noyes* (1882), 21 Blatch. 83; 23 O. G. 435; 13 Fed. Rep. 172; *Bruce v. Marder* (1882), 22 O. G. 1039; 20 Blatch. 355; 10 Fed. Rep. 750; *Roberts v. Schreiber* (1880), 5 Bann. & A. 491; 18 O. G. 125; 2 Fed. Rep. 855; *Hoe v. Cottrell* (1880), 18 O. G. 59; 17 Blatch. 546; 1 Fed. Rep. 597; 5 Bann. & A. 256; *U. S. Stamping Co. v. King* (1879), 17 Blatch. 55; 17 O. G. 1399; 4 Bann. & A. 469; *Williams v. Rome, Watertown, & Ogdensburgh R. R. Co.* (1878), 15 Blatch. 200; 15 O. G. 653; 3 Bann. & A. 413; *Monce v. Adams* (1874), 12 Blatch. 1; 7 O. G. 177; 1 Bann. & A. 126; *In re Pennock* (1874), 1 MacArthur, 531; 5 O. G. 668; *Smith v. Woodruff* (1874), 4 O. G. 635; 1 MacArthur, 459; 6 Fisher, 476; *Hitchcock v. Tremaine* (1872), 1 O. G. 633; 9 Blatch. 550; 5 Fisher, 537.

That utility does not conclusively indicate the exercise of inventive skill, see *Phillips v. Detroit* (1879), 4 Bann. & A. 347; 17 O. G. 191; *Monce v. Adams* (1874), 7 O. G. 177; 12 Blatch. 1; 1 Bann. & A. 126; *Ex parte Greeley* (1873), 4 O. G. 612; Holmes, 284; 6 Fisher, 575.

See § 113 and notes, *ante*.

² In *Smith v. Nichols* (1872), Holmes, 172, Lowell, J. : (175) "The fact that an article is better and more useful in the trade is evidence of novelty; but if the superiority is attained by the application of known means, in a known way, and to produce a known result, though a better one, the novelty required by the Patent Law is wanting." 2 O. G. 649 (650); 6 Fisher, 61 (64).

In *Judson v. Cope* (1860), 1 Bond, 327, Leavitt, J. : (337) "It will be obvious that where there is doubt upon the question of novelty . . . evidence of the superior performance and utility of the patented improvement would have a direct bearing upon the question of novelty. In other words, if the jury are satisfied that the invention patented produces a result decidedly and clearly different from any which had been produced by the action of any prior [device], and that it was decidedly superior to any other in its operation, it would certainly afford a ground for the presumption that the thing itself had not been known before." 1 Fisher, 615 (624).

In *Many v. Sizer* (1849), 1 Fisher, 17, Sprague, J. : (24) "If the changes made by the defendant have rendered his wheel one of greater utility than the plaintiff's, such utility is evidence that some new principle, or mechanical power, or new mode of operation, producing a new kind of result, has been introduced. And the greater such utility, the stronger is such evidence.

of these two kinds of utility, the actual and the comparative, to these two questions of novelty and inventive skill is often much confused, through failure to regard the real distinctions which obtain between them. But they are utterly dissimilar in character and in effect, as well as in the principles upon which those relations are established; and their real value in affording a solution of these questions is lost whenever those distinctions are ignored.

And if a manifest and very high degree of utility is obtained by such changes, it becomes full proof and conclusive that a new principle, or mechanical power, or new mode of operation, producing a new kind of result, has been introduced. . . . (27) If the effect is a wheel of greater utility, that is evidence tending to show that some new principle, or mechanical power, or mode of operation producing a new kind of result has been introduced; and the higher the degree of utility, the stronger is such evidence. And it may arise to so high a degree as to become conclusive." See also the remarks of Shipman, J., in *Eppinger v. Richey*, 14 Blatch. 307, and in *Stanley Works v. Sargent*, 8 Blatch. 344, cited in note 1, *ante*.

In *Househill Co. v. Neilson* (1843), 1 Web. 673, Hope, J.: (690) "Great utility is one important element in the question of novelty. For if the process is of great, manifest, striking, and immediate utility, that is of the utmost importance to the point. Could this have been previously in public use and exercise without clear and abundant proof?"

That superior utility is not conclusive evidence of novelty, see *Wilson Packing Co. v. Chicago Packing & Provision Co.* (1881), 10 Bissell, 559; 21 O. G. 411; 9 Fed. Rep. 547; *Pitts v.*

Wemple (1855), 2 Fisher, 10; 1 Bissell, 87.

That comparative utility indicates novelty, see *Miller v. Pickering* (1883), 16 Fed. Rep. 540; 25 O. G. 89; *Dunbar v. Albert Field Tack Co.* (1879), 4 Fed. Rep. 543; 4 Bann. & A. 518; *Stilwell & Bierce Mfg. Co. v. Cincinnati Gas Light & Coke Co.* (1875), 1 Bann. & A. 610; 7 O. G. 829; *Birdsall v. McDonald* (1874), 6 O. G. 682; 1 Bann. & A. 165; *Sayles v. Chicago & Northwestern R. R. Co.* (1871), 3 Bissell, 52; 4 Fisher, 584; *Carter v. Baker* (1871), 1 Sawyer, 512; 4 Fisher, 404; *Woodman v. Stimpson* (1866), 3 Fisher, 98; *Singer v. Walmsley* (1860), 1 Fisher, 558; *Howe v. Morton* (1860), 1 Fisher, 586; *Judson v. Moore* (1859), 1 Bond, 285; 1 Fisher, 544; *Morton v. Middleton* (1863), 1 Cr. S. 3d Series, 722.

That superior utility indicates substantial difference and hence novelty, see *Roberts v. Schreiber* (1880), 5 Bann. & A. 491; 18 O. G. 125; 2 Fed. Rep. 855; *Stevens v. Keating* (1847), 2 Web. 181.

That immediate and extensive use of an invention is evidence of its novelty and originality, see *Hitchcock v. Tremaine* (1872), 1 O. G. 633; 9 Blatch. 550; 5 Fisher, 537; *Judson v. Moore* (1859), 1 Bond, 285; 1 Fisher, 544.

See §§ 116-121 and notes, *ante*.

CHAPTER V.

OF ABANDONMENT TO THE PUBLIC.

§ 345. Inventions not Patentable if once Abandoned to the Public.

The fifth and final requisite of a patentable invention is that it must remain under the exclusive control of its inventor until the issue of his letters-patent. The patent is designed to temporarily secure to him the continuance of that dominion over his discovery which without the patent he might still be able to maintain, but which, in consideration of the patent, he permanently surrenders to the public after the period of his patent has expired. But if, before the patent issues, he has voluntarily relinquished this exclusive right, there is not only nothing to protect, but no consideration can now move from him toward the public by which the grant of the patent can be sustained. Here the element of contract between the inventor and the public becomes especially apparent. The patent privilege is not a mere reward bestowed upon the inventor for past services, the payment of a debt of gratitude toward one who has already conferred a benefit upon the state; it is also a purchase by the government, acting on behalf of the whole people, of some new art or instrument, capable of beneficial use, for which it recompenses the inventor by securing to him for a time its sole enjoyment; and when, without this recompense, it has obtained the invention through his voluntary act, so far from recognizing him as entitled to remuneration, it unhesitatingly appropriates his invention to itself, whatever loss and difficulty may result to him.¹ Still, while

§ 345. ¹ That abandonment bars a consolidated *Fruit Jar Co. v. Wright* patent, see *Egbert v. Lippman* (1881), (1876), 94 U. S. 92; *Consolidated* 104 U. S. 333; 21 O. G. 75; *Con- Fruit Jar Co. v. Wright* (1874), 12

the law thus stringently adheres to the fundamental principle on which are based all the relations of the public to the inventor, it liberally interprets in his favor the specific rules that govern the dedication of inventions to the public, as well as all those acts of his from which such dedication might be inferred.²

§ 346. **Three Meanings of "Abandonment:" "Abandoned Experiment;" "Abandoned Inventions;" "Abandonment to the Public."**

The dedication of an invention to the public by the inventor is generally called "abandonment." This word is used in reference to three different acts of an inventor, and in each use has an entirely different meaning. Where one who has endeavored to produce a new invention either fails to develop a complete and practicable idea of means, or having fully conceived the idea neglects to reduce it to practice as an operative art or instrument, and in this state of incompleteness relinquishes his efforts without intending to resume them, he is said (though perhaps improperly) to have abandoned the invention; and that which, had he persevered, might have become a patentable invention, is a mere unsuccessful or abandoned experiment. Again, where an inventor has completed his inventive act, and has produced an operative art or instrument capable of practical employment, but has thrown it aside without communicating it to the public, and has temporarily or permanently forgotten it, the invention

Blatch. 149; 6 O. G. 327; 1 Bann. & A. 320; Wayne v. Holmes (1856), 2 Fisher, 20; 1 Bond, 27; Ransom v. Mayor of New York (1856), 1 Fisher, 252; Wyeth v. Stone (1840), 1 Story, 273; 2 Robb, 23; Whittemore v. Cutter (1813), 1 Gallison, 478; 1 Robb, 40.

That the presumption is always against abandonment, see Graham v. McCormick (1880), 10 Bissell, 39; 11 Fed. Rep. 859; 21 O. G. 1533; 5 Bann. & A. 244.

That an invention once abandoned to the public can never be recalled by the

inventor, see Consolidated Fruit Jar Co. v. Bellaire Stamping Co. (1886), 27 Fed. Rep. 377; 35 O. G. 627; Ransom v. Mayor of New York (1856), 1 Fisher, 252; McCay v. Burr (1847), 6 Pa. St. 147; Whittemore v. Cutter (1813), 1 Gallison, 478; 1 Robb, 40.

² In this chapter only abandonment before the issue of a patent is considered. The dedication of a patented invention to the public does not affect its patentable character or rest on any doctrine peculiar to Patent Law. See §§ 981, 1046, 1114, 1194, 1195, and notes, *post*.

has become a "lost art," and is sometimes spoken of as an abandoned invention. But in the third and only proper sense of the term, "abandonment" is applied solely to cases where the inventor, having fully performed his inventive act, and having embodied his idea in tangible materials ready for immediate public use, freely gives it to the public without intending to claim from them the protection to which he is entitled.¹ The first abandonment is an abandonment of his

§ 846. ¹ In *Consolidated Fruit Jar Co. v. Bellaire Stamping Co.* (1886), 27 Fed. Rep. 377, Sage, J. : (381) "If it appears that the inventor, after perfecting his invention and applying for a patent, and thereby irrevocably committing himself to the proposition that his invention is ripe for introduction to the public, accept the decision rejecting his application, and cast aside his invention as no longer of any value to him, he thereby makes it forever public property, and it is not in his power to take it back and make it again his own." 85 O. G. 627 (629).

In *American Hide and Leather Splitting and Dressing Mach. Co. v. American Tool and Mach. Co.* (1870), Holmes, 503, Shepley, J. : (513) "A person is sometimes said to have abandoned his invention when he gives up the idea, abandons it in the popular sense, relinquishes the intention of perfecting his invention, so that another person may take up the same thing and become the original and first inventor. But that is not the kind of abandonment that is referred to here. There is another kind of abandonment, and that is where a party, having made an invention, allows the public to use it, with his knowledge and consent ; allows it to be incorporated into other machines with his knowledge and consent, and to be used by anybody without objection ; as, for instance, if you should invent a machine, put it into public use and sell it to everybody who chose to buy it, and

if you should attach to that machine another invention of yours, and allow everybody who chose to buy that and use it, without objection on your part, with your consent, with your permission, with your allowance, not for the mere purpose of experiment, but for the purpose of profit and gain, that would be an abandonment of it to the public ; and you could not afterward rightfully, honestly, honorably, legally, take out a patent for that invention." 4 Fisher, 284 (299).

That there can be no abandonment, in the technical sense, unless the invention is complete and operative, see *Locomotive Engine Safety Truck Co. v. Penna. R. R. Co.* (1874), 10 Phila. 252 ; 6 O. G. 927 ; 1 Bann. & A. 470.

That the abandonment of such an invention enures to the benefit of the public, not to that of a subsequent inventor, see *Consolidated Fruit Jar Co. v. Bellaire Stamping Co.* (1886), 27 Fed. Rep. 377 ; 35 O. G. 627 ; *Pickering v. McCullough* (1878), 3 Bann. & A. 279 ; 13 O. G. 818 ; *Shoup v. Henrici* (1876), 2 Bann. & A. 249 ; 9 O. G. 1162 ; *Rich v. Lippincott* (1853), 2 Fisher, 1.

That an abandoned invention cannot be patented unless, having become a "lost art," it is re-invented and again bestowed upon the public, see *Rich v. Lippincott* (1853), 2 Fisher, 1.

Closely akin to the doctrine of abandonment, though relating to the personality of the patentee, not to the patentability of the invention, is the question which

intention to become an inventor; and leaves the field open for subsequent inventors to conceive such new ideas, or such improvements upon his idea, as will complete the invention and enable them to appropriate it to their exclusive use. The second abandonment is an abandonment of his intention to render the invention practically available for any purpose, and thereupon it is regarded as never having been conceived. The third and true form of abandonment is a dedication of the invention to the public, and closes the field forever against not only himself but every subsequent inventor, until the art or instrument shall once more pass from public knowledge and thus become a subject for re-invention.

§ 347. *Abandonment to the Public Depends on Intention.*

A completed invention may be abandoned by its inventor by various methods. In general, any act which places the

arises when the earlier inventor, having completed his inventive act, withholds his invention from the public without himself abandoning or forgetting it. This question may become of practical importance in two cases: (1) Where after a long delay the inventor seeks the protection of a patent as against the public; (2) Where during his delay a later rival inventor applies for or obtains a patent, and the first inventor thereupon endeavors to secure the legal recognition of his own monopoly, on the ground of priority of invention. In the first case it may be regarded as still a doctrine of our law that the mere delay of the inventor does not prejudice his rights, although his delay may have been intended for his own advantage in the secret use of his invention as long as it could be kept secret, and in the prolongation of his exclusive privilege by a patent when the invention could not further be concealed. See § 351 note 2, *post*. A due consideration for the rights of the public might well express itself in applying the rules of estoppel to such an inventor, and meeting his own bad faith with a denial of that legal immunity which is

created for the encouragement of inventors, who honestly attempt to advance the welfare of the public as well as of themselves. See *Sheriff v. A. Fulton's Son* (1882), 12 Fed. Rep. 136; 22 O. G. 87; *Sprague v. Adriance* (1877), 3 Bann. & A. 124; 14 O. G. 308; *U. S. Rifle & Cartridge Co. v. Whitney Arms Co.* (1877), 14 Blatch. 94; 11 O. G. 373; 2 Bann. & A. 493; *Consolidated Fruit Jar Co. v. Wright* (1874), 2 Blatch. 149; 6 O. G. 327; 1 Bann. & A. 320. But in the second case the wilful delay of the first inventor ought not to be thus overlooked. The later rival patentee may justly claim that his own time and efforts have been expended on the faith that any other inventor who had previously made the same invention was dealing honestly with the public, and would, within a reasonable period after its reduction to practice, communicate his invention to the public by applying for a patent. The inclination of the courts, in more recent decisions, is to recognize this claim and to hold that the prior inventor has forfeited his rights in favor of the later, whenever he has unreasonably

invention within reach of the public, if unaccompanied by indications that the inventor claims his rightful privilege, amounts to an abandonment. But in all cases the real question is one of intention; and hence while no one but the inventor can abandon the invention, he can abandon it only by such conduct as clearly denotes the voluntary surrender of his rights.¹ Yet the law recognizes radical differences between the effects of different acts in reference to this matter. From some acts it raises no presumption, but leaves it for a jury to decide whether from them an intention of abandonment appears. From others, on the contrary, it conclusively presumes abandonment, and when these are established it does not permit the inventor to deny that he intended to bestow his invention on the public without reward.

§ 348. Intention to Abandon Presumed from Public Use or Sale.

The act from which alone the law presumes the abandonment of an invention is its public use or sale for more than two years before his application for a patent. While other acts, although they show that the inventor does not intend to exercise at present his exclusive privileges, may still leave something to be done before the public can be considered as in full possession of the invention, the use of the invention by the public

delayed his application for a patent. But this rule must not be confounded with the doctrine of abandonment, in any of its forms. It rests, if it exists at all, on broad principles of equity, which must be applied to each instance as it arises, and it cannot be formulated into more specific details as to time and conduct without danger of causing the injustice which it endeavors to avoid. See § 351, note 2, and §§ 388-390, *post*.

§ 347. ¹ That abandonment is a question of fact, not of law, see *Sprague v. Adriance* (1877), 3 Bann. & A. 124; 14 O. G. 308; *Russell & Erwin Mfg. Co. v. Mallory* (1872), 2 O. G. 495; 10 Blatch. 140; 5 Fisher, 632.

That abandonment is a question of intention, see *Johnsen v. Fässman*

(1872), 2 O. G. 94; 1 Woods, 138; 5 Fisher, 471; *McMillin v. Barclay* (1871), 5 Fisher, 189; 4 Brews. (Pa.) 275; *Kendall v. Winsor* (1858), 21 How. 322; *McCormick v. Seymour* (1851), 2 Blatch. 240.

That the law governing abandonment is that in force at the date of the application, see *Beedle v. Bennett* (1887), 122 U. S. 71; 39 O. G. 1326.

That no one but the inventor himself can abandon his invention to the public, see *Jones v. Sewall* (1873), 3 Clifford, 563; 3 O. G. 630; 6 Fisher, 343.

That one joint inventor cannot abandon the invention to the public, see *Sawyer v. Edison* (1883), 25 O. G. 597.

exhausts all that the inventor can bestow. The law cannot permit him to aver that he intended to retain that which he has thus unequivocally surrendered, or to resume it after it has once become a portion of the common stock of knowledge.¹ It therefore treats as an abandonment, whatever he intended it to be, all public use of his invention, except in cases specially provided for, and which hereafter will be more particularly discussed.

§ 349. Abandonment by Various Methods.

In considering the subject of abandonment two topics thus present themselves: (1) Abandonment by conduct from which the jury may infer an intention on the part of the inventor to dedicate his invention to the public; (2) Abandonment by public use or sale.¹ Under these heads we may conveniently arrange the rules established by the legislature and the courts, and best preserve those distinctions without which the doctrine of abandonment cannot be understood.

§ 348. ¹ Though somewhat confused with the question of prior knowledge and use on the part of the public as indicating want of novelty, the English courts have always recognized the doctrine that if the real inventor himself suffered his invention to go into the hands of the public he had thereby lost his right to a patent. Thus in *Househill Co. v. Neilson* (1843), 1 Web. 673, Brougham, J. : (712) "In cases of inventions, the patent right, or monopoly, may be granted by the crown to a person, provided he be, 'the true and first inventor,' and provided also, secondly, that at the time of the grant of the monopoly of the patent, others shall not have used the same. Consequently, observe the result, if either he is proved not to be the true inventor, or if, being the true inventor, nevertheless it be proved that there has been a user at the time of the patent by others; in either the one case or the other the right flies off, the condition does not attach which

condition precedent must have existed in both those particulars, etc."

§ 349. ¹ In *Jones v. Sewall* (1873), 3 Clifford, 563, the court declares that abandonment and public use are two different things. This language can only mean that abandonment and public use are not always the same thing. Abandonment may occur in many other ways than by public use; public use may not in every instance afford evidence of an abandonment. But the rule of law is clear enough that public use for over two years with consent of the inventor always is abandonment; that public use with his consent for less than two years may be accompanied by other circumstances which, taken in connection with the use, prove an abandonment; and that by any conduct and at any time the inventor may evince his intention to abandon his invention to the public, and having done so, loses his right to a patent. 3 O. G. 630; 6 Fisher, 343.

SECTION I.

OF ABANDONMENT INFERRED FROM CONDUCT.

§ 350. Abandonment by Conduct a Question of Fact.

Abandonment of an invention may be inferred from any action or omission of the inventor which, in the opinion of the jury, is sufficient to establish it. No precise test, therefore, can be applied; but in view of all the circumstances of the given case, the jury are to say whether the inventor intended to surrender or retain control over his invention. Still, as the same act differs in significance according to its relation in point of time to the application for a patent, it is necessary to consider it in reference to this relation and to separately discuss: (1) Abandonment before application; (2) Abandonment by application; and (3) Abandonment after application.

§ 351. Abandonment before Application.

An abandonment before application consists in any conduct of the inventor in regard to his invention which indicates an intention upon his part to dedicate it thenceforth to the public. Such conduct may occur at any time before the application.¹ It may comprise a single instantaneous act, or a long series of acts, or mere neglect to act when action is required. Thus where an invention is completed and fully published to the world by the inventor, and then is thrown aside and neither used nor patented by him; or where in words, written or spoken, he expressly bestows it on the public, disclaiming any right exclusive to himself; or where a public use or sale of the invention, though for less than two years, is accompanied by other circumstances showing that the inventor has relinquished his monopoly therein; in these and similar

§ 351. ¹ In *Elizabeth v. Pavement Co.* (1877), 97 U. S. 126, Bradley, J. : (184) "An abandonment of the invention to the public may be evinced by the conduct of the inventor at any time, even within the two years named in the law."

That abandonment may be inferred from delay or other causes, see *Locomotive Engine Safety Truck Co. v. Penna. R. R. Co.* (1874), 10 Phila. 252; 6 O. G. 927; 1 Bann. & A. 470.

instances it has been decided that the actions or omissions of the inventor were sufficient evidence of an abandonment.² But in all cases of this kind the strict presumption is in favor of the inventor; and no conduct which is not entirely volun-

² In the United States Rifle & Cartridge Co. v. Whitney Arms Co. (1877), 14 Blatch. 94, Shipman, J. : (101) "A person may forfeit his rights as an inventor by 'a wilful or negligent postponement of his claims or by an attempt to withhold the benefit of his improvement from the public until a similar or the same improvement should have been made and introduced by others.' (Kendall v. Winsor, 21 Howard, 322.) If there was no purpose on the part of [the plaintiff's patentee] to withhold his improvement from the public, there was a negligent postponement of his claims until after other inventors had acquired equities which it seems unjust to destroy. The language of Judge Woodruff in Consolidated Fruit Jar Co. v. Wright (12 Blatch. C. C. R. 149) though not necessary to the decision of that case, is just and is pertinent to the facts which are here disclosed: 'If an inventor, without substantial reason or excuse, abandons the use of his invention, and for nine years sleeps on his rights, and in the meantime others, in good faith, employ their industry, skill, and money in producing the same thing, and give the public the benefit thereof, putting it into extensive use and on sale, such a state of facts not only warrants the inference of abandonment by the first inventor, but it also creates, as between him and the others, the same equity as would arise if such others had gone further and taken out a patent. Whether the device be patented or has "gone into use without a patent" should make no difference. (Kendall v. Winsor, 21 How. 322.) This is not because lapse of time, *per se*, deprives an inventor of his right, but because the circumstances giving character to the delay indi-

cate abandonment; and also because the intervening rights of others make it inequitable that he should thereafter be permitted to assert any such exclusive title to the invention.'" 11 O. G. 378 (375); 2 Bann. & A. 403 (500).

That to abandon experiments, destroying the experimental structures, is evidence of an intention to abandon the invention in its then existing state, see Seymour v. Osborne (1870), 11 Wall. 516; Johnson v. Root (1862), 2 Fisher, 291; 2 Clifford, 108.

That where an intention to resume the experiments exists, it is not abandonment, see White v. Allen (1863), 2 Clifford, 224; 2 Fisher, 440.

That delay in applying for a patent after the invention is completed does not, *per se*, indicate an intention to abandon the invention, see Kelleher v. Darling (1878), 3 Bann. & A. 438; 4 Clifford, 424; 14 O. G. 678; Henry v. Frankestown Soapstone Stove Co. (1876), 2 Bann. & A. 221; 9 O. G. 408; Andrews v. Carman (1876), 13 Blatch. 307; 9 O. G. 1011; 2 Bann. & A. 277; Russell & Erwin Mfg. Co. v. Mallory (1872), 2 O. G. 495; 10 Blatch. 140; 5 Fisher, 632; Johnsen v. Fassman (1872), 2 O. G. 94; 1 Woods, 138; 5 Fisher, 471; Wood v. Cleveland Rolling Mill Co. (1871), 4 Fisher, 550; Agawam Co. v. Jordan (1868), 7 Wall. 583; Kendall v. Winsor (1858), 21 How. 322; Bentley v. Fleming (1844), 1 C. & K. 587.

That a delay of solicitors in making application is no abandonment, see Birdsall v. McDonald (1874), 1 Bann. & A. 165; 6 O. G. 682.

That no presumption of abandonment arises from delay in procuring

tary, or can reasonably be regarded as consistent with an honest intention to obtain for his invention the protection offered by the law, is ever taken as proof of an abandonment, or allowed to stand between him and the privilege to which every successful and diligent inventor is entitled.

§ 352. Abandonment by Application.

Abandonment by application occurs when the application for a patent, either taken by itself or in connection with other circumstances, indicates an intention on the part of the inventor to surrender to the public some element or attribute of his invention. An application for a patent embraces, among other things, a document known as a specification, which consists of two parts, — a description of the invention, and a statement pointing out such of its peculiar characteristics as the inventor claims to be exclusively his own. These two parts of the specification do not necessarily agree. Though the inventor has described his entire idea of means with each of its

a patent when the delay is caused by sickness, poverty, or insanity, see *Celluloid Mfg. Co. v. Crofut* (1885), 24 Fed. Rep. 796 ; 33 O. G. 235.

That to delay an application in order to make further experiments is not abandonment, see *Locomotive Engine Safety Truck Co. v. Penna. R. R. Co.* (1874), 10 Phila. 252 ; 1 Bann. & A. 470 ; 6 O. G. 927.

That long delay in applying for a patent, coupled with the sale of devices embracing the invention, is abandonment, see *Craver v. Weyhrich* (1887), 31 Fed. Rep. 607.

That an inventor may abandon his invention by permitting it to go into general use for any lapse of time under circumstances which denote an intention on his part to dedicate it to the public, see *Consolidated Fruit Jar Co. v. Wright* (1874), 6 O. G. 327 ; 12 Blatch. 149 ; 1 Bann. & A. 320.

That no general use will of itself indicate such intention unless it be for more than two years, see *Elizabeth v. Pavement*

Co. (1877), 97 U. S. 126 ; *McMillin v. Barclay* (1872), 5 Fishor, 189 ; 4 Brews. (Pa.) 275 ; *Root v. Ball* (1846), 4 McLean, 177 ; 2 Robb, 513.

That a sale of the invention within two years before the application is not evidence of an intention to abandon, see *McCormick v. Seymour* (1851), 2 Blatch. 240 ; *Pitts v. Hall* (1851), 2 Blatch. 229.

That mere words, unaccompanied by acts or omissions, do not indicate abandonment, see *Pitts v. Hall* (1851), 2 Blatch. 229.

That suggestions to others as to the nature of his invention, or consultations with them in regard to it, do not indicate an intention to abandon it, see *Locomotive Engine Safety Truck Co. v. Pennsylvania R. R. Co.* (1874), 1 Bann. & A. 470 ; 6 O. G. 927 ; 10 Phila. 252 ; *Whitney v. Emmett* (1831), Baldwin, 303 ; 1 Robb, 567.

That forfeiture by abandonment is not favored, see *Emery v. Cavanagh* (1883), 17 Fed. Rep. 242 ; *Pitts v. Hall* (1851), 2 Blatch. 229.

subordinate ideas, he may neglect to claim them with such breadth and detail as he ought; and since his patent is commensurate only with his claim, it may fail to protect the whole invention as he has created and described it. The public in this manner are put in possession of the entire invention, while the exclusive right of the inventor is confined to but a part, and thence arises the question whether the failure of the inventor to claim his whole idea operates as an abandonment of the part unclaimed. Here also the decisive fact is the intention of the inventor, and the presumption is in favor of the maintenance of his exclusive rights.¹ If, therefore, there is

§ 352. ¹ In *Ex parte Derby* (1884), 26 O. G. 1208, Butterworth, Com. : (1209) "It is a well-settled principle that abandonment is not to be presumed. It must be affirmatively established by satisfactory proof. An inventor, if he so elects, may, by express declaration, abandon or dedicate his invention to the public. But in the case at bar there is no evidence that the invention has been abandoned by the expressed intention of the inventor. On the contrary, the reverse appears in the very evidence relied upon to prove abandonment. Has the invention been abandoned by the acts of the inventor? In the case of *Shaw v. Cooper* (7 Peters, 292), the Supreme Court say: 'No matter by what means an invention may be communicated to the public before a patent is obtained, any acquiescence in the public use by the inventor will be an abandonment of his right. If the right were asserted by him who fraudulently obtained it, perhaps no lapse of time could give it validity. But the public stand in an entirely different relation to the inventor. The invention passes into the possession of innocent persons who have no knowledge of the fraud, and at a considerable expense, perhaps, they appropriate it to their own use. The inventor or his agent has full knowledge of these facts, but *fails to assert* his

right. Shall he afterward be permitted to assert it with effect? Is not this such evidence of acquiescence in the public use on his part as justly forfeits his right? If an individual witness a sale and transfer of real estate under certain circumstances, in which he has an equitable lien or interest, and does not make known this interest, he shall not afterward be permitted to assert it. On *this principle* it is that a discoverer abandons his right if before the attainment of his patent his discovery goes into public use. His right would be *secured by giving public notice* that he was the inventor of the thing used, and that he *should apply for a patent.*' And further on in the same decision the following language is employed: 'Whatever may be the intention of the inventor, if he suffers his invention to go into public use *through any means whatsoever*, without an immediate *assertion* of his right, he is not entitled to a patent, nor will a patent obtained under such circumstances protect his right.' In this decision, rendered more than fifty years ago, in the infancy of the patent system of this country, we find a clear and accurate exposition of the principle underlying the doctrine of constructive abandonment. In whatever manner the public gains a knowledge of the invention, the right to the use of this knowledge becomes absolute,

nothing, either in the document itself or in the conduct of the inventor, which proves that he intended in this method to

unless the inventor immediately assert his right. The manner pointed out in the decision for asserting his right is 'by giving *public notice* that he was the inventor of the thing used, and that he *should apply for a patent.*' The facts before the court in *Shaw v. Cooper* were that the invention had been publicly used, and thereby the public had gained a knowledge of it; but the language of the court and the principle upon which the decision rests cover a case where information of the invention was communicated to the public through the medium of a patent. In *The Suffolk Co. v. Hayden* (3 Wall. 815), the point was raised that a description of an invention in a patent and *omission to claim it therein* operated as an abandonment or dedication of it to the public, and for that reason a subsequent patent claiming the said invention was void. The court said: 'But the answer to this ground of defence is that it appeared that Hayden, the patentee, had pending before the Commissioner of Patents an application for the same improvement at the time he described it in the specification of the 17th of March, which was doubtless the reason for not claiming it in this patent. The description in no sense affected this application thus pending before the Commissioner, and while it remained before him repelled any inference of abandonment or dedication from the omission to again claim it.' Here the principle announced in *Shaw v. Cooper, supra*, is again recognized, and applied to the extent called for by the facts; for abandonment or dedication to the public was held not to result from a description of an invention in a patent, even though it was not claimed therein, in case *another application claiming such invention was pending before the Commissioner at the time the*

patent was issued. In other words, the pending application negatived the idea of abandonment of the inventor's right to the invention which was described though not claimed in the patent. In the case of *O'Reilly v. Morse* (15 How. 62) the court said: 'It is said, however, that this alleged improvement is not new, and is embraced in his former specification, and that if some portion of it is new it is not so described as to distinguish the new from the old. . . . All that we think is useful or necessary to say is that after a careful examination of the patents, we think the objection on this ground is not tenable.' In this case, though the point now in controversy was raised, yet the decision seems to have turned on the correctness of the counsel's apprehension of the facts upon which the point was based, and as the court found an error in the statement of the facts it was unnecessary to examine the legal proposition involved. In the case of *Campbell v. James* (21 O. G. 337) the following language is used: 'The same combination of post-marker and blotter was also exhibited in Norton's patent of August 9, 1859. As he did not *then reserve* the process of stamping letters with such an instrument, nor the combination of a post-marker and a blotter, and did not make any 'simultaneous application therefor, he could not afterward obtain a patent for such process and combination, but would be restricted to such particular combination or process as might be exhibited in a new device or apparatus.' " The rule suggested by this decision is, that to secure protection for an invention exhibited but not claimed in a patent, the inventor must at the time of the issuance of the patent signify in his disclaimer an intention to reserve it for a future application, or he must evi-

abandon part of his idea, it is assumed that the discrepancy between the claim and the description arose from ignorance or

dence such intention by filing an application claiming such device prior to the issuance of the patent in which it is shown. The decision of *Campbell v. James* is, therefore, perfectly consistent with the decisions of the Supreme Court before mentioned. Indeed, it referred to the several proceedings recounted in *Shaw v. Cooper*, and *Suffolk Company v. Hayden* as disproving constructive abandonment, and determined the case before the court by reference thereto. In *Singer v. Braunsdorf* (7 Blatch. 521); *Graham v. McCormick* (21 O. G. 1533); *McMillin v. Rees* (17 O. G. 1357); *Hatch v. Moffitt* (15 Fed. Rep. 252), and other Circuit Court decisions, views are expressed which are even more liberal than those announced by the Supreme Court; but it is unnecessary to consider them in the present case. It being determined that the inference of abandonment which might result from a description of an invention in a patent without a technical claim thereto would be repelled by an assertion of right by the inventor to said invention, the question remains as to the extent of the effect of such assertion of right. The answer is that abandonment then becomes a question of fact, to be determined by the circumstances of each particular case. A compliance with the requirements suggested in *Shaw v. Cooper*, and other cases cited, makes a *prima facie* case against the plea of abandonment, and this *prima facie* case can only be overcome by proof. Laches tend to establish abandonment, vigilance in the prosecution of the claim being required both by the letter and policy of the law."

That an omission to claim matter clearly described is abandonment, see *Hill v. Commissioner* (1885), 4 Mackay, 266; *Ex parte Derby* (1884), 26 O. G.

1208; *Swift v. Jenks* (1884), 19 Fed. Rep. 641; 27 O. G. 621; *McKay v. Jackman* (1882), 20 Blatch. 466; 12 Fed. Rep. 615; 22 O. G. 85; *Hayes v. Seton* (1882), 20 Blatch. 484; 12 Fed. Rep. 126; *Brainard v. Crammo* (1882), 20 Blatch. 530; 12 Fed. Rep. 621; 22 O. G. 769; *Sheriff v. A. Fulton's Son* (1882), 12 Fed. Rep. 136; 22 O. G. 87; *Combined Patents Can Co. v. Lloyd* (1882), 11 Fed. Rep. 149; 21 O. G. 713; *Rowell v. Lindsay* (1881), 10 Bissell, 217; 6 Fed. Rep. 290; 19 O. G. 1565; *Miller v. Brass Co.* (1881), 104 U. S. 350; 21 O. G. 201.

That whether such description and failure to claim is an abandonment or not depends upon the right of the inventor, under all the circumstances, to correct the omission by a reissue, see *Battin v. Taggart* (1854), 17 How. 74.

That to describe and not claim, through inadvertence, is not abandonment, see *Railway Register Mfg. Co. v. Broadway & Seventh Ave. R. R. Co.* (1886), 26 Fed. Rep. 522; 34 O. G. 921.

That if the invention is delineated in the drawing of a patent but not described in the specification or claim, and is thus brought to the knowledge of the public, it will be abandoned, see *Ex parte Borden* (1884), 26 O. G. 439.

That though an invention is exhibited by the drawings of a patent, the inventor does not thereby abandon it until after two years' public use, see *Hatch v. Moffitt* (1883), 15 Fed. Rep. 252.

That the description of a process in an application for a machine patent does not abandon the process to the public if the process patent is applied for within two years, see *Eastern Paper Bag Co. v. Standard Paper Bag Co.* (1887), 30 Fed. Rep. 63; 41 O. G. 231.

That an application which describes but does not claim an invention is not

inadvertence, and he is permitted to correct it by procuring a reissue of his patent, based on a new and perfect statement of his claims. But, on the other hand, where either by express words in his specification he has dedicated to the public the unclaimed elements of his invention, or by unreasonable delay in seeking a reissue after the defects in his first application have become apparent, or by such conduct, active or passive, upon his part, as would now render the enforcement of his original rights a fraud upon the rights of others, he has since shown that the omission in his claim was originally intended as an abandonment, he cannot be permitted to resume those rights, and by reissuing his patent now appropriate what he has previously given to the world.

§ 353. Abandonment after Application.

An abandonment after application can take place only when the inventor, having filed his application for a patent, voluntarily withdraws it, and permanently relinquishes the purpose

abandonment as against another application by the same inventor for this invention, if the latter application be filed before the first patent issues, see *Graham v. Geneva L. C. Mfg. Co.* (1880), 11 Fed. Rep. 138; 21 O. G. 1536; *Graham v. McCormick* (1880), 11 Fed. Rep. 859; 10 Bissell, 39; 21 O. G. 1533; 5 Baun. & A. 244.

The foregoing cases afford examples of the conflicting statements of the courts concerning the effect of an omission to claim patentable matter described in the application. The subject is more fully discussed in §§ 464-467, 506, 633-635, 687-692, *post.* As a result derived from an examination of all the cases, interpreted and, as far as possible, reconciled by the general principles of Patent Law, the following conclusions are presented:—

I. The mere failure to claim described matter is never, *per se*, an abandonment.

II. The intentional failure to claim described matter is always abandon-

ment, unless there exists also an intention to secure the unclaimed matter by a subsequent patent; which latter intention may be evidenced (1) by filing another application covering such matter before the issue of the first patent; or (2) by reserving in the first patent a right to secure such matter by a future patent; or (3) by applying for a subsequent patent, covering such matter, within a reasonable time after the issue of the first patent, and before other inventors or the public have acted on the apparent abandonment created by the failure to claim in the first patent.

III. The unintentional failure to claim described matter is never abandonment; but that such failure was intentional will be presumed unless the patentee applies for an amendment by reissue, or for a subsequent patent, within reasonable time after he discovers, or is chargeable with knowledge, that his original patent does not protect his entire invention.

of obtaining legal protection for his invention. That an inventor has power thus to abandon his invention is unquestionable, and it may often happen that after endeavoring to procure a patent and encountering unexpected difficulties he will deem it expedient to forego further trouble and expense, and allow his idea to become public property. But the proof of such abandonment as this must be conclusive.¹ No length of time expended in surmounting obstacles arising in the Patent Office, no number of successive applications rendered necessary by the rejection of others previously filed, no interval of unavoidable delay between one application and another, nor any other action or omission of the inventor which is not manifestly inconsistent with the design to further prosecute his claims, can issue in this species of abandonment.² While in

§ 353. ¹ In *United States Rifle & Cartridge Co. v. Whitney Arms Co.* (1886), 118 U. S. 22, Gray, J. : (24) "There may be an abandonment of an invention to the public, as well after an application has been rejected or withdrawn as before any application is made. Such abandonment may be proved either by express declarations of an intention to abandon, or by conduct inconsistent with any other conclusion. An inventor, whose application for a patent has been rejected, and who, without substantial reason or excuse, omits for many years to take any step to reinstate or renew it, must be held to have acquiesced in its rejection, and to have abandoned any intention of further prosecuting his claim." 35 O. G. 873 (873).

In *American Hide and Leather Splitting and Dressing Mach. Co. v. The American Tool and Machine Co.* (1870), Holmes, 503, Shepley, J. : (513) "The abandonment to the public in the sense in which it is here used need not be two years before the date of the application for the patent; it may be afterward, although the presumption always is against an abandonment to the public by a patentee after he has applied for

his patent. But he can do so; he can do so within two years; he can do so at any time. It is a matter that may be proved, but it is never to be presumed." 4 Fisher, 284 (299). See also *Weston v. White* (1876), 13 Blatch. 447; 2 Bann. & A. 364.

That an abandonment after application must be clearly proved, see *McMillin v. Barclay* (1872), 4 Brews. (Pa.) 275; 5 Fisher, 189.

² For a general discussion of the cases of abandonment after application, see *Colgate v. Western Union Telegraph Co.* (1878), 15 Blatch. 365; 4 Bann. & A. 36; 14 O. G. 943.

That no delays in the Patent Office without fault of the inventor work an abandonment, see *Planing Mach. Co. v. Keith* (1879), 101 U. S. 479; *Henry v. Frankestown Soapstone Stove Co.* (1876), 2 Bann. & A. 221; 9 O. G. 408; *Jones v. Sewall* (1873), 3 Clifford, 563; 3 O. G. 630; 6 Fisher, 343; *Dental Vulcanite Co. v. Wetherbee* (1866), 2 Clifford, 555; 3 Fisher, 87; *Sayles v. Chicago & Northwestern R. R. Co.* (1865), 1 Bissell, 468; 2 Fisher, 523.

That a delay caused by war is not abandonment, see *Knox v. Loweree*

pursuit of his legal rights, according to the measure of his abilities, he cannot be affected by the adverse action either of the government or of the public.³ Only when he gives up the struggle and finally surrenders his exclusive privilege as no longer worth maintaining, is the public so possessed of his invention that his rights in it become incapable of recognition.

(1874), 1 Bann. & A. 589; 6 O. G. 802.

That the mere abandonment of the application is not abandonment of the invention, see *Lindsay v. Stein* (1882), 20 Blatch. 370; 10 Fed. Rep. 907; 21 O. G. 1613; *Clark v. Scott* (1872), 2 O. G. 4; 9 Blatch. 301; 5 Fisher, 245; *Bevin v. East Hampton Bell Co.* (1871), 9 Blatch. 50; 5 Fisher, 23.

That an abandonment of the application during eighteen years has been held to be an abandonment of the invention, see *Marsh v. Commissioner of Patents* (1872), 3 Bissell, 321.

That fifteen years' inaction after withdrawal is abandonment, see *Consolidated Fruit Jar Co. v. Bellaire Stamping Co.* (1886), 27 Fed. Rep. 377; 35 O. G. 627.

That no abandonment of an application can take place except by conduct inconsistent with due diligence in prosecuting the application, see *Ballard v. Pittsburgh* (1882), 12 Fed. Rep. 783; *Singer v. Braunsdorf* (1870), 7 Blatch. 521; *Adams v. Edwards* (1848), 1 Fisher, 1.

That no number of successive applications indicate an intention to abandon, but that, in reference to the question of abandonment, all such are regarded as one application, see *Graham v. McCormick* (1880), 10 Bissell, 39; 11 Fed. Rep. 859; 21 O. G. 1533; 5 Bann. & A. 244; *Graham v. Geneva L. C. Co.* (1880), 11 Fed. Rep. 138; 21 O. G.

1536; *Howes v. McNeal* (1878), 15 Blatch. 103; 15 O. G. 608; 3 Bann. & A. 376; *Howard v. Christy* (1876), 2 Bann. & A. 457; 10 O. G. 981; *Goodyear Dental Vulcanite Co. v. Willis* (1874), 1 Bann. & A. 568; 7 O. G. 41; 1 Flippin, 388; *Howe v. Newton* (1865), 2 Fisher, 531; *Godfrey v. Eames* (1863), 1 Wall. 317.

That between two successive applications the inventor may abandon his intention to procure a patent, and then resuming his intention, file a new and independent application, see *Pelton v. Waters* (1874), 1 Bann. & A. 599; 7 O. G. 425.

See further as to abandonment of the application and its effect on the invention §§ 574-581 and notes, *post*.

³ That a public use and sale of the invention, pending an application, however prolonged, is not abandonment, see *Goodyear Dental Vulcanite Co. v. Smith* (1874), 5 O. G. 585; Holmes, 354; 1 Bann. & A. 201; *Smith v. O'Connor* (1873), 4 O. G. 633; 2 Sawyer, 461; 6 Fisher, 469; *Dental Vulcanite Co. v. Wetherbee* (1866), 2 Clifford, 555; 3 Fisher, 87.

That the decision of the Commissioner on a question of abandonment is not conclusive, and the patent may be attacked on that ground, see *United States Rifle & Cartridge Co. v. Whitney Arms Co.* (1886), 118 U. S. 22; 35 O. G. 873.

SECTION II.

OF ABANDONMENT BY PUBLIC USE OR SALE.

§ 354. **Abandonment by Public Use: History of the Doctrine.**

The public use of an invention, with the consent of the inventor, has always been regarded as furnishing conclusive evidence of his intention to abandon it. In its earlier stages the law both in England and in this country was in this respect especially severe. The statute of James I. allowed the grant of letters-patent only for inventions which others, at the date of such letters-patent, did not use; and under this provision the courts held that a single instance of such use by any person other than the inventor, or even by the inventor in a public manner, was sufficient to debar him from a patent. In the United States, the act of 1793 required that the invention should not have been used before the application, and this our courts construed as prohibiting a public use by the consent of the inventor, and decided that his acquiescence in the enjoyment of his invention by the public, whatever might be its duration or extent, was equivalent to an abandonment. So strict a rule was necessarily disadvantageous to inventors and indirectly prejudicial to the public. In 1835 the evil was diminished in Great Britain by an act of Parliament providing for the confirmation of such patents as would otherwise be void by reason of some prior use by others; and in 1852 the 15 and 16 Vict. c. 83 rendered this use a bar only when it occurred before the application. In this country, by the act of 1836, Congress adopted the construction given by the courts to the language of the act of 1793, and also placed the sale of the invention, as an article of traffic, on the same footing with its public use. In 1839 it further relieved inventors by permitting public use and sale of the invention for two years before the application.¹ This provision still continues in our law.

§ 354. ¹ That the date of the application for a patent is the date when such application is filed in the Patent Office, not when the inventor places his case in the hands of his solicitors, see *Graham v. McCormick* (1880), 10 Bissell, 39; 11 Fed. Rep. 859; 21 O. G. 1533; 5 Bann. & A. 244; *Henry v.*

At present, therefore, an abandonment is conclusively presumed against the inventor from the public use or sale of the invention with his consent for more than two years before his application for a patent.² As to what constitutes such public use and sale we shall now inquire, and first, in ref-

Francestown Soapstone Stove Co. (1880), 2 Fed. Rep. 78 ; 17 O. G. 569 ; 5 Bann. & A. 108.

That if on the rejection of one application another is filed, both are regarded as the same application, and the date of the former is that of its successors, see *Graham v. McCormick* (1880), 10 Bissell, 39 ; 11 Fed. Rep. 859 ; 21 O. G. 1533 ; 5 Bann. & A. 244 ; *Graham v. Geneva L. C. Co.* (1880), 11 Fed. Rep. 138 ; 21 O. G. 1536 ; *Howes v. McNeal* (1878), 15 Blatch. 103 ; 15 O. G. 608 ; 3 Bann. & A. 376 ; *Howard v. Christy* (1876), 2 Bann. & A. 457 ; 10 O. G. 981 ; *Goodyear Dental Vulcanite Co. v. Willis* (1874), 1 Bann. & A. 568 ; 7 O. G. 41 ; 1 Flippin, 388 ; *Godfrey v. Eames* (1863), 1 Wall. 317.

That under § 4894 Rev. Stat., if a new application is not filed within two years after a former application is rejected, it does not date from the date of the former, in reference to public use and sale, see *Lindsay v. Stein* (1882), 20 Blatch. 370 ; 10 Fed. Rep. 907 ; 21 O. G. 1613.

That a delay in prosecuting the application for over two years may be condoned if it is unavoidable, and on this point the decision of the Commissioner is final, see *McMillin v. Barclay* (1872), 4 Brews. (Pa.) 275 ; 5 Fisher, 189.

That a reissue application is of the same date as its original, as far as the question of public use or sale is concerned, see *Shaw v. Colwell Lead Co.* (1882), 20 Blatch. 417 ; 11 Fed. Rep. 711.

That no public use or sale after the application, for however long a time,

raises a conclusive presumption of abandonment', see *Goodyear Dental Vulcanite Co. v. Smith* (1874), 5 O. G. 585 ; Holmes, 354 ; 1 Bann. & A. 201 ; *Smith v. O'Connor* (1873), 4 O. G. 633 ; 2 Sawyer, 461 ; 6 Fisher, 469 ; *Dental Vulcanite Co. v. Wetherbee* (1866), 2 Clifford, 555 ; 3 Fisher, 87.

² In *Manning v. Cape Ann Isinglass & Glue Co.* (1879), 4 Bann. & A. 612, Lowell, J.: (613) "It has always been a pre-requisite or condition precedent to the grant of a valid patent that the thing patented shall not have been in use. By the English law, and formerly by ours, a use before the date of the patent, or of the application, destroyed the novelty of the invention. But for the last forty years we have permitted a use not exceeding two years before the application. Obvious reasons of policy and justice require that an inventor should not monopolize what he has neglected to patent for a considerable time, if in the meantime the public have acquired the knowledge of it, whether through him or from an independent source. Before 1870 it was generally understood that two years' use would not destroy the patent unless it was had with the 'consent and allowance' of the inventor. These words are not found in the statute of 1870, nor in the Revised Statutes ; and Judge Blatchford has lately decided that they are no part even of the law of 1839."

That under the act of 1793, use by others than the inventor with his consent was a bar, see *Earl v. Page* (1834), 6 N. H. 477 ; *Pennock v. Dialogue* (1829), 2 Peters, 1 ; 1 Robb, 542 ; Tread-

erence to public use, consider: (1) The nature of the use itself; (2) Its public character; and (3) The consent of the inventor.

§ 355. Experimental Use not Public Use.

That use of an invention from which, if public and consented to by the inventor, abandonment may be presumed, consists in the practical employment of the invention in the ordinary course of trade, as distinguished both from the mere construction of the invention and from its experimental use. To make an instrument is not to use it.¹ A use which is experimental, or is designed to test the capability or merits of an art or instrument, is not a use from which abandonment can be inferred.² Such use assumes that the inventor does

well *v. Bladen* (1827), 4 Wash. 703; 1 Robb, 531; *Pennock v. Dialogue* (1825), 4 Wash. 538; 1 Robb, 466.

That two years' use or sale before the application raises a conclusive presumption of abandonment, see *Andrews v. Hovey* (1887), 123 U. S. 267; 41 O. G. 1162; *Adams & Westlake Mfg. Co. v. Rathbone* (1886), 26 Fed. Rep. 262; *Hutchinson v. Everett* (1885), 26 Fed. Rep. 531; 35 O. G. 1110; *Bates v. Coe* (1878), 98 U. S. 31; 15 O. G. 337; *Elizabeth v. Pavement Co.* (1877), 97 U. S. 126; *McMillin v. Barclay* (1872), 4 Brews. (Pa.) 275; 5 Fisher, 189.

That this presumption cannot be rebutted by any evidence of difficulties with which the inventor was obliged to contend, see *Sisson v. Gilbert* (1871), 5 Fisher, 109 9 Blatch. 185.

That this rule applies to all classes of inventions, including designs, see *Burton v. Town of Greenville* (1880), 18 O. G. 411; 5 Bann. & A. 541; 3 Fed. Rep. 642.

That a defective combination on sale for two years cannot be so reconstructed as to be useful and then patented, unless inventive skill is used and the combination is new, see *Newark Mach. Co. v.*

Hargett (1886), 28 Fed. Rep. 567; 36 O. G. 692.

That the public use and sale of an impracticable machine bars a patent for its component devices, see *Newark Mach. Co. v. Hargett* (1886), 28 Fed. Rep. 567; 36 O. G. 692.

That an assignment of the patent to the user does not prevent the public use from being an abandonment, see *Worley v. Tobacco Co.* (1882), 104 U. S. 340; 21 O. G. 559.

That two years' public use before the first application is necessary to abandonment where several applications are continuous, see *Graham v. McCormick* (1880), 21 O. G. 1533; 10 Bissell, 39; 11 Fed. Rep. 859; 5 Bann. & A. 244.

§ 355. ¹ That the making or construction of an invention, without using or selling it, is not public use, see *Comstock v. Sandusky Seat Co.* (1878), 13 O. G. 230; 8 Bann. & A. 188; *Betts v. Menzies* (1859), 5 Jur. n. s. 1164; *Bramah v. Hardcastle* (1789), Holroyd, 81; 1 Web. 44, n.; 1 Abb. P. C. 51.

² In *Lyman v. Maypole* (1884), 19 Fed. Rep. 735, Blodgett, J.: (736) "The law permits an inventor to con-

not yet regard his own idea of means as perfectly developed, or fears that his embodiment of it is not adapted to its full

struct a machine which he is engaged in studying upon and developing, and place it in friendly hands for the purpose of testing it and ascertaining whether it will perform the functions claimed for it; and if these machines are strictly experiments, made solely with a view to perfect the device, the right of the inventor remains unimpaired; but when an inventor puts his incomplete or experimental device upon the market and sells it, as a manufacturer, more than two years before he applies for his patent, he gives to the public the device in the condition or stage of development in which he sells it." 28 O. G. 810 (811).

In *Sprague v. Smith & Griggs Mfg. Co.* (1882), 12 Fed. Rep. 721, Shipman, J.: (724) "It is perfectly true that a patentee cannot be permitted to use for profit a machine which embodies a perfected invention, for a period of two years or more, and then obtain a valid patent for the old machine by means of the addition of some new improvements which, in the language of Judge Lowell, 'were intended to benefit the patent rather than the machine.' The present case is that of a machine which was imperfect, and which demanded and received the continuous experiments of the inventor to remedy the defects in its organization. It is not true that the inventor cannot safely use for profit such a machine in its imperfect state, lest two years should elapse during the experimental period before the invention is completed and the patent is applied for."

See also *Emery v. Cavanagh* (1883), 17 Fed. Rep. 242; *Graham v. McCormick* (1880), 21 O. G. 1533; 10 Bissell, 39; 11 Fed. Rep. 859; 5 Bann. & A. 244; *Jennings v. Pierce* (1878), 15 Blatch. 42; 3 Bann. & A. 361;

McMillin v. Barclay (1872), 4 Brews. (Pa.) 275; 5 Fisher, 189.

That though the invention upon experiment prove complete, the use may still have been experimental and not public, see *Bentley v. Fleming* (1844), 1 C. & K. 587.

That a continuous use is not experimental use if the subsequent completion of the invention did not add to its patentable character, see *International Tooth Crown Co. v. Richmond* (1887), 39 O. G. 1550; 30 Fed. Rep. 775; 24 Blatch. 223.

That the use of machines, substantially the same, for two years in public, cannot be experimental but is public use, see *Sanders v. Logan* (1861), 2 Fisher, 167.

That a continued use in business without change is not experimental use, see *Manning v. Cape Ann Isinglass & Glue Co.* (1883), 108 U. S. 462; 23 O. G. 2413.

That where an invention is complete and is practically used for a long time in the usual way, it is not experimental use, see *Hall v. MacNeale* (1882), 107 U. S. 90; 23 O. G. 937.

That the effect of public use is not avoided by making non-patentable additions or improvements, see *International Tooth Crown Co. v. Richmond* (1887), 39 O. G. 1550; 30 Fed. Rep. 775; 24 Blatch. 223.

That an experimental use of the apparatus employed in the process more than two years before the application for the process patent is no abandonment of the process, see *Eastern Paper Bag Co. v. Standard Paper Bag Co.* (1887), 30 Fed. Rep. 63; 41 O. G. 231.

That the inaction of the inventor for two years after an experimental use may indicate that he did not regard the in-

expression; and therefore his experimental use of the invention, whether in public or in private, and for however long a time continued, indicates no intention to surrender it to the public, but on the contrary a design to retain entire control over it for the purpose of completely realizing his idea.³ That from a use

vention as complete, see *Beedle v. Bennett* (1887), 122 U. S. 71; 39 O. G. 1326.

That where an invention is made for sale and is sold it is not an experimental use, see *Newark Mach. Co. v. Hargett* (1886), 28 Fed. Rep. 567; 36 O. G. 692.

³ In *Elizabeth v. Pavement Company* (1877), 97 U. S. 126, Bradley, J.: (134) "But in this case it becomes important to inquire what is such a public use as will have the effect referred to. That the use of the pavement in question was public, in one sense, cannot be disputed. But can it be said that the invention was in public use? The use of an invention by the inventor himself, or by any other person under his direction, by way of experiment and in order to bring the invention to perfection, has never been regarded as such a use. *Curtis, Patents*, § 381; *Shaw v. Cooper*, 7 Pet. 292. Now the nature of a street pavement is such that it cannot be experimented upon satisfactorily except on a highway, which is always public. When the subject of invention is a machine, it may be tested and tried in a building, either with or without closed doors. In either case such use is not a public use, within the meaning of the statute, so long as the inventor is engaged, in good faith, in testing its operation. He may see cause to alter it and improve it, or not. His experiments will reveal the fact whether any and what alterations may be necessary. If durability is one of the qualities to be attained, a long period, perhaps years, may be necessary to enable the inventor to discover whether his purpose

is accomplished. And though, during all that period, he may not find that any changes are necessary, yet he may be justly said to be using his machine only by way of experiment; and no one would say that such a use, pursued with a *bona fide* intent of testing the qualities of the machine, would be a public use within the meaning of the statute. So long as he does not voluntarily allow others to make it and use it, and so long as it is not on sale for general use, he keeps the invention under his own control, and does not lose his title to a patent. It would not be necessary, in such a case, that the machine should be put up and used only in the inventor's own shop or premises. He may have it put up and used in the premises of another, and the use may enure to the benefit of the owner of the establishment. Still, if used under the surveillance of the inventor, and for the purpose of enabling him to test the machine, and ascertain whether it will answer the purpose intended, and make such alterations and improvements as experience demonstrates to be necessary, it will still be a mere experimental use and not a public use, within the meaning of the statute. Whilst the supposed machine is in such experimental use, the public may be incidentally deriving a benefit from it. If it be a grist mill, or a carding machine, customers from the surrounding country may enjoy the use of it by having their grain made into flour, or their wool into rolls, and still it will not be in public use within the meaning of the law. But if the inventor allows his machine to be used by other persons generally,

like this benefit accrues indirectly to the public, or some ad-
 either with or without compensation, or if it is with his consent put on sale for such use, then it will be in public use and on public sale within the meaning of the law. If now we apply the same principles to this case, the analogy will be seen at once. Nicholson wished to experiment on his pavement. He believed it to be a good thing, but he was not sure, and the only mode in which he could test it was to place a specimen of it in a public roadway. He did this at his own expense, and with the consent of the owners of the road. Durability was one of the qualities to be attained. He wanted to know whether his pavement would stand and whether it would resist decay. Its character for durability could not be ascertained without its being subjected to use for a considerable time. He subjected it to such use in good faith, for the simple purpose of ascertaining whether it was what he claimed it to be. Did he do anything more than the inventor of the supposed machine might do in testing his invention? The public had the incidental use of the pavement, it is true; but was the invention in public use within the meaning of the statute? We think not. The proprietors of the road alone used the invention, and used it at Nicholson's request, by way of experiment. The only way in which they could use it was by allowing the public to pass over the pavement. Had the city of Boston, or other parties used the invention by laying down the pavement in other streets and places, with Nicholson's consent and allowance, then, indeed, the invention itself would have been in public use within the meaning of the law; but this was not the case. Nicholson did not sell it, nor allow others to use or sell it. He did not let it go beyond his control. He did nothing that indicated any intent to do so. He kept it under his own eyes, and never for a moment abandoned the intent to obtain a patent for it. In this connection it is proper to make another remark. It is not a public knowledge of his invention that precludes the inventor from obtaining a patent for it, but a public use or sale of it. In England, formerly, as well as under our Patent Act of 1793, if an inventor did not keep his invention secret, if a knowledge of it became public before his application for a patent, he could not obtain one. To be patentable, an invention must not have been known or used before the application; but this has not been the law of this country since the passage of the act of 1836, and it has been very much qualified in England. *Lewis v. Marling*, 10 B. & C. 22. Therefore, if it were true that during the whole period in which the pavement was used, the public knew how it was constructed, it would make no difference in the result. It is sometimes said that an inventor acquires an undue advantage over the public by delaying to take out a patent, inasmuch as he thereby preserves the monopoly to himself for a longer period than is allowed by the policy of the law; but this cannot be said with justice when the delay is occasioned by a *bona fide* effort to bring his invention to perfection, or to ascertain whether it will answer the purpose intended. His monopoly only continues for the allotted period in any event; and it is the interest of the public, as well as himself, that the invention should be perfect and properly tested, before a patent is granted for it. Any attempt to use it for a profit and not by way of experiment, for a longer period than two years before the application, would deprive the inventor of his right to a patent." The substance of the doctrine, as thus stated, is this:

Public use is a question of abandonment. The inventor abandons only

vantage is obtained by the inventor, does not change its char-

when he dedicates his invention to the public. As long as he retains control over it he does not dedicate it. By two years' unrestricted public use, etc., he does dedicate and lose control over it.

In *Henry v. Francestown Soapstone Stove Co.* (1876), 9 O. G. 408, Shepley, J. : (409) "The fact of a public use or sale more than two years prior to the application, when clearly proved, is fatal to the patent. But the objection rests upon the principle of forfeiture, and is not to be so favorably regarded as to dispense with the necessity of strict proof. Public use in good faith for experimental purposes, while the inventor is perfecting his invention, and for a reasonable period even before the beginning of the two years of limitation, cannot affect the rights of the inventor." 2 Bann. & A. 221 (223).

In *Whitney v. Emmett* (1831), Baldwin, 303, Baldwin, J. : (310) "A patentee may take a reasonable time to make his specification, drawings, model, to try experiments on the effect and operation of his machinery in order to know whether the thing patented can be produced in the mode specified; he may disclose his secret to those he may wish to consult, or call to his assistance any persons to aid him in making or using his machine, and preparations for procuring his patent. So if the machine is to operate publicly, as in steamboats, a public experiment may be made. . . . In either of these, and in like cases, a disclosure of the secret would not be such previous knowledge, or the use of the invention be such an use, as would impair the patent, etc." 1 Robb, 567 (577).

In re Adamson's Patent (1856), 6 De G., M., & G. 419, the inventor having used his own invention publicly in the course of business before patent, Cranworth, L. C., said : (421) "I think

there has been a clear dedication to the public. Cases may arise in which there may be a doubt as to whether an invention has or has not been made public. In the present instance, however, an invention has been made in the progress of a work, and it has been used publicly by the inventor, not as an invention, but in the carrying on and execution of that work. . . . No doubt an experiment might have been made, and if made *bona fide* only for the purpose of testing the merits of an invention I do not think it would have amounted to a dedication to the public; but where, as in the present case, thousands of persons had the opportunity of seeing the apparatus at work for a period of four months, during the carrying on of the petitioner's contract and in the regular course of the undertaking, it is quite clear that no intention of applying for a patent originally existed; and under such circumstances . . . I must hold that there was a dedication to the public."

That an experimental use may be in public, if necessary, and does not thereby become public use, see *Railway Register Mfg. Co. v. Broadway & Seventh Ave. R. Co.* (1886), 26 Fed. Rep. 522; 34 O. G. 921; *Railway Register Mfg. Co. v. Broadway & Seventh Ave. R. Co.* (1884), 22 Fed. Rep. 655; 30 O. G. 180; *Campbell v. Mayor of New York* (1881), 20 Blatch. 67; 20 O. G. 1817; 9 Fed. Rep. 500; *Andrews v. Cross* (1881), 19 O. G. 1705; 8 Fed. Rep. 269; 19 Blatch. 294; *Graham v. McCormick* (1880), 21 O. G. 1533; 10 Bissell, 39; 11 Fed. Rep. 859; 5 Bann. & A. 244; *Sinclair v. Backus* (1880), 5 Bann. & A. 81; 17 O. G. 1503; 4 Fed. Rep. 539; *Campbell v. James* (1879), 18 O. G. 979; 17 Blatch. 42; 4 Bann. & A. 456; *Draper v. Wattles* (1878), 3 Bann. & A. 618;

actor.⁴ A use clearly experimental, in good faith and for a reasonable time, though it may show that the invention is in fact complete, does not affect the exclusive rights of the inventor or constitute a dedication to the public. Such dedication is inferrible only from a use in the same manner and for the same beneficial purposes as would exist if the invention, being finished, patented, and published to the world, had been recognized and adopted by the public as an operative means for the accomplishment of certain ends.

§ 356. Public Use is such Use as Gives the Public a Knowledge and Control of the Invention.

A public use is not necessarily a use *in* public nor a use *by* the public, as these terms are generally understood. Any use is public by which the invention passes beyond the control of the inventor. The practical employment of the art or instrument by a single person other than the inventor, if under no obligations as to secrecy or to limitations in the mode of use, is public use; and this is true whether the use is open or concealed, if it be in accordance with the customary method of employing such inventions.¹ Even a use by the inventor or

16 O. G. 629; U. S. Rifle & Cartridge Co. v. Whitney Arms Co. (1877), 14 Blatch. 94; 11 O. G. 373; 2 Bann. & A. 493; Birdsall v. McDonald (1874), 1 Bann. & A. 165; 6 O. G. 682; Locomotive Engine Safety Truck Co. v. Pennsylvania R. R. Co. (1874), 1 Bann. & A. 470; 6 O. G. 927; 10 Phila. 252; Jones v. Sewall (1873), 3 O. G. 630; 3 Clifford, 563; 6 Fisher, 343; American Nicholson Pavement Co. v. City of Elizabeth (1873), 6 Fisher, 424; 3 O. G. 522; Sisson v. Gilbert (1871), 5 Fisher, 109; 9 Blatch. 185; Winans v. N. Y. & Harlem R. R. Co. (1855), 4 Fisher, 1; Pitts v. Hall (1851), 2 Blatch. 229; *In re* Newall (1858), 4 C. B. n. s. 269; Honiball v. Bloomer (1854), 2 Web. 199; Bentley v. Fleming (1844), 1 C. & K. 587.

That the same privilege of experimental use, even in public, was recog-

nized before the act of 1839, see *Winans v. Schenectady & Troy R. R. Co.* (1851), 2 Blatch. 279.

⁴ In *Smith & Griggs Mfg. Co. v. Sprague* (1887), 123 U. S. 249, Matthews, J. : (256). "A use by the inventor for the purpose of testing the machine, in order by experiment to devise additional means for perfecting the success of its operation, is admissible; and where, as incident to such use, the product of its operation is disposed of by sale, such profit from its use does not change its character; but where the use is mainly for the purposes of trade and profit, and the experiment is merely incidental to that, the principal and not the incident must give character to the use." 41 O. G. 1037 (1039).

See also cases under note 2, *ante*.

§ 356. ¹ In *Egbert v. Lippman* (1881),

his servants or his fellow-workmen, if in the ordinary course of trade and exposed to the inspection of the public, is held to

104 U. S. 333, Woods, J.: (336) "We observe, in the first place, that to constitute the public use of an invention it is not necessary that more than one of the patented articles should be publicly used. The use of a great number may tend to strengthen the proof, but one well-defined case of such use is just as effectual to annul the patent as many. *McClurg v. Kingsland*, 1 How. 202; *Consolidated Fruit Jar Co. v. Wright*, 94 U. S. 92; *Pitts v. Hall*, 2 Blatchf. 229. For instance, if the inventor of a mower, a printing-press, or a railway-car makes and sells only one of the articles invented by him, and allows the vendee to use it for two years without restriction or limitation, the use is just as public as if he had sold and allowed the use of a great number. We remark, secondly, that whether the use of an invention is public or private does not necessarily depend upon the number of persons to whom its use is known. If an inventor, having made his device, gives or sells it to another, to be used by the donee or vendee without limitation or restriction, or injunction of secrecy, and it is so used, such use is public, even though the use and knowledge of the use may be confined to one person. We say, thirdly, that some inventions are by their very character only capable of being used where they cannot be seen or observed by the public eye. An invention may consist of a lever or spring hidden in the running-gear of a watch, or of a ratchet, shaft, or cog-wheel covered from view in the recesses of a machine for spinning or weaving. Nevertheless, if its inventor sells a machine of which his invention forms a part, and allows it to be used without restriction of any kind, the use is a public one. So, on the other hand, a use necessarily open to public view, if

made in good faith solely to test the qualities of the invention, and for the purposes of experiment, is not a public use within the meaning of the statute. *Elizabeth v. Pavement Company*, 97 U. S. 126; *Shaw v. Cooper*, 7 Pet. 292." 21 O. G. 75 (76). Dissenting opinion by Miller, J., that unless the use is such that the public may have knowledge, it is not public use; that a secret steel in a corset, for example, used for years by the wearer is not publicly used.

In *Perkins v. Nashua Card and Glazed Paper Co.* (1880), 17 O. G. 1285, Lowell, J.: (1286) "The law desires to encourage inventors to make their discoveries known for the improvement of the art, and to discourage an extension of the monopoly beyond the statutory period. For these reasons, and because of the difficulty of ascertaining the amount of knowledge which may have been derived from the exhibition, publication, or use of the invention, it has always been held that when the public have had means of knowledge they have had knowledge of the invention. Thus if a book has been published describing the invention, it is not important that no one has read it. *Stead v. Williams*, 7 M. & G. 818. If a pier has been placed in the bed of a river, or a pipe underground, it is conclusively presumed to be known to all men. It has been intimated that a use in a workshop, where the workmen are pledged to secrecy, may not be a public use. *Kendall v. Winsor*, 21 How. 322; charge of Curtis, J., p. 326; *Bevin v. East Hampton Bell Co.*, 9 Blatch. 50; *Heath v. Smith*, 3 Ellis & B. 255. In the last of these cases it is held that if the invention has been worked in the ordinary way, without an injunction of secrecy, the use is public. In *McClurg v. Kings-*

be a public use, from the facilities which it affords and the inducements which it offers to the public to avail themselves of

land, 1 How. 202, it is said by Mr. Justice Baldwin, *obiter*, that use in a factory is a public use. A use very trifling in amount, or a publication purely technical, or a single sale have often been held to deprive an inventor of his patent, without evidence that any one interested to acquire knowledge of the invention had acquired it. *Henry v. Providence Tool Co.*, 14 O. G. 855; *Egbert v. Lippman*, 14 O. G. 822; *McMillin v. Barclay*, 5 Fisher, 189; *Re Adamson's Patent*, 6 De G., M., & G. 420; *Patterson v. Gas Light Co.*, 3 App. Cas. 239; *Lang v. Gisborne*, 31 Beav. 133. . . . Taking these decisions together, I understand the law to be that actual knowledge of the invention need not have been derived by any one interested to practise it. It is enough that any one or more persons not under a pledge of secrecy saw the invention practised, or even might have seen it if they had used their opportunities, provided it was in fact practised in the ordinary way after being completed. And it must be held either that the workmen and visitors were a part of the public, or that they were persons from whom the public might have acquired the art without a breach of trust." 2 Fed. Rep. 451 (452); 5 Bann. & A. 395 (396).

In *Manning v. Cape Ann Isinglass and Glue Co.* (1879), 4 Bann. & A. 612, Lowell, J.: (614) "Public use means not only a use by the public but a use in public, that is to say, one which is not secret, and therefore one from which, so far as the inventor is concerned, the public may, by any of the chances of life, acquire the knowledge. A remarkable case is that of the lady who wore an improved pair of corsets, given her by the inventor, wore them two years before he applied for a patent upon the article, which was held a public use. *Egbert v.*

Lippman, 14 O. G. 822. In a case like the present, the use of a machine by the inventor himself 'in the ordinary way of the public use of a machine,' which I understand to mean without special secrecy, will be a public use. *Pitts v. Hall*, 2 Blatch. C. C. R. 229, 235; *Bevin v. East Hampton Bell Co.*, 9 Blatch. C. C. R. 50; *McMillin v. Barclay*, 5 Fisher, 189; *Re Adamson's Patent*, 6 De G., M., & G. 420; *Heath v. Smith*, 3 Ellis & B. 256. The non-existence of public use being a condition precedent to the validity of the grant, the intent of the inventor not to abandon the invention, or his reasons for not applying for a patent, though of a most potent character, such as illness, are immaterial. See *Pennock v. Dialogue*, 2 Pet. 1, and the remarks of Marshall, C. J., on that case in *Grant v. Raymond*, 6 Pet. 218, 248; *McClurg v. Kingsland*, 1 How. 202, 208, *per* Baldwin, J.; *Sisson v. Gilbert*, 9 Blatch. C. C. R. 185; *Egbert v. Lippman*, 14 O. G. 822. Evidence that any one has copied the invention which is thus brought, presumptively, to the knowledge of mankind, is not necessary to the success of this defence. Such a fact would often be difficult to prove or disprove, and the use itself, in any of the modes above explained, works a forfeiture, without more."

See also *Whitney v. Emmett* (1831), Baldwin, 303; 1 Robb, 567.

That public use is use in public, not in secret, see *Henry v. Providence Tool Co.* (1878), 14 O. G. 855; 3 Bann. & A. 501; *Adams v. Edwards* (1848), 1 Fisher, 1.

That the use may be public though concealed from view (as in a lock, or safe-walls, etc.), see *Hall v. MacNeale* (1882), 107 U. S. 90; 23 O. G. 937.

That a single instance of use in public is sufficient, see *Clark Pomace*

its advantages.² But a mere temporary use permitted to another as an act of kindness, or a use existing under injunctions of secrecy or subject to the will of the inventor, or the private use of the invention by the inventor or his employees

Holder Co. v. Ferguson (1883), 21 Blatch. 376; 17 Fed. Rep. 79; 24 O. G. 1090; *Egbert v. Lippman* (1881), 104 U. S. 333; 21 O. G. 75; *Worley v. Tobacco Co.* (1881), 104 U. S. 340; 21 O. G. 559; *Henry v. Providence Tool Co.* (1878), 14 O. G. 855; 3 Bann. & A. 501; *Kelleher v. Darling* (1878), 4 Clifford, 424; 14 O. G. 673; 3 Bann. & A. 438; *Boston Elastic Fabrics Co. v. East Hampton Rubber Thread Co.* (1876), 9 O. G. 745; 2 Bann. & A. 268; *Am. H. & L. S. & D. Mach. Co. v. Am. & T. Mach. Co.* (1870), Holmes, 503; 4 Fisher, 284; *McCormick v. Seymour* (1851), 2 Blatch. 240; *Honiball v. Bloomer* (1854), 2 Web. 199.

² In *McMillin v. Barclay* (1871), 5 Fisher, 189, McKennan, J.: (195) "The act of July 4, 1836, forbids the granting of a patent for an invention, which had, at the time of the application therefor, been in public use or on sale, with the consent or allowance of the inventor. - This provision is modified by the act of March 3, 1839, so as to allow such use or sale for two years prior to the application. Different opinions have been entertained as to the kind of use which these acts of Congress contemplate. By some judges they have been held to mean a use in public by persons other than the inventor; and again, others have held that a use in public by the inventor himself, which is not merely experimental, will have the effect of invalidating the patent. In *Ryan v. Goodwin*, 3 Sum. 518, Mr. Justice Story says: 'It is clear by our law, whatever it may be by the law of England, that the public use or sale of an invention, in order to deprive the inventor of his right to a patent, must be a public use or sale by others, with his knowledge and con-

sent, before his application therefor.' But he must be understood to have predicated this of the facts in the case before him, in which only a use by persons other than the inventor was alleged. While the object of the law was to protect the public against the exclusive claim of an inventor who had dedicated his invention to their use, by allowing its practical employment in public, it was at the same time designed to require of him reasonable diligence in applying for his patent. As it is the public use of a completed invention against which this provision of the law is directed, it could scarcely have been intended to authorize such use by the inventor himself, which, if employed by another, with his consent, would work a forfeiture of his right to a patent. His own direct act is just as significant of an intended abandonment of his inchoate right as is that of another with his consent. Indeed, it is difficult to comprehend that a use in public by an inventor himself is not as effectually 'a public use with his consent and allowance,' as where his invention is permissively so employed by another." 4 Brews. (Pa.) 275 (279). See also *Pitts v. Hall* (1851), 2 Blatch. 229.

That use in a factory where the inventor is employed, if open and with his consent, is public use, see *McClurg v. Kingsland* (1843), 1 How. 202; 2 Robb, 105.

That use in a factory by the workmen in view of the customers of the business is public use, see *Smith & Griggs Mfg. Co. v. Sprague* (1887), 123 U. S. 249; 41 O. G. 1037.

That a single use openly by the inventor is public use, see *Jones v. Barker* (1882), 11 Fed. Rep. 597; 22 O. G. 771.

though its results are given to the world, is not a public use, since in each case the circumstances of the use denote that the inventor purposes to keep the art or instrument under his own control.³

§ 357. Public Use not Abandonment unless Consented to by the Inventor.

Until a recent period it seems to have been the uniform doctrine of our courts that the public use of an invention raised no presumption of its abandonment, and constituted no bar to a patent, unless such use had been enjoyed with the consent or allowance of the inventor.¹ In the act of 1836

³ In *Wyeth v. Stone* (1840), 1 Story, 273, Story, J. : (280) "In the next place, as to the supposed public use of Wyeth's machine before his application for a patent. To defeat his right to a patent under such circumstances, it is essential that there should have been a public use of his machine, substantially as it was patented, with his consent. If it was merely used occasionally by himself in trying experiments, or if he allowed only a temporary use thereof by a few persons, as an act of personal accommodation or neighborly kindness, for a short and limited period, that would not take away his right to a patent. To produce such an effect, the public use must be either generally allowed or acquiesced in, or at least be unlimited in time, or extent, or object. On the other hand, if the user were without Wyeth's consent, and adverse to his patent, it was a clear violation of his rights, and could not deprive him of his patent." 2 Robb, 23 (30).

That the use of an article in private is not abandonment, see *Adams v. Edwards* (1848), 1 Fisher, 1.

That unrestricted use by allowance of the inventor with no injunction of secrecy is public use, see *Manning v. Cape Ann Isinglass & Glue Co.* (1883), 108 U. S. 462 ; 23 O. G. 2413.

That a special parol license to build two structures on the inventor's plan, before the patent issues, is not abandonment, see *McCay v. Burr* (1847), 6 Pa. St. 147.

That a license to use before patent is not necessarily an abandonment, see *Slemmer's Appeal* (1868), 58 Pa. St. 155.

§ 357. ¹ Although this doctrine makes its first appearance as a legislative enactment in the act of 1836, it had, from the earliest period, been uniformly recognized as a fundamental principle of our Patent Law. By the act of 1790 patents were permitted only where the invention had not been "before known or used." By the act of 1793 the invention was not patentable if "known or used before the application." In the act of 1800 it was provided that "every patent which shall be obtained pursuant to this act, for any invention, art, or discovery which it shall afterward appear had been known or used previous to such application for a patent, shall be utterly void." The statutes being in this condition, the case of *Pennock v. Dialogue* came before the Supreme Court in 1829 (2 Pet. 1 ; 1 Robb, 542), where the question of prior public use was raised and discussed, the court holding that such

this provision was clearly expressed, but in the modification introduced into the law in 1839, extending the duration of a

use, even under existing statutes, did not defeat the patent, unless it had taken place with the knowledge and consent of the inventor. The court below had charged the jury that "if an inventor makes his discovery public, looks on and permits others freely to use it, without objection or assertion of claim to the invention, of which the public might take notice, he abandons the inchoate right to the exclusive use of the invention to which a patent would have entitled him had it been applied for before such use." After verdict for defendants, on writ of error, Mr. Webster, for the plaintiffs, claimed, *inter alia*, that "the use of an invention, however public, if it be by the permission and under the continual exclusive claim of the inventor, does not take away his right, except after an unreasonable lapse of time, or gross negligence in applying for a patent." Mr. Sargeant, for the defendant, insisted, *inter alia*, that "the inventor, by abstaining from getting a patent, encouraged the public to use the article freely and thus benefited his own manufactory. And he is not at liberty, when this advantage is exhausted, to turn round and endeavor to reach another and a different kind of advantage, by appropriating the use exclusively to himself." But he conceded that "if the invention should be pirated, the use or knowledge obtained by the piracy, or otherwise obtained without the knowledge or consent and without the fault of the inventor," would not bar him from getting a patent. Justice Story, in delivering the opinion of the court, says: (2 Pet. 16; 1 Robb, 558) "The single question, then, is whether the charge of the court was correct in point of law. It has not been and indeed cannot be denied that an in-

ventor may abandon his invention and surrender or dedicate it to the public. This inchoate right, thus once gone, cannot afterwards be resumed at his pleasure; for where gifts are once made to the public in this way, they become absolute. . . . The question which generally arises at trials is a question of fact rather than of law, — whether the acts or acquiescence of the party furnish in the given case satisfactory proof of an abandonment or dedication of the invention to the public." Then stating that the test of abandonment is given by the statutes in the phrases before cited, he continues: (2 Pet. 18; 1 Robb, 561) "What then is the true meaning of the words '*not known or used before the application*'? . . . The words, to have any rational interpretation, must mean not known or used by others before the application. But how known or used? If it were necessary, as it well might be, to employ others to assist in the original structure or use by the inventor himself; or if before his application for a patent his invention should be pirated by another, or used without his consent; it can scarcely be supposed that the legislature had within its contemplation such knowledge or use." Then reviewing the English cases and statute and remarking that the use referred to in them as defeating a patent "has always been understood to be a public use, and not a private or surreptitious use in fraud of the inventor," he proceeds: (2 Pet. 23; 1 Robb, 567) "It is admitted that the subject is not wholly free from difficulties; but upon most deliberate consideration we are all of opinion that the true construction of the act is that the first inventor cannot acquire a good title to a patent if he suffers the thing invented to go into public use, or to be

permitted public use to two years before the application for a patent, that clause was not repeated, nor has it been incor-

publicly sold for use, before he makes application for a patent. His voluntary act or acquiescence in the public sale and use is an abandonment of his right ; or rather creates a disability to comply with the terms and conditions on which alone the Secretary of State is authorized to grant him a patent."

Further, that before the act of 1836 a public use or sale without the knowledge or consent of the inventor could not affect his right to a patent, see *Mellus v. Silsbee* (1825), 4 Mason, 108 ; 1 Robb, 506 ; *Whitney v. Emmett* (1831), Baldwin, 303 ; 1 Robb, 567 ; *Shaw v. Cooper* (1833), 7 Pet. 292 ; 1 Robb, 643.

These doctrines were formulated and sanctioned by the act of 1836, which made the allowance and consent of the inventor an essential element in any public use affecting his title to a patent. Under this act, and that of 1839 (on the interpretation of which the modern departure from the ancient rules is based), numerous decisions have been rendered uniformly announcing the same necessity for knowledge and consent. Among these decisions is *Ryan v. Goodwin* (1839), 3 Sumner, 514, in which Story, J., says : (518) " As to the second point, it is clear by our law, whatever it may be by the law of England, that the public use or sale of an invention, in order to deprive the inventor of his right to a patent, must be a public use or sale by others with his knowledge and consent, before his application therefor. If the use or sale is without such knowledge or consent, or if the use be merely experimental to ascertain the value or utility or success of the invention by putting it in practice, that is not such a use as will deprive the inventor of his title. Our law also requires that the use or sale

should not only be with the knowledge and consent of the inventor, but that it should be before his application for a patent. A sale or use of it with such knowledge or consent, in the intermediate time between the application for a patent and a grant thereof, has no such effect. It furnishes no foundation to presume that the inventor means to abandon his invention to the public ; and does not, because it is not within the words of our act, create any statute disability to assert his right to a patent." 1 Robb, 725 (729).

In *Jones v. Sewall* (1873), 3 Clifford, 563, Clifford, J. : (592) " No one but the inventor is competent to abandon his invention to the public. His acts and declarations, if explicit, are sufficient for the purpose, or he may accomplish the same end by continued acquiescence in the acts of others, of which it appears that he had knowledge ; but the proof of knowledge and acquiescence must be beyond all reasonable doubt, as every presumption is the other way." 6 Fisher, 343 (367) ; 3 O. G. 630 (638).

Further, that the consent of the inventor to the public use is necessary, see *Davis v. Fredericks* (1884), 21 Blatch. 556 ; 19 Fed. Rep. 99 ; *Emery v. Cavanagh* (1883), 17 Fed. Rep. 242 ; *Campbell v. Mayor of New York* (1881), 20 O. G. 1817 ; 20 Blatch. 67 ; 9 Fed. Rep. 500 ; *Andrews v. Cross* (1881), 19 O. G. 1705 ; 8 Fed. Rep. 269 ; 19 Blatch. 294 ; *Campbell v. James* (1879), 18 O. G. 979 ; 17 Blatch. 42 ; 4 Bann. & A. 456 ; *Draper v. Wattles* (1878), 16 O. G. 629 ; 3 Bann. & A. 618 ; *Andrews v. Carman* (1876) 9 O. G. 1011 ; 13 Blatch. 307 ; 2 Bann. & A. 277 ; *Locomotive Engine Safety Truck Co. v. Penna. R. R. Co.* (1874), 10 Phila. 252 ; 1 Bann. & A. 470 ; 6 O. G. 927 ;

porated into any subsequent statute. For this reason our courts have lately seemed inclined to treat the act of 1839 as repealing that provision of the act of 1836, and to consider public use as an abandonment, or a bar to a patent, whether with or without the allowance or consent of the inventor.²

Jones v. Sewall (1873), 3 Clifford, 563 ; 6 Fisher, 343 ; 3 O. G. 630 ; *Russell & Erwin Mfg. Co. v. Mallory* (1872), 10 Blatch. 140 ; 5 Fisher, 632 ; 2 O. G. 495 ; *Allen v. Blunt* (1846), 2 W. & M. 143 ; 2 Robb, 530 ; *Hovey v. Stevens* (1846), 1 W. & M. 290 ; 2 Robb, 479 ; *Pierson v. Eagle Screw Co.* (1844), 3 Story, 402 ; 2 Robb, 268 ; *Wyeth v. Stone* (1840), 1 Story, 273 ; 2 Robb, 23.

Between the passage of the act of 1839 and the year 1883 the Supreme Court had occasion to examine this question in six cases. In two of them, viz., *Elizabeth v. Pavement Co.* (1877), 97 U. S. 126, and *Bates v. Coe* (1878), 98 U. S. 31, it expressly asserted that under the act of 1839 a public use without the consent of the inventor does not affect his rights. In the other four it recognized such consent as necessary to an abandonment by public use ; see *Kendall v. Winsor* (1858), 21 How. 322 ; *Consolidated Fruit Jar Co. v. Wright* (1876), 94 U. S. 92 ; *Worley v. Tobacco Co.* (1881), 104 U. S. 340 ; *Egbert v. Lippman* (1881), 104 U. S. 333.

It is in the face of these decisions, which not merely expound the words of a statute, but declare and apply essential principles of the common law, that a doctrine is now introduced into our patent system which, unless so qualified as to practically make it a mere definition of "knowledge and consent," is inconsistent alike with authority and with the fundamental rules whereby the rights of all parties to contracts and all owners of property have been hitherto controlled.

² The first case of importance in which this view was formally advocated

seems to have been *Egbert v. Lippman* (1878), 15 Blatch. 295, although in earlier cases Clifford, J., notwithstanding his repeated assertions of the usual rule, had said that under the act of 1870 and the Revised Statutes a public use, with or without the consent of the inventor, would defeat his rights if coupled with laches in applying for a patent, — apparently thus confounding the abandonment presumed from public use with that inferrible from actions or omissions of the inventor. In *Egbert v. Lippman*, speaking of the effect of public use as an abandonment under the act of 1839, the court declares : (296) "The seventh section of the act of July 4, 1836 (5 U. S. Stat. at Large, 119), provided that a patent should be issued if it should not appear to the Commissioner of Patents that the invention had been in public use or on sale, with the applicant's consent or allowance, prior to his application for the patent. The fifteenth section of that act provided that, in a suit for infringement the defendant should have judgment if it should be proved that the thing patented had been in public use or on sale, with the consent and allowance of the patentee, before his application for a patent. By the seventh section of the act of March 3, 1839 (5 U. S. Stat. at Large, 354), it was enacted that every person who shall have purchased or constructed any newly invented machine prior to the application by the inventor for a patent, shall be held to possess the right to use, and vend to others to be used, the specific machine so made or purchased, without liability therefor to the inventor, and

This new position harmonizes with the tendency of modern

that 'no patent shall be held to be invalid by reason of such purchase, sale, or use prior to the application for a patent, as aforesaid, except on proof of abandonment of such invention to the public, or that such purchase, sale, or prior use has been for more than two years prior to such application for a patent.' The patent in question was applied for and issued when the act of 1839 was in force. The effect of that act is to require that an inventor shall not permit his invention to be used in public at a period earlier than two years prior to his application for a patent, under the penalty of having his patent rendered void by such use. Consent and allowance by the inventor are not necessary to such invalidity. But, *a fortiori*, consent to a use in public, not followed by an application for a patent within two years afterwards, makes the patent, when granted, invalid. The policy introduced by the act of 1839 is continued in the act of July 8, 1870, and in the Revised Statutes. The 24th section of the act of 1870 (16 U. S. Stat. at Large, 201) provides that a patent may be obtained for an invention if it has not been in public use or on sale for more than two years prior to the application for such patent, unless it is proved to have been abandoned. This provision is embodied in section 4886 of the Revised Statutes. The 61st section of the act of 1870 (*id.* 208), now section 4920 of the Revised Statutes, provides that it shall be a defence to a suit for the infringement of a patent that the thing patented had been in public use or on sale in the United States for more than two years before the application for a patent, or had been abandoned to the public. The policy introduced by the act of 1839 and thus continued is that the inventor must apply for his patent within two years

after his invention is in such condition that he can apply for a patent for it, and that, if he does not apply within such time, but applies after the expiration of such time and obtains a patent, and it appears that his invention was in public use at a time more than two years earlier than the date of his application, his patent will be void, even though such public use was without his knowledge, consent, or allowance, and even though he was in fact the original and first inventor of the thing patented and so in public use. Such public use for such length of time is made equivalent to absolute abandonment." 14 O. G. 822, (822); 3 Bann. & A. 468 (469).

In this opinion occur two sentences which may perhaps be regarded as the fountain out of which the modern doctrine flows, though in endeavoring to sustain it, the courts urge other reasons derived from narrow and technical constructions of the statutes. The learned judge, in speaking of the act of 1839, says: "The effect of that act is to require that an inventor shall not '*permit*' his invention to be used in public at a period earlier than two years prior to his application for a patent, under the penalty of having his patent rendered void by such use. Consent and allowance by the inventor are not necessary to such invalidity." These sentences were *obiter dicta* in the case under consideration, the public use there found having been with the inventor's knowledge and consent, and hence are probably not as carefully framed as otherwise they might have been. But as they stand, they announce the proposition that an inventor, without "consenting to" or "allowing" the use of his invention, may nevertheless "permit" it. To many this would seem a mere play upon words. Webster, Dic. *in loc.* defines "permit" by "allow,"

judicial authority to discourage, as far as possible, any

and discussing the possible shade of difference between the synonymes "to permit, allow, etc.," says: "'To permit' is more positive, denoting a decided assent, either directly or by implication. 'To allow' is more negative, and imports only acquiescence or an abstinence from prevention." See also "allow;" and Worcester, Dic. *in loc.* The learned judge in this case, however, undoubtedly intended to distinguish in some degree between "allowance" and "permission." If he regarded "consent and allowance" as implying some voluntary act or recognition, and "permission" as expressive of failure to prevent or prohibit a known or suspected use of the invention, the distinction, though reversing the exact meaning of the words, may be justified, but was unnecessary, since it has always been held that acquiescence, even though silent, was consent. (See § 358 and notes, *post.*) If by "permission" he intended the failure to prevent unknown, fraudulent, and surreptitious uses, his position was not only a denial of all previous doctrines on the subject, but a declaration that piracy and fraud, though concealed from its victim, and unpreventable by him, may operate to deprive him of his rights and transfer his invention to the public without his knowledge and against his will. If in "permission" he included the absence of interference on the part of the inventor with the unknown use of the invention as the product of a rival's inventive skill, he set aside at once the characteristic principle of our law that the first conceiver of an invention, if guilty of no wilful fault or neglect, is entitled to a patent, whatever success his rivals may have attained either in the creation or the use of the invention, and returned to the English theory, that merit resides alone in publication, at least so far as to re-

gard the prior publication by a rival as a sufficient reason for refusing a patent to the innocent and diligent first inventor. If, as the latter portion of the quoted passage indicates, he endeavored to formulate, and by his construction of the act of 1839 to support, the rule that an inventor must exclude the possibility of a two years' public use of his invention by applying for a patent within that period after he had completed his inventive act, it was the introduction of a doctrine warranted by no former interpretation of the statutes, contradicted by an unbroken current of decisions, and inconsistent with universal principles of reason and justice, unless qualified by excepting from its operation all cases in which the delay arose from circumstances over which the inventor had no control. But whichever of these ideas was present in the mind of the distinguished jurist from whose pen this decision proceeded, the conclusion which he reached, that the patent of the inventor will be invalid if the invention was in public use more than two years before his application, "even though such public use was without his knowledge, consent, or allowance, and even though he was in fact the original and first inventor of the thing patented and so in public use," became the guide to several other courts in subsequent cases, and has at last obtained announcement from the Supreme Court itself.

Thus in *Andrews v. Hovey* (1883), 5 McCrary, 181, Love, J.: (206) "Upon what principle of construction may we attempt to interpolate the significant words 'consent or allowance' into the statute. These words do not appear in the statute. No such condition is expressed as these words imply. The plain, simple, and unqualified provision is that 'no patent

delay of the inventor in applying for a patent after his inven-

shall be held to be invalid by reason of such purchase, sale, or use prior to the application, except on proof of abandonment of such invention to the public, or that such purchase, sale, or prior use has been for more than two years prior to such application for a patent.' Not a word is here used to the effect that such prior use or sale shall be with the 'allowance or consent' of the patentee." 26 O. G. 1011 (1018); 16 Fed. Rep. 387 (405).

In *Manning v. Cape Ann Isinglass & Glue Co.* (1883), 108 U. S. 462, Woods, J.: (465) "It is the policy of the patent laws to forbid the issue of a patent for an invention which has been in public use before the application therefor. The statute of 1836, 5 Stat. 117, section 6, did not allow the issue of a patent when the invention had been in public use or on sale for any period, however short, with the consent and allowance of the inventor; and the statute of 1870, 16 Stat. 201, section 24, Rev. Stat. section 4886, does not allow the issue when the invention had been in public use for more than two years prior to the application, either with or without the consent or allowance of the inventor." 23 O. G. 2413 (2414).

In *Andrews v. Hovey* (1887), 123 U. S. 267, Blatchford, J.: (273) "It is very plain that, under the act of 1836, if the thing patented had been in public use or on sale with the consent or allowance of the applicant for any time, however short, prior to his application, the patent issued to him was invalid. Then came section 7 of the act of 1839, which was intended as an amelioration in favor of the inventor, in this respect, of the strict provisions of the act of 1836. The first clause of that section provides for the protection of a person who, prior to the application for the patent, purchases or constructs a specific machine or

article, and declares that he may use and sell such specific machine or article after the patent is issued, without liability to the patentee. The section does not require, in order to this protection, that the purchase or construction shall have been with the consent or allowance of the person who afterwards obtains the patent and seeks to enforce it against such purchaser or constructor. The words 'consent or allowance' are not found in the provision. The only requirement is that the specific machine or article shall have been purchased or constructed at some time prior to the application for a patent. The second clause of the section then passes to consider the effect upon the validity of the patent 'of such purchase, sale, or use prior to the application' for the patent, and declares that 'no patent shall be held to be invalid by reason of such purchase, sale, or use prior to the application for a patent as aforesaid, except on proof of abandonment of such invention to the public, or that such purchase, sale, or prior use has been for more than two years prior to such application for a patent.' The expression 'such purchase' clearly means the purchase from any person, and not merely from the person who becomes the patentee of the machine or article. The expression 'such sale or use' clearly refers to the use or sale by the person who has purchased or constructed the machine or article, the right to use and sell which is given to him by the first part of the section. That right is given to a person who has constructed the machine or article, as well as to one who has purchased it; and the plain declaration of the second part of the section is, that where the purchase or construction of the machine or article took place more than two years prior to the application for the patent, or where the use or sale by

tion is complete, but it is not consistent with the theory of

the person who so purchased or constructed the machine or article took place at a time more than two years prior to the application, the patent becomes invalid. It is not possible in any other way to give full effect to the word 'constructed,' in the first part of the section. The word 'purchased,' and the word 'constructed' are used in the same connection, and in connection with the words 'so made or purchased,' which occur afterwards; and the word 'purchased' cannot be limited to a purchase from the applicant for the patent, nor can the word 'constructed' be limited to a construction with the consent and allowance of such applicant, without interpolating into the statute the words 'consent or allowance.' We can find no warrant for doing this. The evident purpose of the section was to fix a period of limitation which should be certain, and require only a calculation of time, and should not depend upon the uncertain question of whether the applicant had consented to or allowed the sale or use. Its object was to require the inventor to see to it that he filed his application within two years from the completion of his invention, so as to cut off all question of the defeat of his patent by a use or sale of it by others more than two years prior to his application, and thus leave open only the question of priority of invention. The evident intention of Congress was to take away the right (which existed under the act of 1836) to obtain a patent after an invention had for a long period of time been in public use without the consent or allowance of the inventor; it limited that period to two years, whether the inventor had or had not consented to or allowed the public use. The right of an inventor to obtain a patent was in this respect narrowed, and the rights of the public as against him were enlarged, by

the act of 1839. The language of section 24 of the act of 1870, now section 4886 of the Revised Statutes, is to the same effect, and carries out the policy inaugurated by the act of 1839. It allows a patent to be granted only for an invention which was not in public use or on sale for more than two years prior to the application for the patent, subject to the defence of abandonment within such two years, which is also the requirement of section 61 of the same act; while section 37 of that act requires that a person, in order to have the right to use and sell, without liability, a specific thing made or purchased prior to the application for the patent, shall have purchased it of the inventor, or constructed it with his knowledge and consent." 41 O. G. 1162 (1164).

The discrepancy between the positions taken in the four cases from which these extracts have been made is somewhat remarkable. In *Egbert v. Lippman* and *Andrews v. Hovey* in the Supreme Court, Judge Blatchford asserts that the object and effect of the act of 1839, and of the corresponding provisions in the act of 1870 and the Revised Statutes, is "to require the inventor to see to it that he filed his application within two years from the completion of his invention so as to cut off all question of the defeat of his patent by a use or sale of it by others more than two years prior to his application." This assumes that the inventor may take two years after his complete reduction to practice to test the availability and commercial value of his invention, and implies that no public use of the invention as the invention of another, though more than two years before his application for a patent, raises a conclusive presumption of abandonment, unless coupled with

dedication to the public, which always involves knowledge and

that period of delay after his own inventive act is finished and he becomes entitled to a patent. But in *Andrews v. Hovey* in the Circuit Court, and in *Manning v. Isinglass & Glue Co.*, the judges ignore this element of delay on the part of the inventor, and declare that the acts under consideration do not "allow the issue [of a patent] when the invention had been in public use for more than two years before the application, either with or without the consent or allowance of the inventor," thus making the two years' use a bar, whether it were fraudulent and surreptitious or under a license, and whether it were the use of the invention as the invention of the present inventor or of his rival, and whether it occurred before or after the first and diligent conceiver of the idea had succeeded in reducing it to practice.

See also *Andrews v. Hovey* (1888), 124 U. S. 694; *Duffy v. Reynolds* (1885), 24 Fed. Rep. 855; 33 O. G. 621; *Kelleher v. Darling* (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438.

That the public use of the patented device, or a device substantially identical therewith, for more than two years before the application for the patent is a complete bar to the patent, see *Detroit Lubricator Co. v. Lunkenheimer* (1886), 30 Fed. Rep. 190. In this case it seems that the device used was not the work of the patentee or copied from his but invented by another and used as such. The case also treats this two years' use as a defence irrespective of the question of priority of invention, and as resting purely on the statute.

The difficulties attendant upon this position are rendered more striking by the opinion in *Andrews v. Hovey* (1888), 124 U. S. 694, in which a rehearing on the former case, in 123 U. S. 267, was denied.

In considering the arguments of the petitioners and the authorities cited in support of the ancient doctrine, the Supreme Court apparently concede that a piratical or fraudulent use would not defeat a patent, and by stating that the public use in the case at bar was the use of the invention of the patentee, by persons who derived their knowledge of the invention from him through his carelessness or indifference, at least refrain from establishing the rule that a public use by a later conceiver but earlier reducer could invalidate the patent of the first and diligent conceiver. If this be the scope of the view taken by the court, and is to be accepted as the proper rule, then no public use can be a bar unless it is the use of the patentee's invention as distinguished from that of a rival, and is untainted with piracy or fraud; in other words it must be a use which the patentee "permitted." Thus we return to the verbal controversy raised by *Egbert v. Lippman* (1878), 15 Blatch. 295, and are again confronted with the proposition that public use for more than two years before the application defeats a patent, although the inventor does not know of it, nor consent to it, nor allow it, provided he "permits" it. For the further interpretation of this proposition the efforts of both jurists and philologists would seem to be required.

Although the construction of the act of 1839 may be regarded as settled, at least for a time, by these decisions of the Supreme Court, the opposite view may be here presented, as possibly throwing some light upon questions to which this literal construction of the statute is sure to lead.

Prior to the act of 1836 two great principles had become settled features of our Patent Law: First, that no fraudulent, piratical, or surreptitious

consent, nor with the doctrine of estoppel under which the

use of an invention before the application of the inventor for a patent, for however long a period continued, could in any manner affect his rights; Second, that the first conceiver of an idea of means, if diligent in reducing it to practice, was entitled to a patent notwithstanding that a later conceiver and earlier reducer had already completed the invention and given it to the public, either with or without procuring a patent for it to himself. If these principles are departed from the entire character of our law is changed, and it is inconceivable that by the act of 1839 or any subsequent enactment such a change has taken place without manifesting itself at once and unmistakably in the language of the statutes and the utterances of the courts.

The act of 1836 was evidently intended for the benefit of inventors, and was the offspring of a public sentiment in their favor which increased rather than diminished during the ensuing forty years. In less than three years afterward the act of 1839 was passed, every other provision of which was marked by the same liberal spirit toward inventors, and was manifestly designed for the furtherance of their interests. It is not probable, therefore, at the outset, that Congress, while thus enlarging other privileges of inventors, attempted to withdraw the protection which the courts had always given them against the piratical and surreptitious use of their inventions, or to place them at the mercy of rival inventors of whose achievements and actions they were wholly ignorant. But no such conclusion can properly be drawn from the language of this act. The section reads as follows:—

“*And be it further enacted, That every person or corporation who has, or shall have, purchased or constructed any*

newly invented machine, manufacture, or composition of matter, prior to the application of the inventor or discoverer for a patent, shall be held to possess the right to use, and vend to others to be used, the specific machine, manufacture, or composition of matter, so made or purchased, without liability therefor to the inventor or any other person interested in such invention; and no patent shall be held to be invalid by reason of such purchase, sale, or use prior to the application for a patent as aforesaid, except on proof of abandonment of such invention to the public; or that such purchase, sale, or prior use has been for more than two years prior to such application for a patent.”

If there is any significance to precise and carefully selected language, the meaning of this section cannot be mistaken. It has reference to a definite transaction between *the inventor* and his purchaser or licensee; and determines the effect which such transaction shall have upon their respective rights. The first clause provides that a purchase or licensed construction of the invention before the application for a patent should empower the purchaser or maker to use or sell it after the patent had been granted. The second clause declares that *such* purchase, use, or sale should not impair the right of the inventor to his patent unless coupled with acts of abandonment, or occurring more than two years before the application was made. There is no reference whatever, either express or implied, to any use of any rival invention, or to the surreptitious use of the inventor's invention. It is a clear and specific extension of the provisions of the act of 1836, conferring upon inventors the additional privilege of putting their inventions into market for two years before applying for a patent, on condition that their purchasers and

public use or sale of his invention could destroy the right of

users shall thereby acquire a perpetual implied license to use and sell the articles so made or purchased. It is true that the phrase "consent and allowance of the inventor" does not occur in the section; but the repetition of the phrase "*such* purchase, etc.," shows beyond peradventure that the purchase is the one referred to in the first clause as made from *the inventor*; and the legislative body that enacted the statute was certainly warranted in presuming that the courts which were to interpret and apply it would recognize the fact that a "*purchase, without the knowledge and consent of the vendor,*" would be impossible.

That this construction of the statute is the true one is shown by its adoption by all contemporary judges. See *McClurg v. Kingsland*, (1843), 1 How. 208, 209; 2 Robb, 105; *Pierson v. Eagle Screw Co.* (1844), 3 Story, 406, 407; 2 Robb, 268; *Hovey v. Stevens* (1846), 1 W. & M. 301; 2 Robb, 490; *Kendall v. Winsor* (1858), 21 How. 330; and MS. cases cited *in loc.* in Law's Dig. Patent Cases, pp. 604-608.

The position taken by Story, J., in *Pierson v. Eagle Screw Co.* is especially clear and forcible. After declaring that the 7th section of the act of 1839 has the meaning and effect here stated, he closes as follows: "Any other construction of these clauses would lead to this extraordinary conclusion, that the inventor would be deprived of the benefit of his invention and his right to a patent without any laches, or misconduct on his own part, by the mere acts of a wrong-doer without his knowledge or against his will; and the exceptions, in a practical sense, would become nullities. But construed as we construe them, they have a plain, appropriate, and satisfactory meaning. This view of the matter is in entire coinci-

dence with the whole theory and enactments of all the other Patent Acts, and with the judicial interpretations which have been constantly put upon them. It has been the uniform doctrine of the courts of the United States that no fraudulent or wrongful use of an invention, and no public use without the consent or knowledge or sanction of the inventor, would deprive him of his right to a patent."

That this construction is correct is evident also from the language used in section 37 of the act of 1870 and section 4899 of the Revised Statutes, in which the first clause of the act of 1839 is perpetuated, viz., "that every person who may have *purchased of the inventor, or with his knowledge and consent may have constructed*, any newly invented or discovered machine or other patentable article . . . shall have the right to use, etc." Compare this legislative interpretation with that given by the Supreme Court in *Andrews v. Hovey*, *ante*, to the words "purchased" and "constructed."

In this connection it may be suggested that the second clause of the act of 1839 might properly be restricted to the transaction described in the first clause, and applied only to cases where the purchase, use, or sale was under the implied license of the inventor; leaving all questions of unlicensed use, whether wrongful or under some rival inventor, to be determined by the general doctrines of abandonment or estoppel, without regard to any specific period of time.

The act of 1870 and the patent provisions in the Revised Statutes of 1874, are a compilation, condensation, and rearrangement of the various acts relating to letters-patent theretofore subsisting, and like all other revisions are to be interpreted, in case of doubt, by

the inventor to a patent only when accompanied by some fault or bad faith of his own.³

referring to the acts from which they were compiled. It is never presumed that such restatements of existing laws are intended to change the rules previously in operation, and unless the language adopted and sanctioned by the legislature positively requires it, no departure from the former doctrine can be permitted. See *U. S. v. Butterworth* (1884), 3 Mackay, 229; 27 O. G. 519. But in the act of 1870 and the Revised Statutes there is no express indication of any variation in the rules which govern the rights of the inventor. In both the 7th section of the act of 1839 is divided, the first clause appearing as § 37 of the act of 1870, and § 4899 of the Revised Statutes, while the second clause, shorn of part of its first member, is inserted in §§ 24 and 61 of the act of 1870, and in §§ 4886 and 4920 of the Revised Statutes. In § 4886, which reproduces § 24 of the act of 1870, it is made a condition precedent to the issue of a patent that the invention of the applicant shall not have been in public use or on sale for more than two years prior to his application. The whole structure of this section shows that the invention used or sold must be the invention of the applicant, not of some other inventor, and though no mention is made of his knowledge or consent as entering into the use or sale, there is certainly nothing to indicate any departure from the ancient doctrine that a surreptitious or piratical use or sale could in no manner prejudice his rights. The provision in § 4920 (or § 61 of 1870), is more destitute of guides to its real meaning, but its language demands no divergence from the interpretation given to it in § 4886, that it refers to the invention as the invention of the patentee, and not as the fruit of the inventive skill of

any rival inventor, and to a use or sale which was not piratical or surreptitious, and therefore must have been known to and acquiesced in by the patentee. Taking the act of 1870 and the revision of 1874 for what they truly are, an attempt to codify and clarify the Patent Laws, and not to change either their fundamental principles or their well established rules, and interpreting them by the originals which they represent, the mist which has been thrown around this subject will speedily be dissipated, and the former and just doctrine will be definitely and authoritatively declared.

³ The evils consequent upon the adoption of this rule, whether they are theoretical or practical, will probably be avoided by the future introduction of such distinctions and qualifications as at the same time preserve the just rights of the inventor and promote the public interest. Sweeping propositions are uniformly dangerous both in reasoning processes and in actual application. Experience usually provides a remedy by curtailing and discriminating until a true and just doctrine is reached, — this mode of development being peculiarly evident in the history of Patent Law. With that future in view, a classification of the cases in which this rule can properly be followed, either wholly or in part, or cannot be observed at all, may serve a useful purpose.

When a defence of public use is urged, the facts will show that the invention used was either (1) the result of the inventive act of the plaintiff's inventor, or (2) had been created by and was employed as the production of some rival inventor. These cases stand on different ground as to this entire question, and must be separately considered.

(1) If the invention used were the

§ 358. Public Use Acquiesced in if Known to the Inventor and not Prohibited.

If the consent of the inventor is essential, neither a fraudulent nor a surreptitious use of the invention raises a presump-

fruit of the patentee's inventive skill, and by its use were derived from him, this use must have been either with or without the consent of the inventor. If with his consent, or through any neglect on his part which is morally equivalent to consent, there can be no difficulty, since in this case the old and new rules are identical. But if the use were without his knowledge, he employing proper diligence to know, it was a secret fraud upon his rights, a simple piracy of his invention. No such use can justly deprive him of a patent, or invalidate it when granted, however long such use may be continued. This was the position maintained by our courts before the act of 1836 was passed, and while the law permitted no use by others before the application for a patent; nor is it supposable that any legislature or judicial body will ever take the ground that if a person can steal the knowledge of an invention and put it into public use without the cognizance of the inventor, the theft shall, after two years, redound to the public benefit and leave them in permanent possession of the results of the inventor's skill. The law may well require an inventor to apply for a patent within a prescribed period after his invention is completed, but as it has not done so, the same effect ought not to be indirectly sought by making crime and fraud the means of forcing the inventor to a premature disclosure of his secret.

(2) If the invention used had been created by, and was employed as the production of, some rival inventor, either the rival or the plaintiff's patentee was the first and true inventor. If the rival were the first inventor, no

question of public use arises, the plaintiff's patent being invalid upon other grounds. If the plaintiff's patentee were the first inventor, the public use of the invention must have occurred either before or after he had completed the reduction of his idea to practice. A public use, unknown to the inventor, and before he has perfected his invention, manifestly can have no effect upon his rights. If he were the first conceiver, and were diligent in reduction, no act of his rival could deprive him of a patent in the interest of the rival or of any other individual; and there is no principle of law or ethics which would support the claim that what the rival could not appropriate to himself he could nevertheless dedicate to the public. The fundamental theory of our law that the first conceiver, if a diligent reducer, is to receive a patent, notwithstanding any achievements or successes of a rival, should not be shaken by admitting that a public use by the rival, concealed from the first inventor, can defeat the right of the first inventor to a patent when this effect is not accomplished even by the issue of a previous patent to the rival himself. No other position, in such a case, is tenable but that an unknown public use, which occurred before the plaintiff's patentee had brought the invention to such perfection as would have made it suitable subject-matter for a patent, cannot invalidate or bar the issue of a patent.

But where a public use, though occurring before the plaintiff's patentee completes the invention, is known to him or comes to his knowledge after he has reduced his idea to practice, it may be fairly held that he must act with promptness and make his application for

tion of abandonment. Knowledge, or failure to use accessible means of knowledge which in law is knowledge, is necessary

a patent with reasonable diligence. His inventive act being finished, and his invention ready for a patent, justice to the public requires that he should not allow them to remain uninformed as to his rights after he ascertains that they are liable to be misled by such public use unless he makes his own claim known by applying for a patent. No measure of delay in such cases can be fixed by law. If knowledge exists before his invention is completed, a reasonable time should be allowed him, after completion, to make his application. If knowledge is first obtained after his reduction to practice, a reasonable time after the knowledge is acquired is proper; reasonable time, in either instance, being determined by reference to all the circumstances of the case.

If the public use occurs after the completion of the invention by the plaintiff's patentee, a different rule is justified by legal principle and wise regard for public welfare. Where the first and true inventor, having completed his inventive act, unreasonably delays his application for a patent, and pending such delay a subsequent inventor produces the invention and places it before the world by a public use or sale of more than two years' duration, whether with or without the knowledge of the first inventor, the right of the latter to protect it by a patent is forfeited, and the invention remains forever in the possession of the public. This rule rests upon the principle of equitable estoppel. As a prior inventor, unreasonably withholding his application for a patent, may be estopped to claim the invention as against a subsequent inventor who, in ignorance of the concealed invention of the former, has expended time and inventive skill

in producing the same art or instrument (see § 346, and notes), so if the subsequent inventor, instead of appropriating his invention to his own use, dedicates it to the public, who in good faith and without knowledge of the first inventor's rights apply it to the satisfaction of their wants for a period sufficient to bar the last inventor's claim to a monopoly, the first inventor may be properly regarded as estopped from insisting on his ownership of the invention as against the public, unless his circumstances warranted his long delay. There is here no question of piratical use, for the invention used is that of the subsequent not the prior inventor. There is no invasion of the recognized privileges of a diligent first inventor, for after the invention is complete and patentable, the inventor voluntarily postpones the endeavor to secure it by a patent. The case is one where both the subsequent inventor and the public are innocently misled by such conduct on the part of the first inventor as, in view of common events, he must have known was likely to have that result, and hence he may well be considered to have contemplated such result and indirectly to have abandoned his invention. A suggestion of this position is found in *Pennock v. Dialogue* (1829), 2 Peters, 1, where Story, J., discussing the early doctrine of public use, says: (22, 23) "In respect to a use by piracy, it is not clear that any such fraudulent use is within the intent of the statute; and upon general principles it might well be excluded. In respect to the case of a second invention, it is questionable at least, whether, if by such second invention a public use was already acquired, it could be deemed a case within the protection of the act. If the public were already in possession and common

to consent, and a use successfully concealed from the inventor, to whomsoever else it may be known, imposes upon him no obligation to interfere in order to protect his rights.¹ But

use of an invention, fairly and without fraud, there might be sound reason for presuming that the legislature did not intend to grant an exclusive right to any one to monopolize that which was already common. There would be no *quid pro quo* — no price for the exclusive right or monopoly conferred upon the inventor for fourteen years." This suggestion does not express the entire law on the subject, since it takes no notice of the diligent inventor's rights as against the subsequent inventor and the public. But, assuming the existence of these rights, it fairly discloses the principle that a public possession, once honestly obtained, cannot be defeated unless by a superior claimant who has not wilfully or negligently contributed to place the public in the position from which he now seeks to exclude them. See also to the same effect *Manning v. Cape Ann Isinglass & Glue Co.* (1879), 4 Bann. & A. 612; *United States Rifle & Cartridge Co. v. Whitney Arms Co.* (1877), 14 Blatch. 94; 11 O. G. 373; 2 Bann. & A. 493.

The doctrine of abandonment can be relieved of much, if not of all, of its ambiguity by preserving the radical distinction between abandonment inferred from conduct and abandonment presumed by law. The former is a question of fact, to be determined from the evidence, unaided by legal presumption. The latter is a conclusion which the law draws from specific circumstances, whenever those circumstances are proved to have existed. The difficulties now attending the doctrine seem to have been created mainly by the struggle of the courts to turn the former method of abandonment into the latter, and to raise a conclusive presumption of law from circumstances

which, though they might warrant an inference of abandonment as a matter of fact, were not those specific circumstances which authorize the court to find abandonment as a matter of law. This appears to have been the case in the decisions of Judge Blatchford in *Egbert v. Lippman* and *Andrews v. Hovey*, before cited. The delay of the inventor in applying for a patent for two years after he has completed his invention, and after his invention has gone into public use, either through his own instrumentality or that of other inventors, unless caused by some condition or event over which he had no control and hence without bad faith or laches on his part, may well constitute the basis of an inference that the inventor intended to abandon his invention, although his want of knowledge that the invention was in public use might prevent the court from applying to him the inevitable and un rebuttable presumption of the law. To restore the doctrine to its ancient harmony and intelligibility it is merely necessary to hold, —

I. That the law conclusively presumes abandonment by the inventor only when the invention has been in public use or on sale, as his invention and with his acquiescence, for more than two years before his application for a patent.

II. That abandonment in fact may be inferred from unreasonable delay in patenting the invention, or from any other circumstances which render the inventor chargeable with bad faith toward the public or voluntary negligence in the assertion of his rights.

See §§ 346, 351, and notes, *ante*.

§ 358. ¹ That surreptitious use is no evidence of abandonment, see *Kendall*

from his knowledge or his means of knowledge acquiescence is properly inferred, unless by prohibition or by application for a patent he seasonably endeavors to prevent the public from appropriating the invention;² and though strict proof both of his knowledge and his negligence is required,³ yet, these being once established, his privileges are forfeited if without his interference the term specified elapses after he becomes chargeable with knowledge of the use.⁴

§ 359. Abandonment by Sale.

The same general characteristics must exist in any sale of the invention from which abandonment is to be inferred. The sale must have been in the usual course of business,¹ and

v. Winsor (1858), 21 How. 322; *Pennock v. Dialogue* (1829), 2 Peters, 1; 1 Robb, 542; *Mellus v. Silsbee* (1825), 4 Mason, 108; 1 Robb, 506. See also § 357 and notes, *ante*.

² That acquiescence is consent, see *Kendall v. Winsor* (1858), 21 How. 322; *Mellus v. Silsbee* (1825), 4 Mason, 108; 1 Robb, 506.

That silence in view of known use is acquiescence, see *Sisson v. Gilbert* (1871), 9 Blatch. 185; 5 Fisher, 109.

³ That the presumptions are in favor of the inventor, see *Emery v. Cavanagh* (1883), 17 Fed. Rep. 242; *Graham v. McCormick* (1880), 10 Bissell, 39; 11 Fed. Rep. 859; 21 O. G. 1533; 5 Bann. & A. 244; *Jennings v. Pierce* (1878), 15 Blatch. 42; 3 Bann. & A. 361; *Pitts v. Hall* (1851), 2 Blatch. 229.

⁴ That acquiescence in two years' use defeats a patent, see *Toppan v. National Bank Note Co.* (1861), 4 Blatch. 509; 2 Fisher, 195; *Bell v. Daniels* (1858), 1 Bond, 212; 1 Fisher, 372; *Ransom v. Mayor of New York* (1856), 1 Fisher, 252; *Allen v. Blunt* (1846), 2 W. & M. 121; 2 Robb, 530.

§ 359. ¹ In *Henry v. The Frankestown Soapstone Stove Co.* (1880), 17 O. G. 569, Lowell, J.: (569) "Sales in the usual

course of business, whether absolute or conditional, if they are sales of the patented thing, work a forfeiture. A single sale has this effect as well as a hundred sales." 2 Fed. Rep. 78 (80).

In *Morgan v. Seaward* (1837), 1 Web. 187, Parke, B.: (194) "It must be admitted that if the patentee himself had, before his patent, constructed machines for sale as an article of commerce, for gain to himself, and been in the practice of selling them publicly, that is, to any one of the public who would buy, the invention would not be new at the date of the patent." 2 M. & W. 544 (559); 2 Abb. P. C. 419 (428).

In *Wood v. Zimmer* (1815), 1 Holt, N. P. C. 60, the patentee had sold the article in the public market four months before the date of the patent. Such sale was evidence of the invention having been used and exercised for the purposes of commerce, and not simply for the purpose of experiment. The patent was held invalid. See 1 Web. 44, n.; 1 Abb. P. C. 202.

In *Morgan v. Seaward* (1837), 2 M. & W. 559, one article had been made in secret and exported. It was held not to invalidate the patent. See 1 Web. 44, n.; 1 Web. 187; 2 Abb. P. C. 419.

That actual sale is not necessary, —

the invention must have been regarded by the contracting parties as a complete and operative means, ready for immediate practical employment in the arts.² When such a sale is unconditional, the art or instrument is placed beyond the control of the inventor and irrevocably dedicated to the public; and the same result follows where title is to pass at the option of the purchaser, since here the inventor has no power to resume, at pleasure, his exclusive right.³ A single sale of this kind, of a single article and to a single person, is thus consid-

to offer or expose for sale in the ordinary methods is sufficient, — see *Plimpton v. Winslow* (1883), 14 Fed. Rep. 919; 23 O. G. 1731; *Burton v. Town of Greenville* (1880), 5 Bann. & A. 541; 18 O. G. 411; 3 Fed. Rep. 642; *Hancock v. Somervell* (1851), 39 New L. J. 158.

That to offer for sale, though there is no demand for the article, is enough, see *Losh v. Hague* (1838), 1 Web. 202; 2 Abb. P. C. 501.

That to place the article on sale, if it be used, though no sales take place, is abandonment, see *Plimpton v. Winslow* (1883), 23 O. G. 1731; 14 Fed. Rep. 919.

² That the invention sold must be complete and operative, see *Henry v. Francetown Soapstone Stove Co.* (1880), 17 O. G. 569; 2 Fed. Rep. 78; *Draper v. Wattles* (1878), 16 O. G. 629; 3 Bann. & A. 618; *Am. H. & L. S. & D. Mach. Co. v. Am. T. & Mach. Co.* (1870), Holmes, 503; 4 Fisher, 284; *Winans v. N. Y. & Harlem R. R. Co.* (1855), 4 Fisher, 1.

That the sale of an experimental machine in the market for over two years is abandonment of the machine in its existing state, see *Lyman v. Maypole* (1884), 19 Fed. Rep. 735; 28 O. G. 810. See notes to this case in 19 Fed. Rep. on Abandonment, Experiments, etc.

³ In *Henry v. The Francetown Soapstone Stove Co.* (1880), 2 Fed. Rep. 78, Lowell, J. : (80) "In my opinion the evidence tends to show a sale of the in-

vention. True, some sales were conditional; that is to say, the stoves were to be returned if they were not satisfactory to the buyers; but this does not, without further explanation, prove that they were experimental. It may show that the purchaser had doubts about the article, but does not prove any on the part of the seller. . . . It is very unlikely that a buyer would take what he understood to be an experimental thing; but if he did, the evidence should be unequivocal that a test of the invention was one of the purposes of the seller. This article could be tested by the inventor as well in his own house as in any other place; and when he sold it in its completed form, though with warranty or on condition, he sold it." 17 O. G. 569 (569).

Thus that to sell "on trial," to be kept and paid for if satisfactory to the vendee, is a sufficient sale, see *Kells v. McKenzie* (1881), 20 O. G. 1663; 9 Fed. Rep. 284.

That selling "to see if it will sell," is also sufficient, see *Consolidated Fruit Jar Co. v. Wright* (1874), 6 O. G. 327; 12 Blatch. 149; 1 Bann. & A. 320.

That any sale without limitation is enough, see *Schneider v. Thill* (1880), 5 Bann. & A. 565.

That if the invention is sold embraced in another, without notice, it is abandonment, see *Egbert v. Lippman* (1881), 104 U. S. 333; 21 O. G. 75.

ered as an unmistakable indication of his intention to abandon the invention, unless, within the time required by statute, he counter-indicates it by his application for a patent.⁴ But when the title of the purchaser is by the terms of the agreement made optional with the inventor, or where from the provisions of the contract it is evident that the inventor still retains control of his invention, and can at will recall the privilege he has bestowed, there is no such presumption, but the intent of the inventor is to be discovered, as a fact, from the whole transaction, as in ordinary cases of abandonment.⁵ A sale of the invention by the inventor himself, of course, establishes his knowledge and consent. But where sales have been made by others the rule is the same, both in reason and

⁴ In *Innis v. Oil City Boiler Works* (1885), 22 Fed. Rep. 780, Acheson, J. : (780) "Doubtless a single sale by an inventor, in the ordinary course of business, of a machine embodying his completed invention, more than two years before his application for a patent, will defeat his right thereto, and may be shown in bar of a suit for infringement. And it may well be that such consequence will not be averted by the mere condition in the contract of sale that the purchaser shall have the right to return the machine and take back the price should it fail to work satisfactorily. *Henry v. Frankestown Soapstone Stove Co.*, 17 O. G. 569 ; 2 Fed. Rep. 78. But the proofs here show that the one sale relied on to support the plea was not only characterized by that condition, but was otherwise exceptional. It was made at an under price and without profit to the seller. Moreover, I am persuaded that the sale was made for the purpose of securing a fair test of the invention. . . . (781) Upon the whole evidence it is plain that the transaction was altogether experimental ; therefore the invention was not 'in public use or on sale' within the meaning of the statute. . . . It being once shown that the use was experimental, then, upon

the question of its reasonableness in point of duration, every presumption should be made in favor of the inventor." 30 O. G. 998 (998).

That a single complete sale shows abandonment, if more than two years before application, see *Henry v. Providence Tool Co.* (1878), 14 O. G. 855 ; 3 Bann. & A. 501 ; *Kelleher v. Darling* (1878), 4 Clifford, 424 ; 14 O. G. 673 ; 3 Bann. & A. 438 ; *Am. H. & L. S. & D. Mach. Co. v. Am. T. & Mach. Co.* (1870), Holmes, 503 ; 4 Fisher, 284 ; *McCormick v. Seymour* (1851), 2 Blatch. 240 ; *Honiball v. Bloomer* (1854), 2 Web. 199 ; *Losh v. Hague* (1838), 1 Web. 202 ; 2 Abb. P. C. 501.

⁵ That a sale "on trial," may be for the purpose of testing the invention itself, and if so is not abandonment, see *Graham v. McCormick* (1880), 10 Bissell, 39 ; 11 Fed. Rep. 859 ; 21 O. G. 1538 ; 5 Bann. & A. 244 ; *Graham v. Geneva L. C. Mfg. Co.* (1880), 11 Fed. Rep. 138 ; 21 O. G. 1536 ; *Draper v. Wattles* (1878), 3 Bann. & A. 618 ; 16 O. G. 629.

That a sale on trial though with warranty is not necessarily abandonment, see *Graham v. McCormick* (1880), 21 O. G. 1538 ; 10 Bissell, 39 ; 11 Fed. Rep. 859 ; 5 Bann. & A. 244.

enactment, as in the case of public use. No presumption of law arises that the rights of the inventor are abandoned by such sales, unless after they come within his knowledge he acquiesces in this appropriation of his art or instrument by the public until the time for protecting himself has expired.

§ 360. Public Use or Sale Abandons only the Exact Invention Used or Sold.

The public use or sale of an invention works an abandonment only of the exact invention used or sold.¹ Where the same art or instrument may serve as the embodiment of two distinct ideas of means, it represents two different inventions; and its use or sale as one, the other being yet unrecognized, is no abandonment of it as that other. Thus, for example, an invention patented and used as a design may also serve as the expression of a different idea when employed as a machine or manufacture; and if this idea be of later origin, and have involved the exercise of the inventive faculties, it constitutes a different invention and is entitled to protection, for however long a period the same tangible embodiment has been in public use as a design.² But when the two inventions are the

§ 360. ¹ That the invention used must be the same means now claimed to have been abandoned, see *Graham v. McCormick* (1880), 11 Fed. Rep. 859; 10 Bissell, 39; 21 O. G. 1533; 5 Bann. & A. 244; *Henry v. Francetown Soap-Stone Stove Co.* (1890), 17 O. G. 569; 2 Fed. Rep. 78; *Draper v. Wattles* (1878), 16 O. G. 629; 3 Bann. & A. 618; *Am. H. & L. S. & D. Mach. Co. v. Am. T. & Mach. Co.* (1870), Holmes, 503; 4 Fisher, 284; *Winans v. N. Y. & Harlem R. R. Co.* (1855), 4 Fisher, 1.

² That the same concrete art or instrument may express two entirely distinct ideas of means, and therefore may be two entirely distinct inventions, has been already demonstrated. That if the construction and use of the concrete invention of itself discloses to the world both of these ideas, the fact that it is claimed by its inventor as the expression

of but one does not prevent the public from obtaining full possession of both is evident; and its public use or sale for the prescribed time thus necessarily operates as an abandonment of the one not claimed and patented. But where the concrete art or instrument does not confer upon the public, of itself, both these ideas, but having been employed as the embodiment of one, is afterwards adopted as the expression of the other, which has remained hitherto undisclosed, this subsequent adoption and use is a new gift to the public, and the invention thereby reduced to practice must be entirely unaffected by any previous public use or sale of the concrete invention as the expression of the other. Applying this rule to the case supposed in the text: The same material substance, if receiving a given form, may present a new appearance to the eye and

same in their essential character, whether they are employed in the same manner or for the same general purposes, or are known by the same or different names, or purport to have been created by the same or by another inventor, the public use or sale of one with the acquiescence of the inventor whose abandonment is in question, for the period mentioned in the statutes, destroys the patentability of his entire invention.⁸

thus embody the idea of a design, and may also in that same form accomplish some mechanical purpose and thus embody the idea of a machine or manufacture. The latter idea is not necessarily disclosed by the use of the given form as a design, since its mechanical operation may not be discovered until long after it has gone into common use as an ornament; but when discovered and practically applied it has all the characteristics of a new invention, and is and ought to be patentable as such without any reference to its previous use as a design. This is the view taken in *Collender v. Griffith* (1880), 18 Blatch. 110; 18 O. G. 241. The converse does not follow the same rule, however, for if the form be first employed for mechanical purposes, it necessarily produces its effect upon the eye as an appearance as soon as it is brought into use as a device, and operates as a design as effectually and publicly as it can ever do. The only new idea now possible concerning it is that of protecting it as a design, not of using it as the expression of a design. And hence its public use or sale for two years as a device must be an abandonment of it as a design.

That the public use of an article with a design upon it is an abandonment of of the design, see *Theberath v. Rubber & Celluloid Harness Trimming Co.* (1883), 23 O. G. 1121; 15 Fed. Rep. 246; *Burton v. Town of Greenville* (1880), 5 Bann. & A. 541; 18 O. G. 411; 3 Fed. Rep. 642.

In *McKay v. Dibert* (1881), 19 O. G.

1851; 5 Fed. Rep. 587, the court expressed a doubt whether where an invention embraces a machine, a product, and a process, and the machine alone is patented, the public use and sale of the machine for two years will defeat a subsequent patent for the product or process. This doubt should be solved by an application of the same principle. If the use of the machine *ipso facto* disclosed the product and the process, and thus rendered them accessible to the public, such use and sale would be abandonment; not otherwise.

⁸ That the first inventor cannot obtain a patent when the same art or instrument has been brought into public use for over two years as the invention of a subsequent inventor, see *Loom Co. v. Higgins* (1881), 105 U. S. 580; 21 O. G. 2031; *Cleveland v. Towle* (1869), 3 Fisher, 525.

See, also, §§ 346, 357, and notes, *ante*.

That where the inventor procures a foreign patent before applying in the United States the public use of his invention for more than two years before his application here must, under the act of 1839, have been a general use as distinguished from a use of one or more machines by the inventor, see *Am. H. & L. S. & D. Mach. Co. v. Am. T. & Mach. Co.* (1870), Holmes, 503; 4 Fisher, 284.

That the issue of a prior patent does not show public use, see *Weston v. White* (1876), 13 Blatch. 364; 9 O. G. 1196; 2 Bann. & A. 321.

§ 361. **Conclusion: Five Requisites to Patentability.**

In concluding this investigation of the requisites to patentability, we may sum up the essential characteristics of a patentable invention in the following propositions:—

I. It must be an idea of means, originating in an exercise of the creative faculties of the human mind, and embodied in some instrument or operation capable of immediate practical employment in the arts.

II. The instrument or operation which results from the embodiment of this idea of means must belong to one of the six species of inventions named in the acts of Congress as entitled to protection by a patent.

III. This instrument or operation must be new to the public at the date of its invention by the patentee.

IV. This instrument or operation must be of such a character that, if communicated to the public, it will confer a practical benefit upon them.

V. This instrument or operation must remain under the control of the inventor at the date of the issue of the patent.

Having these five characteristics an invention becomes patentable. To whom such patent issues will furnish the next subject for discussion.

BOOK II.

OF INVENTORS AND PATENTEES.

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OF INVENTORS AND PATENTEES.

PRELIMINARY ANALYSIS.

§ 362. Patent Privilege Grantable only to Inventors.

THE exclusive public use of an invention can justly be secured by law to no person except its inventor. To his creative faculties alone is due the new idea of means, and to him only can rightfully belong the art or instrument in which that idea is embodied. From him the public have received, or are about to receive, all the benefits conferred upon them by the invention, and solely to him do they therefore owe the recompense which finds expression in the privilege conceded by a patent. This is a fundamental principle, not merely of natural justice, but of positive law. The common law recognized no letters-patent as valid unless the grantee were the inventor of the article or manufacture covered by the grant. The statute of James I., herein declaring and affirming the common law, forbade the issue of such letters to any one except the first and true inventor of the substance or the operation patented; and though the theory prevailing in the English courts as to the nature of the inventive act embraced the enterprise, risks, and expenditures of an importer as well as the originating activities of a creator, the principle was still intact that he who first within the realm possesses the invention and bestows it on the public is alone entitled to be temporarily protected in its ownership, and to enjoy the reward which a service freely rendered to the public properly demands.

§ 263. Patent Privilege Grantable only to Inventors: but to Inventors Irrespective of Age, Sex, or Coverture.

In the United States this principle is expressly formulated both in the Constitution and the acts of Congress. Without a change in the language of the Constitution, no patent could be conferred except upon an inventor, and for his own invention or discovery. The various statutes by which our patent system has been inaugurated and developed have uniformly followed the same rule, and confined their privileges to the true inventor or discoverer of the subject-matter described and claimed in the application for a patent; and our courts, excluding from their theory of the inventive act everything except an exercise of the creative faculties, have constantly refused to recognize in any one but the originator of the idea embodied in the art or manufacture a right either to obtain a patent or to maintain it if obtained. Indeed, so positive and specific is this rule that no agreement of private parties can be effectual against it. No concession, on the part of the real inventor, that some one else is the inventor or the first inventor, can either change the fact or confer upon the latter the right to patent the invention as his own.¹ Even the power of Congress to designate by special act some person as the true inventor, and as such to bestow exclusive privileges upon him, contrary to the fact, has been disputed, and if the question were a new one would now doubtless be emphatically denied.² Subject to this rule any person may become a pat-

§ 363. ¹ In *Hammond v. Pratt* (1879), 16 O. G. 1235, Paine, Com.: (1238) "Parties have no right, by contract, falsely to concede priority of invention. Such a concession confers upon the party in whose favor it is made no right to demand a patent as the first and original inventor, whatever rights it may or may not confer upon him as an equitable assignee. It is still the duty of the Patent Office to grant the patent to the first and original inventor or to his assignee, and not to the party who, in defiance of the facts, is conceded to be the first and original inventor."

See also *Allen v. Gilman* (1872), 2 O. G. 293.

² That a patent can be granted only to a real inventor, see *Slemmer's Appeal* (1868), 58 Pa. St. 155.

That whether an act of Congress can determine that any one is the first inventor, *quere*, see *Evans v. Eaton* (1818), 3 Wheaton, 454, 513; 1 Robb. 243.

That an interference decision in the Patent Office is not binding in the courts, even between the parties, see *Gloucester Isinglass & Glue Co. v. Brooks* (1884), 19 Fed. Rep. 426; *Union Paper Bag Mach. Co. v. Crane* (1874), Holmes,

entee. An alien stands on the same footing with a citizen, and a married woman with a *feme sole*,—the rights of her husband in the invention and the patent being cognizable only by the laws of the State in which they dwell.³ A single exception exists in the case of an employee of the Patent Office, who is not allowed to apply for or obtain a patent during the term of his employment.⁴

429 ; 6 O. G. 801 ; 1 Bann. & A. 494. See also §§ 613, 1017, 1183, and notes, *post*.

³ That an alien stands on the same footing with a citizen before the Patent Law, see *Thomas v. Reese* (1880), 17 O. G. 195 ; *Ex parte Nagel* (1880), 17 O. G. 198 ; *Lauder v. Crowell* (1879), 16 O. G. 405 ; *Shaw v. Cooper* (1833), 7 Peters, 292 ; 1 Robb, 643.

That a foreign patentee may take out an American patent at any time, unless his invention has been in public use in this country for two years, see *Henry v. Providence Tool Co.* (1878), 3 Bann. & A. 501 ; 14 O. G. 855.

That a married woman may be the grantee of a patent, the rights of her husband in the patent being regulated by local law, see *Fetter v. Newhall* (1883), 17 Fed. Rep. 841 ; 21 Blatch. 445 ; 25 O. G. 502.

That the power of a married woman over her patent rights, as to assignment, etc., depends on the local law, see *Fetter v. Newhall* (1883), 17 Fed. Rep. 841 ; 21 Blatch. 445 ; 25 O. G. 502.

That an infant or ward may be the owner of a patent, see *Fetter v. Newhall* (1883), 17 Fed. Rep. 841 ; 21 Blatch. 445 ; 25 O. G. 502.

That an invention by a slave can be patented neither by him nor by his master, see *Opinion Atty. Gen.* (1858), 9 Op. At. Gen. 171.

⁴ Rev. Stat. 1874, § 480 ; act of 1836, § 2 ; and see *Opinion of Commissioner* (1884), 26 O. G. 637.

This disqualification extends, however, only to the period of his employ-

ment. Thus in *Page v. Holmes Burglar Alarm Telegraph Co.* (1880), 17 Blatch. 484, Blatchford, J. : (507) "The second section of the act of 1836 does not declare that a person taking employment in the Patent Office shall be held to have forfeited, or dedicated to the public thereby, any invention before made by him. It simply prevents him from acquiring an interest in a patent while he remains such employee. But, as soon as his employment ceases, he is in the same position, so far as any effect of the mere fact of his having been in such employment is concerned, as if he had never been in such employment." 1 Fed. Rep. 304 (325) ; 17 O. G. 737 (742).

That a Patent Office employee cannot be an applicant and cannot file an application, see *Com. Dec.* (1884), 26 O. G. 637.

That an employee of the Patent Office may obtain patents for his inventions after he leaves the Office, see *Foote v. Frost* (1878), 14 O. G. 860 ; 3 Bann. & A. 607.

That the Commissioner of Patents, after his term expires, may have a patent for an invention made during his term of office, and the patent will date back to the invention, see *Foote v. Frost* (1878), 3 Bann. & A. 607 ; 14 O. G. 860.

That an employee of the Patent Office, after his employment ceases, may have a patent for inventions made by him before his employment commenced, see *Page v. Holmes Burglar Alarm Telegraph Co.* (1880), 1 Fed. Rep. 304 ; 17 Blatch. 484 ; 17 O. G. 737.

§ 364. Patent Privilege Grantable only when the Inventor has Generated an Idea of Means and Reduced it to Practice.

No one can be an inventor until he has performed a complete inventive act, that is, until he has conceived an idea of means and reduced it to practice in some art, machine, manufacture, composition of matter, or design. Of the nature of this act, of the mode of its performance, and of its result, we have already spoken sufficiently in the preceding pages. All that is there described as involved in the essential character of the inventive act, or as requisite to constitute a patentable invention, must be accomplished before any one can claim the privilege of its exclusive public use. And though in the reduction of his idea to practice the inventor may employ the constructive experience and ability of others, the entire idea itself must owe its origin to the exercise of his own inventive skill, and thus becomes at once the subject and the measure of the patent privilege which he receives.

§ 365. Patent Privilege Grantable to Sole Inventor on his Completion of the Inventive Act.

Where this inventive act has been performed by but a single person, no question meriting discussion is likely to arise. If it appears that the invention is complete, that it involves inventive skill, that it is new and useful, and has not been abandoned to the public, the patent is awarded, as a matter of course, to him who alone claims to have been its inventor. But where two or more persons have performed inventive acts of the same character, or have participated in the same inventive act, difficulties almost insurmountable are sometimes encountered in the endeavor to determine to which of these rival or concurrent claimants the merit and the recompense of the inventive act belong. Out of the controversies thus engendered have grown many special doctrines, which it is the province of these next succeeding chapters to consider.

§ 366. Patent Privilege Grantable to Rival, Co-operative, or Joint Inventors.

It is apparent that where two or more persons have exercised their inventive skill in reference to the same invention

they must occupy toward each other one of three relations: Either (1) they are rival inventors, — that is, each has conceived the entire idea of means independently of the others, and but for their antagonistic claims would be entitled to a patent for the whole invention; or (2) they are co-operating inventors, — that is, each has invented a subordinate feature of the complete art or instrument, which being united with the inventions of the others form the actual invention as known and practised in the arts; or (3) they are joint inventors, — that is, all acting together have developed an idea of means which is the fruit of the joint exercise of their inventive faculties, though no specific severable part thereof can be attributed to any individual of the group. In the first case, as the exclusive use of the invention cannot be secured to more than one of these independent inventors, the law is compelled to determine arbitrarily, yet with due regard to reason and justice, which it will recognize as the true inventor and as the grantee of the patent. In the second case, as each of the inventive acts by which the several subordinate features of the art or instrument have been produced are in themselves complete and distinguishable from the others, the result of each is patentable as an entire invention by the individual who has created it; while the act of union by which these different features have been brought together into one single instrument or operation is in its turn, if originating in inventive rather than constructive skill, a separate invention, whose inventors are permitted to protect it by a separate patent. In the third case, as no inventive act has been performed by either of the individuals, neither can claim and patent the invention or any part of it as exclusively his own; but as all, taken together, have conceived and perfected the invention, they have become jointly entitled to the patent. By these provisions, adapted to each class of cases, the law is able to secure to the true inventor in the first class, and to each of the inventors in the second and third classes, the entire result of his inventive acts, and thus completely to apply the principle on which the patent privilege itself is based.

§ 367. Patent Privilege Grantable to Representatives of Deceased Inventor.

The right of an inventor to protect his invention by a patent is distinct from the privilege created by the patent, although it ceases when a lawful and sufficient patent is obtained. This right is property, and on the death of the inventor becomes part of his estate, and is available to his heirs or devisees, as he may have provided. His executor or administrator is, by statute, clothed with the power to apply for and obtain the patent, in trust for those who may be beneficially interested in the invention; and these personal representatives of the inventor thenceforth occupy the same position toward the invention and the public as the inventor would have done if living.

§ 368. Patent Privilege Grantable to Assignees of Inventor.

The right of the inventor to obtain a patent is also assignable, and when assigned in proper form the assignee is substituted for the original inventor as to all the powers and privileges which accrue to him as the result of his inventive act.¹ Although the act of the inventor is still the meritorious cause for which the patent issues, the assignee is made by statute, under the assignment, the recipient of the entire recompense which the public is able to bestow. The patent may be issued directly to him, and for all future purposes of the invention he is regarded as the true inventor.

§ 368. ¹ That the right of an inventor to obtain a patent is an inchoate right which may be assigned, see *United States Stamping Co. v. Jewett* (1880), 7 Fed. Rep. 869; 18 Blatch. 469; 18 O. G. 1529; *Cammeyer v. Newton* (1876), 94 U. S. 225; 11 O. G. 287; *Hammond v. Mason & Hamlin Organ Co.* (1875), 92 U. S. 724; *Newell v. West* (1875), 13 Blatch. 114; 9 O. G. 1110; 2 Bann. &

A. 113; *Troy Iron & Nail Co. v. Corning* (1852), 14 How. 193; *Gayler v. Wilder* (1850), 10 How. 477; *Rathbone v. Orr* (1850), 5 McLean, 131; *Gay v. Cornell* (1849), 1 Blatch. 506; *Nesmith v. Calvert* (1845), 1 W. & M. 84; 2 Robb, 311.

See also §§ 408-414, 769-772, and notes, *post*.

§ 369. Classes of Inventors and Patentees.

In discussing in detail the various provisions of the law concerning inventors and patentees, we shall thus find our subject naturally falling into five divisions:—

- I. Of rival inventors;
- II. Of co-operating inventors;
- III. Of joint inventors;
- IV. Of personal representatives;
- V. Of assignees;

under each of which the doctrines of the courts and the enactments of Congress in reference thereto will now be considered.

CHAPTER I.

OF RIVAL INVENTORS.

§ 370. Patent Privilege Grantable to the Earliest of Rival Inventors.

Where two or more persons, independently of each other, have performed the same complete inventive act, each is an original inventor, and but for the others would be entitled to the patent. Two patents cannot however be granted for the same invention, because an exclusive privilege cannot subsist in distinct individuals, and also because the issue of one patent exhausts the power of the government to afford protection to the inventor. Hence the law is forced to choose between the rival original inventors, and confer the exclusive privilege upon the one who in reason seems best to deserve it. This it does by providing that the first, or earliest in time, of these original inventors shall be regarded as the only true inventor;¹ his priority of invention rendering it at least doubtful

§ 370. ¹ In *Smith v. Barter* (1875), 7 O. G. 1, Thacher, Com.: (3) "No principle is better established than that the first inventor is he who first reduces the invention to practical form by embodying it in a machine capable of useful operation, modified, it is true, by the proviso that if the first to conceive the invention is second in reduction to practice, his right to the invention shall not be destroyed if he was using due diligence in perfecting it."

In *Agawam Co. v. Jordan* (1868), 7 Wall. 583, Clifford, J.: (602) "The settled rule of law is that whoever first perfects a machine is entitled to the patent, and is the real inventor, although

others may have previously had the idea and made some experiments towards putting it in practice. He is the inventor, and is entitled to the patent, who first brought the machine to perfection and made it capable of useful operation."

That the first producer of the completed invention is the first inventor unless another had earlier conceived the idea and was diligent in reducing it to practice, or had suggested to the first producer the entire idea, see *Hall v. Johnson* (1883), 23 O. G. 2411.

That the inventor who first performs a complete inventive act, not only conceiving the idea of means, but reducing it to practice, is the one *prima facie* en-

whether the inventions of the others can be really new, while his merit, if not greater than the others in itself, is not diminished by their subsequent discoveries.

§ 371. **Earliest Applicant, under English Law, the Earliest Inventor.**

Under the English law this question of priority presented no special difficulties. The date of the patent, or that of the application, has been treated as the date of the invention, and this being a matter of public record was ascertainable by simple inspection. Under this doctrine the first patentee, or applicant for a patent, was held to be the first inventor and alone entitled to the exclusive use of the invention, — a rule entirely consistent with the theory that the chief merit of the inventor consists in giving the invention to the public.

§ 372. **Earliest Performer of Inventive Act, under American Law, the Earliest Inventor.**

In this country, on the other hand, the courts early adopted the view that the exercise of the inventive faculties is as true a ground for public recompense as the act of making known the invention to the world. While, therefore, the publication of the invention is here recognized as an essential part of the consideration for the patent, the courts unhesitatingly go behind it when necessity requires, in order to ascertain which one of several rival publishers is the first and true inventor.

titled to the patent, see *Electric R. R. Signal Co. v. Hall Railroad Signal Co.* (1881), 6 Fed. Rep. 603; *Smith v. Barter* (1875), 7 O. G. 1; *Smith v. Prior* (1873), 2 Sawyer, 461; 4 O. G. 633; 6 Fisher, 469; *Sayles v. Hapgood* (1869), 2 Bissell, 189; 3 Fisher, 632; *Agawam Co. v. Jordan* (1868), 7 Wall. 583; *Whitely v. Swayne* (1868), 7 Wall. 685; *Brodie v. Ophir Silver Mining Co.* (1867), 5 Sawyer, 608; 4 Fisher, 137; *Teese v. Phelps* (1855), 1 McAllister, 48; *Allen v. Hunter* (1855), 6 McLean, 303; *Good-year v. Day* (1852), 2 Wall. Jr. 283; *Lowell v. Lewis* (1817), 1 Mason, 182;

1 Robb, 131; *Woodcock v. Parker* (1813), 1 Gallison, 438; 1 Robb, 37.

That where one patent antedates another for the same invention the later patentee must prove that his inventive act took place before the earlier patent, and then the earlier patentee must prove that his inventive act preceded that of the later patentee, the evidence in all cases being clear and beyond reasonable doubt, see *Thayer v. Hart* (1884), 22 Blatch. 229; 20 Fed. Rep. 693; 28 O. G. 542.

See also § 375 and notes, *post*.

The date of the patent or the application still remains the *prima facie* date of the invention; but when dispute arises the date of the inventive act may be investigated, and priority awarded to him by whom this act was first performed.

§ 373. **Inventive Act a Continuous Act: Begins with Conception of Idea: Ends with Reduction to Practice.**

In this investigation the mental and the physical parts of the inventive act are both regarded. The inventive act begins with the conception of the idea of means; it ends with the embodiment of that idea in a practically operative art or instrument. It is thus in its nature a continuous act; the conception of the idea being sometimes instantaneous, sometimes gradual; the reduction to practice being in one case easy and rapid, in another slow and difficult. Hence it often happens that two independent inventors, performing the same inventive act, move at different rates of progress, owing to differences in their individual circumstances or their constructive skill. Though their conceptions of the idea are simultaneous, one may reduce to practice earlier than the other. Though one precedes the other in conception, the other may yet be the first to produce the complete practical invention. Here new questions present themselves, to be determined, like the former, by the reason and the justice of the law.

§ 374. **Earliest Reducer, if Earliest or Contemporaneous Conceiver, the Earliest Inventor.**

Where one of two rival inventors has reduced the idea to practice before the other has conceived the idea, the former is unquestionably the first and true inventor. Where their conceptions are simultaneous, and one precedes the other in reduction, his earlier completion of the inventive act makes him the first inventor and the proper patentee. Neither of these cases, therefore, requires special discussion. But where the one who first conceives the idea is anticipated in its reduction to practice by another and subsequent originator of the same idea, further discrimination becomes necessary, and an additional test of priority must be applied.

§ 375. Later Reducer, if Earliest Conceiver and Diligent in Reduction, the Earliest Inventor.

The public interest requires that every valuable invention should be perfected and made available for use at the earliest practicable moment. At the same time it is conceded that the really meritorious part of the inventive act is the conception of the idea, and therefore that the first conceiver, though the last reducer, is the actual first inventor.¹ It is the purpose of the law at once to promote the public interest and to do full justice to the first inventor; and inasmuch as the delay in his reduction must result either from his own negligence for which he ought to suffer, or from circumstances beyond his control which ought not to avail others to his injury, the rule has been established that the first conceiver of the idea of means, if diligent in reducing it to practice, is entitled to the patent, even though a subsequent conceiver should first have rendered the invention available for public use. The test of priority in all such cases is thus the diligence of the first conceiver in reducing his idea to practice. If he has been diligent he receives the patent. If he has been negligent the patent is awarded to the first reducer.² In examining the nature of this test, it will be found convenient to consider: —

I. The conception of the idea of means, its date, and evidence; and

II. Diligence in reduction to practice.

§ 375. ¹ That the conceiver, not the embodier, is the inventor, see *Yoder v. Mills* (1885), 26 Fed. Rep. 273; 34 O. G. 1048.

That the inventor who first conceives the idea and puts it into practical operation is entitled to the patent, see *Worswick Mfg. Co. v. City of Buffalo* (1884), 20 Fed. Rep. 126; 27 O. G. 1239.

² That the negligence of the first conceiver gives to the first reducer a prior

right, see *Hubel v. Dick* (1886), 28 Fed. Rep. 132; 36 O. G. 939; *Gill v. Scott* (1883), 23 C. G. 2511.

That a mere conception, not diligently put in practical form, avails nothing against a subsequent conceiver who has perfected the invention and obtained a patent, see *Pennsylvania Diamond Drill Co. v. Simpson* (1886), 29 Fed. Rep. 288.

See also § 370 and notes, *ante*.

SECTION I.

OF THE CONCEPTION OF THE INVENTION.

§ 376. "Conception" Defined.

The conception of the invention consists in the complete performance of the mental part of the inventive act. While this in theory necessarily precedes the physical part or reduction to practice, it in fact also embraces whatever of thought and skill the inventor may have exercised in bringing the invention to that point where reduction to practice can begin. By it inventive genius, so far as it relates to this particular invention, is exhausted; all that remains to be accomplished, in order to perfect the art or instrument, belongs to the department of construction, not creation. It is thus the formation, in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice.

§ 377. Conception must Generate an Idea of Means.

The idea thus conceived is, in the first place, an idea of means; an idea of the application of some force to its appropriate objects in such a manner as to accomplish a desired result.¹ Until an idea of this character is developed there is no conception of an invention. To perceive an existing want; to conceive that in some way it may be supplied; even to discover what attributes an article or operation must possess in order to relieve the want,—neither of these acts results in an idea of means by which the want may be removed. To apprehend the qualities of a given substance, to conclude either from reasoning or observation that it might be usefully applied to a given purpose, falls also short of the conception of an idea of means.² The creative process of the inventor must go far

§ 377. ¹ In *Carver v. Hyde* (1842), 16 Peters, 513, Taney, C. J. : (519) "Now the end to be accomplished is not the subject of a patent. The invention

consists in the new and useful means of obtaining it."

See also §§ 87-90 and notes, *ante*.

² That the mere conception that a

beyond these achievements. It must not only discern the want, the possibility of its supply, and the attributes with which the article or operation that supplies it must be endowed, but it must produce the art or instrument itself ready for application to the removal of the want.³ It must bring into actual contact with its object the force now latent in the given substance, and thus fulfil the purpose whose possibility the inventor as yet only perceives. When the idea has reached this point it is the idea of an invention; before this it is merely an empty speculation, or a fact in nature open to the perception of all mankind.

§ 378. **Conception must Generate an Idea of Practically Operative Means.**

This idea must, in the second place, include every essential attribute of the complete and practical invention. If anything remains to be created or devised in order to enable the instrument or art to perform its functions in the manner proposed by the inventor, his conception of the invention is not finished, nor has he brought into existence any true idea of means. Where the shape, size, material, or location of its various parts, or the nature or arrangement of its component operations, are necessary to its practical accomplishment of the purposes for which it is designed, each of these must be fully developed in, and apprehended by, the mind of the inventor, in a condition adapted to immediate embodiment in the concrete art or instrument. But matters of mere form, as distinguished from matters of substance, constitute no part of this idea. If the performance of its functions by the concrete invention is not dependent on the shape, the size, the

certain substance might be useful in a certain process, but not followed by acts or words expressing the conception, cannot be regarded as the conception of an invention, see *Slade v. Blair* (1880), 17 O. G. 261.

That the conception that something might be done is not the conception of an invention, see *Wicks v. Dubois* (1877), 11 O. G. 244; *Gordon v. Withington* (1876), 9 O. G. 1009.

³ That to discern a want, and to experiment, or cause others to experiment, after means to supply it, but without discovering such means, is not a conception of the invention, see *Bell v. Brooks* (1881), 19 O. G. 290; *Union Paper Collar Co. v. Van Deusen* (1872), 10 Blatch. 109; 2 O. G. 361; 5 Fisher, 597.

See also § 88 and notes, *ante*.

capacity, the proportions, or materials of which it is composed, or on the location or arrangement of its elements, the thought of the inventor may or may not have occupied itself with these. The conception is complete without them; and whatever attention they may have received belongs to the physical and not the mental part of the inventive act.¹

§ 379. Conception must Generate an Idea of Practically Operative Means Ready for Communication to the Public.

This idea must, in the third place, be so definitely and clearly present in the mind of the inventor that he is able to communicate it to the public. A vague and general notion, incapable of exact expression either in acts or words, although it may contain all the essential attributes of an invention, is not such a conception of the invention as confers a benefit upon the world, or adds to the stock even of the inventor's knowledge. It may have originated in his creative faculties, and be in process of development toward a complete conception, but until it has become an object of his contemplation and is understood by him as a separate entity, or a plan of operation capable of being practically carried out, or an image or design able to be reproduced in tangible materials, it cannot be regarded as a mental possession which the inventor can bestow upon mankind.¹ It is not while the cre-

§ 378. ¹ See §§ 78-80, 229-244, 318, and notes, *ante*.

§ 379. ¹ In *Stevens v. Putnam* (1880), 18 O. G. 520, Marble, Com.: (521) "I concur in the statement . . . that the conception of an invention is that 'state or stage of the invention when it is complete in the inventor's mind, but has not yet been reduced to practice or embodied in material form,' as I also do . . . that a mere conception that a desired result can be accomplished is not such a conception as can give date to an invention. The earliest date at which an invention can be said to exist is that time when there was in the mind of the inventor a well-defined idea of something which might rightfully constitute

the subject of a patent. The law is well settled that a mere unembodied principle or discovery is not a subject of a patent, and it must logically follow that the mere mental apprehension of the same is not the conception of an invention. When, however, the principle or discovery is rendered of practical service by its embodiment in material form, there exists something for which a patent can be allowed; and the union in the mind of the inventor of this principle or discovery with the means of its embodiment is conception of the invention. Commissioner Leggett, in the case of *Cameron & Everett v. J. R. Brick* (C. D. 1871, 89), in discussing this subject, used the following language: "The point

ative energies are at work shaping and sharpening the idea of means that the conception of the invention becomes perfect. It is when these energies have ceased to act, when the idea stands before the mental vision of the inventor as clearly as the concrete invention before the eyes of an observer, that the conception is complete and the work of reduction is ready to begin.

§ 380. **Date of Conception is Date of Complete Conception.**

The date of the conception of an invention is the date when this idea of means, including all the essential attributes of the invention, becomes so clearly defined in the mind of the inventor as to be capable of exterior expression. The evidence by which this date is determined, in case of controversy, must be of such a nature as to demonstrate that the conception was complete. Obviously, the mere assertion of the inventor that at a given time this idea was fully present

of time at which invention, in such sense as to merit the protection of law, dates is neither when the first thought of it is conceived nor when the practical working machine is completed, but it is when the thought or conception is practically complete; when it has assumed such shape in the mind that it can be described and illustrated; when the inventor is ready to instruct the mechanic in relation to putting it in working form; when the "embryo" has taken some definite form in the mind and seeks deliverance; and when this is evidenced by such description or illustration as to demonstrate its completeness. It may still need much patience and mechanical skill, and perhaps a long series of experiments, to give the conception birth in a useful working form. The true date of invention is at the point where the work of the inventor ceases and the work of the mechanic begins. Up to that point he was *inventing* but had not *invented*, and he must have *invented* before the law will come to his protection."

That experiment is not conception, but

conception must be matured into readiness for reduction, see *Voelker v. Gray* (1885), 30 O. G. 1091; *Washburn v. Gould* (1844), 3 Story, 122; 2 Robb, 206.

That the conception of an invention does not exist until the idea of means is complete and settled in the mind of the observer and nothing remains to be done but to give it practical embodiment, see *Boyd v. Cherry* (1888), 4 McCrary, 70; *Bell v. Brooks* (1881), 19 O. G. 290; *Pelton v. Waters* (1874), 7 O. G. 425; 1 Bann. & A. 599; *Andrews v. Carman* (1876), 9 O. G. 1011; 13 Blatch. 307; 2 Bann. & A. 277; *Ransom v. Mayor of New York* (1856), 1 Fisher, 252.

That where two persons claim the same invention, each denying it to be joint, and no positive evidence exists in favor of either, the fact that one seems to have understood it better than the other may be taken as proof that he is the real inventor, see *Barker v. Woodruff* (1872), 1 O. G. 253.

See also §§ 79, 80, and notes, *ante*.

to his mental vision, unaccompanied by contemporaneous acts or words indicating its existence, is not such evidence; for though his good faith be unquestioned, it is still doubtful whether his apprehension of the invention was definite enough to have enabled him to reduce it to practice without a further exercise of inventive skill.¹ But any full and accurate description of it either in words or drawings is sufficient, as also is a model if it be an instrument, or even an unsuccessful effort to embody it when the endeavor discloses that the idea was complete although the attempt to represent it may have failed.² In the absence of all other proof, the date of the ap-

§ 380. ¹ In *Farmer v. Brush* (1880), 17 O. G. 150, Paine, Com. : (150) "A conception which is a mere mental abstraction, not connected with acts or words, is not a conception in the sense of the law."

² In *Reeves v. Keystone Bridge Co.* (1872), 5 Fisher, 456, McKennan, J. : (462) "A patentee . . . may show, by sketches and drawings, the date of his inceptive invention, and if he has exercised reasonable diligence in perfecting and adapting it, and in applying for his patent, its protection will be carried back to such date; and in a race of diligence between rival inventors, the one who first perfects an invention, and embodies it in a distinct form, is entitled to priority; but can this be accorded to one who has conceived the idea of an invention, and has sketched it on paper, but has done nothing more in reference to it for a period of five years, as against the patent of an independent though subsequent inventor? . . . (463) It must, therefore, be considered as an established rule that illustrative drawings of conceived ideas do not constitute an invention, and that unless they are followed up by a seasonable observance of the requirements of the patent laws, they can have no effect upon a subsequently granted patent to another." 1 O. G. 466 (468); 9 Phila. 368 (370).

In *Philadelphia & Trenton R. R. Co. v. Stimpson* (1840), 14 Peters, 448, Story, J. : (462) "In many cases of inventions, it is hardly possible in any other manner to ascertain the precise time and exact origin of the particular invention. The invention itself is an intellectual process or operation, and, like all other expressions of thought, can in many cases scarcely be made known, except by speech. The invention may be consummated and perfect, and may be susceptible of complete description in words, a month or even a year before it can be embodied in any visible form, machine, or composition of matter. . . . In short, such conversations and declarations, coupled with a description of the nature and objects of the invention, are to be deemed a part of the *res gestæ*, and legitimate evidence that the invention was then known to and claimed by him; and thus its origin may be fixed at least as early as that period." 2 Robb, 46 (69).

That the complete conception of the idea of an invention may be shown by drawings, see *Loom Co. v. Higgins* (1881), 105 U. S. 580; 21 O. G. 2031; *Kneeland v. Sheriff* (1880), 2 Fed. Rep. 901; 18 O. G. 242; 5 Bann. & A. 482; *Smith v. Edson* (1875), 7 O. G. 827; *Brookfield v. Brooke* (1873), 4 O. G. 81; *Reeves v. Key-*

plication for a patent, if containing such description, is taken as the date of the conception.⁹

§ 381. Conception may be Prior to or Contemporaneous with Reduction.

In many inventions the act of conception is clearly distinct, in point of time, from that of reduction; and in these cases the rules given above are easily applied. In many others the work of conception and reduction goes forward almost simultaneously, so nearly so that no date can be fixed as that before which the conception was complete and after which the reduction to practice was begun. This is true in nearly all inventions which are the result of experiment,—where the inventor, instead of evolving the entire art or instrument out of his own thought, conjectures that such an act or substance will subserve a given purpose, and having tried it, finds that it accomplishes the end. The production of a new means by this method is, equally with the former, an inventive act, but

stone Bridge Co. (1872), 5 Fisher, 456; 1 O. G. 466; 9 Phila. 368.

That verbal declarations and descriptions may show the conception of the invention to have been perfect, see *Sayles v. Hapgood* (1869), 2 Bissell, 189; 3 Fisher, 632.

That a model may show the conception to have been complete, see *Loom Co. v. Higgins* (1881), 105 U. S. 580; 21 O. G. 2031.

That an unsuccessful attempt to reduce to practice may show the idea to be complete, see *Warner v. Anders* (1877), 11 O. G. 109.

That where it is doubtful who first conceived the invention, and neither has reduced it to practice, one who made a working model, demonstrating its practicability, is preferred to the other, who before that had made a sketch of the invention, see *Clark v. Osborn* (1874), 5 O. G. 667.

That neglect to apply for a patent, want of scientific knowledge, failure to put into use, etc., indicate that the

conception was incomplete, see *The Telephone Cases* (1887), 126 U. S. 1; 43 O. G. 377; *American Bell Telephone Co. v. People's Telephone Co.* (1884), 22 Blatch. 531; 22 Fed. Rep. 309; 29 O. G. 1029.

That failure to give an invention to the public when advantage from it could be derived in no other way is evidence that the conception is incomplete, see *Voelker v. Gray* (1885), 30 O. G. 1091.

⁹ That the date of an application for a patent is, in the absence of other proof, evidence of the date of the conception, see *Dane v. Chicago Mfg. Co.* (1872), 2 O. G. 677; 3 Bissell, 380; 6 Fisher, 130. See also § 132 and notes, *ante*, and § 1024 and notes, *post*.

That where two persons are trying to invent, and it is doubtful which first succeeds, the one who first obtains a patent is regarded as first inventor, see *Cox v. Griggs* (1861), 1 Bissell, 362; 2 Fisher, 174.

at no instant before the experiment succeeds can it be said that the conception of the invention exists in the inventor's mind. Until that instant it is mere speculation, at most a probable deduction from facts already known ; and the same act which reduces it to practice gives to the conception its definite and final form. Hence the date of the conception in such cases is the date, not when experiments begin, but when they end ; and the first to bring the art or instrument into successful operation is the first conceiver of the entire invention.¹

§ 382. Conception of Foreign Invention is Contemporaneous with Knowledge or Application in the United States.

The foregoing doctrines relate only to inventions whose original conception has occurred in the United States. Under our law no notice is or can be taken of any inventive act performed abroad until its result is published either in a patent or a printed book. At whatever date, therefore, an unpatented or unpublished foreign invention may have been in fact conceived by its inventor, its conception in the United States takes place only when it becomes an object of intellectual apprehension within the limits of this country.¹ Thus if the inventor, having

§ 381. ¹ In *Union Paper Bag Mach. Co. v. Pultz & Walkley Co.* (1878), 15 Blatch. 160, Shipman, J. : (166) "The patentee has the right to take up the improvement at the point where it was left by his predecessor, and if, by the exercise of his own inventive skill, he is successful in first perfecting and reducing to practice the invention which his predecessor undertook to make, he is entitled to the merit of such improvement, as an original inventor." 15 O. G. 423 (425) ; 3 Bann. & A. 403 (408).

That where an invention is reached by a series of experiments, the one who first succeeds, not the one who first begins, is the first inventor, see *Taylor v. Archer* (1871), 8 Blatch. 315 ; 4 Fisher, 449 ; *Hoffman v. Aronson* (1871), 8 Blatch. 324 ; 4 Fisher, 456 ; *National Filtering Oil Co. v. Arctic Oil Co.* (1871), 8 Blatch. 416 ; 4 Fisher, 514.

§ 382. ¹ In *Thomas v. Reese* (1880), 17 O. G. 195, Paine, Com. : (196) "The law makes no distinction between citizens and foreigners as applicants in the Patent Office. . . . But . . . the law does make a wide distinction between an invention made in the United States and an invention made in a foreign country, by whomsoever made. An invention made in the United States by a foreigner stands on the same footing in the Patent Office of the United States as an invention made in the United States by a citizen. An invention made in a foreign country by a citizen of the United States stands on the same footing in the Patent Office as an invention made in a foreign country by a foreigner. The distinction recognized by the law between an invention made in a foreign country and one made in the United States is this : The single fact that the

completed the mental part of his inventive act abroad, comes into the United States, not having already given his inven-

vention was previously made in the United States, whether by a citizen or a foreigner, is a bar to the grant to any subsequent inventor, whether such subsequent inventor is a citizen or a foreigner, and whether he made the invention in the United States or in a foreign country; but the single fact that the invention was previously made in a foreign country, whether by a citizen of the United States or by a foreigner, is no bar to the grant of a patent to a subsequent inventor, whether such subsequent inventor is a citizen or a foreigner, and whether he made the invention in a foreign country or in the United States. It is provided in section 4886 of the Revised Statutes that a prior foreign patent shall be a bar to the grant of a patent in the United States for the same invention. This is a broad and general provision, and might be fatal to an application by the foreign patentee for an American patent of his own invention. But the next section obviates this difficulty by the provision that a foreign patent shall not, of itself, bar the grant of an American patent to the inventor who is a foreign patentee. This presents the question whether the effect of the two sections is to enable the foreign patentee, in an interference, to carry the date of his invention back of the date of his American application to that of his foreign patent, and to relieve him from the necessity of proving a reduction to practice in the United States or elsewhere, or whether, on the other hand, its effect is merely to relieve him from the statutory bar to the grant, without exempting him from the necessity of proving the importation of a *completed invention* into the United States prior to the filing of his application, in order to carry the date of his invention back of the date of filing such application. These are, I think, still open questions in the Patent Office. . . .

(198) If an inventor, having conceived his invention in a foreign country, comes to the United States to complete it, and with due diligence reduces it to practice in the United States, he may, in an interference, carry back the date of his invention to the day of his arrival in the United States. If, having conceived it and reduced it to practice abroad, he comes to the United States for the purpose of introducing it to public use, or of obtaining a patent in the United States, he may, in an interference, fix the date of his completed invention on the day of his arrival in the United States. If, having conceived it and reduced it to practice abroad, he communicates it to an agent in a foreign country and sends his agent to the United States to obtain letters-patent or to introduce it to public use, he may, in an interference, fix the date of his invention on the day of his agent's arrival in the United States. If, having conceived it and reduced it to practice in a foreign country, he communicates it to an agent in the United States for the purpose of obtaining letters-patent or of introducing it to public use in the United States, he may, in an interference, carry the date of his invention back to the day in which it was fully disclosed to such agent in the United States."

In *Lauder v. Crowell* (1879), 16 O. G. 405, Paine, Com.: (406) "When an application for letters-patent for an invention made in the United States and an application for letters-patent for an unpatented invention made in a foreign country confront each other in the Patent Office, the American invention, if earlier in date, is a bar to the grant of a patent for the foreign invention; but the foreign invention, although first in date, is not a bar to the grant of a patent for the American invention. When two applications for patents for foreign in-

tion to the world, the date of his arrival on our shores is the date recognized by our law as the date of his conception; or if he entrusts his secret to an agent, whom he sends into this country upon business connected with the invention, the conception dates from the moment when the agent comes within our boundaries. Hence when a question of priority arises between inventions, one of which was conceived in the United States, while the other had its origin in a foreign country, the rules by which the date of each is ascertained are very different. In the American invention the date of the conception is carried back to the instant when the inventor can be shown to have first clearly apprehended his idea of means; in the foreign invention, only to the moment when some person to whom the conception was familiar came within the area of the United States. Where both inventive acts have been performed abroad and neither has been patented, the date of the first application in the United States is held to fix the date of first conception; while if one has been patented, the other not, the former has priority; and if both have been patented the date of the first patent is the date of first conception. In all these cases, however, the definition and requisites of the conception remain the same. It is the completion of the mental part of the inventive act, — the entire development of an idea of means, embracing every essential characteristic of the concrete invention, and capable of being at once expressed in some patentable art or instrument.

ventions, not patented abroad, confront each other in the Patent Office, neither of them is an obstacle to the grant of a patent for the other. . . . The applicant first in point of time in this office is entitled to the patent if he is an original inventor, and if, when he made his application, he believed himself to be the first inventor. When two applicants for patents for the same foreign invention, of whom only one is a foreign patentee, are before the Patent Office of the United States, the foreign patent of one of the applicants is a bar to the issue of an American patent to the other, even though he is in fact the prior inventor. When both of two applicants for Ameri-

can patents for foreign inventions are foreign patentees, the applicant whose invention was first patented abroad, if he is an actual inventor, and, when he filed his application, believed himself to be the first inventor, will be entitled to the American patent."

That the date of a foreign invention cannot be earlier than the knowledge of the invention, by samples or otherwise, in the United States, see *Hovey v. Hufeland* (1872), 2 O. G. 493.

That the date of a foreign patented invention is the date of the patent as against an invention made in the United States, see *Chambers v. Duncan* (1876), 10 O. G. 787.

SECTION II.

OF DILIGENCE IN REDUCING TO PRACTICE.

§ 383. Diligence in Reduction Important only when Later Conceiver is Earliest Reducer.

The person who first conceives the invention, in the manner described in the foregoing section, if diligent in reducing it to practice, is entitled to the patent in preference to any subsequent conceiver, although the latter may have been the first to render the invention available for public use.¹ This ques-

§ 383. ¹ In *White v. Allen* (1863), 2 Clifford, 224, Clifford, J. : (230) "Whoever first perfects a machine and makes it capable of useful operation, says Judge Story, is entitled to a patent, and he accordingly held, in *Reed v. Cutter*, 1 Story, 599, that an imperfect and incomplete invention, resting in mere theory, or in intellectual notion, or in uncertain experiments, and not actually reduced to practice and embodied in some distinct machinery, apparatus, manufacture, or composition of matter, was not patentable under the patent laws of the United States. Pursuant to that rule, the same learned judge also held that he is the first inventor, in the sense of the Patent Act, and entitled to a patent for his invention, who has first perfected and adapted the same to use, and that until the invention is so perfected and adapted to use, it is not patentable under the patent laws. *Washburn v. Gould*, 3 Story, 122; *Woodcock v. Parker et al.*, 1 Gall. 438. Taken as a general rule, no doubt is entertained of the correctness of the proposition as stated, but it must be regarded as subject to the qualification that he who invents first shall have the prior right if, as is prescribed in the fifteenth section of the

Patent Act, he is using reasonable diligence in adapting and perfecting the same within the meaning of that provision. . . . (238) Cases undoubtedly occur . . . where an individual employed in inventing, or in making experiments in that behalf, feeling dissatisfied with the result of his efforts, becomes discouraged in prosecuting the investigation, and finally loses all confidence in the prospect of his ultimate success, and under the influence of such discouragements or from a desire to engage in more profitable business, or to pursue a more pressing or favorite undertaking, decides to break up what he has accomplished, and lays the parts aside, not positively intending to abandon the subject, yet wholly uncertain whether he will ever resume it or make any further use of the parts so laid aside. Such cases are doubtless of frequent occurrence, and while they do not show an unconditional abandonment of the undertaking, they do show an indefinite suspension of the same, and an entire uncertainty, during such suspension, whether the interested party will ever furnish the invention to the public. Where an invention is thus voluntarily broken up and laid aside, without any controlling impediment in

tion of diligence in reduction to practice is never raised except in cases where a later inventor has anticipated the earlier

the way of an application for a patent, and under all the other conditions specified in the preceding proposition, and another, in the meantime, invents the same thing, without any knowledge of that which is so suspended, and reduces the same to practice, applies for and takes out his patent, and introduces the patented invention into public use, I am of the opinion that he must be regarded as the original and first inventor of the improvement." 2 Fisher, 440 (446, 453).

In *Reed v. Cutter* (1841), 1 Story, 590, Story, J. : (596) "Under our patent laws no person who is not at once the first, as well as the original, inventor by whom the invention has been perfected and put into actual use, is entitled to a patent. A subsequent inventor, although an original inventor, is not entitled to any patent. If the invention is perfected, and put into actual use by the first and original inventor, it is of no consequence whether the invention is extensively known or used, or whether the knowledge or use thereof is limited to a few persons, or even to the first inventor himself. It is sufficient that he is the first inventor, to entitle him to a patent; and no subsequent inventor has a right to deprive him of the right to use his own prior invention. . . . (599) In a race of diligence between two independent inventors, he who first reduces his invention to a fixed, positive, and practical form, would seem to be entitled to a priority of right to a patent therefor. The clause of the fifteenth section [act of 1836], now under consideration, seems to qualify that right by providing that in such cases he who invents first shall have the prior right, if he is using reasonable diligence in adapting and perfecting the same, although the sec-

ond inventor has, in fact, first perfected the same and reduced the same to practice in a positive form. It thus gives full effect to the well-known maxim, that he has the better right who is prior in point of time, namely, in making the discovery or invention." 2 Robb, 81 (87).

That as against a subsequent conceiver who has first reduced the invention to practice, the first conceiver is entitled to a patent provided he can connect his priority of conception with his own reduction to practice by showing reasonable diligence in his efforts so to reduce the invention to practice, see *Electric R. R. Signal Co. v. Hall R. R. Signal Co.* (1881), 6 Fed. Rep. 603; *Kneeland v. Sheriff* (1880), 2 Fed. Rep. 901; 18 O. G. 242; 5 Bann. & A. 482; *Gardner v. Dudley* (1880), 17 O. G. 801; *Dickson v. Kinsman* (1880), 18 O. G. 1225; *McKenna v. Redden* (1879), 16 O. G. 458; *Ackerman v. Archer* (1879), 15 O. G. 562; *Burgess v. Wetmore* (1879), 16 O. G. 765; *Sprague v. Adriance* (1877), 14 O. G. 308; 3 Bann. & A. 124; *Towers v. Pease* (1877), 13 O. G. 176; *Warner v. Anders* (1877), 11 O. G. 109; *Gross v. Sargent* (1877), 11 O. G. 797; *Lay v. Wiard* (1876), 9 O. G. 349; *Freeborn v. Foye* (1876), 9 O. G. 884; *Palm v. Behel* (1876), 10 O. G. 701; *Crane v. Whitehead* (1875), 7 O. G. 219; *Baldwin v. Bigelow* (1875), 7 O. G. 1011; *Hammond v. Laird* (1874), 7 O. G. 170; *Smith v. Barter* (1874), 7 O. G. 1; *Rees v. Richards* (1874), 7 O. G. 37; *Bradford v. Corbin* (1874), 6 O. G. 223; *Ex parte Carr* (1874), 5 O. G. 30; *In re Edson* (1873), 4 O. G. 500; *Hyatt v. French* (1873), 4 O. G. 609; *Smith v. O'Connor* (1873), 4 O. G. 633; 2 Sawyer, 461; 6 Fisher, 469; *Rice v. Winchester* (1873), 3 O. G. 348; *American*

in the embodiment of the idea of means. A sole inventor may occupy what time he pleases in expressing his conception in tangible materials; still, as from him alone the public must receive the benefit of the invention, to him alone belongs the recompense of the inventor, whatever delays may have occurred in its disclosure. For the same reason, if the first conceiver is also the first reducer, it is from him that the complete invention first proceeds, however slowly it has been developed in his hands; and no subsequent conceiver and reducer of the same invention can claim to have conferred upon the public any new instrument or operation. Thus it is only when the second in conception has preceded an earlier conceiver in the embodiment of the idea and its adaptation to practical use that the diligence of the first conceiver becomes a matter of importance, and by it then his right to a patent for the invention must stand or fall.²

§ 384. Diligence in Reduction Required only of Earliest Conceiver, and of him only when he is the Later Reducer: No "Race of Diligence."

This obligation of diligence has no relation to the subsequent conceiver. From some expressions found in the decisions it might be inferred that upon the second conception a race of diligence began between the two inventors, and that the patent ought to be awarded to the one by whom superior diligence was exercised. But this view would be incorrect.¹

Nicholson Pavement Co. v. Elizabeth (1873), 3 O. G. 522; 6 *Fisher*, 424; *Pattee v. Russell* (1873), 3 O. G. 181; *Vinton v. Pierce* (1873), 3 O. G. 629; *Frevort v. Gahr* (1873), 3 O. G. 660; *Allen v. Gilman* (1872), 2 O. G. 293; *Chapman v. Candee* (1872), 2 O. G. 245; *Kirby v. Johnston* (1872), 1 O. G. 405; *Wheeler v. Russell* (1872), 1 O. G. 183; *Morse v. Clark* (1872), 1 O. G. 275; *Munger v. Connell* (1872), 1 O. G. 491; *Reeves v. Keystone Bridge Co.* (1872), 5 *Fisher*, 456; 1 O. G. 466; 9 *Phila.* 368; *Cox v. Griggs* (1861), 1 *Bissell*, 362; 2 *Fisher*, 174; *Ellithorpe v. Robertson* (1859), 2 *Fisher*, 83; 4 *Blatch.* 307;

Phelps v. Brown (1859), 4 *Blatch.* 362; 1 *Fisher*, 479; *Ransom v. Mayor of New York* (1856), 1 *Fisher*, 252; *Allen v. Blunt* (1846), 2 *W. & M.* 121; 2 *Robb*, 530.

² That no question arises as to the diligence of an inventor in reducing his invention to practice unless some subsequent inventor has reduced the invention to practice in advance of the prior inventor, see *Bering v. Haworth* (1878), 14 O. G. 117; *Allen v. Gilman* (1872), 2 O. G. 293.

§ 384. ¹ In *Millward v. Barnes* (1877), 11 O. G. 1060, *Spear, Com.*: (1061) "Respecting the matter of dili-

No matter what degree of diligence he may have manifested, the second conceiver has not even a *prima facie* right to the patent, unless he was the first to reduce to practice; and if he has anticipated the other in reduction it is on this ground, and this only, that his claims are based. The law regards him with no such indulgence as it does the first conceiver. It takes no notice of the difficulties with which he has contended, nor of the efforts which he may have made to confer the benefit of his invention on the public. The fact that he has so conferred it is sufficient in the absence of any prior conception or of reasonable diligence on the part of a prior conceiver; but even this fact avails him nothing if the first conceiver has properly endeavored to complete his own inventive act, and has thus fulfilled the obligation which the law imposes on him. Hence there can be no comparison of diligence as between rival inventors; no "race of diligence" in any sense of a competing effort to attain a prize. While it is true that as soon as the second inventor has developed the idea of means in his own mind it becomes a question of importance whether he will complete its practical embodiment before the first inventor; and while it is also true that the priority of either will depend largely on the respective diligence

gence, as bearing upon the question of priority, I do not regard it as comparative, or, as it is sometimes termed, a 'race of diligence,' where one was first to conceive and the other to reduce to practice. If the second to conceive is the first to reduce to practice, his claim is founded upon that fact, and derives no support whatever from previous efforts; and whether he has been more or less diligent from the time of the conception of his invention to its maturity, he stands in exactly the same position. The fact that, being an original inventor, he did actually first reduce the invention to practice is all that we are to look for, or that he can base his claim to priority upon. Not so, however, with the one first to conceive. He must show affirmatively that he was reasonably diligent

from the time of his conception of the invention until its completion. His diligence is not to be compared with that of his competitor, but must stand as an independent fact. It is for him to show that, under the circumstances, he used reasonable diligence, in order that he may connect the two events, conception and completion, and so establish a superior title to the invention. Diligence is thus made one of the elements necessary to his title as prior inventor, and without it his title would be defective and could not prevail as against one claiming under the title of the first to reduce to practice."

See also *Electric R. R. Signal Co. v. Hall R. R. Signal Co.* (1881), 6 Fed. Rep. 603; *Brookfield v. Brooke* (1873), 4 O. G. 81.

of each ; yet the superior diligence of the second, if it be such, adds nothing to his merit where he first succeeds in the reduction, nor does it aid him where his tangible embodiment has been anticipated by the first inventor, nor does it qualify in any manner the consideration given by the law to the diligence of the first inventor where the second has first accomplished the reduction. Diligence is predicable only of the first conceiver. It is required of him and of him only ; it avails him and him only ; and no delay or expedition, on the part of the later conceiver, furnishes any standard by which the diligence of the former can be estimated, unless so far as it may throw light on the nature of the invention and indicate the actual difficulties with which the first conceiver has been forced to contend.

§ 385. Whether Diligence in Reduction is Required of Earliest Conceiver before Later Conception by Earliest Reducer.

From this erroneous tendency to compare the diligence of rival inventors has arisen another question, upon which no final conclusion seems to have yet been reached, namely, whether the diligence required of the first conceiver covers the whole period between his conception and reduction, or commences only at the date of the conception by the second inventor. Thus, as a race assumes the existence of at least two contestants, it has been stated that the race of diligence does not begin until the date of the second conception, and from this it has been concluded that the obligation to diligence does not exist, on the part of the first conceiver, until the date of the later conception.¹ But, upon principle, this is evidently wrong. The two grounds upon which the right of an inventor to a patent rests are the benefit conferred upon the public by the use of his concrete invention, and the stimulus given to inventive genius by rewarding him who first

§ 385. ¹ In *Packard v. Sandford* (1879), 16 O. G. 1182, Paine, Com. : (1185) "A race of diligence between two inventors never begins until the date of the later conception. The obligation to diligence on the part of the first to conceive does not exist until the

day of the later conception, which cannot give to that obligation a constructive existence relating back to the earlier conception."

To the same effect, see *Farmer v. Brush* (1880), 17 O. G. 150 ; *Lake v. Kempster* (1879), 16 O. G. 1187.

originates a new and valuable idea of means. The first of these grounds is the most important, and in a certain way the second is included in it. When two inventors stand ready to confer the same benefit for the same consideration, and the law, being obliged to choose between them, decides the controversy upon the personal consideration involved in the second ground, and awards the patent to the first conceiver, it can only do so on the theory that justice as well as the public interest require that the first conceiver be rewarded in preference to him who first is ready to bestow the invention on the public. But neither public interest nor justice are promoted by dispensing honors or rewards to an inventor who, having conceived the idea of means, makes no effort to render it practically available until its later conception by another inventor renders him liable to lose his prize. Here is no stimulus to diligence except the fear that without his knowledge some other inventor may enter the same field and attain the same result. Apart from this fear, the rule now controverted offers a recompense for negligence, and tends not only to encourage laxity upon the part of the first conceiver but to deter inventors by the doubt whether their own exertions may not prove profitless upon the discovery that a prior conception, unembodied and which at present no one is endeavoring to embody, may by and by appear and rob them of the fruits of their inventive skill. Justice requires that the public should reward those only who keep faith with it; who apply their creative energies to the promotion of the public good; and who, having generated ideas, reduce them as speedily as possible to practical and beneficial public use. The public interest demands that the first publisher of an invention should receive the recompense of its exclusive use, unless some more meritorious inventor has been hindered by circumstances beyond his control from conferring the invention on the public; and while the law has no occasion to inquire into the diligence of the first publisher, because priority of publication is itself a sufficient ground of merit, yet where this ground is disputed on behalf of a prior conceiver, who has not yet bestowed the invention on the public, the claim of the latter can only be acknowledged when it appears that to the merit of a first con-

ception he has added that of diligent endeavor to complete the inventive act and give his concrete art or instrument to the service of his fellow-men.

§ 386. Diligence in Reduction Preserves the Continuity of the Inventive Act.

That this view of the period during which diligence is necessary is correct is evident from the relation which this diligence establishes between the beginning and the completion of the inventive act. The inventive act is not usually an instantaneous act. The conception of the idea may be in some cases without perceptible duration, but the reduction to practice generally requires considerable periods of time. When the conception of the idea is complete, the inventive act is begun. When the reduction is finished the inventive act is ended. And whatever the interval between them, the first conceiver is permitted to claim the whole act as bearing the date of the conception, as against the subsequent conceiver, provided he connects his conception with his reduction by proof of reasonable diligence in effecting it, thus giving to the whole inventive act a practically and legally continuous character.¹ But it can hardly be regarded as consistent with this theory that the first conceiver, having completed the development of his idea in his own mind, should be at liberty to suspend his operations until some subsequent conceiver has developed the same idea, and then resuming his endeavors

§ 386. ¹ In *Farmer v. Brush* (1880), 17 O. G. 150, Paine, Com.: (150) "The law accords a patent to the first and original inventor. It is the reduction to practice, and not the conception alone, which constitutes completed invention. But suppose that A forms what is known to the law as a conception of the invention, and at a subsequent date reduces it to practice, and that in the meantime B both conceives the invention and reduces it to practice. The question whether A or B is entitled to the patent depends on the further question whether, as between A and B, the invention of A

is to take the date of his conception or the date of his reduction to practice. This question is not explicitly answered by the terms of the statute. But the answer furnished by judicial interpretation of the statute is that if A connects his reduction to practice with his conception by showing due diligence in the prosecution of the invention from the date of his conception to the date of his reduction to practice, his invention takes the former date and he is entitled to the patent, but otherwise it is to be granted to B." In a subsequent portion of this decision, the Commissioner seems to endorse

carry them forward to reduction and claim priority for the entire inventive act on account of his priority of conception. Alike, therefore, upon principle and upon the presumption out of which the rule itself arises, it appears that the diligence required of the first conceiver relates to the entire period between his conception and his reduction, and that in default of this the second conceiver, if the first reducer, is entitled to the patent. And this seems to be the doctrine of most of the decisions of the courts upon this question.²

§ 387. Reasonable Diligence Alone Required.

No general standard, by which diligence can be estimated, has been established by the law, nor, in the nature of things, is such a standard possible. It must be reasonable, under all the circumstances of the particular case in question.¹ The

the doctrine that the diligence is required only from the date of the second conception. Or, possibly, he may intend to distinguish between the diligence necessary to the first conceiver, and the race of diligence which begins with the later conception. The sentences above quoted are, however, a clear statement of the rule as, upon reason and principle, it should be established.

² In *White v. Allen* (1863), 2 Clifford, 224, Clifford, J. : (239) "The Federal courts have everywhere held that an inventor, who has first actually perfected his invention, will not, if he has exercised good faith, be deemed to have surreptitiously or unjustly obtained a patent for that which was in fact first invented by another, unless the latter was at the time using due diligence in adapting and perfecting what he had accomplished; and it was expressly held in *Ransom v. The Mayor of New York*, Law's Dig. App. 72, *per* Hall, J., that if a person does not use due diligence in perfecting his invention after he has conceived the idea, and another conceives the same idea and perfects it, and secures his patent and applies it to

use, the latter will be considered as the original and first inventor, and that a patent granted to the former will be void." 2 Fisher, 440 (454).

In *Ransom v. Mayor of New York* (1856), 1 Fisher, 252, Hall, J. : (272) "If the plaintiffs did not use reasonable diligence to perfect the invention patented, after the idea of it was first conceived, and in the meantime other persons not only conceived the idea but perfected the invention, and practically applied it to public use, before the invention of the plaintiffs had been so far perfected that it could be applied to practical use, the plaintiff's patent is void, because they were not the first and original inventors of the thing patented."

§ 387. ¹ In *Bradford v. Corbin* (1874), 6 O. G. 223, Leggett, Com. : (224) "Different cases have their peculiar facts and incidents, and hence it is impossible to make decisions or enact rules which will form just precedents or sure guides applicable to every subsequent case. The nature of the invention in controversy has often much to do with the conduct of the parties, and while

character of the invention; the health, the means, the liberty of the inventor; his occupation upon kindred or subordinate inventions, — are proper subjects for consideration.² Such reasonable diligence does not involve uninterrupted effort, nor the concentration of his entire energies upon this single enterprise.³ At the same time, no difficulties in reduction will excuse delay unless they have been practically insurmountable, nor will his voluntary pursuit of independent lines of experiment, nor his unwillingness to risk his time and money in a doubtful venture, nor the apparent want of a market for the invention, justify

laches could be safely presumed against the inventor of a simple device or article by reason of long delay in applying for a patent, the presumption would not exist, to that extent at least, if the invention in dispute consisted in an intricate and complicated machine, wherein the first conception falls far short of a completed invention, but long and costly experiments almost invariably beset the path of the inventor."

In *Cox v. Griggs* (1861), 1 Bissell, 362, Drummond, J.: (364) "It is the right and privilege of a party, when an idea enters his mind in the essential form of an invention, — inasmuch as most inventions are the result of experiment, trial, and effort, and few of them are worked out by mere will, — to perfect by experiment and reasonable diligence his original idea, so as not to be deprived of the fruit of his skill and labor by a prior patent, if he is the first inventor. But there must be what we would consider reasonable diligence, looking at all the facts in the case." 2 Fisher, 174 (176).

That whether a prior inventor has used reasonable diligence in reducing his invention to practice is a question to be determined, not by reference to any fixed standard, but in view of all the circumstances of the case, see *Electric R. R. Signal Co. v. Hall R. R. Signal Co.* (1881), 6 Fed. Rep. 603; *McTammany, Jr., v. Needham* (1880), 18 O. G. 1050;

Bering v. Haworth (1878), 14 O. G. 117; *Brookfield v. Brooke* (1873), 4 O. G. 81; *Lay v. Ballard* (1873), 3 O. G. 687; *Chapman v. Candee* (1872), 2 O. G. 245; *Reisinger v. Clark* (1872), 2 O. G. 339.

² In *McTammany, Jr., v. Needham* (1880), 18 O. G. 1050, Marble, Com.: (1051) "Diligence in perfecting an invention is a relative matter, and the law does not require that an inventor who is engaged in developing a number of improvements at the same time should devote all his time and energy to any one at the expense of the others."

That the inventor is engaged in a series of inventions, of which the one in question is a member, is a good excuse for developing the others to the postponement of this, see *Ex parte Carr* (1874), 5 O. G. 30.

That the inventor is in the employ of others to whom his time and labor belongs is a good reason for delays, see *Morse v. Clark* (1872), 1 O. G. 275.

That poverty will excuse delay, see *Cushman v. Parham* (1876), 9 O. G. 1108; *Proctor v. Ackroyd* (1874), 6 O. G. 603; *Webster v. New Brunswick Carpet Co.* (1874), 5 O. G. 522.

That sickness will excuse delays, see *Munger v. Connell* (1872), 1 O. G. 491.

³ That reasonable diligence does not necessitate continuity of effort, see *Chapman v. Candee* (1872), 2 O. G. 245.

That it does not require the devotion

the cessation of his endeavors.⁴ While the law is indulgent to the inventor, and saves him from the consequences of delays which he could not avoid, it gives him no option as to the diligent pursuit of his reduction according to his actual abilities, but holds him strictly to the rule as justice and the public interest require.⁵

§ 388. **Whether Diligence in Applying for a Patent is Required of an Earlier Rival Inventor.**

With this subject of diligence in reducing to practice another has been sometimes associated, to the confusion of both. It may occur that an inventor, having conceived the idea of an invention and embodied it in tangible materials, conceals it from the public until a subsequent inventor conceives it, reduces it to practice, and applies for a patent. In this case, as

of all the inventor's energies to the invention, see *Munger v. Connell* (1872), 1 O. G. 491.

⁴ In *Barnes v. Clinton* (1876), 9 O. G. 1158, Duell, Com.: (1159) "When a man, after making a model, destroys it, leaves the subject, and proceeds to experiment and perfect other devices for producing the same result, does not again recur to the matter, experiment, or in any manner indicate ownership and a desire to perfect the improvement, until, after a lapse of more than two years, he sees another engaged upon the same invention, demonstrating its practical utility and value, the presumption is very strong that such model was an abandoned experiment, or at least that he was culpably negligent in adapting and perfecting the invention."

That the inventor was partially occupied with other inventions is no reason for neglecting the present one, if it was reasonably possible to go on with it, see *Warner v. Anders* (1877), 11 O. G. 109.

That he was unwilling to risk his money upon it, for fear of loss, is no good reason for delay; nor that his em-

ployers would not agree to use it; nor that he was under contract to sell them all his inventions, see *Bradford v. Corbin* (1874), 6 O. G. 228.

⁵ In *Sayles v. Chicago & Northwestern R. R. Co.* (1865), 1 Bissell, 468, Drummond, J.: (471) "The Patent Law looks with indulgence upon the delays which arise from the circumstances of parties who may make an invention, and it is only when the invention is intentionally abandoned or neglected, or the parties show by their acts that they have not done all they can do, that the law declares that they shall not be protected in their inventions." 2 Fisher, 523 (526).

That to overthrow the claims of a patentee on the ground that he is a junior inventor, the earlier conceiver must show entire freedom from laches, all doubts being resolved in favor of the patentee, see *Voelker v. Gray* (1885), 30 O. G. 1091.

That difficulties, when surmountable with reasonable effort, do not excuse delays, see *Barnes v. Clinton* (1876), 9 O. G. 1158.

in those already considered, the second inventor is the first to give the invention to the public, and is *prima facie* entitled to the patent. But, as a matter of fact, the same complete inventive act had been performed by the first inventor before the conception of the idea of the invention by the later. Obviously there can be here no question as to the diligence of the first inventor in reducing to practice, for his reduction was complete and his invention ready for publication and for patent before the second inventor had developed the idea of means. Whether the second invention supersedes the first and gives the patent to the second inventor, or whether the first inventor is still the proper patentee notwithstanding his failure to patent the invention and its subsequent conception and reduction by the second inventor, are questions which have received divers answers from the courts, and upon which opinion is still contradictory.

§ 389. Negligence in Applying for a Patent Neither Makes the Invention a Lost Art nor Abandons it to the Public.

It will relieve these questions of some obscurity to distinguish them from two others which in many respects are similar. When an inventor has completed his invention he may either put it aside, without disclosing it to others, and finally forget it; or he may disclose it to others and suffer it to become so known as to be accessible to the public; or he may, without disclosing it, without definite intention to relinquish it, and without forgetting it, simply neglect to patent it. In the first case, his invention becomes a "lost art," and may be re-invented and patented by any subsequent inventor. In the second, the invention, if not patented within two years from its first use in public, is abandoned to the public, and cannot thereafter be patented by any one. In the third case arises the question now under discussion. By some authorities the invention, under such circumstances, is regarded as a lost art, inasmuch as it is known to none but the inventor, who manifests no disposition to communicate it to the public. By others it is held that reduction to practice is not complete until the invention has been used in public, and hence that, in this case, the inventive act was never

finished but was a mere experiment and therefore no bar to a patent to a subsequent inventor.¹ Others regard the invention as complete and as still the property of the inventor, and declare that since he has not abandoned his invention to the public, the sole right to the patent must remain in him, notwithstanding any subsequent conception and reduction by another.

§ 389. ¹ In *Mallott v. Cogger*, (1879), 16 O. G. 45, Paine, Com. : (46) "If upon the completion and actual use, either in public or in private, of a machine or article of manufacture, the invention embodied therein becomes a successful experiment so as to entitle the inventor to a patent and to defeat the claim of a subsequent inventor without further action or diligence on the part of the first inventor, still the invention does not pass absolutely from the domain of experiment until it has been actually used *in public*. If forgotten *before* or *after* such public use it may be re-invented and patented by a subsequent inventor. If *abandoned before* such public use it is an abandoned experiment and may be patented by a subsequent inventor. If *abandoned after* such public use it cannot be patented by a subsequent inventor, but becomes the property of the public. The same considerations of public policy which permit a subsequent inventor to take a patent for an invention previously completed by reduction to practice and then forgotten, also permit such subsequent inventor to obtain a patent for an invention previously reduced to practice and then abandoned without public knowledge or use. The public has the same interest in securing the benefits of an invention withheld by a prior inventor from public knowledge and use which it has in securing the benefits of a forgotten invention, and therefore, has the same reason for encouraging the discovery of an abandoned invention which it has

for encouraging the reclamation of a forgotten invention. The merit of the second inventor of an abandoned invention is equal to that of the second inventor of a forgotten invention, for he rescues the invention from oblivion and confers its benefits upon the public in one case just as truly as in the other. And so far as the rights of the first inventor are concerned, it is clear that he who abandons his completed invention, without bringing it to public knowledge or use, has no stronger claim to consideration than he whose invention has been forgotten. No statutory provisions interdict the grant of a patent to a subsequent inventor for an invention abandoned without public knowledge or use. An invention reduced to practice by actual use in private and then abandoned, cannot be said to have been known and used by others in this country." In this opinion the question of priority of invention as determining the personality of the patentee is to some extent confounded with that of the patentability of the invention itself, as counter-indicated by prior use and knowledge. This is especially apparent in the latter sentence cited.

That where an earlier inventor has reduced to practice and then laid the invention aside and abandoned it, the invention becomes an abandoned experiment, and another may invent it, but the first cannot then revive his claim, see *Sheridan v. Latus* (1883), 25 O. G. 501.

§ 390. Negligence in Applying for a Patent Does not Affect the Rights of the Inventor except by Estoppel.

That an invention cannot be a lost art while it resides definitely and fully in the memory of the inventor and can at will be reproduced by him and put to practical employment; that reduction to practice is complete as soon as the idea of means has been embodied in tangible materials capable of practical use in the arts, whether actually used in public or not; that no invention is abandoned to the public except by two years' public use or sale or by some act, word, or omission on the part of the inventor unequivocally expressing his intention to bestow the invention on the public without demanding the protection of a patent, — these are propositions which numerous decisions of the courts have placed beyond dispute. The real answer to the question under consideration rests upon a different ground, and one not yet formally recognized in those acts of Congress which constitute the basis of our Patent Law. Upon principle, as we have seen already, the first inventor who discloses the invention is entitled to the patent, unless a prior conceiver of the same idea, who is on that account more meritorious than the later, is in good faith endeavoring to bestow the same invention on the public. Out of this principle grows the rule that such a first conceiver must use reasonable diligence in reducing his idea to practice, in order to entitle him to a patent as against a subsequent conceiver who has first produced the concrete art or instrument. And the same reason exists for requiring an inventor who has first completed the invention to proceed with reasonable diligence to disclose it by applying for a patent, if he desires to claim it as against a subsequent inventor. The force of this reason has led several tribunals to declare that such a rule exists, and to endeavor to sustain it by embracing this case in the similar but not identical cases which we have distinguished from it;¹

§ 390. ¹ In *Hubel v. Dick* (1886), 28 Fed. Rep. 132, Shipman, J.: (140) "The question, therefore, is should the first inventor, who proceeded with reasonable diligence to perfect an important invention, and who produced a successful machine before the junior inven-

tor's patent was issued, lose his right to the fruit of his invention on account of the delay which he exhibited in applying for his patent? That laches merely in applying for a patent, when there were no laches in otherwise perfecting the invention, may compel an inventor

while other courts, unwilling to advance beyond the letter of the law in excluding the first inventor from his customary

to be deprived of his patent, another inventor having meanwhile given the same invention to the public, is probably true. The remarks of Acting Commissioner Duncan in *Monce v. Adams*, 1 O. G. 2, are important and valuable upon this point." 36 O. G. 939 (942).

In *Boyd v. Cherry* (1883), 4 McCrary, 70, McCrary, J.: (77) "If kept secret by the first inventor until the second has discovered it and given it to the public, the latter will be protected, for it is to him that the public is indebted; it is from him that the public has received value; and as no one can impart that which he does not possess, it must appear that the alleged prior inventor was aware not only of his discovery, but also of its utility."

In *Farmer v. Brush* (1880), 17 O. G. 150, Paine, Com.: (151) "If an inventor abandons or forgets his invention before its public use, it may become the property of a subsequent inventor. Abandonment, in the sense in which the term is here used, is the cessation of all effort to furnish the invention for public use. Such abandonment may be voluntary and absolute, as when the invention is deliberately thrown aside with a purpose never to resume it; but it also may occur when the invention is thrown aside, not with a purpose never to resume it, but without any purpose to resume it. If it is merely laid aside temporarily, with an intention to resume it, there is no abandonment. But the question of abandonment in such case is not one of mere mental operation. A mere mental purpose or intention to give the public at some future time the benefit of a completed invention, unaccompanied by any corresponding acts or words, amounts to nothing; and the presumption raised by acts of the party of a purpose to abandon will not be overcome by his testi-

mony that he mentally intended not to abandon it. Such testimony will be construed in connection with the acts of the party; and although it may throw light upon such acts, and, taken in connection with them, may determine their meaning and effect, yet it will not be always decisive when contradictory, rather than explanatory, of such acts. Now a mere delay of two years in the application for a patent is not evidence of abandonment; but neglect to confer the benefits of the invention upon the public, whether it is or is not accompanied by neglect to apply for a patent, is evidence of abandonment. The inventor may voluntarily keep his invention secret as long as he sees fit to do so, provided he applies for a patent before another invents the device. He may abandon or forget his invention, provided he resumes or recalls it before another makes the invention. But his rights do not, in either case, relate back through the intermediate '*vacuum*' to the original invention, so as to give him the benefit of its date as against a rival inventor."

In *Packard v. Sandford* (1879), 16 O. G. 1182, Paine, Com.: (1185) "As between the public and an inventor who reduces his invention to practice in private, there is no obligation of diligence resting on the inventor. It is only when another inventor appears that any such obligation arises. . . . A race of diligence between two inventors never begins until the date of the later conception. The obligation to diligence on the part of the first to conceive does not exist until the day of the later conception, which cannot give to that obligation a constructive existence relating back to the earlier conception. With the reduction to practice, either in public or in private,

privileges, have held that no laches of the inventor, not amounting to abandonment of the invention to the public, can

by the inventor first to conceive, the race of diligence forever ends. The course which the inventor latest to conceive may take after that date does not concern the inventor first to conceive; and the obligation resting upon the first to conceive after that date is not one of diligence as between himself and his competitor. It takes an entirely different form. It is an obligation to the public not to abandon or forget his invention. If he does not fail in that obligation his competitor can have no patent. If he does forget or abandon his invention after reducing it to practice in private and before a public use, his competitor may come in and claim the patent. If he forgets it or abandons it after a public use, his competitor can take no patent, but the forfeiture will enure to the benefit of the public."

In *Monce v. Adams* (1872), 1 O. G. 1, Duncan, Com.: (3) "The section named (section 61, act 1870), saves an existing patent as against a public use limited in point of time as specified; but neither in terms nor inferentially does it extend any guaranty to an inventor against the superior diligence of a competitor entering the field at a later date, unless the first inventor not only reduces his conceptions to practical form but proceeds to put the invention into public use or on sale. If he does this he thereby destroys the right of a subsequent inventor to protection, no matter how diligent he may be; since no man is entitled to a patent for that which, prior to his own invention of it, has gone into public use. But if, uninfluenced by controlling circumstances, he fails to do this, he assumes the risk of incurring all the disabilities that attach to the man who comes out second in a race of diligence. What constitutes a 'race of diligence' — whether

it is ended when the invention is once reduced to practice — is not clearly indicated in the law. The statute employs the phrase 'reasonable diligence in *adapting and perfecting*' the invention. If this be not mere tautology, it must mean something more than merely reducing to practice; it must intend positive action, looking to the introduction of the invention, or at least to giving the world knowledge of it. But whatever be the significance of these particular words, there can be but little doubt that in fact an inventor is to be held to as strict accountability for the time suffered to elapse between the perfecting of his invention and its revelation to the public through the medium of the Patent Office, as for the time consumed in reducing it to practice after the original conception. This question was discussed at length in *Gray v. Hale*, Commissioner's Decisions, May 27, 1871; and the conclusion reached upon the strength of the authorities then cited, to the effect that a wilful or negligent postponement of one's claims may, under some circumstances, work a forfeiture of his right to a patent, even in the actual absence of any intention to relinquish it, or of any public use of the invention known or assented to, has an important bearing upon the present case. The fact that the delay extends over a less period than two years is, in itself, considered an immaterial circumstance. Not even this limited period of exemption is accorded an inventor. The object of the patent law is to multiply inventions with a view, primarily, to the public advantage and to secure their free use at the earliest date; and to this end its policy is to reward that man from whom the public actually derives the benefit received, unless, in fact, another, prior in making

deprive him of the right to a patent against any and all subse-

the invention, is proceeding to give it to the world with no further delay than what is imposed by circumstances beyond his control. If an inventor puts his invention into use or on sale, he causes that the public shall have the free use of it at the end of two years, unless he sooner makes an application for a patent; and in this last event the free use of it devolves upon the public at the end of seventeen years from the date of any patent that may be granted. On the other hand, if an invention, when perfected, may be withheld from use and kept a secret without the risk of forfeiture by reason of its subsequent discovery by another party, such right, for aught of limitation imposed by statute, may continue indefinitely, can be terminated in fact only by the actual introduction of the invention by another for the space of two years. Even the granting of a patent to the subsequent inventor would not defeat it; nothing less than a two years' actual or constructive public use under the patent could avail for this purpose. But such a doctrine would be obnoxious to the whole spirit of the Patent Law, and is contrary to a long line of well-established judicial decisions. It is true, as often announced, that mere delay, no matter how long continued, cannot impair an inventor's right to a patent. It is only when by reason of such delay, another party gains the opportunity to give the invention to the world, and actually becomes the first to do this, that the first inventor's rights pass away."

In *Kendall v. Winsor* (1858), 21 How. 322, Daniel, J.: (327) "It is undeniably true that the limited and temporary monopoly granted to inventors was never designed for their exclusive profit or advantage; the benefit to the public or community at large was another and doubtless the primary ob-

ject in granting and securing that monopoly. This was at once the equivalent given by the public for benefits bestowed by the genius and meditations and skill of individuals, and the incentive to further efforts for the same important objects. The true policy and ends of the patent laws enacted under this government are disclosed in that article of the Constitution, the source of all these laws, viz.: 'to promote the progress of science and the useful arts,' contemplating and necessarily implying their extension, and increasing adaptation to the uses of society. (*Vide* Constitution of the United States, Art. I. Sec. 8, Clause 9.) By correct induction from these truths it follows that the inventor who, designedly and with the view of applying it indefinitely and exclusively for his own profit, withholds his invention from the public, comes not within the policy or objects of the Constitution or acts of Congress. He does not promote, and, if aided in his design, would impede, the progress of science and the useful arts. And with a very bad grace could he appeal for favor or protection to that society which, if he had not injured, he certainly had neither benefited nor intended to benefit. Hence if, during such a concealment, an invention similar to or identical with his own should be made and patented, or brought into use without a patent, the latter could not be inhibited nor restricted upon proof of its identity with a machine previously invented and withheld and concealed by the inventor from the public."

That where an inventor has completed his invention, and reduced it to practice, if he withholds all knowledge of it from the public, neither applying for a patent, nor putting the invention to practical use, and meanwhile another inventor invents, introduces, and pat-

quent inventors.² The former rule may on equitable grounds be regarded as the more correct, since an inventor who, having

obtains it, the former shall be regarded as having forfeited his prior rights, and the subsequent inventor is the proper patentee, see *Ex parte Carr* (1874), 5 O. G. 30; *Pattee v. Russell* (1873), 3 O. G. 181; *Johnson v. Root* (1858), 1 Fisher, 351; *Ransom v. Mayor of New York* (1856), 1 Fisher, 252.

² In *Harmet v. Reese* (1882), 21 O. G. 1875, Marble, Com.: (1876) "Counsel, however, have advanced the proposition that an inventor who has perfected his invention may by his neglect and laches forfeit his right to obtain a patent therefor in favor of a subsequent and independent inventor. This doctrine is, as I believe, foreign to the Patent Law. When a person has reduced an invention or discovery to a fixed, positive, and practical form, and made a full disclosure of its character to others, his right to a patent is complete (*Reed v. Cutter*, 1 Story, 590), and if he foregoes that right no subsequent inventor can comply with the conditions upon which alone a patent can be granted. (*Pickering v. McCullough et al.*, 13 O. G. 818.) If the first and original inventor abandons his invention to the public expressly or tacitly, by neglecting seasonably to assert his exclusive right, he cannot recall that right (*Mellus v. Silsbee*, 4 Mason, 108), and still less can a later inventor appropriate it to himself. (*American Hide Company v. American Tool Company*, 4 Fisher, 284.) Under these circumstances the first invention is not a waif or stray which can be reclaimed at will by its original owner or converted by a subsequent discoverer to his own use. It has passed into the public domain, and the public is already, therefore, in possession of the knowledge of the invention which would form the consideration of the grant of a patent to the second inventor. (Consoli-

dated *Fruit Jar Company v. Wright*, 4 Otto, 92.)"

In *Rice v. Winchester* (1873), 3 O. G. 348, Leggett, Com.: (348) "It has been laid down by the courts in numerous cases . . . that where one has conceived but not perfected an invention, an independent inventor may have a valid patent who has subsequently conceived, perfected, and introduced the invention, unless in the meantime the party first to conceive it was using reasonable diligence in adapting and perfecting it. In this case it is clear that Winchester was first to conceive the invention, but the tribunals named differ as to whether he had completed it or was using reasonable diligence to do so. If Winchester had completed and embodied his invention in practicable form, in which it could unmistakably be communicated to the public, and it was new, then no obstacle but abandonment in fact, or its use in public for more than two years, could deprive him of his right to a patent for it under the statute. But if he had not done this, then, unless he used reasonable diligence in adapting and perfecting it, he might be forestalled by a patent to an independent inventor more diligent than himself."

That the delay of an inventor in patenting his invention, or in bringing it to public use or attention, after once reducing it to practice, offers no opportunity to a subsequent inventor to invent, reduce, and patent it, see also *Shoup v. Henrici* (1876), 11 Phila. 514; 2 Bann. & A. 249; 9 O. G. 1162; *Allen v. Blunt* (1846), 2 W. & M. 121; 2 Robb, 530.

That a delay after reduction, for the purpose of reasonably testing the invention, is permissible, see *Hubel v. Dick* (1886), 28 Fed. Rep. 132; 36 O. G. 939.

perfected his invention, voluntarily conceals it and unreasonably delays his application for a patent, thereby wilfully misleads subsequent and innocent inventors into the belief that the field covered by the invention is still open, and he therefore ought to be estopped from patenting the invention and appropriating its exclusive enjoyment to himself after their honest efforts in the same direction have succeeded.³

³ There seems to be no good reason why the doctrine of estoppel should not be applied in its fullest extent to an inventor who, having completed his invention, voluntarily delays his application for a patent. In the present condition of industrial enterprise he may be fairly chargeable with knowledge that other persons skilled in the art to which his invention appertains have perceived the same want, that they are striving to discover means by which this want may be removed, and that their inventive efforts are very likely to result in the same art or instrument which he already has produced. If under these circumstances he wilfully keeps silent concerning his prior discovery and permits these later inventors to expend their money, time, and energy in endeavors which would be at once abandoned were he to disclose the character of his own invention, he is certainly not entitled, on any principle of justice and fair dealing, to urge against them his superior right after they have completed their inventive acts and diligently attempted to secure the benefit of the invention to themselves and to the public by applying for a patent.

This doctrine would probably have long ago met with universal acceptance had it not been unnecessarily confounded with abandonment of the invention to the public, which rests upon the actual or presumed intention of the inventor to relinquish his exclusive right to the invention in favor of the community at large.

Abandonment and estoppel have, it

is true, an indirect relation to each other. An invention can be dedicated to the public by no one but the true inventor, and of several rival inventors he only can abandon the invention to whom the law would otherwise secure it by a patent. Hence if the prior conceiver, having been diligent in reduction and not estopped, by negligence in applying for a patent, from claiming the invention as against his rival, chooses to secure it by a patent, no act or omission of the rival can dedicate it to the public. But if the prior conceiver has been negligent in reduction, whereby the later conceiver has become in law the first inventor, or if, although the first reducer as well as first conceiver, he has delayed his application for a patent until he is estopped to assert his rights against a later inventor, then the latter may either patent the invention to himself or may abandon it to the public at his pleasure. In this method estoppel may be one step in a series of events which results in the total surrender of the invention to the public.

But apart from this indirect relation, estoppel and abandonment are totally distinct. The former can be predicated only of the person claiming the monopoly in the invention, and rests on equitable grounds in no respect peculiar to Patent Law. The latter can be predicated only of the invention itself and is an expression of the fundamental principle of Patent Law that no monopoly can be created in rights or property that have already passed into the law-

§ 391. Earliest Conceiver not Entitled to Patent until he has Reduced to Practice.

It must not be assumed from this indulgence manifested by the law to the diligent first conceiver that he can claim a patent before his own reduction to practice is complete. A reduction made by the subsequent inventor avails him nothing.¹ It does not constitute a part of his inventive act nor

ful possession and enjoyment of the public. The doctrine of estoppel, as enforced against a negligent inventor in favor of his rival, is thus neither an extension of nor a departure from the principles of Patent Law, but is a rule of universal application which may as appropriately be resorted to in controversies between the antagonistic claimants of an invention as in those which arise in reference to any other class of property.

See further on this subject §§ 346 and notes, and 357 and note 3, *ante*.

§ 391. ¹ In *Ackerman v. Archer* (1879), 15 O. G. 562, Paine, Com. : (562) "The adjudications of the courts and of the Patent Office have established the principle that, as against a patent granted, an applicant claiming to be a prior inventor must either have first so reduced the invention to practice as to demonstrate its capability of use, or have first conceived the invention and with due diligence proceeded to so reduce the same to practice as to demonstrate its capability of use. If the device does not of itself afford evidence of its capability of use, but is of such a nature that proof of actual use, or some other proof *ab extra*, is necessary to demonstrate its capability of use, then the applicant must show that he has put the device to practical use or ascertained its capability of practical use. . . . (563) It is, of course, against the policy of the law to grant a second patent for the same invention, even to a prior inventor, before its capability of practical use has been demonstrated ; but it is also against the policy of the law to grant a second

patent to an applicant claiming to be the prior inventor, even after a patentee has shown the invention to be capable of use, unless that shall have been ascertained and shown by the applicant himself."

In *Burgess v. Wetmore* (1879), 16 O. G. 765, Paine, Com. : (766) "It is not enough in order to entitle an applicant to a patent that some one else has shown the practicability of the invention by reducing it to practice. . . . The law accords the patent to the later applicant, who connects by due diligence a prior conception, not with a reduction to practice by somebody else, but with a reduction to practice by himself or by his agent."

In *Crane v. Whitehead* (1875), 7 O. G. 219, Thacher, Com. : (219) "Now the law, as construed by the courts, gives the right to an invention to him who first reduces it to practical form by embodying it in a machine in use, or at least ready for use, unless a prior inventor is at the time using due diligence in adapting and perfecting the same invention. But before this prior inventor can have any standing in court, he must be able to show that he has also perfected the invention and made it ready for use ; until he has done this he cannot successfully challenge the right of his competitor to the invention which the latter has embodied in operative machinery."

That drawings are not reduction as against subsequent inventors, see *Pennsylvania Diamond Drill Co. v. Simpson* (1886), 29 Fed. Rep. 288 ; *Detroit*

can it serve him as a demonstration that his own idea of means is capable of practical application in the arts. He must have finished his inventive work, and have complied with every legal requirement as fully as if no other laborer but himself were in the field, or he cannot yet be regarded as entitled to the recompense of an inventor.

Lubricator Co. v. Renchard (1881), 9
Fed. Rep. 293; Reeves v. Keystone
Bridge Co. (1872), 5 Fisher, 456; 8
Phila. 368; 1 O. G. 466. See also
§ 318 and note 2, *ante*.

That the testimony of the prior con-
ceiver does not constitute reduction,
see Pennsylvania Diamond Drill Co. v.
Simpson (1886), 29 Fed. Rep. 288.

CHAPTER II.

OF CO-OPERATING INVENTORS.

§ 392. "Co-operating Inventors" Defined.

An operation or an instrument, as practically known and used in the arts, is often the result of the inventive skill of two or more persons, who have acted together in producing the invention. In such a case, if the idea of means expressed in the concrete invention is single, and has been developed by the united efforts of all the inventors, the invention is a joint invention, and those concerned in it are jointly entitled to the patent. But where the concrete art or instrument embodies more than one idea of means, and each idea is the result of the inventive skill of different persons; or where the principal idea is due to one, while others have supplied such ancillary conceptions as render the invention more available; all the inventors whose creative genius has aided in producing the invention have interests which, as far as practicable, the law will recognize and protect. It is to these we have applied the title of Co-operating Inventors.

§ 393. Suggestions as to Reduction not Co-operative Invention.

The co-operation here described has relation to the mental part of the inventive act alone. In reducing an idea of means to practice, an inventor has a right to avail himself of the constructive skill and ingenuity of others; and the suggestions which he may derive from them, and the improvements which he may adopt in consequence of these suggestions, belong to the embodiment of his invention and not to its essential character. Hence no notice is taken by the law either of these suggestions or their author. They are regarded as part of the service which the inventor bargains for with the con-

structor and for which he pays; and so far as any one can be protected in their exclusive use, they are covered by the patent he obtains.¹

§ 394. Suggestions as to Inseparable and Dependent Ideas of Means not Co-operative Invention.

But as to those suggestions and improvements which owe their origin to the inventive skill of others than the principal inventor, the rule is different. The theory and spirit of the law secures to every one the fruit of his creative efforts, and permits no one except their author to appropriate them to his exclusive use. Practically, however, a strict adherence to this theory and spirit of the law is not always possible. Not every suggestion which involves an exercise of the inventive faculties is a complete idea of means, or even a complete step forward in the development of an existing idea, capable of substantive embodiment and patentable as a separate invention. While it may render the principal idea more useful to the public and more profitable to the inventor, it may be so dependent upon it and inseparable from it as to be inconceivable without it, even as a patentable improvement. Under such circumstances, its suggester has invented nothing which the law is able to protect, or which he himself is able to enjoy. The alternative is presented either to allow it to go unprotected, and open to the use of any one who has a right to the employment of the principal invention, or to treat it as an incident belonging to and following the principal, and thus the property of the principal inventor and covered by his patent. The latter is the rule adopted by the courts, as at once more just and more encouraging to inventors than the former;¹ se-

§ 393. ¹ That suggestions to an inventor do not deprive him of the merit of the invention, unless they impart to him the complete idea of means, see *Watson v. Belfield* (1886), 26 Fed. Rep. 536; 35 O. G. 1112; *Hall v. Johnson* (1883), 23 O. G. 2411; *Slemmers' Appeal* (1868), 58 Pa. St. 155; *Alden v. Dewey* (1840), 1 Story, 336; 2 Robb, 17. See also § 84 and notes, *ante*.

§ 394. ¹ In *Collar Co. v. Van Deusen* (1874), 23 Wall. 530, Clifford, J.: (563) "Where a person has discovered a new and useful principle in a machine, manufacture, or composition of matter, he may employ other persons to assist in carrying out that principle, and if they, in the course of experiments arising from that employment, make discoveries ancillary to the plan and preconceived

curing to the principal inventor all ancillary inventions made by his employees and assistants, whenever these are not sufficiently separable from the principal invention to be patentable by themselves.

design of the employer, such suggested improvements are in general to be regarded as the property of the party who discovered the original principle, and they may be embodied in his patent as part of his invention. Doubt upon that subject cannot be entertained, but persons employed, as much as employers, are entitled to their own independent inventions; and if the suggestions communicated constitute the whole substance of the improvement the rule is otherwise, and the patent, if granted to the employer, is invalid, because the real invention or discovery belongs to the person who made the suggestions." 7 O. G. 919 (923). This case affords a very instructive view of the relations sometimes arising between an inventor and his employees, and of their respective positions before the law. Evans, the assignor of the plaintiffs, was a manufacturer, and claimed to be the inventor, of paper collars. He found great difficulty in making collars of the desired qualities for want of paper possessing certain characteristics, and employed various paper-makers to experiment toward the production of such a paper as he required. As they presented to him, from time to time, the fruits of their experiments, he pointed out to them the particulars in which their papers were still deficient but gave them no information as to the ingredients to be used, or the methods to be employed in arriving at the necessary results. It was held that he was neither the inventor of the paper finally produced, nor of the process by which it was made; that he had merely pointed out an end to be attained, not the means of its attainment, and was not entitled to appropriate the

discoveries of the paper-makers as his own invention.

In *Agawam Co. v. Jordan* (1868), 7 Wall. 583, Clifford, J.: (603) "Persons employed, as much as employers, are entitled to their own independent inventions, but where the employer has conceived the plan of an invention and is engaged in experiments to perfect it, no suggestions from an employee, not amounting to a new method or arrangement which in itself is a complete invention, is sufficient to deprive the employer of the exclusive property in the perfected improvement. But where the suggestions go to make up a complete and perfect machine, embracing the substance of all that is embodied in the patent subsequently issued to the party to whom the suggestions were made, the patent is invalid because the real invention or discovery belonged to another."

To the same point see also *Harrison v. Hogan* (1880), 18 O. G. 921; *Yost v. Powell* (1877), 13 O. G. 122; *Chase v. Witter* (1876), 9 O. G. 593; *De Sanno v. Ritchel* (1876), 9 O. G. 792; *Cogswell v. Burke* (1872), 1 O. G. 380; *Penock v. Dialogue* (1825), 4 Wash. 538; 1 Robb, 466.

But that an improvement made by a user of the invention without the knowledge of the inventor cannot be claimed by the latter, see *Berdan Fire Arms Mfg. Co. v. Remington* (1873), 3 O. G. 688.

That the inventor of a new device, adopting a suggestion as to the mode of making it, and procuring a patent to himself and the suggester as an assignee of a half-interest, is to be regarded as the true inventor of the device, see *Fraser v. Gates* (1885), 118 Ill. 99.

§ 395. Suggestions of Separable but United Ideas of Means are Co-operative Invention.

Suggestions and improvements which are capable of independent contemplation, either as distinct ideas of means or as separate stages in the development of the same idea, belong, however, to their respective inventors.¹ The fact that, as it stands before the world, the invention is a single art or instrument does not show that it has originated in the inventive skill of a single individual, or that the one who first conceived the general idea which it embodies is alone entitled to the patents which protect it. Each part of which it is composed, as well as the method by which its several parts have been united in the complete invention, may be a separate invention, produced by a different inventor, and protected by a different patent. Thus in a combination, every element may have been produced by a distinct inventor, and the co-operative law under which they are now brought together may have been conceived by still another, while the whole is known in

§ 395. ¹ In *Odiorne v. Winkley* (1814), 2 Gallison, 51, Story, J.: (53), "The original inventor of a machine is exclusively entitled to a patent for it. If another person invent an improvement on such machine, he can entitle himself to a patent for such improvement only, and does not thereby acquire a right to patent and use the original machine; and if he does procure a patent for the whole of such a machine with the improvement, and not for the improvement only, his patent is too broad and therefore void. . . . To illustrate these positions, suppose a watch was first invented by a person so as to mark the *hours* only, and another person added the work to mark the minutes, and a third the seconds, — each of them using the same combinations and mode of operations to mark the hours as the first. In such a case the inventor of the second-hand could not have entitled himself to a patent embracing the inventions of the other parties. Each inventor would undoubtedly be entitled

to his own invention and no more. In the machines before the court there are three great stages in the operation, each producing a given and distinct effect: 1. The cutting of the iron for the nail; 2. The griping of the nail; 3. The heading of the nail. If one person had invented the cutting, a second the griping, and a third the heading, it is clear that neither could entitle himself to a patent for the whole of a machine which embraced the inventions of the other two, and by the same mode of operation produced the same effect; and if he did his patent would be void. Some machines are too simple to be thus separately considered; others again are so complex as to be invented by a succession of improvements, each added to the other." 1 Robb, 52 (55).

See also *Tilghman v. Proctor* (1880), 102 U. S. 707; 19 O. G. 859; *Railway Co. v. Sayles* (1878), 97 U. S. 554; 15 O. G. 243; *Chase v. Witter* (1876), 9 O. G. 593.

practice as but a single manufacture, process, or machine. Or any simple art or instrument may have at first embodied but the generic idea, which has since been developed and enlarged by numerous improvements, until the comparatively perfect invention represents the inventive skill and triumphs of many meritorious inventors. To each of these the law awards his recompense according to his merit, giving to each the exclusive use of the element, the improvement, or the co-operative law he has invented, and protecting, by the letters-patent issued to each, his precise invention and no more.

CHAPTER III.

OF JOINT INVENTORS.

§ 396. "Joint Inventors" Defined.

Where two or more persons, acting jointly, conceive the same idea of means, they are joint inventors and are jointly entitled to the patent. The sphere of their joint labors and success is thus the mental part of the inventive act. That one conceives the idea and another reduces it to practice; that one conceives the principal idea and the other an idea which is ancillary to and inseparable from it; that one conceives one idea and the other a different idea, both of which are united in the concrete invention, — neither of these are joint invention, nor do they give to the inventors the right to become joint patentees. Only where the same single, unitary idea of means is the product of two or more minds, working *pari passu*, and in communication with each other, is the conception truly joint and the result a joint invention.¹

§ 397. Two Modes of Joint Invention: By Community of Mental Effort; By Community of Experiment.

In examining the methods in which joint inventions are created, it will be necessary to recur to the distinction between those inventive acts which are performed by complete mental development of the idea followed by reduction to practice, and those which, proceeding by successive experiments, at the same moment and by the simultaneous operation of the physical and mental faculties, both conceive and embody the

§ 396. ¹ That in a joint invention both must unite in the invention of something essential, see *Slemmer's Appeal* (1868), 58 Pa. St. 155.

That the assignment of a half-interest does not show that the assignor was not the sole inventor, see *Fraser v. Gates* (1885), 118 Ill. 99.

invention. In the first species of inventive acts the joint inventors meet only upon the plane of mental effort, and are not necessarily associated upon that of the physical embodiment; for the idea of means, being once conceived by their joint endeavors, may be left to either or to some third party to be reduced to practice, without changing its character as a joint invention. But in the second class, as the embodiment and conception advance side by side, and the completeness of the one is known to the inventors only from the successful practical application of the other, the concurrence of the inventors in the physical experiments by which the inventive act proceeds is essential to render the result a joint invention.

§ 398. Joint Invention by Community of Mental Effort.

Where the conception is attained by mental effort only, the joint inventive act may present any one of several different phases. It is not necessary that the same idea should occur simultaneously to each. On the contrary, it is immaterial who first conceives any particular theory or plan of the invention, or in what order the development of its subordinate ideas proceeds.¹ Where two or more inventors have agreed that a

§ 398. ¹ In *Worden v. Fisher* (1882), 11 Fed. Rep. 505, Brown, J.: (506) "There can be no doubt that if the circumstances are such as to show that two persons both contributed to an improvement, and such improvement is the result of mutual contributions of the two, they are to be treated as joint inventors, and a joint patent should be taken out. . . . (508) To constitute two persons joint inventors it is not necessary that exactly the same idea should have occurred to each at the same time, and that they should work out together the embodiment of this idea in a perfected machine. Such a coincidence of ideas would scarcely ever occur to two persons at the same time. If an idea is suggested to one, and he even goes so far as to construct a machine embodying this idea, but it is not a completed and working machine, and another person

takes hold of it, and by their joint labors, one suggesting one thing and the other another, a perfect machine is made, a joint patent may properly issue to them. If, upon the other hand, one person invents a distinct part of a machine, and another person invents another distinct and independent part of the same machine, then each should obtain a patent for his own invention." 21 O. G. 1957 (1957, 1958).

In *Gottfried v. Phillip Best Brewing Co.* (1879), 17 O. G. 675, Dyer, J.: (676) "Where a device or combination is claimed to have been the joint invention of two or more parties, and the question arises for determination upon evidence, it must appear that it was the product of their mutual suggestions and joint efforts; for joint invention is the result of the mutual contributions of the parties, and if one suggests an idea in a

result, if it could be achieved, would be desirable, neither as yet having attempted to provide a means, and from this point go forward by mutual consultations and suggestions to devise one, the means devised becomes a joint invention. Or where one of the inventors has already in his mind a general indefinite idea of means, still incomplete and needing further exercise of inventive skill to fit it for a practical embodiment, and then the other, perceiving its deficiencies and the method of correcting them, makes his suggestions which the first accepts, from whence the two advance together to the complete development of the idea; this also is a joint invention. In short, wherever, before the entire conception of the invention by one inventor, another meets him and by his con-

general way and the other falls in with it and by his aid develops it and gives it definite practical embodiment, the two may be considered joint inventors." 5 Bann. & A. 4 (9).

In *Chase v. Chase* (1873), 4 O. G. 4, Leggett, Com.: (5) "The testimony . . . goes to show that Chase probably had a general idea of the invention in his mind before he saw White about it, but nothing more. When they consulted together, White's suggestions were such that they came to a definite agreement how the device ought to be made, and he made it accordingly. This is the ordinary process of joint invention. It is the result of the mutual contributions of the parties. If one suggests an idea in a general way and the other falls in with it, and by his aid develops it and gives it definite practical embodiment, the two may be considered joint inventors."

In *Barrett v. Hall* (1818), 1 Mason, 447, Story, J.: (472) "A joint patent may well be granted upon a joint invention. There is no difficulty in supposing, in point of fact, that a complicated invention may be the gradual result of the combined mental operations of two persons acting together, *pari passu*, in the invention. And if this

be true, then, as neither of them could justly claim to be the sole inventor in such a case, it must follow that the invention is joint, and that they are jointly entitled to a patent." 1 Robb, 207 (233).

That wherever an invention is the result of the joint efforts of two or more inventors, it is a joint invention, see *Thomas v. Weeks* (1827), 2 Paine, 92.

That where one conceives the invention and the other makes a suggestion essential to its success they are joint inventors, see *Consolidated Bunting Apparatus Co. v. Woerle* (1887), 29 Fed. Rep. 449; 38 O. G. 1015.

That where two or more persons make suggestions and an invention results, it is a joint invention, see *Reutgen v. Kanowrs* (1804), 1 Wash. 168; 1 Robb, 1.

That where two work together for a common end which is finally accomplished by their united efforts the invention is joint, see *Sawyer v. Edison* (1883), 25 O. G. 597.

That where a joint invention is a unit, it is immaterial which of the joint inventors conceived the separate parts of it, or in what order, see *Carter v. Perry* (1875), 8 O. G. 518.

sent unites with him in exercising inventive skill upon the development and perfecting of the conception, the product of their joint endeavor is a joint invention.

§ 399. Joint Invention by Community of Experiment.

The same variety is possible in the exterior relations of the joint inventors, where the inventive act consists in the repeated trial of experiments. The exact part which each performs is of no consequence. Nor does it matter that one has been experimenting long in vain, nor even that he may have made some actual advance toward the discovery to which he aspires. It is enough if the experiment which finally succeeds — the one which demonstrates the practicability of accomplishing the end in view, and indicates the means by which it is attainable — has been conducted under their united supervision, and in accordance with ideas and theories to which both have contributed.

§ 400. Date of Conception of Joint Invention.

The date of the conception of a joint invention cannot be earlier than the date at which the joint inventors first united their inventive skill.¹ As the conception can have no existence until it is complete and capable of practical embodiment, and as no joint inventive act is possible where the conception is perfected in the mind of one inventor before the other is united with him, the meeting of the joint inventors upon the basis of a common effort to produce the joint invention marks the remotest period to which the date of the inventive act can be referred. Of course, it does not follow from this fact that the conception was at that time completed. Upon this question the same rule is applicable as in the case of sole inventions, whether the inventive act proceeded by mental efforts only or by a series of experiments.

¹ That a joint invention cannot be regarded as conceived earlier than the first consultation of the joint inventors, as their individual efforts and con-
ceptions constitute no part of the joint inventive act, see *Dwyer v. Dickey* (1876), 10 O. G. 585.

§ 401. Joint and Several Inventions may be Embodied in the Same Art or Instrument.

Any art or instrument which expresses more than one subordinate idea of means, may embody both a joint and several invention. Two or more inventors, each of whom has produced an elemental means, may unite in the creation of the co-operative law under which they become a combination. Several inventors of the parts of a machine or manufacture, or of the steps of a process, may thus be sole inventors as to each portion of the concrete invention, and joint inventors in regard to it when considered as a whole.¹ For every complete inventive act must stand alone, resulting in its own product, meriting its own recompense, and, theoretically at least, protected by its own patent. And although several of these may be combined to constitute an art or instrument essentially distinct from each and all of its component inventions, the rights of those whose genius thus contributes to the ultimate invention are unchanged, and each remains entitled to protection from the law.

§ 402. Joint Patent must Issue for a Joint Invention.

A patent for a joint invention must be applied for and be issued in the names of all the joint inventors.¹ If one of the inventors should obtain the patent to himself alone, the patent would be void unless his act could be regarded as a simple fraud upon the others, and equity could compel him to hold the patent privilege in trust for them.² If, on the other hand,

§ 401. ¹ That where each of two persons produces independent parts of an entire invention, and they unite and so create the whole, they are joint inventors of the resulting invention, see *Chase v. Chase* (1873), 4 O. G. 4.

§ 402. ¹ That a joint patent should always be issued for a joint invention, see *Thomas v. Weeks* (1827), 2 Paine, 92; *Barrett v. Hall* (1818), 1 Mason, 447; 1 Robb, 207.

That a sole patent for a joint invention is void, see *Carter v. Perry* (1875), 8 O. G. 518; *Tennant's Case* (1802), Dav.

P. C. 429; 1 Web. 125; 1 Abb. P. C. 115.

That a patent for a joint invention cannot issue to one of the inventors, though the other has assigned all interests to him, see *Opinion Atty. Gen.* (1833), 2 Op. At. Gen. 571.

See on the subject of the joint ownership of patents §§ 795-799 and notes, *post*.

² That if one joint inventor obtains the patent to himself it is fraudulent, and he will be treated as a trustee for the others, see *Reutgen v. Kanowrs*

a joint patent is granted for a sole invention, the patent is invalid;⁸ for a patent privilege is indivisible, and being granted

(1804), 1 Wash. 108; 1 Robb, 1; *contra*, Slemmer's Appeal (1808), 58 Pa. St. 155.

That joint patentees are joint owners, not copartners, see *Fraser v. Gates* (1885), 118 Ill. 99; *Pitts v. Hall* (1854), 3 Blatch. 201; *Parkhurst v. Kinsman* (1849), 1 Blatch. 488.

⁸ That a joint patent for a sole invention is void, see *Stewart v. Tenk* (1887), 41 O. G. 1502; *Royer v. Coupe* (1886), 29 Fed. Rep. 358; 39 O. G. 239; *Ransom v. Mayor of New York* (1856), 1 Fisher, 252.

That joint patents for sole inventions and sole patents for joint inventions are alike void, see *Slemmer's Appeal* (1808), 58 Pa. St. 155.

That a joint patent for a sole invention is void, and cannot be validated by the parties or the Patent Office, see *Ex parte Boursaloux, James & Lyon* (1878), 16 O. G. 233.

That an inventor of an original and an inventor of an improvement may take out a new joint patent for the whole if the inventor of the improvement assigns to the other one half of his invention, see *Duke v. Graham* (1884), 19 Fed. Rep. 647.

That a joint patent is *prima facie* evidence of joint invention and must be answered by proof, see *Belle Patent Button Fastener Co. v. Lucas* (1886), 23 Fed. Rep. 371; 37 O. G. 1004.

That neither one of two joint inventors can claim a patent to himself alone, see *Runstetler v. Atkinson* (1883), 23 O. G. 940.

That one joint inventor cannot abandon the invention to the public, see *Sawyer v. Edison* (1883), 25 O. G. 597.

It is a fair question whether the rule which holds that a joint patent for a sole invention and a sole patent for a joint invention are void, is not unnecessarily severe. In the difficulty that

attends the discrimination of the mental operations which result in the conception of an idea of means, it may often happen that two or more co-operating inventors will honestly believe that their inventive act was joint, or two or more joint inventors will suppose that their creative processes were several and independent of each other. In the history of our patent system the cases have probably been very few in which, contrary to the known fact, joint or sole patents have been applied for and obtained; and as wherever a patent issues in either form a patentable invention must have been created and given to the public, and the reward must have been conferred upon at least one person to whose inventive skill the invention was partially or wholly due, justice and public policy would seem to require that the patent should be sustained unless there are controlling reasons to the contrary. In examining this question, as the grant of a joint patent for a sole invention and the grant of a sole patent for a joint invention involve the application of different principles of law, they will be separately considered.

(1.) The issue of a joint patent for a sole invention has been held invalid on the ground that in this case the monopoly is bestowed upon at least one person who is not an inventor and who therefore is not by law entitled to receive it; and since the patent privilege is indivisible and cannot be regarded as conferred upon the meritorious patentee to the exclusion of the other, it cannot properly subsist in either, and hence the entire patent must be void. To thus deprive the real inventor of his recompense, because he has mistakenly united with him in its ownership a person who did not deserve it, is certainly a harsh proceeding, contrary to the spirit of our

to at least one person who is not an inventor, is contrary to law and therefore void. That the error of the patentee,

Patent Law, and not to be adopted unless essential to the preservation of some public or private right.

The parties affected by the creation or destruction of a monopoly are the public upon one side and the true inventor on the other. Where a patentable invention has been produced, its inventor has an indisputable right to a monopoly therein, unless by his own acts or negligence the right is forfeited, and until such forfeiture occurs, or his granted monopoly expires, the public can properly acquire no interest in the invention. The issue of a joint patent for a sole invention thus in no manner prejudices the public right. It neither takes nor withholds from them anything which they are justly or lawfully entitled to enjoy, and where the mistake is *bona fide* on the part of the meritorious applicant there is no ground of forfeiture on which the denial of his exclusive privilege can be sustained. So far, therefore, as the public are concerned, there is no reason why the patent should be treated as invalid, if on any principle of law or equity the grant, as made, can be upheld.

The actual inventor, on the other hand, is in no position to complain that a joint rather than a sole patent has been issued. His concession that the invention was due to the joint efforts of himself and his co-patentee was voluntary, and as far as the circumstances rendered it possible was made with a full knowledge of the facts, and hence no legal injury can result to him from regarding this admission as conclusive. Certainly his rights as sole inventor are not vindicated by declaring the entire patent void, and depriving him of his reward because he has improperly though honestly allowed another to obtain a share therein. Far better would it serve his interests to sustain the patent and permit him to

reap that proportion of his recompense to which he is still entitled, notwithstanding his mistaken relinquishment of the remainder to his co-patentee.

One theory upon which a patent of this character can be supported is that of an assignment of an interest in the invention to the alleged co-inventor before their application for a patent. Such an assignment can be made and an equitable title to the patented invention can be created, either by writing, or by words spoken, or by conduct, where the intention so to do is unequivocally expressed; and the patent, when issued, will vest in the equitable assignee either upon the recording of his written assignment or the decree of a court of equity enforcing the original contract, unless superior rights would be thereby affected. But no more unequivocal manifestation of a design to share the benefits of a patent privilege with another can exist than where the inventor joins the other with him in an application for a patent to both; and though he may so far misconceive the nature of the consideration for the assignment as to suppose it to consist in a more intimate union with himself in the inventive act than the facts will justify, his intention to make the other a joint owner of the patent is as definite and justifiable as in any other case of an assignment. The law which authorizes the issue of a joint patent to an inventor and his assignee where the assignment requests that the patent may be thus granted, and has been recorded before the issue of the patent, is in its spirit and intent, if not in its letter, fully adequate to cover such a transaction as the present and to save the rights of all parties according to the relations they have voluntarily adopted toward each other.

If to this position it is objected that

in this respect, was *bona fide* and without negligence is not regarded as sufficient to protect him from its fatal consequences.

the parties, having described themselves in the application as joint inventors, and having supported this description by the application-oath, cannot be permitted to allege a different relation, the answer is that a *bona fide* mistake in matters of this character ought not to, and generally does not, operate to defeat rights which equitably vest in the parties by whom the mistake is made. Thus where the application-oath is unintentionally omitted, or the applicant, believing that he is the first inventor, so describes himself though the fact be otherwise, or inadvertently misstates the character and scope of his invention, — in these and numerous other instances his honest error works no other harm than to compel him to correct it, where such correction is important to the public. The same indulgence ought not to be denied where the mistake is of such slight consequence to the community, and so easily made, as in the application for a joint patent by parties, the unity or diversity of whose inventive acts can rarely be infallibly determined.

(2.) A sole patent to one of two or more joint inventors is held invalid on the ground that the patentee, having performed merely an indivisible part of the inventive act, is not a true inventor, and therefore not entitled to the patent. But by the grant of such a patent the rights of the public are no otherwise affected than in the case of a joint patent for a sole invention. The only party prejudiced is the co-inventor who has not re-

ceived that share in the monopoly which is his due. The forfeiture of the invention to the public for a *bona fide* and perhaps unavoidable error in this respect is not consistent with the spirit of the law nor with the position taken by the courts in similar cases. Nor is the wrong actually suffered by the excluded co-inventor in any degree redressed by avoiding the whole patent and bestowing the invention unreservedly upon the public.

A proper mode of preserving the rights of all parties in this case is suggested in *Reutgen v. Kanowrs* (1804), 1 Wash. 168, viz. by treating the sole patentee as holding the monopoly in trust for his co-inventors, and compelling him to execute such assignments as will perfect their legal titles. This is the mode resorted to where a patent is obtained by an inventor after he has assigned his interest in the invention, and could with equal propriety be adopted where one co-inventor procures a patent which equitably belongs to others as well as to himself. By this mode the patent will in fact, if not in form, be actually granted to the true inventors, and the rights of all in the monopoly will be equally protected.

See also Commissioner's Report for 1887, *in loc.*, 42 O. G. 612.

That where a joint patent has issued for a sole invention, the sole inventor may file a subsequent application and obtain a patent, see *Kohler v. Kohler* (1888), 43 O. G. 247.

CHAPTER IV.

OF PERSONAL REPRESENTATIVES OF THE INVENTOR.

§ 403. Rights of Deceased Inventor Vest in Heirs or devisees.

The right of an inventor to a patent vests in him at the moment his invention is completed, and can be divested only through a forfeiture resulting from his negligence or through his voluntary abandonment of the invention to the public. His death does not affect it. If he makes any disposition of it in his will, such provision is as valid as one concerning any other class of property. If he dies intestate, the right descends, by statute, to his heirs at law.¹

§ 404. Patents Granted to Representatives of Deceased Inventors.

It is obvious that the Patent Office is not a tribunal by which the adverse claims of heirs and devisees may be decided. It is not practicable there to test the validity of wills, to construe testamentary provisions, or to determine who are proper heirs at law. All such questions must necessarily be left to the local courts within whose jurisdiction they arise.¹ In issuing a patent, therefore, the law contents itself with an examination of the claims which the alleged inventor might have

§ 403. ¹ That the right of an inventor descends to his heirs, and a patent will issue to his personal representative in trust for them, see *Wilson v. Rousseau* (1846), 4 How. 646.

See also as to the rights and duties of Personal Representatives §§ 367, *ante*, and 800-802, *post*.

§ 404. ¹ That the letters of administration issued by a competent court will be presumed to be regular, see *Northwestern Fire Extinguisher Co. v. Phila. Fire Extinguisher Co.* (1874),

10 Phila. 227 ; 6 O. G. 34 ; 1 Bann. & A. 177.

That State laws cannot limit the powers of administrators under the Patent Laws of the United States, see *Brooks v. Jenkins* (1844), 3 McLean, 432.

That an administrator's title to a patent is not derived from the State law, and there is no necessity for local State administration, in order to enable him to assert his rights, see *Goodyear v. Hulihan* (1867), 3 Fisher, 251 ; 2 Hughes, 492.

urged, if living, and finding them well-founded grants the patent to his personal representative, leaving the actual owners of the right to adjust their controversies in the tribunals of the States where they reside.²

² In *Shaw Relief Valve Co. v. City of New Bedford* (1884), 19 Fed. Rep. 753, Lowell, J. : (754) "A question which cannot be thus disposed of, and which has been argued with earnestness, and is pending in at least one other circuit, is whether the complainant's title to an undivided part of one of the patents is sufficient. It seems that this title comes through an administrator of the patentee; and the defendant contends that the grant of a patent, by Rev. St. § 4884, is to the patentee, 'his heirs and assigns,' and that by force of these words a patent descends directly to the heirs, without the intervention of the administrator. This is a new and somewhat surprising proposition. It has never been doubted before that a patent is personal property, which follows the ordinary course, and goes to the executor or administrator in trust for the next of kin. The cases take this for granted, and when any question has been mooted, it has had reference to the due qualification of the executor or administrator, or something of that sort, as in *Rubber Co. v. Goodyear*, 9 Wall. 788. The text-writers treat of patent rights as personal property which goes to the executor. *Norman*, Pat. 145; *Schonler, Ex'rs*, § 200. The defendant argues that the statute of 1870 changed the rule, by omitting the words 'executors and administrators' from what is now section 4884, intending to make a sort of real estate of this incorporeal right. He has not argued that the widow can be endowed of it, but I suppose that will follow. A grant of personal property to a man and his heirs, without further qualification, means to him and his next of kin,

according to the statute of distributions. 4 Kent, Comm. (5th ed.) 587, note *d*, and cases; *Vaux v. Henderson*, 1 Jacob & W. 388, n.; *Gittings v. McDermott*, 2 Mylne & K. 69; *Re Nowton's Trusts*, L. R. 4 Eq. 171; *Re Gryll's Trusts*, L. R. 6 Eq. 589; *Re Steeven's Trusts*, L. R. 15 Eq. 110; *Re Thompson's Trusts*, 9 Ch. Div. 607; *Houghton v. Kendall*, 7 Allen, 72; *Sweet v. Dutton*, 100 Mass. 589. Such a grant is simply a limitation of an estate of inheritance, having no reference one way or the other to the administrator. He takes in trust for the next of kin, because the estate is more than a life estate." 28 O. G. 283 (283).

See also *Bradley v. Dull* (1884), 19 Fed. Rep. 913; 27 O. G. 625; *Hodge v. North Missouri R. R. Co.* (1870), 1 Dillon, 104; 4 Fisher, 161.

That the "legal representative" is the executor or administrator, see *Shaw Relief Valve Co. v. New Bedford* (1884), 19 Fed. Rep. 753; 28 O. G. 283.

That the term "legal representatives" may sometimes include assignees as well as executors, etc., see *Hamilton v. Kingsbury* (1878), 14 O. G. 448; 15 Blatch. 64.

That at the death of a patentee the patent vests in his personal representative, at the domicile of the deceased patentee, who is then the owner of the patent for the whole United States, see *Hodge v. North Missouri R. R. Co.* (1870), 4 Fisher, 161; 1 Dillon, 104.

That a patent does not vest in the heirs or devisees of the patentee's administrator, see *Pelham v. Edelmeyer* (1883), 25 O. G. 292.

§ 405. Representatives of Deceased Inventors Receive Patents in Trust for Heirs or Devisees.

The executor or administrator who thus receives the patent has no personal interest therein, nor does he hold it as a part of the assets of the estate committed to his charge. He is a mere trustee for the true owners, as determined by descent or by the will, and is accountable to them for all the use he makes of, or authority he exercises over, the invention. No words to this effect are necessary in the patent. The fact that, as the personal representative of the inventor, he obtains the patent is enough to charge him with this trust, and render it enforceable, like any other, in a court of equity.¹

§ 406. Authority of Representatives of Deceased Inventors over Patents Granted to them in Trust for Heirs or Devisees.

Such personal representative occupies the same position that his decedent would have done, in reference to all matters arising in the Patent Office concerning the invention. Where the law permits of an extension of the patent, it is his place to apply for and secure it.¹ If a reissue becomes necessary,

§ 405. ¹ In *Stimpson v. Rogers, Smith, & Co.* (1859), 4 Blatch. 333, *Ingersoll, J.*: (336) "The law, when the facts appear that a patentable invention has been made, that the person making it died without taking out a patent, that he made a will and appointed an executor, that such executor, as executor, made an application for a patent for the invention of the testator and not for his own invention, and that the patent for the invention of the testator was granted to the executor, as executor, creates the trust that it is for the use and benefit of those to whom the property in the invention was given by the will."

That a patent in the representative's hands is not personalty belonging to the decedent's estate, but is a franchise held in trust for the heirs, see *Goodyear v. Hullihen* (1867), 3 Fisher, 251; 2 Hughes, 492.

That a patent to an administrator is held by him in trust, but the *cestuis que*

trust need not be named therein, see *Northwestern Fire Extinguisher Co. v. Phila. Fire Extinguisher Co.* (1874), 10 Phila. 227; 6 O. G. 34; 1 Bann. & A. 177.

That Congress can grant a patent to the heirs of an inventor by allowing the Patent Office to issue it after the application has been forfeited by delay, see *Graham v. Johnston* (1884), 21 Fed. Rep. 40.

§ 406. ¹ In *Brooks v. Jenkins* (1844), 3 McLean, 432, *per curiam*: (436) "The question was raised as to the right of the administrator to apply for an extension of the patent in his own name. This point was considered on the motion made for an injunction, and decided in favor of the administrator, in whose name the patent was extended. That decision was not made without hesitancy, and the doubt expressed by Judge Story of its correctness, in the very recent case of *Woodward & Brown v. Gould*, which brought up the same

he must surrender the old patent and obtain the new. By him also disclaimers must be filed, suits for infringement prosecuted, and assignments made;² he alone being known in the Patent Office as the owner of the invention and entitled to enforce or to convey the right to its exclusive use.

§ 407. Applications Pending at Death of Inventor to be Prosecuted by his Representatives.

The same duty which devolves upon a personal representative to apply for and obtain a patent for an invention made by his decedent compels him to prosecute an application made by the inventor, and pending in the Office at his death.¹ Here, as before, the patent issues in the name of the executor or administrator, and the same trust attaches to it in favor of the devisees or heirs at law.

question on the same patent, has somewhat shaken my confidence in the view formerly taken. As the point will be taken before the Supreme Court, I deem it unnecessary now to discuss it at large. My opinion, though shaken, is not changed. On a full discussion in the Supreme Court, I may find reasons to lead me to a different result. But it still seems to me that the renewal of the patent in the name of the administrator is so clearly within the spirit and policy of the act of 1836, it should be sustained. There is nothing that the act requires the patentee to do which may not be done by his administrator, except the oath of the ascertained value of the invention, and of the receipts and expenditures, etc. But these receipts and expenditures may be ascertained by the books of the patentee, or from other evidence. The avowed object of the law, in granting an extension of the patent, is to give an adequate remuneration to the patentee, for 'his time, ingenuity and expense; he having satisfactorily shown to the board that he had not received such a remuneration.' Now, why should this remuneration be withheld from the heirs of a deceased patentee?

If a patentee die after his invention, and before he obtains a patent, his administrator may apply for and obtain it. The same reason and justice require a renewal in behalf of the heirs where the remuneration has been inadequate. It is true the act does not expressly so provide."

See also *Wilson v. Rousseau* (1846), 4 How. 646; *Woodworth v. Hall* (1846), 1 W. & M. 248; 2 Robb, 495.

² That an administrator or executor can assign a patent and give a good title thereto, see *Donoughe v. Hubbard* (1886), 27 Fed. Rep. 742; 35 O. G. 1561; *Bradley v. Dull* (1884), 27 O. G. 625; 19 Fed. Rep. 918.

§ 407. ¹ That if the inventor dies before applying for a patent, his executor or administrator should apply; and if he die after application, the patent should issue to his executor or administrator, see *Rice v. Burt* (1879), 16 O. G. 1050.

That where an inventor dies pending an application for a patent, his representative may file a new application, if the rights of third persons will not be affected thereby, see *Rice v. Burt* (1879), 16 O. G. 1050.

CHAPTER V.

OF ASSIGNEES OF THE INVENTOR.

§ 408. Right to Apply for and Obtain Patent Assignable.

The right of an inventor to a patent is assignable, not only by himself to his immediate assignees, but by these in their turn unlimitedly to others.¹ Any person may be such assignee, even an infant or a married woman, and will hold the right subject to the provisions of the local law.² The capability of this class of property to be assigned, as well as the method and effect of the assignment are, however, under the entire control of the United States and rest upon the language and construction of the acts of Congress.³

§ 408. ¹ In *Selden v. Stockwell Self-Lighting Gas Burner Co.* (1881), 9 Fed. Rep. 390, Blatchford, J. : (396) "The defendant contends that the word 'assignee,' in the statute, means the immediate assignee, and not the ultimate assignee. . . . This is not the proper construction of the statute. The 'assignees' means the assignee in any degree and however remote. By section 4884 the grant is directed to be made to 'the patentee, his heirs or assigns.' This is not limited to the first assignee. So section 4898, in declaring that 'every patent, or any interest therein, shall be assignable,' and that 'the patentee or his assigns' may convey an exclusive right under the patent for the whole or any specified part of the United States, clearly means that an assignee in any degree is an assignee for all purposes. All parts of the statute are to be construed harmoniously in this respect, as there appears to be no good reason for a

contrary construction. It is true that section 4 of the Patent Act of February 21, 1793 (1 St. at Large, 322) used the words 'assignees of assigns to any degree;' but the absence of the words 'to any degree' cannot, in view of all the provisions of the present statute, be regarded as restricting the meaning of the word 'assignee.'" 19 Blatch. 544 (552); 20 O. G. 1377 (1378).

See also *Consolidated Electric Light Co. v. Edison Electric Light Co.* (1885), 23 Blatch. 412; 25 Fed. Rep. 719; 33 O. G. 1597.

That the assignee of two joint inventors becomes thereby the owner of a sole patent afterward issued to one of such joint inventors, see *Kohler v. Kohler* (1888), 43 O. G. 247.

² That a married woman, or an infant, or a ward, may be assignee, see *Fetter v. Newhall* (1883), 17 Fed. Rep. 841; 21 Blatch. 445; 25 O. G. 502.

³ That all rights of assignees rest on

§ 409. Right to Patent Assignable at any Stage of Inventive Act.

This right may be assigned at any stage of the invention. It is not essential that both conception and reduction be complete, and the concrete invention thus be ready for a patent. The idea of means may be developed and its embodiment imperfect or not yet begun; or the idea may still be general and indefinite; or the inventor may have gone no farther than to determine to attempt the creation of a means for the accomplishment of some desirable result; he yet has power to bind the future invention in his hands and make it in advance the property of whomsoever he may choose.¹ And such assignment will be valid, as between the parties to it, though no patent ever issue, whatever rights a subsequent inventor or the public may acquire.²

the statute, see *Suydam v. Day* (1846), 2 Blatch. 20.

The property of an inventor in his patented invention is divisible into (1) The invention, or the right to make, use, and sell the new art or instrument; and (2) The monopoly, or the right to exclude others from such making, use, or sale. The former exists from the moment the inventive act is completed, and may be enjoyed or disposed of by him as he pleases. Before his inventive act is finished no property in the invention can exist, but the proposed inventor may make contracts concerning it which will operate upon it when completed, and create rights in it which can be then enforced. The latter property exists only after the patent creating the monopoly is granted and until then cannot be enjoyed by the inventor or, in any proper sense, assigned to others. But as in the case of the invention he may bind it by contracts which become operative when the patent issues, and which derive their force partly from the doctrines of the common law and partly from the provisions of the statutes relating to the ownership of patents. In this chapter contracts which re-

late to the future ownership of the monopoly are alone considered, and these are called "assignments," in compliance with custom, though strictly they do not differ from any other agreements affecting prospective rights. Contracts concerning the invention only are hereafter discussed (§§ 806-834) under the name of Licenses. Conveyances of the patented invention are treated (§§ 752-805) under their proper title of Assignments. Conveyances of future patents are also referred to in §§ 368, *ante*, and 771, 772, *post*.

§ 409. ¹ That an assignment is good although the invention is not yet perfected, see *Bunker v. Stevens* (1885), 26 Fed. Rep. 245; 36 O. G. 345; *Continental Windmill Co. v. Empire Windmill Co.* (1871), 8 Blatch. 295; 4 Fisher, 428; *Opinion Atty. Gen.* (1859), 9 Op. At. Gen. 403.

That an assignment is good though the invention is not yet patented, see *Hammond v. Mason & Hamlin Organ Co.* (1875), 92 U. S. 724; *Kathbone v. Orr* (1850), 5 McLean, 131.

² That an assignment is good between the parties though no patent ever issues, see *Hammond v. Mason & Hamlin Organ Co.* (1875), 92 U. S. 724.

§ 410. Form of Assignment Immaterial.

No special form of such assignment is required by law. It may be oral or in writing; and if in writing it need not be under seal nor be recorded; and though recorded, the record gives it no additional validity.¹ The intention of the assignor to transfer the patent for the specific invention claimed under the assignment must appear; and in ascertaining this intention, the ordinary rules of construction are applied to the language of the instrument where the assignment is in writing, or the general designs, relations, and circumstances of the parties are considered where the conveyance has been oral.² Whatever expresses this intention is sufficient to create a title to the patent in the assignee.

§ 411. Assignment of Right to Patent Creates Equitable Title to Patent when Granted.

An assignment of the right to a patent is, in effect, a contract to assign the patent when issued, and as such is enforce-

§ 410. ¹ That the assignment of an unpatented invention may be oral as well as written, see *Burr v. De La Vergne* (1886), 102 N. Y. 415.

That the assignment of a future patent need not be recorded, and if recorded derives therefrom no additional validity, see *Wright v. Randel* (1881), 19 Blatch. 495; 21 O. G. 493; 8 Fed. Rep. 591.

That where the assignment requests the Patent Office to issue the patent to the assignee, the assignment must be recorded before the issue of the patent, see § 4895, Rev. Stat.

² That a deed conveying all the inventor's "property and estate whatsoever and wheresoever, of every kind and description" carries his inchoate rights in all unpatented inventions, see *Railroad Co. v. Trimble* (1870), 10 Wall. 367.

That an assignment of one patent "with all modifications, improvements, and re-issues" does not cover a later invention attaining the same end by different means, see *Stebbins Hydraulic*

Elevator Mfg. Co. v. Stebbins (1880), 17 O. G. 1348; 4 Fed. Rep. 445.

That an assignment of an imperfect invention, with all the improvements upon it that the inventor may make, is equitably a conveyance of the perfected results, and thus whoever receives the patent holds it in trust for the assignee, see *Littlefield v. Perry* (1875), 21 Wall. 205; 7 O. G. 964.

That a conveyance of all the inventions which the assignor may hereafter make will cover future inventions, see *Opinion Atty. Gen.* (1859), 9 Op. At. Gen. 403.

That an irrevocable power of attorney to control a patent is equivalent to an assignment, see *Hartshorn v. Day* (1856), 19 How. 211.

That an assignment entitling the assignee to have the patent issued to him must be a formal assignment of a completed invention, and not an agreement to assign future inventions, see *Runstetler v. Atkinson* (1883), 23 O. G. 940.

able in equity.¹ Of itself it creates no legal title to the patent, though when the patent issues and the assignment is recorded the legal title passes to the assignee unless superior rights would thereby be invaded.² Nor does it empower the assignee to take a patent for the invention in his own name, unless a provision granting that authority, and requesting the Patent Office to recognize it, is incorporated in the assignment.³ In the absence of this provision, and until perfected

§ 411. ¹ That an assignment of the patent privilege before the patent issues is a contract to assign the patent when issued, and creates an equitable title to the patent in the assignee, although the patent issue to the inventor, see *Aspinwall Mfg. Co. v. Gill* (1887), 40 O. G. 1133; *United States Stamping Co. v. Jewett* (1880), 7 Fed. Rep. 869; 18 Blatch. 469; 18 O. G. 1529; *Hammond v. Pratt* (1879), 16 O. G. 1235; *Littlefield v. Perry* (1875), 21 Wall. 205; 7 O. G. 964; *Newell v. West* (1875), 13 Blatch. 114; 9 O. G. 1110; 8 O. G. 598; 2 Bann. & A. 113; *Troy Iron & Nail Co. v. Corning* (1852), 14 How. 193; *Gayler v. Wilder* (1850), 10 How. 477.

That the equitable title in the assignee cannot prevail over the legal title of innocent *bona fide* purchasers from the inventor after the patent issues, unless in the assignment it was provided that the patent issue to the assignee, see *Davis Wheel Co. v. Davis Wagon Co.* (1884), 22 Blatch. 221; 20 Fed. Rep. 699; *Wright v. Randel* (1881), 19 Blatch. 495; 21 O. G. 493; 8 Fed. Rep. 591; *Gibson v. Cook* (1850), 2 Blatch. 144.

That an assignment of the entire right, before patent, entitles the assignee to a patent in his own name; but an assignment of a part interest, however large, does not give the assignee any legal claim to the patent, see *Opinion Atty. Gen.* (1859), 9 Op. At. Gen. 403.

That formerly patents could not issue to an inventor and an assignee jointly, but only to an inventor or an assignee

of the whole interest, see *Opinion Atty. Gen.* (1845), 4 Op. At. Gen. 399.

² That if the assignee of a future patent puts his assignment on record after the patent issues, the legal title will vest in him if there are no superior rights, see *U. S. Stamping Co. v. King* (1880), 7 Fed. Rep. 869; 18 Blatch. 469; 18 O. G. 1529.

That an agreement to assign becomes an assignment in fact as soon as the price is paid; and that the title is good in the assignee before the money has been paid, see *Hartshorn v. Day* (1856), 19 How. 211.

³ That an assignment of a future patent is a mere contract and that the patent cannot issue to the assignee unless the assignment so order, see *Hammond v. Pratt* (1879), 16 O. G. 1235.

That a parol assignment of a future patent neither gives the assignee a right to take out a patent in his own name, nor entitles him to be a joint patentee, see *Hammond v. Pratt* (1880), 16 O. G. 1235.

That a patent issuing to the assignee gives him the legal title, see *Perkins v. U. S. Electric Light Co.* (1883), 24 O. G. 204; 21 Blatch. 308; 16 Fed. Rep. 513.

That where an inventor assigns to A, A to B, and B to C, and all assignments are on record before the issue of the patent, if the patent issues to A the title vests at once in C, see *Consolidated Electric Light Co. v. McKeesport Light Co.* (1887), 44 O. G. 110; *Consolidated Electric Light Co. v. Edison*

by the vesting of the legal title, the rights of the assignee in the patent are thus merely equitable. He takes them subject to all prior equities, and, in his hands, they yield to any legal title subsequently acquired from the inventor by innocent *bona fide* assignees.⁴

§ 412. Assignment of Right to Patent does not Cover Extension.

Whether such an assignment covers the right to an extension, where the law concedes that privilege to the inventor, depends upon the character of the assignment.¹ Presumptively it relates only to the original patent, and hence the extension does not pass unless the express words or necessary implications of the contract require it.² But it is competent

Electric Light Co. (1885), 23 Blatch. 412; 25 Fed. Rep. 719; 33 O. G. 1597.

That oversights in the Patent Office cannot affect the title of the real owner of a patent, see Consolidated Electric Light Co. v. Edison Electric Light Co. (1885), 23 Blatch. 412; 25 Fed. Rep. 719; 33 O. G. 1597.

That a court of equity will not aid an inventor to obtain a patent in violation of his own agreements, see Runstetler v. Atkinson (1883), 23 O. G. 940.

⁴ That an assignee takes subject to all the legal consequences of the previous acts of his assignor, such as implied licenses, disclaimers, etc., see Blades v. Rand, McNally, & Co. (1886), 27 Fed. Rep. 93; McClurg v. Kingsland (1843), 1 How. 202; 2 Robb, 105. See also § 789 and notes, *post*.

That a contract to assign vests the right to the patent in the promisee, and his property therein cannot be affected by any subsequent licenses granted by the promisor, see Adams v. Bridgewater Iron Co. (1886), 26 Fed. Rep. 324.

§ 412. ¹ That the right to an extension, where the law allows extensions to be granted, may be assigned, see Prime v. Brandon Mfg. Co. (1879), 16 Blatch. 453; 4 Bann. & A. 379; New-

ell v. West (1875), 13 Blatch. 114; 9 O. G. 1110; 2 Bann. & A. 113; 8 O. G. 598; Gear v. Grosvenor (1873), Holmes, 215; 3 O. G. 380; 6 Fisher, 314; Nicholson Pavement Co. v. Jenkins (1872), 14 Wall. 452; 5 Fisher, 491; 1 O. G. 465; Clum v. Brewer (1855), 2 Curtis, 506; Day v. Candee (1853), 3 Fisher, 9.

² That the extension will not pass under a general assignment of the patent, but must be expressly granted, see Johnson v. Wilcox & Gibbs Sewing Mach. Co. (1886), 23 Blatch. 531; 27 Fed. Rep. 689; Waterman v. Wallace (1875), 13 Blatch. 128; Holmes v. Spaulding (1873), 4 O. G. 581; Gear v. Grosvenor (1873), 6 Fisher, 314; Holmes, 215; 3 O. G. 380; Mowry v. Grand St. & Newtown R. R. Co. (1872), 10 Blatch. 89; 5 Fisher, 586; Wetherill v. Passaic Zinc Co. (1872), 2 O. G. 471; 6 Fisher, 50; 9 Phila. 385; Jenkins v. Nicholson Pavement Co. (1870), 4 Fisher, 201; 1 Abbott U.S. 567; Goodyear v. Hullihen (1867), 3 Fisher, 251; 2 Hughes, 492; Goodyear v. Day (1856), 6 Duer, 154; Gibson v. Cook (1850), 2 Blatch. 144; Phelps v. Comstock (1848), 4 McLean, 353; Wilson v. Rousseau (1846), 4 How. 646; 2 Robb, 372; Brooks v. Bicknell (1845), 4 McLean, 64; Wilson v. Turner (1845), Taney,

for the inventor, if he wishes, to transfer not only the immediate right, but the remoter incidents; and where the language or the circumstances of his conveyance clearly indicate such an intention it will be effective to vest in the assignees all rights which the inventor might himself secure.³

278; *Woodworth v. Sherman* (1844), 3 Story, 171; 2 Robb, 257.

³ In *Hendric v. Sayles* (1878), 98 U. S. 546, Clifford, J.: (554) "Apt words are required, where the conveyance is of an existing patent, to show that the conveyance includes more than the term specified in the patent; but where the conveyance is of the invention, whether before or after the patent is obtained, the rule is otherwise, unless there is something in the instrument to indicate a different intention, — the rule being that a conveyance of the described invention carries with it all its incidents; and all the well-considered authorities concur that the inchoate right to obtain a renewal or extension of the patent is as much an incident of the invention as the inchoate right to obtain an original patent; and if so, it follows that both are included in the instrument which conveys the described invention without limitation or qualification. *Emmons v. Sladden*, 9 O. G. 354; *Gayler v. Wilder*, 10 How. 477; *Clum v. Brewer*, 2 Curt. C. C. 520; *Cannon v. Bowles*, 2 Bro. C. C. 84."

That an assignment of the entire invention and of all letters-patent that may be granted therefor, before a patent has issued, will carry the extension as well as the original privilege, see *Ruggles v. Eddy* (1872), 10 Blatch. 52; 5 Fisher, 581; *Nicholson Pavement Co. v. Jenkins* (1872), 14 Wall. 452; 1 O. G. 465; 5 Fisher, 491; *Railroad Co. v. Trimble* (1870), 10 Wall. 367; *Clum v. Brewer* (1855), 2 Curtis, 506.

That an assignment of the "invention," merely, does not carry an extension, see *Johnson v. Wilcox & Gibbs*

Sewing Mach. Co. (1886), 27 Fed. Rep. 689; 23 Blatch. 531.

That though an assignment of "said letters-patent" only carries the original privilege, an assignment of all "letters-patent that may be granted," will embrace an extension, see *Ruggles v. Eddy* (1872), 10 Blatch. 52; 5 Fisher, 581.

That an assignment of the "invention" for the "full term for which letters-patent may be granted" carries the extension, see *Gear v. Holmes* (1873), 6 Fisher, 595; *Nicholson Pavement Co. v. Jenkins* (1872), 14 Wall. 452; 1 O. G. 465; 5 Fisher, 491; *Ruggles v. Eddy* (1872), 5 Fisher, 581; *Thayer v. Wales* (1872), 5 Fisher, 448.

That a contract to convey an interest in letters-patent "to the fullest duration he is or may be entitled to" carries extensions, see *Chase v. Walker* (1866), 3 Fisher, 120.

That the conveyance of the patent and "any further patent," etc., carries an extension, see *Chase v. Walker* (1866), 3 Fisher, 120.

That the phrase "said letters-patent" may cover an extension, see *Chase v. Walker* (1866), 3 Fisher, 120.

That the word "renewal" means an extension, see *Pitts v. Hall* (1854), 3 Blatch. 201.

That an assignment of "all rights which may be secured to him from time to time" includes extensions, see *Railroad Co. v. Trimble* (1870), 10 Wall. 367.

That an assignment of "the invention" after patent issued does not carry the extension, see *Waterman v. Wallace* (1875), 13 Blatch. 128.

That an assignment of the entire "interest in letters-patent" for the full

§ 413. Assignment of Right to Patent Binding on Representatives of Deceased Inventor.

The obligations of this contract on the part of the inventor do not cease at his death. The right to the future patent still continues in the assignee, and if the assignment so provides and the invention is completed, the patent will be issued to the assignee upon the application of the personal representatives of the inventor. But where no such authority has been given to the assignee by the assignment, his rights are merely equitable, and can be enforced against the personal representatives of the inventor, by compelling them to procure the patent and perfect the title.¹ Unless the invention is completed before the death of the inventor, there is of course no patentable subject-matter, and the contract fails.

§ 414. Assignment of Right to Patent by Employee to Employer.

An employee may agree to devote his inventive faculties to the service of his employers, and thus confer upon them all the fruits of his inventive skill during the period covered by his contract.¹ But an agreement of this character must be

term for which they may be granted does not carry the extension, see *Gear v. Grosvenor* (1873), *Holmes*, 215; 6 *Fisher*, 314; 3 O. G. 380. But see note to this case in *Holmes*, 215.

That a grant of all the patents the grantor "has or intends to obtain" does not carry extended terms, see *Wetherill v. Passaic Zinc Co.* (1872), 6 *Fisher*, 50.

That an agreement of an inventor to assign to himself and another does not affect his extension, see *Johnson v. Wilcox & Gibbs Sewing Mach. Co.* (1886), 27 *Fed. Rep.* 689; 23 *Blatch*. 531.

For a general discussion of the right to an extension and the respective claims of executors, administrators, and assignees in reference thereto, see *Wilson v. Rousseau* (1845), 1 *Blatch*. 3; and same case (1846), 4 *How.* 646; 2 *Robb*, 372; especially the questions: 1. Whether an executor can have an extension; 2. Whether an extension, on

petition of an executor, enures to his benefit or that of assignees of the inventor; 3. Whether after a sale of the patent by his decedent, the executor can have an extension.

That where an assignee owning an extension assigns all his right, title, and interest, it will carry the extension, see *Ex parte Mason* (1872), 1 O. G. 357.

See also as to the assignment of an extension §§ 770, 779, 844, and notes, *post*.

§ 413. ¹ That an assignment of a future patent having been made by a deceased inventor, his personal representatives should obtain the patent and complete the legal title in the assignee, see *Newell v. West* (1875), 13 *Blatch*. 114; 9 O. G. 1110; 8 O. G. 598; 2 *Bann. & A.* 113.

§ 414. ¹ That an employee may assign his inventions to his employer, in advance of making them, and the inventions when made will equitably belong

unequivocal, and cannot be implied from a general bargain for his time and skill and labor, nor is it proved conclusively by the fact that the experiments resulting in the invention were made at the request and the expense of the employers.² But

to the employer, see *Continental Windmill Co. v. Empire Windmill Co.* (1871), 8 Blatch. 295 ; 4 Fisher, 428.

That where an invention has been made by a workman at the expense of his employer, who gave him extra wages on account of his skill as an inventor, the employer *prima facie* has a right to use it, see *Bensley v. Northwestern Horse Nail Co.* (1886), 26 Fed. Rep. 250 ; 36 O. G. 689.

That where an employee using the time and at the expense of the employer makes an invention, the employer may use it, see *Jencks v. Langdon Mills* (1886), 27 Fed. Rep. 622 ; 36 O. G. 347.

That when a workman is hired to invent, the employer will own the inventions which fall within the scope of the contract while the others will belong to the employee, see *Joliet Mfg. Co. v. Dice* (1883), 105 Ill. 649.

That an employee hired to assist an inventor in making improvements and to use his inventive skill for that purpose cannot claim, hold, or transfer to a person having knowledge of such contract, any invention so made against his employer, but the inventions are the property of the employer, and if patented by the employee a bill to compel their conveyance will lie, see *Annin v. Wren* (1887), 44 Hun, 352.

That an agreement between copartners that the firm is to have a joint right in any inventions made by either, is binding, and will cover inventions jointly made by a copartner and a third party at the firm's expense, see *Burr v. De La Vergne* (1886), 102 N. Y. 415.

² In *Hapgood v. Hewitt* (1882), 11 Bissell, 184, Gresham, J. : (186) "Persons are not deprived of their right to their inventions while in the service of

others, unless they have been hired and paid to exercise their inventive faculties for their employers. A contract by which one person agrees to pay a sum of money for the time, labor, and skill of another, for a given period, gives the employer no right to an assignment of a patent that is issued to his employee for an invention made during the period of his employment." 11 Fed. Rep. 422 (424) ; 21 O. G. 1786 (1786).

See also *Hapgood v. Hewitt* (1886), 119 U. S. 226 ; *Hall v. Johnson* (1883), 23 O. G. 2411 ; *Damon v. Eastwick* (1882), 14 Fed. Rep. 40 ; 22 O. G. 1709 ; 15 Phila. 506 ; *Whiting v. Graves* (1878), 13 O. G. 455 ; 3 Bann. & A. 222.

That a workman hired to perfect machinery, and bound to devote his skill and labor to his employer, is not obliged to abstain from taking patents for his inventions in his own name, though they are used by his employer, see *Green v. Willard Improved Barrel Co.* (1876), 1 Mo. App. 202.

That even though an employee is experimenting at the expense and request of his employer, his inventions are still his own, see *Dice v. Joliet Mfg. Co.* (1882), 11 Bradwell (Ill.) 109 ; *Damon v. Eastwick* (1882), 14 Fed. Rep. 40 ; 22 O. G. 1709 ; 15 Phila. 506.

That as between master and servant the inventor is the one who conceives the idea and reduces it to practice, see *Dice v. Joliet Mfg. Co.* (1882), 11 Bradwell (Ill.), 109.

That the making of the models by other servants of the employer does not show that he is the inventor, see *Dice v. Joliet Mfg. Co.* (1882), 11 Bradwell (Ill.), 109.

That a patent granted to one member of a firm is not partnership property,

such an agreement may be evidenced by circumstances ; and the conduct of the employee in permitting his employers to claim and treat the invention as their own may operate as an estoppel to prevent him from denying their asserted rights.³ An agreement of this nature relates only to the period of service, and inventions made prior to that period or after its expiration belong to the employee and are patentable by him alone.⁴

although the firm paid the patent fees and used the invention, see *McWilliams Mfg. Co. v. Blundell* (1882), 22 O. G. 177.

That a partner, merely as such, has no rights in an invention made by his copartner during the existence of the firm, although the invention is an improvement on machinery owned by the firm and is made with the firm means, and in time which by the partnership articles belonged to the firm, see *Burr v. De LaVergne* (1886), 102 N. Y. 415.

³ That where an inventor has allowed his employer or others to deal with his invention as their own, he may be estopped from claiming it, see *National Feather Duster Co. v. Hubbard* (1881), 11 *Bissell*, 76 ; 9 *Fed. Rep.* 558 ; 21 O. G. 635 ; *Dixon v. Moyer* (1821), 4 *Wash.* 68 ; 1 *Robb*, 324.

⁴ That when the term of hiring has expired, inventions thereafter made by the employee belong to himself alone,

or to his subsequent assignees, see *Appleton v. Bacon* (1862), 2 *Black*, 699.

By their contract with a workman his employers may acquire a right either to the ownership or to the use of his inventions. The law does not favor a claim of the employers to the former, and hence requires strict proof that by the agreement the employee intended to convey to them his future patented inventions both as to the invention itself and as to the monopoly created by the patent. On the other hand, a transfer to the employers of the right to use the invention is easily established and will generally be presumed whenever the workman has applied the invention to his employers' business without express contract and without demanding recompense until his term of service has expired. In examining the cases which relate to contracts of this character between masters and servants the distinction here alluded to must be kept in mind.

§ 414

END OF VOL. I.

E. J. O. A.
7/16/07

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THE LAW OF PATENTS.

THE
LAW OF PATENTS

FOR
USEFUL INVENTIONS.

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BOOK III.
OF LETTERS-PATENT.

VOL. II.—1

TREATISE

ON

THE LAW OF PATENTS.

BOOK III.

OF LETTERS-PATENT.

PRELIMINARY ANALYSIS.

§ 415. The Patent Privilege Created and Defined by the Grant of Letters-Patent.

THAT act of the government by which it confers on an inventor the right to the exclusive public use of his invention is the grant of letters-patent. Prior to this act, whatever right he has in his discovery is vested in him only by the law of nature, and is limited to the free use of his invention by himself, subject to its equally free imitation or re-invention by others. But by the grant of letters-patent his right to use becomes an exclusive one. While his own privileges in reference to the discovery are not enlarged, the privileges which the law of nature confers on other persons are suspended, and pending the term of his patent the whole control over the invention resides in him alone. The issue of a patent is therefore, to all intents and purposes, the creation of a new right in favor of the inventor, — the right to exclude all other persons from the use of the invention, — and bestows on him a true monopoly, whose character and extent, as well as duration, the government must specifically define. Of this exclusive privilege the letters-patent are at once the measure and the evidence. By them

the scope of the invention patented is conclusively determined, and the line drawn between those objects which lie open to unrestricted use and those which none but the inventor can lawfully employ. On them depend, on the one hand, the entire commercial value of the invention, with the consequent reward of the inventor, and on the other hand, the privileges still remaining in the public. Hence it becomes most important that in them the invention should be accurately pointed out, and that by them the rights of the inventor should be permanently established within the precise limits which the nature of his discovery and its position in the arts require.

§ 416. Patent Office Established to Secure the Issue of Legal and Correct Letters-Patent.

It is to secure this accuracy in the description of the invention in the letters-patent, and to fix this precise limit between the rights of the inventor and the public, that the Patent Office of the United States has been created. To this department of the government have been committed the interests of individual inventors as well as those of the whole community, so far as they depend upon the progress of the industrial arts. To it the inventor has recourse if he wishes for protection while completing his discovery and reducing it to practice. To it he applies, when his inventive act is finished, for the patent by which his monopoly is to be conferred. By it his application is examined, the novelty and utility of his alleged invention are determined, the language he has used in its description, or in the statement of his claims, is corrected and made to correspond with the real character of his invention, and the controversies between himself and rival inventors are decided. The proceedings necessary to the performance of these various functions and to the securing of these different results have developed, under successive acts of Congress and the decisions of the courts and the Commissioner, into an elaborate system of laws and regulations, in accordance with which all applications for letters-patent must be prepared, submitted, scrutinized, and granted or denied.

§ 417. Authority of Patent Office to Amend Defective Letters-Patent.

Notwithstanding all available diligence and skill on the part of inventors in describing their inventions, and all the care of the Patent Office in examining them, errors often occur in letters-patent, which, if allowed to remain and govern the reciprocal rights of the inventor and the public, would be productive of serious injustice. The law has therefore authorized the correction of these errors, even after the patent is issued by the government, and although it has controlled the relations of the inventor and the public for a long period of time. These errors result mainly from an excess in the description of the invention in the letters-patent, whereby the inventor has received a grant of the exclusive use of more than he has himself invented; or, on the contrary, from some omission or inaccuracy in the description, whereby the right secured by the patent is more limited than that to which the nature of his invention has entitled him. In either case, an application to the Patent Office for the amendment of his letters-patent becomes necessary,—an application which is always granted where the error has occurred without his own misconduct or neglect.¹

§ 418. Illegal Letters-Patent Repealed, not by Patent Office but by Courts.

The same power which can create a patent privilege can also, when it becomes necessary, destroy it. The authority to grant letters-patent when the required conditions are performed implies an authority to repeal them whenever it is ascertained that the grant had been improperly conferred. Thus, although the Constitution authorizes Congress only to secure to inventors their exclusive rights, yet it has always claimed and exercised the power to provide methods for invalidating its own grants upon discovering that the patentee had no right to retain them. This power, however, has not been confided to the Patent Office; for a patent, when once issued, passes beyond the control of that department, except for the purpose of amendment on the application of the

§ 417. ¹ See §§ 633-715 and notes, *post*.

patentee. All questions as to the repeal of patents fall within the jurisdiction of the courts of the United States, and the proceedings instituted for that object are regulated by the statutes or the general provisions of the law.¹

§ 419. Letters-Patent Interpreted by the Courts.

The grant of an exclusive privilege to an inventor creates a contract relation between himself and the public, the obligations of which, on both sides, are expressed in the letters-patent. A patent is thus a written agreement by which the rights and duties of the inventor on the one hand, and of the people at large upon the other, are defined. Like every other contract, the character and scope of these rights and duties depend upon the terms of the patent as interpreted by the courts, and this interpretation is governed by the same general rules which are applied in construing any written obligation between one party and another. Whatever may have been the real nature of the invention, or the true intention of the inventor in describing it, or even the limits which the Patent Office has attempted to establish for his exclusive rights, the monopoly actually secured by the patent is ascertained and determined by the judicial construction given to its various provisions. In the last resort the patent privilege is, therefore, measured by the judgment of the courts; and hence the legal doctrines applied in construing contracts are always to be borne in mind when the letters-patent, or the documents preliminary to them, are to be prepared.¹

§ 420. Rights Created by Letters-Patent Transferrable.

The right conferred by the grant of letters-patent is the right to the exclusive use of the invention during a specific period of time. This right differs, in some respects, from the right to the invention itself. The right to the invention vests in the inventor by virtue of his own creative act, and under existing laws includes the right not only to use it without a patent, but to obtain a patent for it, and under certain circumstances to procure an extension of that patent for an ad-

§ 418. ¹ See §§ 716-730 and notes, *post.*

§ 419. ¹ See §§ 731-751 and notes, *post.*

ditional term of years. The right created by the letters-patent is collateral to the right to the invention, and consists in the authority to prohibit other persons from making, using, or selling the patented art or instrument during the time named for the continuance of the monopoly. Like the right to the invention, however, this right may be transferred to others, either as an entirety or in subdivisions, and for such periods and upon such conditions as the inventor may desire. All these conveyances are limited in their effect by the interpretation given to the patent by the courts, and the titles of all who claim an interest in the patent relate back to the original letters-patent as the source from which they spring.¹

§ 421. **Extension of Letters-Patent: General Divisions of the Law Relating to Letters-Patent.**

From an early period the law has taken notice of the fact that during the original term for which the monopoly was granted the inventor may, from circumstances not within his own control, fail to obtain the entire recompense which he deserves; and it therefore has provided, sometimes in one method, sometimes in another, for the extension of the letters-patent after the first term has expired. This duty is also confided, wholly or in part, to the Patent Office; and when exercised completes the series of invaluable services which that department of the government has been empowered to render to the meritorious inventor.¹ Thus it appears that the provisions of Patent Law concerning those letters-patent by which the rights of the inventor and the public are defined, and the titles of the patentee and his transferees to the exclusive use of the invention are established, relate to six principal subjects: —

- I. The Grant of Letters-Patent.
- II. The Amendment of Letters-Patent.
- III. The Repeal of Letters-Patent.
- IV. The Construction of Letters-Patent.
- V. The Transfer of Letters-Patent.
- VI. The Extension of Letters-Patent.

§ 420. ¹ See §§ 752-834 and notes, *post.*

§ 421. ¹ See §§ 835-845 and notes, *post.*

CHAPTER I.

OF THE GRANT OF LETTERS-PATENT.

§ 422. Grant of Letters-Patent Governed by Statute and by Rules of Patent Office: Authority of such Rules.

The proceedings relating to the grant of letters-patent are regulated in part by the acts of Congress, and in part by rules established by the Patent Office itself. While the general features of these proceedings may properly be made the subject of permanent provisions in the statutes, their numerous and ever varying details can be controlled only by the vigilant and flexible authority of the department in which they arise. For this reason power has been conferred upon the Commissioner of Patents to adopt such regulations as he may deem expedient for the conduct of the business committed to his charge. These rules are subordinate to the statutes, and if inconsistent with them are invalid, but otherwise are of the same obligation as the acts of Congress.¹ Officers of the department, as well as parties and attorneys, are bound to recognize and follow them until duly repealed, and no departure from them, except in some case of necessity, is permitted.²

§ 422. ¹ That the Patent Office has power to make its own rules, and if these are consistent with the statutes, they are as binding as an act of Congress, see *United States v. Marble* (1882), 22 O. G. 1365.

That the rules of the Office as to the forms of papers, etc., must be complied with, see *Ex parte Mason* (1888), 43 O. G. 627.

That the Executive Department will not interfere with the regulations of the Patent Office, see *Opinion Atty. Gen.* (1869), 13 Op. At. Gen. 28.

That if inconsistent with the stat-

ute, the rule yields and the statute prevails, see *Stone v. Greaves* (1879), 17 O. G. 260.

² That the rules are binding until repealed, see *Smith v. Cowles* (1885), 30 O. G. 343; *Ex parte Smoot* (1877), 11 O. G. 1010.

That the rules are binding on the officers of the department as well as on the public, see *Brown v. La Dow* (1880), 18 O. G. 1049; *Ex parte Smoot* (1877), 11 O. G. 1010.

That the rules must not be departed from without necessity, see *Ex parte Skinner* (1881), 19 O. G. 662.

Changes in these regulations can be made at any time by the same authority which originally enacted them; and after such a change the new rule is to be obeyed even in pending cases, unless injustice will thereby be done to the contestants.³ In the absence both of a statute and a rule of the department, the Patent Office is governed by the principles which the courts apply to cases of a similar character.⁴

§ 423. Grant of Letters-Patent Illegal unless Statutory Prerequisites Fulfilled.

According to the acts of Congress and the rules of the Patent Office, certain preliminary steps on the part of the inventor are made essential to the granting of a patent. The bestowal of the patent privilege depends entirely upon the provisions of the statutes, and the conditions named therein must be fulfilled or the letters-patent will be null and void.¹ With these prerequisites the Patent Office has no power to dispense, though of their existence and sufficiency the Commissioner is in many cases the final judge; and that they did exist and were sufficient the issue of the letters-patent is always *prima facie* evidence.²

³ That there is no excuse for an officer who adheres to a practice after it has been overruled on appeal, see *Ex parte* Kitson (1881), 20 O. G. 1750.

That where new rules do not injure parties in pending cases they will be followed, see *Fowler v. Benton* (1880), 17 O. G. 266.

That the decisions of courts operate on all cases alike from the time they are rendered, while the rules of practice apply only to cases filed after their adoption, if they would prejudice the parties, see *Ex parte* Pfaudler (1882), 23 O. G. 269.

⁴ That where the same questions arise in the Patent Office as in the courts, they are governed by the same rules, see *Dana v. Greenleaf* (1875), 9 O. G. 198.

That the same rules as to the evidence establishing the fact of invention

are followed in the Patent Office and the courts, see *Chambers v. Duncan* (1876), 10 O. G. 787.

§ 423. ¹ That the right to letters-patent rests on the statutes, and the conditions authorizing their issue must be strictly fulfilled, see *Ex parte* Benton (1882), 23 O. G. 341; *Moffitt v. Gaar* (1860), 1 Bond, 315; 1 Fisher, 610; *Latta v. Shawk* (1859), 1 Bond, 259; 1 Fisher, 465.

² That the Patent Office cannot dispense with the legal prerequisites to a patent, see *Eagleton Mfg. Co. v. West, Bradley, & Cary Mfg. Co.* (1883), 111 U. S. 490.

That the patent is *prima facie* evidence that all prerequisites existed, see *Dorsey Harvester Rake Co. v. Marsh* (1873), 6 Fisher, 387.

That as to some prerequisites the decision of the Patent Office is final,

§ 424. Authority of the Commissioner, Acting Commissioner, and Examiners.

The principal officers of the government concerned in the granting of letters-patent are the Commissioner of Patents, the Acting Commissioner, and the various grades of examiners. As the Patent Office is a branch of the Department of the Interior, its general operations are under the supervision of the Secretary of that department, and he may require the Commissioner to perform the functions imposed upon him by the law.¹ The Commissioner is, however, practically at the head of the Patent Office. His powers are partly judicial, partly ministerial. As a judicial officer, he sits as a court of appeal in certain classes of contested cases.²

see *Hoe v. Cottrell* (1880), 1 Fed. Rep. 597.

See also §§ 451, 967, 1016, 1032, and notes, *post*.

§ 424. ¹ That the Commissioner acts under the supervision of the Secretary of the Interior, and may be required by him to perform his official duties, see *Dec. Sec. Int.* (1877), 12 O. G. 475.

That the duties of the Commissioner are of two classes: (1) those imposed on him by law; and (2) those imposed by rule of the department, see *Houston v. Barker* (1888), 44 O. G. 697.

That the Commissioner is subject to the control of the Secretary of the Interior only where he is not controlled by the statutes, see *U. S. v. Butterworth* (1884), 3 Mackay, 229; 27 O. G. 519.

That no appeal lies from the judicial acts of the Commissioner to the Secretary of the Interior, see *Houston v. Barker* (1888), 44 O. G. 697; *Butterworth v. Hoe* (1884), 112 U. S. 50; 29 O. G. 615; *U. S. v. Butterworth* (1884), 3 Mackay, 229; 27 O. G. 519.

That the Secretary has no appellate jurisdiction over the Commissioner as to the quasi-judicial duties imposed on him by law, and though he has authority to direct him to perform his duties, he cannot control the mode of their

performance unless they are merely ministerial, see *Houston v. Barker* (1888), 44 O. G. 697.

That the appellate jurisdiction of the Secretary is limited to cases arising under the rules prescribed by him for the government of his department, see *Houston v. Barker* (1888), 44 O. G. 697.

That where the Commissioner acquiesces in the decision of the Secretary he cannot treat it as a nullity when the Supreme Court afterwards decides that the Secretary had no power to act, see *Drawbaugh v. Blake* (1885), 30 O. G. 259.

That the Secretary will not interfere where the Commissioner has made every endeavor to be correct, unless there has been fraud or palpable error, see *Dec. Sec. Int.* (1883), 23 O. G. 629.

² That the Commissioner acts judicially in granting or refusing a patent, but is nevertheless bound by established rules and principles, see *Butterworth v. Hoe* (1884), 112 U. S. 50; 29 O. G. 615.

That the judicial powers of the Commissioner are chiefly as a court of appeal, see *Stone v. Greaves* (1880), 17 O. G. 397.

That the Commissioner is not to follow the decisions of lower tribunals

As a ministerial officer, he has jurisdiction over the whole matter of the examination of applications and the grant and issue of patents, but in the discharge of these ministerial duties he is subject to the statutes and the rules of the Office; and his powers cannot be extended beyond these, either by his own authority or by the construction of the courts.³ The Acting Commissioner is, for all legal purposes, the Commissioner himself; his jurisdiction cannot be collaterally attacked, and patents certified and allowed by him are of the same validity as those issued by the Commissioner in person.⁴ The examiners, with the exception of the Examiners-in-Chief, are appointed by the Commissioner, and are charged with various duties, especially those of correcting errors in the descriptions of alleged inventions contained in applications for letters-patent, of examining the novelty and utility of such inventions, and of hearing and deciding upon the claims of rival inventors. The functions of the other officers of this department are mainly clerical, and require no particular enumeration.⁵

if he thinks them erroneous, see *Sellers v. Walter* (1886), 37 O. G. 1001.

³ That the Patent Office in granting patents before 1836 acted ministerially rather than judicially: see Opinion Atty. Gen. (1831), 2 Op. At. Gen. 454.

That the ministerial jurisdiction of the Commissioner extends to the whole matter of examining applications and granting patents, see *Stone v. Greaves* (1880), 17 O. G. 397.

That the ministerial powers of the Commissioner cannot be extended by the courts, see *Child v. Adams* (1854), 1 Fisher, 189; 3 Wall. Jr. 20.

⁴ That the Acting Commissioner is, for all legal purposes, the Commissioner, see *Dorsey Harvester Rake Co. v. Marsh* (1873), 6 Fisher, 387.

That the clerk is Acting Commissioner when the Commissioner is sick or absent, see *Woodworth v. Hall* (1846), 1 W. & M. 389; 2 Robb, 517.

That the jurisdiction of the Acting Commissioner cannot be collaterally

attacked, and that his certificate is good between the parties, see *Woodworth v. Hall* (1846), 1 W. & M. 248; 2 Robb, 495.

⁵ That the duties of examiners are fixed by the Commissioner, see *Hull v. Com.* (1875), 7 O. G. 559; 2 MacArthur, 90.

See also § 51 and notes, *ante*.

For a discussion of the powers of the Board of Examiners, see *Ex parte Hull* (1875), 9 O. G. 1.

That an examiner cannot pass on any matter expressly decided by a superior tribunal, see *Ex parte Reynolds* (1883), 24 O. G. 993.

That the jurisdiction of an examiner does not change with the person of the incumbent, but remains unaffected until the case passes to a different tribunal or is ended, see *Ex parte Fredericks* (1887), 40 O. G. 691.

That the proceedings in the Patent Office are always presumed to be regular, see *Eagleton Mfg. Co. v. West*,

§ 425. Patent Solicitors and Attorneys.

The business between inventors and the Patent Office is usually transacted through attorneys. An inventor has the right to prepare his own application, and to appear and prosecute his claims in person; but in most cases by doing this he necessarily encounters great difficulties, arising partly from his ignorance of the requirements of the law, and partly from his inability to comply with them if they were known. A due regard for their own interests has led inventors to intrust such affairs to men trained for that purpose, and the practice has been encouraged by the Patent Office as tending to facilitate its own labors, as well as to render more secure the rights of patentees. All such attorneys act under the supervision of the Commissioner, and are subject to a withdrawal of their privileges for misconduct toward the Office or their clients. Their obligations to their employers and their authority and methods of transacting business are governed partly by the regulations of the Office, and partly by the ordinary rules of law.¹

§ 426. Applications: Caveats: Interferences.

The object of an inventor in endeavoring to procure a patent is twofold: (1) To secure for himself the grant of an exclusive privilege; (2) To prevent a similar grant to any rival applicant. To accomplish the first object he must file in the Patent Office an application in which he describes and claims a patentable invention resulting from his own creative act, and must support his application by an oath that he believes himself the first and true inventor of the art or instrument therein described. If the allegations of this application are, upon the customary examination in the Patent Office, found correct, his petition for a patent is formally allowed and in due course of proceedings the letters-patent will be issued, creating in him the desired monopoly.¹ The latter object, though a secondary one, is still of great import-

Bradley, & Cary Mfg. Co. (1880), 17 O. G. 1504; 18 Blatch. 218; 2 Fed. Rep. 774.

§ 425. ¹ See §§ 431-437 and notes, *post*.

§ 426. ¹ See §§ 449-585 and notes, *post*.

ancho. As every patent is *prima facie* valid, it clothes the patentee with a presumptive right to the exclusive use of the invention, and although issued to another than the real inventor, and therefore liable to be avoided by the courts, while it exists it constitutes a cloud upon the title of the true inventor, rendering his own letters-patent of doubtful validity even where it forms no obstacle to his procuring them. Methods have consequently been provided for the attainment of this as well as the first object. An inventor who is engaged in developing his conceptions or reducing them to practice, and is not yet prepared to make a formal application for a patent, may protect himself against the issue of a patent to his rival by filing in the Patent Office a notice called a *Caveat*, and maintaining it on file until his invention is completed and his own application is prepared.² Where his rival first appears after his own application has been presented to the Office, he can secure the adjustment of their conflicting claims, and, if he be the true and first inventor, the issue of the patent to himself and its refusal to his rival, by a proceeding known as an *Interference*.³ These three proceedings constitute the principal business of the Office in relation to the grant of patents.

§ 427. Patent Office Practice and Procedure.

In the conduct of these proceedings the Patent Office is guided not only by the acts of Congress and the written rules of the Office, but by its own established practice. In this tribunal, as in every other, statutes and rules receive a practical interpretation by their application to particular states of fact, and methods of procedure are extended or defined by usages subordinate to, but still beyond, the provisions of the written law. With the facility for reducing all such usages to formal rules which is afforded by the powers of the Commissioner, there is, however, less room for these judicial and traditionary regulations in the Patent Office than in most other bodies where conflicting claims are decided.

² See §§ 438-448 and notes, *post*.

³ See §§ 586-616 and notes, *post*.

§ 428. Patent Privilege Created at the Date of the Issue of the Letters-Patent: Mode and Conditions of Issue.

The final action of the Patent Office in the granting of a patent is the issue of the letters-patent to the inventor. Then, and then alone, does his title to the patent privilege become complete.¹ Neither the application, nor the admission of the novelty and utility of his invention by the examiners, nor the decision in his favor of any contest with rival claimants, establishes his rights as against the public. This can be done only by the actual issue of the letters-patent. The mode in which this issue shall take place, the form and contents of the instrument itself, the term which it shall specify as the duration of the monopoly, and the acts to be performed by the inventor on receiving notice of the grant, are all specifically prescribed by law.²

§ 429. Letters-Patent Grantable by Special Act of Congress.

In certain cases letters-patent may be granted without the intervention of the Patent Office. Instances arise where the merits of an inventor justly entitle him to the privileges of a patentee, although from peculiar circumstances his case is not within the jurisdiction conferred upon the Patent Office by the statutes. In such instances an application may be made directly to Congress itself, whose general powers under the Constitution enable it to secure to the inventor the exclusive use of his invention, in any manner and for any time which it may deem expedient. Patents thus granted fall under the general provisions of the law, except when otherwise specified in the act conferring them.¹

§ 428. ¹ That no legal title to the patent exists until the patent issues, see *Pontiac Knit Boot Co. v. Merino Shoe Co.* (1887), 31 Fed. Rep. 286.

² See §§ 617-632 and notes, *post*.

§ 429. ¹ The power of the Federal legislature, under the Constitution, to grant a monopoly to an inventor by special act has been repeatedly affirmed by the courts, and frequently exercised by Congress itself. The fact that the invention has already gone into ex-

tensive public use, or that a long period has elapsed since it was ready for bestowal on the public, or that an application to the Patent Office for a patent has been refused, may furnish a reason why Congress should decline to show this favor to the inventor, but in no wise restricts its authority to do so, should the measure seem expedient. Existing monopolies cannot in this manner be abrogated or curtailed; but with this limitation the action of Con-

§ 430. Grant of Letters-Patent: Subordinate Topics: Order of Discussion.

In considering the various rules relating to the grant of letters-patent, and the many subordinate and collateral topics which the general subject embraces, the following arrangement will be pursued:—

- I. Of Patent Attorneys, their Rights and Duties.
- II. Of Caveats and the Procedure thereon.
- III. Of the Form of the Application.
- IV. Of the Subject-Matter of the Application.
- V. Of the Description of the Invention.
- VI. Of the Claim.
- VII. Of the Drawings and Model.
- VIII. Of the Filing of the Application and Payment of Fees.
- IX. Of Procedure in Uncontested Cases.
- X. Of Procedure in Interference Cases.
- XI. Of the Form and Effect of Letters-Patent.

SECTION I.

OF ATTORNEYS.

§ 431. Relation of Patent Attorneys to the Patent Office.

An inventor may choose any person of intelligence and good moral character to act as his attorney in the prosecution of his application for a patent.¹ Over all such attorneys the Commissioner of Patents has a certain authority and he may pass upon their appointments and dismissals;² but the Patent Office is not responsible for their conduct toward their clients,

gress may be retrospective or prospective only, and may bestow on the monopoly such characteristics of duration and extent as the wisdom of the legislature may determine. See further on this subject §§46, 47, and notes, *ante*.

§ 431. ¹ That patent attorneys are not required to be learned lawyers, see *Osgood v. Badger* (1888), 44 O. G. 1065.

That no qualifications of age, sex,

or capacity are requisite to patent attorneys, see *Hoosier Drill Co. v. Ingels* (1879), 15 O. G. 1013.

² That the Commissioner may pass on powers and revocations of attorneys, see *Ex parte Morley* (1886), 37 O. G. 337; *Ex parte Pitney* (1880), 17 O. G. 447.

That patent attorneys are not agents of the Patent Office, see *Hoosier Drill Co. v. Ingels* (1879), 15 O. G. 1013.

nor will it aid inventors in selecting them. Nor are special privileges permitted by the Office to any one attorney over another; nor has one any more facilities for procuring patents than another, except such as arise out of his own superior diligence and skill.

§ 432. Patent Attorneys Appointed only by a Written Power.

An inventor can appoint an attorney only by a written power of attorney, and the Patent Office cannot recognize the attorney as such until the power of attorney has been duly filed in the department. This written power must be signed by the inventor or other proper applicant, and must name each and every person upon whom the attorneyship is to be conferred. A power of attorney given to a firm must thus specifically mention each member of the firm or it cannot be regarded as bestowing the required authority either upon the firm as a whole or upon any of the copartners. Any power of attorney may contain a written authorization, by virtue of which the original attorney may substitute another for himself, or may associate another with him; but such authorization will not empower the substitute or associate to delegate his authority to others.¹ The rules requiring and governing the power of attorney are stringent and universal, not even a member of Congress being allowed to examine patent cases, nor act in them, without first filing such written power.

§ 433. Authority of Attorney Revocable or Irrevocable: How Revoked.

A power of attorney may be either irrevocable or revocable. Where it constitutes part of a contract, in the fulfilment of which the attorney has a beneficial interest, it is irrevocable; although even in such cases the attorney is still, so far as the

§ 432. ¹ That an associate attorney cannot be appointed by the applicant without the consent of the regular attorney, see *Ex parte Ranks* (1887), 38 O. G. 329.

That an associate attorney should be appointed by the regular attorney upon the written authority of his client,

see *Ex parte Ranks* (1887), 38 O. G. 329.

That where an applicant appoints two or more attorneys he must designate with which the Office shall hold correspondence, otherwise it will recognize only the resident attorney, see *Ex parte Jewett* (1887), 38 O. G. 781.

application for a patent is concerned, the mere agent of his principal.¹ Unless the authority is thus irrevocable, it may be terminated by the client at his pleasure. In order to do this, he should give written notice of such revocation to the Patent Office; whereupon the Office will immediately notify the attorney, and thenceforth deal personally with the client, or with such other attorney as he may lawfully appoint. This notice puts an end to the authority of the attorney; and neither the Patent Office nor any contesting party to whom the notice of the revocation may be given is at liberty thereafter to recognize him as representing his former principal.² The death of the principal also terminates a revocable power of attorney; and where an applicant dies pending his application, his personal representatives must re-appoint the attorney, or ratify his former appointment, before he can be allowed to act for them.³ But the assignment, by an applicant, of an undivided interest in the invention will not revoke a previous power of attorney nor authorize the assignee to revoke it; though where a power of attorney is conferred before the application, and subsequently, but still before the application, the entire interest in the invention is assigned, the authority of the attorney of the assignor expires, and a new appoint-

§ 433. ¹ That when a power of attorney is part of a contract which creates a beneficial interest in the attorney, it is irrevocable, see *Ex parte Harrison* (1878), 13 O. G. 547.

That an attorney holding an irrevocable power is still the mere agent of his principal, see *Ex parte Cox* (1872), 2 O. G. 491.

That a power of attorney not coupled with an interest is revocable at will, see *Ex parte Morley* (1886), 37 O. G. 337.

² That an applicant can discharge his attorney on giving notice to the Patent Office without leave of the Commissioner, see *Hoosier Drill Co. v. Ingels* (1879), 15 O. G. 1013.

That notice to the Patent Office of revocation terminates the authority of the attorney and the right of the Office to deal with him as such, see *Ex parte*

Morley (1886), 37 O. G. 337; *Hoosier Drill Co. v. Ingels* (1879), 15 O. G. 1013.

That notice to the adverse parties of such revocation deprives them of the right to recognize him as attorney, see *Hoosier Drill Co. v. Ingels* (1879), 15 O. G. 1013.

³ That the death of an applicant revokes his power of attorney, see *Eagleton Mfg. Co. v. West, Bradley, & Cary Mfg. Co.* (1880), 18 Blatch. 218; 2 Fed. Rep. 774; 17 O. G. 1504.

That the former attorney of a deceased applicant has no power to amend the application after his death without the oath of the representative, see *Eagleton Mfg. Co. v. West, Bradley, & Cary Mfg. Co.* (1880), 18 Blatch. 218; 2 Fed. Rep. 774; 17 O. G. 1504. Affirmed s. c. (1883) 111 U. S. 490.

ment, or the ratification of the previous one, by the assignee is necessary.⁴

§ 434. Authority of Attorney Limited to the Application Accompanying the Power.

The relation created between the inventor and his attorney by the filing of the written power of attorney is neither permanent nor universal, but has reference only to the particular proceedings of which the power of attorney forms a part, and ends when that proceeding is concluded.¹ If several applications are instituted concurrently by the same inventor, a separate power of attorney must be filed in each, although in all the person of the attorney may be the same. For purposes of notice in certain cases, however, the Patent Office continues to recognize an attorney as a medium of communication with his client after the business for which he was appointed is completed.

§ 435. Authorized Attorney the Sole Medium of Communication between Patent Office and Inventor: his Rights and Duties.

After the filing of the written power of attorney in the Patent Office, all its correspondence with the inventor takes place through his attorney. The attorney has a right to inspect the papers in his case while in the custody of the Office, and is allowed to consult with the examiners and their assistants in regard to questions which arise concerning it in their departments. In all his dealings with the Patent Office he is required to conduct himself with courtesy and decorum; and written applications, arguments or other documents, containing anything in violation of this requirement, will ordinarily be returned to him without action. In his dealings with his client he is subject to the general rules of

⁴ That when an entire invention is assigned before application, and the attorney has received his power from the inventor alone, the power must be ratified by the assignee or a new attorney appointed, see *Ex parte Ackerman* (1880), 17 O. G. 1036.

§ 434. ¹ That the authority of an attorney is not continuous, but ends when the application ends, see *Hoosier Drill Co. v. Ingels* (1879), 15 O. G. 1013.

agency, and is obliged to use such skill and diligence as the nature of the business he has undertaken may demand.¹ But neither his culpable neglect nor his fraudulent conduct are allowed to prejudice his principal, unless they have been instigated or accepted by the principal himself, or unless vested rights or public interests would be unjustly violated were the acts of the attorney held invalid.²

§ 436. Compensation of Patent Attorneys: Lien on Letters-Patent.

The attorney of an inventor, like any other attorney, has a lien upon the papers of his client for his fees.¹ The letters-patent, when issued by the Office, are delivered to him if he so desires, and may be retained by him until his reasonable charges against the patentee for services and disbursements have been paid. The same privilege belongs to an associate or substitute attorney in reference to all papers properly coming into his possession, although the patent itself is not delivered to him by the Office without a special order from the primary attorney.

§ 437. Attorneys Disbarred by Commissioner for Cause.

The power of the Commissioner over the attorneys of inventors extends to their suspension or dismissal for gross misconduct, either toward the Patent Office or their clients. This power is conferred on the Commissioner by statute, and

§ 435. ¹ That a party is bound by the acts of his attorney, acting in good faith and within the scope of his authority, see *Ex parte Hatchman* (1884), 3 Mackay, 288; 26 O. G. 738; *Ex parte Hatchman* (1883), 25 O. G. 979.

² That delays fraudulently caused by his attorney do not prejudice the inventor, see *Case v. Hastings* (1875), 7 O. G. 557.

For some purposes the acts of the attorney bind his principal, even though involving a breach of duty or a want of professional skill. Where the interests of rival claimants are to be affected by a disavowal of the measures adopted

by the attorney, or where the public have availed themselves of the apparent abandonment of rights which greater vigilance or knowledge on the part of his attorney might have secured to the inventor, the principal is bound by the acts of his agent and must seek his remedy for the ignorance or neglect in the usual mode. Examples of the application of this rule will be observed in many cases hereafter cited, especially in reference to the subject of Re-issues.

§ 436. ¹ That an attorney, or a substitute attorney, has a lien on the papers of his client, see *Ex parte Bowers* (1879), 16 O. G. 1004.

its necessity is manifested by the frequency of the occasions which demand its exercise. The suspension or dismissal may be general, covering all present and future proceedings in which the attorney is or might be employed, or it may be particular, merely preventing him from acting in the special cases named. This power, however, is not arbitrary nor conclusive. A hearing upon formal charges, in pursuance of the usual judicial methods, is accorded to the attorney; and the order for his dismissal, with the reasons for it, must be submitted to and receive the approval of the Secretary of the Interior before it goes into effect.

SECTION II.

OF CAVEATS.

§ 438. Purpose of Caveat.

The purpose of a caveat is to secure to an inventor the opportunity to have the question of priority between himself and a rival inventor determined before the issue of letters-patent to either.¹ In the absence of such an opportunity the first applicant for a patent would receive the grant, although as a matter of fact he was not the earliest inventor. If subsequently to the issue of his patent the earlier inventor made his application, and successfully maintained his claim of priority, he would become entitled to, and would obtain, a patent also. Thus two outstanding patents for the same invention would exist, each vesting the exclusive right in a different patentee, — a condition of affairs endangering the value of the invention not only to the rival patentees but to the public, since the use of the invention under either patent is a *prima facie* infringement of the other. To prevent this difficulty as far as possible Congress in 1836 provided the present method of securing to inventors who may not be ready to present their own applications such timely notice of the pendency of

§ 438. ¹ That the object of a caveat (1859), 18 How. Pr. 7; 4 Blatch 362; is to protect the first conceiver, and 1 Fisher, 479; *Allen v. Hunter* (1855), secure him a proper notice of subsequent applications, see *Phelps v. Brown* 6 McLean, 303.

other applications covering the same invention as will enable them to make their claims and have them investigated by the Patent Office before any one receives the patent.

§ 439. Nature and Effect of Caveat.

A caveat is a written notice to the Patent Office that the caveator claims to be the first and true inventor of the art or instrument therein described. Its effect is to prevent the grant of a patent for the same alleged invention, without notice to the caveator, in case an application should be filed by another inventor during the life of the caveat. Thus it simply entitles the caveator to a certain notice. It does not afford him any protection against public use, nor supply the place of due diligence in perfecting his invention and reducing it to practice.¹ It gives him no advantage over any rival claimant, who may subsequently file a caveat or an application for a patent; nor does it impose upon him any obligation, either to present an application on his own behalf, or to oppose the issue of the patent to his rival.

§ 440. Who may File a Caveat.

No person is permitted to enjoy this privilege unless he is a citizen of the United States, or, if an alien, unless he has resided in this country for one year next preceding the filing of his caveat, and has formally declared his intention to become a citizen. He must also be the actual inventor of the art or instrument described in his caveat, and must believe himself to be its first inventor; and for reasons known to himself, but into which neither the Patent Office nor the law inquires, he must desire further time to mature his invention before filing his own application for a patent.¹

§ 439. ¹ In *Bell v. Daniels* (1858), 1 Bond, 212, Leavitt, J.: (218) "The effect of the caveat is to protect the claim of an inventor from all interfering applications made within one year after its filing, by requiring the Office to notify him of such applications, that he may resist the interference if he chooses. But if, during the time which elapses

between the filing of his caveat and his application he allows his invention to go into public use, his caveat will not protect him." 1 Fisher, 372 (377).

§ 440. ¹ That a caveat cannot be filed for a design as a design cannot exist at all until it is complete enough to be patented, see *Ex parte Carty* (1888), 44 O. G. 570.

§ 441. Contents of Caveat.

The caveat itself consists of a petition on oath, a specification, and in some cases a drawing. The petition alleges the citizenship or resident alienage of the caveator, his inventive act, and his desire to perfect his invention before applying for a patent, and prays that his accompanying specification may be placed on file in the Patent Office. The oath affirms the allegations of citizenship or residence, and the belief of the caveator that he is the first inventor. The specification embraces a description of the object of invention, and of its distinguishing characteristics. In this description the same particularity is not required as in that annexed to a petition for a patent; but it must be as complete and exact as the inventor is able to give, and must be precise enough to enable the examiners in the Office to determine whether an invention described in a subsequent application is probably the same. Any defect in this respect must be amended before the caveat can be accepted by the Office. The specification must also be limited to one invention, according to the rules established for the application for a patent; and if amendments offered describe a different or an additional invention they cannot be received, except as new and separate caveats. When practicable, a full and accurate drawing of the invention, executed upon some substance capable of being folded for convenient filing, should accompany the specification. The caveat must be signed by the inventor, although in caveats for joint inventions the signature of one inventor only is sufficient.¹ The established fee must also be forwarded with the caveat. A failure to comply with any of these requirements renders the caveat of no validity, and the caveator is not entitled to the notice which it is intended to secure.

§ 442. Filing of Caveat: its Secrecy.

On the receipt of the caveat by the Patent Office, in proper form, it is filed in the secret archives of the Office and there

¹ That a caveat for a joint invention may be signed by one of the inventors only, see *Ex parte Gray* (1877), 12 O. G. 396.

That a caveat and oath by one in-

ventor is no bar to an application by him and another as joint inventors if the mistake were *bona fide*, see *Hoe v. Kahler* (1882), 12 Fed. Rep. 111; 20 Blatch. 430.

remains during its life, inaccessible to all persons except the inventor, or his duly authorized agent, and the officers of the department. No information is permitted to be given to any others, either concerning its contents or the fact of its existence, unless by the direction of the caveator.¹

§ 443. Duration of Caveat.

A caveat, once filed, remains in force for one year from the date of its acceptance by the Patent Office. At the expiration of this term it may be renewed for another year by the payment of an additional fee; and so on from year to year during the pleasure of the caveator. If not renewed it still remains in the secret archives of the Office, although it ceases to secure any rights to the inventor.

§ 444. Notice of Subsequent Applications to Caveator: Proceedings Thereon.

Whenever an application for a patent for the same invention is filed by a rival inventor, either simultaneously with the caveat or during its life, and the invention described is found by the Office to be patentable and to correspond apparently with that specified in the caveat, proceedings on the application are suspended, the application with its specification, drawings, and model is deposited within the secret archives of the Office, and the caveator is notified to file his application for a patent in order that the rival claims may be determined. The caveator must thereupon present his application within three months from the expiration of the time regularly required for the transmission of such notice to him by mail from Washington; and if it then appears that the two applications claim the same invention an interference will be declared and the controversy heard and decided in the mode provided for that purpose.¹ This notice to the caveator

§ 442. ¹ That the rule requiring caveats to be kept secret is lawful, see Dec. Sec. Int. (1883), 23 O. G. 629.

That the fraudulent disclosure of a caveat to a rival applicant does not bar the right of the latter to a patent for the invention described and claimed in an application filed before the disclosure

was made, see *American Bell Telephone Co. v. National Improved Telephone Co.* (1886), 27 Fed. Rep. 663.

§ 444. ¹ In *American Nicholson Pavement Co. v. Elizabeth* (1873), 3 O. G. 522, Nixon, J. : (525) "The 12th section of the act of July 4, 1836, under which the foregoing caveat was filed,

it is the duty of the Commissioner to give; and if, through any fault or inadvertence in the Office, it should be omitted, or if the caveator should fail to receive it, and a patent for the invention issue to the applicant, the latter can take no advantage from his patent in any subsequent interference proceeding between himself and the caveator.² Although his

authorizes any person who shall have invented any new art, machine, or improvement thereof, and shall desire further time to mature the same, upon payment of twenty dollars, to file in the Patent Office a caveat, setting forth the design and purpose thereof, and its principal and distinguishing characteristics, and praying protection of his right till he shall have matured his invention. Such caveat is filed in the confidential archives of the Office and preserved in secrecy. The obvious design of this section is to afford to inventors the opportunity of perfecting their discoveries and inventions. To prevent an abuse of the privilege, it is further provided that if an application is made by any other person, within one year from the time of filing the caveat, for a patent of any invention with which it may in any respect interfere, it shall be the duty of the Commissioner to deposit the descriptions, specifications, drawings, and model, in the confidential archives of the Office, and to give notice by mail to the person filing the caveat of such application, who shall, within three months after receiving the notice, if he would avail himself of the benefits of his caveat, file his description, specifications, drawings, and model. If no such application is made, the caveator has a reasonable time in which to mature his invention or discovery; and when his letters-patent are issued, if he have used due diligence, he has the right to have his matured invention incorporated into his patent, and to supersede those that have intervened between the date of his first discovery and his subsequent

taking out of the patent." 6 Fisher, 424 (431).

² In *Frevert v. Gahr* (1873), 3 O. G. 660, Thacher, Act. Com. : (660) "The law, however, not only contemplates that notice shall be duly sent, but that it shall be received by the caveator; that he shall have no benefit of his caveat for which he has paid, which he cannot have if he does not receive notice of an interfering application. I do not mean to assert that the Office is bound to insure him notice, further than it does in ordinary cases, by duly mailing the notice and suspending the interfering application, as was done in this instance. But when it appears in proof as a matter of fact that the notice, through no fault of his, did not reach the caveator, then it follows that the patentee has obtained his patent without the proceedings in interference which the law contemplates shall be had in all cases of this nature. Whereas, if the notice had not failed to reach its destination, the parties would, in all probability, have come before the Office as applicants upon equal footing, as the law intends in such cases; now, by the fault of neither party nor the Office, the patentee, as such, has, upon the record, acquired an advantage. It cannot be ignored that his apparent advantage in this instance comes through a mere accident, and that if allowed its ordinary value the spirit of the law would obviously be subverted. Therefore I am not disposed to consider Gahr in any better position than he would have been had the interference been declared pending his application."

That it is the duty of the Commis-

patent cannot be recalled it will be regarded as surreptitiously obtained, and both the caveator and himself will be treated as standing on equal ground as rival applicants.³ But this rule in reference to notice applies exclusively to applications filed pending the caveat; of those which are already in the Office when the caveat is filed, and those which are presented after the life of the caveat expires, the caveator has no right to be informed, but must take the same chances concerning them as any other inventor.⁴

§ 445. **Caveat not to be Withdrawn: Copies: Amendments.**

A caveat, having been once filed in the Office, cannot be withdrawn by the caveator, either for the purpose of amendment or for any other purpose. Copies of it, or of its accompanying papers, may be obtained by him or his authorized agent in the usual manner; and any correction or addition which he may desire to make, if proper to be made at all, must be separately prepared and filed.

§ 446. **Caveat as Evidence: as Estoppel.**

A caveat is evidence of the date of the invention described therein, and may be used in certain cases as proof that the inventive act had been performed before the time when it was filed.¹ But unless necessarily inferred from the description given, it does not show that the invention was then completed; nor, on the other hand, does the statement in it that the caveator desires further time to mature his invention

sioner to give to the caveator the proper notice, and its accidental omission cannot prejudice his rights, see *Phelps v. Brown* (1859), 4 Blatch. 362; 18 How. Pr. 7; 1 Fisher, 479.

³ That a patent issuing on a subsequent application, without notice to the caveator, gives no advantage to the patentee, but as against the caveator he will still be treated as a rival applicant, see *Ware v. Bullock* (1874), 7 O. G. 39; *Phelps v. Brown* (1859), 4 Blatch. 362; 18 How. Pr. 7; 1 Fisher, 479.

That a patent issued on a subsequent application without notice to the caveator is "surreptitiously obtained," see *Phelps v. Brown* (1859), 4 Blatch. 362; 18 How. Pr. 7; 1 Fisher, 479.

⁴ That an application and a caveat being filed simultaneously by two different inventors, the caveator is entitled to notice, see *Ex parte Essex* (1876), 9 O. G. 497.

§ 446. ¹ See MS. cases cited in *Law's Digest*: title, *Caveat*. Also § 1015 and notes, *post*.

conclude him from averring that the art or instrument was at that time perfect and ready for a patent.²

§ 447. **Caveat not Assignable.**

The law makes no provision for the assignment of a caveat, or of the right to notice which it is intended to secure. The invention described therein may be transferred under such terms of contract as shall protect the assignee by obliging the inventor to proceed with his application, upon receiving notice, on behalf of the real owner of the invention; and the caveat may serve as a means for identifying the invention applied for with the invention so transferred.

§ 448. **Caveator not Concluded by his Description of the Invention.**

The description of the invention as given in a caveat is not conclusive upon the inventor or his assignee. It does not purport to be an account of a result accomplished, but of a result expected and desired; and, when attained, this result may vary in many particulars from the one foreseen by the inventor. While, therefore, as entitling him to a notice of subsequent applications, the caveat is taken according to the terms of the description, he is not estopped by it, when his invention is completed, from connecting with his perfect art or instrument the inventive act imperfectly delineated by him in the caveat. Having filed this as a matter of precaution, he may proceed with his experiments; and if he uses due diligence he may secure his matured invention by a patent, although other inventors have conceived the same ideas or successfully prosecuted the same experiments since the date of his original discovery.¹ In all such cases the question between him and his rivals is simply that of priority of invention, to be determined according to the principles already stated.

² That a caveat does not show whether or not the invention is perfected, see *Johnson v. Root* (1858), 1 Fisher, 351.

§ 448. ¹ That if the first conceiver, having filed his caveat, uses reasonable diligence in reducing to practice, he may protect his matured invention in his patent, see *American Nicholson Pavement Co. v. Elizabeth* (1873), 3 O. G. 522; 6 Fisher, 424; *Phelps v. Brown* (1859), 4 Blatch. 362; 18 How. Pr. 7; 1 Fisher, 479.

SECTION III.

OF THE APPLICATION: ITS FORM.

§ 449. Application for Letters-Patent Made by Whom.

An application for a patent must in all cases be made by the inventor, if living, whoever may by law be actually entitled to the ownership of the exclusive privilege when granted. A patent may be issued, as shown at length in the preceding Book, either to the inventor himself, his personal representatives, or his assigns; but the measures to obtain it must be originated by the inventor, unless this has been rendered impossible by his death. If he has died after completing the invention and without applying for a patent, the application must be made by his executor or administrator in the interest of his heirs or devisees or assignees, in whom, by law or by the act of the inventor, the right to the patent may be vested. An application for a patent for a joint invention must be made by all the joint inventors.

§ 450. Proper Applicant Determined from the Record Title in the Patent Office.

In receiving and examining applications the Patent Office deals only with those who appear, by the records of the Office, to be the proper applicants.¹ It has no jurisdiction over questions of title between rival claimants, and cannot undertake to make or alter or enforce the agreements of contending parties. It therefore recognizes the inventor as the only

§ 450. ¹ In *Ex parte* Edison (1875), 7 O. G. 423, Thacher, Com. : (424) "The issue before the Commissioner is, to whom shall the patents be granted? In determining this question, the Commissioner must be guided entirely by the record. He has not the authority of a court to consider evidence, outside the record, as to outstanding equities. The only question that he can decide is, who on the record possesses the *legal* title to these inventions? He must

issue the patents accordingly, if the requirements of the Office in such cases provided have been complied with."

That an application is evidence of the applicant's title, see Com. Dec. (1884), 26 O. G. 637.

That in issuing patents the Patent Office has no power to reform or cancel assignments or decide the equitable rights of parties on extraneous proof, but must follow the record title, see *Ex parte* Paine (1878), 13 O. G. 408.

party in interest, until by proof of his death and the presentation of the proper letters by his personal representative, the latter is substituted in his place, or until, by the filing and recording of an assignment, the assignee is made either the sole owner of the invention, or a joint owner with the inventor. Thus, although the application be originally made by the inventor, the person of the applicant, as known to the Patent Office, may be subsequently changed, either wholly or in part. By the death of the inventor, or by his assignment of the entire interest in the invention or in the future patent, he ceases to be known to the Office as an applicant, and his executor or administrator or the assignee is alone entitled to hold correspondence with the department concerning the invention; while if the assignment has transferred only an undivided interest in the invention or the patent, both the inventor and the assignee now constitute the applicant, and both are so regarded by the Office and must act jointly in the prosecution of their claims. Changes of this character may take place up to the date of the issue of the patent, and the patent will then be granted to whosoever may appear of record to be its proper owner.²

§ 451. Applications must Conform to Legal Requirements: if Granted, such Conformity Presumed.

Every application for a patent must conform in all respects to the requirements of the law.¹ The Patent Office has no power to dispense with any of them, however unessential they may seem to be.² Its own authority, as well as the rights of

² That an assignment filed of record after the final fee is paid will be considered in the Patent Office, see *Ex parte Paine* (1878), 13 O. G. 408.

That assignees of two joint inventors become thereby the owners of a sole patent afterward granted to one of the joint inventors and may control the application, see *Kohler v. Kohler* (1888), 43 O. G. 247.

§ 451. ¹ That all essential statutory prerequisites must be fulfilled or the patent will be void, see *Eagleton Mfg. Co. v. West, Bradley, & Cary Mfg. Co.*

(1884), 111 U. S. 490; 27 O. G. 1237; *Eagleton Mfg. Co. v. West, Bradley, & Cary Mfg. Co.* (1880), 18 Blatch. 218; 2 Fed. Rep. 774; 17 O. G. 1504; *Latta v. Shawk* (1859), 1 Fisher, 465; 1 Bond, 259; *Ransom v. Mayor of N. Y.* (1856), 1 Fisher, 252; *Child v. Adams* (1854), 1 Fisher, 189; 3 Wall. Jr. 20.

See also § 423 and notes, *ante*.

² That the Patent Office has no power to dispense with such prerequisites though the courts may have sustained patents not possessing them, see *Eagleton Mfg. Co. v. West, Bradley, &*

applicants, rests upon the provisions of the statutes, and is validly exercised only when such provisions are obeyed.³ But this rule is not pressed to an extreme against the interests of applicants. Where the applicant has in good faith complied with his own obligations under the direction of the Office, no error or neglect on its part can prejudice his rights.⁴ Moreover, from the granting of the patent the courts presume that all formal requirements have been fulfilled, and do not suffer this presumption to be disputed, except in some proceeding directly instituted to repeal the patent.⁵

Cary Mfg. Co. (1883), 111 U. S. 490 ; 27 O. G. 1237 ; *Ex parte* Heginbotham (1875), 8 O. G. 237.

³ In *Moffitt v. Gaar* (1860), 1 Bond, 315, Leavitt, J. : (317) "It is an undoubted truth that an inventor has no legal rights or immunities under a patent, except such as are conferred by the statute. With whatever solemnity or observance of legal form it may have issued, if wanting in any substantial statutory requisite, it is a nullity. And such defect is always available as a defence in a suit for an infringement." 1 Fisher, 610 (612).

That a patent is invalid unless the substantial legal requirements are complied with, though the patentee is innocent of bad intent, see *Ex parte* Benton (1882), 23 O. G. 341.

⁴ In *Commissioner v. Whitely* (1866), 4 Wall. 522, Swayne, J. : (532) "It is averred in the petition, and not denied in the answer, — and therefore, as in other like cases of pleading, to be taken as conceded, — that the application was filed with the acting Commissioner. It is also admitted in the answer that the requisite amount of fees had been paid by the relator, but it is added that it had not been placed to the credit of the Office, and was in the hands of the chief clerk, subject to the relator's order. The relator had done all in his power to make his application effectual, and had a right to consider it properly before the Commissioner."

That errors in the Patent Office, without the fault of the inventor, cannot affect his rights, see *Bignall v. Harvey* (1880), 18 O. G. 1275 ; 4 Fed. Rep. 334 ; 18 Blatch. 353 ; *Sayles v. Chicago & Northwestern R. R. Co.* (1865), 2 Fisher, 523 ; 1 Bissell, 468 ; *Phelps v. Brown* (1859), 1 Fisher, 479 ; 4 Blatch. 362 ; 18 How. Pr. 7 ; *Sparkman v. Higgins* (1846), 1 Blatch. 205.

That delays in the Patent Office, if not attributable to the negligence of the applicant, cannot affect his rights, see *Jones v. Sewall* (1873), 6 Fisher, 343 ; 3 Clifford, 563 ; 3 O. G. 630 ; *Johnsen v. Fassman* (1871), 1 Woods, 138 ; 5 Fisher, 471 ; 2 O. G. 94 ; *Dental Vulcanite Co. v. Wetherbee* (1866), 2 Clifford, 555 ; 3 Fisher, 87 ; *Sayles v. Chicago & Northwestern R. R. Co.* (1865), 1 Bissell, 468 ; 2 Fisher, 523 ; *Adams v. Jones* (1859), 1 Fisher, 527 ; *Rich v. Lippincott* (1853), 2 Fisher, 1.

That delays in the Patent Office, if acquiesced in by the applicant, may bar his rights, see *Bevin v. East Hampton Bell Co.* (1871), 5 Fisher, 23 ; 9 Blatch. 50.

⁵ In *Philadelphia & Trenton R. R. Co. v. Stimpson* (1840), 14 Peters, 448, Story, J. : (458) "It is a presumption of law that all public officers, and especially such high functionaries, perform their proper official duties, until the contrary is proved. And where, as in the present case, an act is to be done or patent granted upon evidence and

§ 452. Legal Requisites of Application.

An application for a patent, as well as all communications with the Patent Office concerning it, must be in writing; and if not correctly, legibly, and clearly written the Commissioner may require them to be printed at the cost of the party filing them. The application must be in the English language and be addressed to the Commissioner, and must include a petition, an oath, and a specification or Description and Claim

proofs to be laid before a public officer, upon which he is to decide, the fact that he has done the act or granted the patent is *prima facie* evidence that the proofs have been regularly made, and were satisfactory. No other tribunal is at liberty to re-examine or controvert the sufficiency of such proofs, if laid before him, when the law has made such officer the proper judge of their sufficiency and competency. It is not, then, necessary for the patent to contain any recitals that the prerequisites to the grant of it have been duly complied with, for the law makes the presumption; and if, indeed, it were otherwise, the recitals would not help the case without the auxiliary proof that these prerequisites had been, *de facto*, complied with. This has been the uniform construction, as far as we know, in all our courts of justice upon matters of this sort. Patents for lands, equally with patents for inventions, have been deemed *prima facie* evidence that they were regularly granted, whenever they have been produced under the great seal of the government, — without any recitals or proofs that the prerequisites of the acts under which they have been issued have been duly observed." 2 Robb, 46 (63).

That the decision of the Commissioner on the sufficiency of the applicant's fulfilment of the formal prerequisites to a patent is final, see Hancock Inspirator Co. v. Jenks (1884), 21 Fed. Rep. 911; Hoe v. Cottrell (1880), 1 Fed. Rep. 597; 18 O. G. 59; 17 Blatch.

546; 5 Bann. & A. 256; De Florez v. Reynolds (1878), 14 Blatch. 505; 3 Bann. & A. 292; United States Rifle & Cartridge Co. v. Whitney Arms Co. (1877), 14 Blatch. 94; 11 O. G. 373; 2 Bann. & A. 493; Tarr v. Folsom (1874), 5 O. G. 92; Holmes, 312; 1 Bann. & A. 24; McMillin v. Barclay (1871), 5 Fisher, 189; 4 Brews. (Pa.) 275; Seymour v. Osborne (1870), 11 Wall. 516.

That the issue of a patent is *prima facie* evidence that all prerequisites are complied with, see Konold v. Klein (1878), 3 Bann. & A. 226; Gear v. Grosvenor (1873), 3 O. G. 380; 6 Fisher, 314; Holmes, 215; Dorsey Harvester Rake Co. v. Marsh (1873), 6 Fisher, 387; Crompton v. Belknap Mills (1869), 3 Fisher, 536.

That a patent need not recite that all its prerequisites have been fulfilled, see Gear v. Grosvenor (1873), Holmes, 215; 6 Fisher, 314; 3 O. G. 380.

That a patent can be attacked on the ground of formal defects in the application or its prerequisites only by a *scire facias*, a bill in equity, or an information to set aside the patent, see Hoe v. Cottrell (1880), 18 O. G. 59; 17 Blatch. 546; 1 Fed. Rep. 597; 5 Bann. & A. 256.

That judgments by the Patent Office are *prima facie* only, not conclusive, see Wilson v. Barnum (1849), 2 Fisher, 635; 1 Wall. Jr. 347; 2 Robb, 749.

That the Patent Office is not estopped to deny the validity of its own grant, see McKnight v. Van Wagenen (1876), 9 O. G. 1161.

of the art or instrument for which a patent is desired. In certain cases it must be accompanied by drawings and a model or specimen of the invention. No application can be accepted by the Office for examination until it is complete in all its parts;¹ and where it has been signed or sworn to in blank or without actual inspection of the petition and specification, or has been altered or partly filled up after being signed or sworn to, it will be stricken from the files if such irregularity is discovered before the patent is delivered.²

§ 453. The Application-Petition: its Requisites.

The petition is a communication addressed to the Commissioner and duly signed by the applicant, requesting the grant of letters-patent for the invention described in the application. It must state the name and residence of the petitioner, and in its designation of the invention must contain words of reference to the specification for a fuller disclosure thereof.¹ It should also set forth the person on whose behalf the application is made and to whom the patent is desired to issue; declaring whether it be to the applicant himself, or whether, in case of a previous assignment, it be to the assignee of an entire interest alone, or jointly to the assignee of a part interest and the applicant.

§ 454. The Application-Oath: By and Before Whom Made.

The oath of the applicant is one of the most important portions of his application.¹ Being in many cases conclusive as

§ 452. ¹ That there can be no patent without an application, see *Railway Register Mfg. Co. v. Broadway & Seventh Ave. R. R. Co.* (1886), 26 Fed. Rep. 522; 34 O. G. 921; *Eagleton Mfg. Co. v. West, Bradley, & Cary Mfg. Co.* (1884), 111 U. S. 490; 27 O. G. 1237.

That an examiner should refuse to act unless there is a proper application before him on which to act, see *Ex parte Benton* (1882), 23 O. G. 341.

² That a blank application and oath signed and forwarded to Washington to be filled up does not comply with the law, and a patent granted thereon

is invalid, see *Ex parte Benton* (1882), 23 O. G. 341.

That the applicant must sign his first name in full, see *Ex parte Gentry* (1888), 44 O. G. 822.

§ 453. ¹ That the petition for a patent must so refer to the specification that the patent prayed for may be identified, see *Ex parte Mason* (1888), 43 O. G. 627.

§ 454. ¹ In *Ex parte Heginbotham* (1875), 8 O. G. 237, Spear, Act. Com.: (237) "The oath is a prerequisite to the granting of a patent. It was so held by Judge Story in the very case

to the facts therein alleged, it must conform strictly to the requirements of the law.² It must be made by the inventor, if alive, or if he be dead, by his personal representative.³ It can be taken before any person in the United States authorized by law to administer oaths; or, when the applicant resides in a foreign country, before any minister, *chargé d'affaires*, consul, or commercial agent holding commission under the United States, or before any notary public, — the oath being in all cases attested by the official seal of the officer administering it.⁴

§ 455. **The Application-Oath: its Averments.**

This oath may be in the usual form of an oath, or in that of an affirmation. The applicant must swear that he does verily believe himself to be the original and first inventor of the art or instrument for which he desires a patent; that he does not know and does not believe that the same was ever before known or used; and that the invention has not been in public use nor on sale in the United States for more than two years preceding the date of the present application.¹ He must

in which he held the patent valid, notwithstanding the informality of the oath (*Whittemore v. Cutter*, 1 Gall.), and other courts have found the same; but, because the courts have sustained patents where some of the prerequisites to their granting have been ignored or dispensed with by the Office, it by no means follows, as contended by the present applicant, that it is a matter discretionary with the Commissioner."

That the oath is not a mere formality, but is necessary and gives *prima facie* validity to the patent, see *Ex parte Eaton* (1873), 4 O. G. 525.

That no patent can issue without the application-oath, see *Opinion Atty. Gen.* (1820), 1 Op. At. Gen. 332.

² That the oath, being often conclusive, must be made strictly according to law and before the proper officer, see *Warnant v. Warnant* (1880), 17 O. G. 265.

That the oath need not be dated, see *French v. Rogers* (1851), 1 Fisher, 133.

That the oath need not be in writing, see *Hancock Inspirator Co. v. Jenks* (1884), 21 Fed. Rep. 911.

³ That the application-oath must be made by the applicant, not by his agent or attorney, see *Opinion Atty. Gen.* (1861), 10 Op. At. Gen. 137.

⁴ That an oath in a foreign country to an application can be taken only before an officer designated under section 4802, there being no authority to take an oath except by statute, and the laws of a foreign country having no force as against the statute, see *Ex parte Gruson* (1884), 26 O. G. 274.

§ 455. ¹ That the oath must aver that the invention has not been in public use or on sale in this country for more than two years before the application, see *Ex parte Rowan* (1882), 22 O. G. 1037; *Ex parte Livingston* (1881), 20 O. G. 1747.

Whether the phrase "with the consent and allowance" of the inventor

also aver his citizenship and place of residence, and disclose the names, numbers, and dates of any foreign patents he may have obtained for the same invention.² This oath relates to the entire specification, and must be true concerning each and every portion of it, but does not include the model, in the construction of which parts may become necessary of which he is not the first and original inventor.³ It is also limited in its effect to the invention thus described, and with each amendment of the specification by which new matter is introduced as part of the original invention a new oath must be filed.⁴

§ 456. The Application-Oath : its Truth or Falsehood.

The averments of this oath concerning the originality of the invention relate only to the belief of the inventor, and the oath is not, therefore, a false one, nor the patent based thereon illegally obtained, though it be subsequently discovered that the invention has been previously known. But an oath wilfully false concerning the citizenship of the applicant, or any other matter made essential by the statutes, is a fraud

can properly be inserted in this averment must depend on the interpretation of the law of Abandonment as discussed in §§ 357, 358, and notes, *ante*.

That the oath must aver that the inventor does not believe that the invention was ever known or used before his inventive act, see *Ex parte Rowan* (1882), 22 O. G. 1037.

² That the applicant must disclose under oath all his foreign patents for the same invention, see *Ex parte Mason* (1888), 43 O. G. 627 ; Opinion Sec. Int. (1882), 21 O. G. 1197 ; *Ex parte Bland* (1879), 15 O. G. 828.

That the rule requiring disclosure of the date of foreign patents is reasonable, see *U. S. v. Marble* (1882), 22 O. G. 1365 ; and is authorized by Sec. 4887, Rev. Stat., see *Ex parte Touffin* (1879), 15 O. G. 657.

That the disclosure of foreign patents must be definite and in the usual form, see *Ex parte Mason* (1888), 43 O. G. 627.

³ That the oath applies to and covers the entire specification, see *Ex parte Eaton* (1873), 4 O. G. 525 ; *Hogg v. Emerson* (1848), 6 How. 437 ; 2 Robb, 655.

That the oath must cover every feature claimed, see *Ex parte Clark* (1886), 36 O. G. 120 ; *Ex parte Foster* (1885), 33 O. G. 113.

That the oath does not relate to the model, see *Ex parte Eaton* (1873), 4 O. G. 525.

That an oath on a joint application relates to the whole, not to separate parts of the invention, see *Tieman, Simpson, & Collins* (1877), 11 O. G. 1.

That an application-oath relates only to the claimed inventions, for which a patent is solicited, see *Ex parte Crandall* (1886), 35 O. G. 625 ; *Drawbaugh v. Blake* (1883), 23 O. G. 1221.

⁴ For the form and other requisites of the amendment-oath, see § 561 and notes, *post*.

upon the government, and renders the patent void.¹ After the patent issues, however, the Patent Office has no jurisdiction over it, and cannot entertain the question whether the oath were true or false.²

§ 457. The Application-Oath : how far Conclusive.

The oath is in all cases *prima facie* evidence that the applicant is the first and true inventor, and in uncontested cases in the Patent Office is conclusive upon all the matters to which it relates. Where rival applications are filed, each containing the same oath made by its own applicant, the contradictory affidavits nullify each other, and the question is open to further proof without bias toward either party.¹ The averments of the oath concerning the grant of foreign patents for the same invention to the applicant add nothing to the force of the oath as evidence of the originality of his invention.²

§ 456. ¹ That a false oath of citizenship is an irremediable defect and avoids the patent, see *Child v. Adams* (1854), 3 Wall. Jr. 20 ; 1 Fisher, 189.

² That after a patent has once issued the Patent Office cannot inquire whether the application-oath were true or false, see *Ex parte Gillen* (1877), 11 O. G. 419.

§ 457. ¹ In *Little v. Lillie* (1876), 10 O. G. 543, Duell, Com. : (544) "When an application is made the party is required to make oath that he verily believes himself to be the first and original inventor ; and this is received as evidence of the fact, and renders the patent, when granted, *prima facie* evidence that the patentee is the first and original inventor. (*Philadelphia & Trenton Railroad v. Stimpson*, 14 Pet. 456 ; *Corning v. Burden*, 15 How. 270 ; *Parker v. Stiles*, 5 McLean, 60.) When, however, a party claims an invention which is described and may be claimed by another applicant or patentee, the oath of one nullifies that of the other, and it becomes a mat-

ter for further proof as to which one is, in contemplation of law, the first and original inventor. It is for this purpose that an interference is declared, not to determine the patentability of the invention, but whether the party claiming it is the person designated by the statute as the originator of the invention. This distinction is observed throughout all the statutes on this subject."

See also *Bartholomew v. Sawyer* (1859), 1 Fisher, 516 ; 4 Blatch. 347.

² That the affidavit of an applicant concerning his foreign patents is only presumptive evidence that he is the real inventor, see *Ex parte Nagel* (1880), 17 O. G. 198.

That the oath of an applicant that another had obtained a patent in England for the *same* invention, as one communicated to him, is conclusive evidence that the applicant is the sole inventor until the contrary appears, see *Von Alteneck v. Thomson* (1880), 17 O. G. 571.

§ 458. **The Application-Oath: Letters-Patent not Invalidated by its Omission.**

Although the oath is one of the essential portions of the application, and cannot be dispensed with by the Patent Office, yet a patent granted without an oath is not on that account invalid.¹ The presumption that all things were rightly done in the department is sufficient to sustain it in all suits, except those which are instituted directly for its repeal.²

SECTION IV.

OF THE APPLICATION: ITS SUBJECT-MATTER.

§ 459. **Subject-Matter of Application must be a Patentable Invention.**

The subject-matter of the application for a patent must be a patentable invention. It must be a concrete art or instru-

§ 458. ¹ In *Crompton v. Belknap Mills* (1869), 3 Fisher, 536, Clark, J. : (541) "Suppose the oath was not taken, would the patent be void on that account? It was held otherwise by Justice Story, in the case of *Whittemore v. Cutter*, ¹ Gall. 429. The taking of the oath, though to be done prior to the granting of the patent, is not a *condition precedent*, failing which the patent must fail. It is the evidence required to be furnished to the Patent Office that the applicant verily believes he is the original and first inventor of the art, etc. If he takes this oath, and it turns out that he was not the first inventor or discoverer, his patent must fail and is void. So, if he do not take it, and still he is the first inventor or discoverer, the patent will be supported. It is *prima facie* evidence of the novelty and originality of the invention until the contrary appear. *Parker v. Stiles*, 5 McLean, 60. So the act says, on payment of the duty, — that is, fees, —

the Commissioner shall make an examination, and, if the invention shall be found useful and important, shall issue a patent. Suppose the fee should not be required or paid, would the patent, therefore, be void? Yet the one requirement appears to be as much a condition precedent as the other. Both directory, not to be dispensed with; but neither involving the validity of the patent when granted."

See also *Hartshorn v. Eagle Shade Roller Co.* (1883), 18 Fed. Rep. 90; 25 O. G. 1191; *Dyer v. Rich* (1840), 1 Met. 180; *Whittemore v. Cutter* (1813), 1 Gallison, 429; 1 Robb, 28.

² That an oath will be presumed from the grant of a patent, see *Hoe v. Kahler* (1885), 25 Fed. Rep. 271; 34 O. G. 127; affirming s. c. in 20 Blatch. 430; 12 Fed. Rep. 111.

That there is no presumption that the records of the Patent Office show all that was done, see *Hoe v. Kahler* (1885), 25 Fed. Rep. 271; 34 O. G.

ment, embodying an idea of means conceived by the creative faculties of the inventor, belonging to one of the six classes enumerated in the statutes, and being new, useful, and not already abandoned by the inventor to the public.¹ For nothing less than this can any valid patent be granted; and, of course, for nothing less can any application for a patent be entertained. These characteristics of a patentable invention have been sufficiently discussed, and therefore here demand only this passing reference. There are, however, a few additional provisions of the law, particularly relating to the scope of an application for a patent, which require our present notice. These may be grouped into: (1) Rules which compel an applicant to limit his application by the Claims of patents

127; affirming s. c. in 20 Blatch. 430; 12 Fed. Rep. 111.

That the recital in a patent that the oath was taken is conclusive until fraud is shown, though the patent issues on an amended application, see *Hancock Inspirator Co. v. Jenks* (1884), 21 Fed. Rep. 911; *Seymour v. Osborne* (1870), 11 Wall. 516.

§ 459. ¹ In *Starr v. Farmer* (1883), 23 O. G. 2325, Teller, Sec. : (2327) "The question whether an invention has been perfected and is capable of useful operation has to be determined in the consideration of every application for a patent; for until a conception has been shown to be complete and capable of useful adaptation, requiring no further invention to make it practically operative, a patent therefor cannot be legally issued. To provide the means from which the Commissioner of Patents may decide upon the patentability in this respect of a discovery, the law prescribes that an applicant for a patent shall file a written description of the invention, and of the manner and process of making, constructing, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains to construct and use the same;

and he is further required to illustrate it by drawings. Patents are constantly issued for inventions the utility and completion of which are not shown otherwise than by the specifications and drawings, the cases being exceptional in which the applicant is required to present an operative model to demonstrate his discovery. Where an original discoverer has made a formal application for a patent in conformity with the requirements of the law, has furnished a description of the invention, which with the drawings and the model, if required by the Commissioner, is a sufficient disclosure to a person skilled in the art of the practical utility of an invention which in other respects is patentable, and has evinced by diligent prosecution of his application a faith in its importance, it is not necessary, to entitle him to be considered an inventor, that he shall prove actual reduction to practice. It is enough, if he has shown, in the manner prescribed in the law, that the invention is perfect and capable of useful operation."

That where the invention is obviously impracticable the application must be rejected, see *Ex parte De Bausset* (1888), 43 O. G. 1583.

that he has previously obtained ; and (2) Rules which govern the joinder of separate inventions in a single application.

§ 460. Subject-Matter must not be an Invention already Patented in the United States by the same Inventor.

Two patents cannot be granted by the United States to the same inventor for the same invention. Its power to create a monopoly is exhausted by the first grant, and hence the later patent must be absolutely void.¹ That the application on which the later patent is based was of earlier date than that in pursuance of which the first patent issued is immaterial.² The government, having once conferred upon the inventor all it had to bestow in reference to that invention, cannot add to his exclusive privilege by a repetition of its granting act ; and therefore, where the scope of both the earlier and the later patents is the same, the former is the only one by which the rights of the inventor are secured. And since no application for a patent can be proper where the patent, if allowed, would be invalid, an application for a patent for any invention covered by a previous patent to the same inventor is prohibited.

§ 461. Subject-Matter may be an Invention already Patented in the United States by a Rival Inventor, or in a Foreign Country by the same Inventor.

This rule applies, however, only where the same inventor seeks an additional patent from the United States. The later

§ 460. ¹ That there cannot be two concurrent American patents to the same inventor for the same invention, and that where two such patents are issued the last is void, see *McMillin v. Rees* (1880), 1 Fed. Rep. 722 ; 17 O. G. 1222 ; 5 Bann. & A. 269 ; *Ex parte Locke* (1879), 16 O. G. 1140 ; *Ex parte Langlois* (1878), 14 O. G. 84 ; *Ex parte Cottrell* (1876), 9 O. G. 495 ; *Jones v. Sewall* (1873), 3 O. G. 630 ; 3 Clifford, 563 ; 6 Fisher, 343 ; *Suffolk Co. v. Hayden* (1865), 3 Wall. 315 ; *Treadwell v. Bladen* (1827), 4 Wash. 703 ; 1 Robb, 531 ; *Morris v. Huntington* (1824), 1 Paine, 348 ; 1 Robb, 448 ; *Odiorne v. Amesbury Nail Factory* (1819), 2 Mason, 28 ; 1 Robb, 300 ; *Barrett v. Hall* (1818), 1 Mason, 447 ; 1 Robb, 207.

² That a later patent to the same inventor is void, though its application were earliest, see *McMillin v. Rees* (1880), 1 Fed. Rep. 722 ; 17 O. G. 1222 ; 5 Bann. & A. 269.

application of a rival inventor assumes that no monopoly has been created in favor of his adversary by the former patent, that patent being invalid because granted to one who was not, as the law requires, the original and first inventor.¹ The application of the same inventor for a re-issue of his former patent, so amended as to protect his actual invention, is merely an endeavor to secure in express terms the privilege which the government has already ambiguously bestowed.² And where the same inventor who has obtained a patent from a foreign state subsequently makes an application for a patent in the United States, the monopoly he seeks is one essentially distinct in territorial limits from that which he has previously received, and therefore one which may yet be conferred upon him by the government within whose gift it still resides.³ It is when the granting of a patent on the present application would be the mere empty repetition of the granting act, as distinguished from the clearer definition of a monopoly already in existence, and from the creation of a new monopoly either in favor of the same inventor or his rival, that the application is improper and must on that account be refused.

§ 461. ¹ That a patent issued to a rival inventor is no bar to a later one to the true inventor, see *Hibbard v. Richmond* (1880), 17 O. G. 1155.

That where two patents to different inventors cover the same general invention the later will, if possible, be construed to claim only the new matter appearing therein, see *Richardson v. Noyes* (1876), 10 O. G. 507.

² That upon the surrender of a former defective patent a later one may be granted and be valid, see *Jones v. Sewall* (1873), 3 O. G. 630 ; 3 Clifford, 563 ; 6 Fisher, 343.

³ That a prior foreign patent does not invalidate though it limits the term of a subsequent American patent, see *Dolbear v. American Bell Telephone Co.* (1888), 126 U. S. 1 ; 43 O. G. 377.

That a prior foreign patent does not prevent the issue of a broader American patent, see *Faure v. Bradley* (1888), 44 O. G. 945.

That the grant of surreptitious foreign patents to others cannot affect the rights of the real inventor in the United States, see *Kendrick v. Emmons* (1875), 2 Bann. & A. 208 ; 9 O. G. 201.

That under section 8, act of 1836, no American patent could be granted if the foreign patent issued more than six months before, see *Cornely v. Marckwald* (1883), 17 Fed. Rep. 83.

That a foreign patentee seeking an American patent is not compelled to adhere to the precise subject-matter of his foreign patent, see *Ex parte Siemens* (1877), 11 O. G. 969.

§ 462. Subject-Matter must not Include Inventions already Patented in the United States by the same Inventor.

An application which, together with new matter, includes matter already patented in the United States by the same inventor is within this rule, as well as one whose scope corresponds exactly with that of the preceding patent.¹ An inventor who devises an improvement to his own patented invention cannot apply for and obtain a patent for the whole invention as improved, but only for the new development of his original idea.² The inventor of a combination, the elements of which are already protected by his previous patents, cannot obtain additional protection for those elements by claiming them in his application for a patent for the combination. In both these instances, as in all similar ones, it may be necessary to the comprehension by the public of his last invention that the former should be fully described in the new application, but the application itself must so distinguish the earlier invention from the later that it shall clearly appear to be an application for a patent only for the last invention.

§ 463. Subject-Matter may be a New Use of an Invention already Patented in the United States by the same Inventor.

An application for a patent for a previously patented invention by the same inventor, on the ground that new uses for it have been discovered since the issue of the former patent, is also forbidden by this rule.¹ All uses to which an invention can be put, whether by its inventor or by others, without an additional exercise of inventive skill, are covered by the original patent for that invention, even although such uses were unknown when the patent issued; and hence another patent, based upon such uses, would be a simple duplication

§ 462. ¹ That no patent with generic Claims can be granted after one with a Claim for the species, see *Ex parte Upton* (1884), 27 O. G. 99; *Ex parte Holt* (1884), 29 O. G. 171.

² That an inventor may patent an improvement on his own invention, see *O'Reilly v. Morse* (1853), 15 How. 62.

§ 463. ¹ That a second patent cannot issue for the same invention though used for separate purposes, see *McComb v. Brodie* (1872), 5 Fisher, 384; 2 O. G. 117; 1 Woods, 153.

See also §§ 259-271 and notes, *ante*.

of the grant. Where a new use for the invention is discovered by the exercise of the inventive faculties of the same or other inventors, the new use is itself a new invention, and if possessing all the other statutory requisites, it may be patented as a new art or combination in which the old invention is employed as an instrument, or as an elemental means; but it adds nothing to the patentable character of the original invention, nor does it constitute any ground for the protection of that invention in another patent. Here, also, the application for a patent for the new art or combination may have occasion to describe the former invention in order to convey an adequate idea of the new use which is to be the subject of the future patent; but the distinction between the old invention and the new must be apparent on the face of the application, and a patent for the latter only must be claimed.

§ 464. Subject-Matter must not be an Invention already Patented in the United States by the same Inventor, although his Former Patent is Inoperative and Invalid.

An application for a new patent by the same inventor where his previous patent, although not covering his entire invention, is capable of being re-issued so as to afford it a complete protection, is within this rule. An important difference must be here remembered between an invention as it appears upon the face of a patent and as it exists practically in the arts. Some concrete inventions are simple units, the result of a single inventive act, not separable into distinct patentable parts, and any patent for such an invention must either protect the whole product of the inventor's skill or fail to protect anything whatever. Other concrete inventions consist of parts, each of which is an independent invention and separately patentable; and a patent for the entire invention may be valid and sufficient although its inventor makes no attempt to protect therein the individual inventions of which it is composed. Only a patent for an invention of the former class can properly be brought within this rule. A patent for a simple unitary invention, if properly expressed, protects everything that the inventor has invented, and any failure to secure to

him the entire monopoly to which he is entitled can be cured by a correction of its verbal ambiguities. It is an act of the government bestowing a particular exclusive privilege, and although the limits of that privilege may be uncertain on account of some defect in the language by which it is described, the grant is an effectual one, and cannot be repeated however it may need to be defined.¹ Hence an amendment of the patent by re-issue is not only a sufficient remedy for the inventor, but it is all the remedy to which, in accordance with the theories that underlie the Patent Law, he is entitled.

§ 465. Subject-Matter may be an Integral Part, or a Combination, of other Inventions already Patented in the United States by the same Inventor.

On the other hand, where a concrete invention is composed of parts each of which is the result of a separate inventive act, it is optional with the inventor either to protect all these inventions by a single patent or to apply for and obtain different patents for the several subordinate inventions. If in his first application for a patent he endeavors to secure protection for all, and if in his first patent the government evidently confers upon him a monopoly as to all, however imperfectly the grant of the monopoly may be expressed, no new application for a patent for any of them can be entertained; and the inventor must avail himself of his right to a re-issue, or remain without remedy.¹ But if the inventor has attempted in his former application only to procure a patent for the concrete invention as a whole, or for some one or more of its several

§ 464. ¹ In *Ex parte Roberts* (1887), 40 O. G. 573, Hall, Com.: (574) "Where the invention is one, integral, and indivisible, whether it relates to different parts of a single organization or combination, or process and product, or genus and species, a prior patent which claims or covers part of the whole invention, in legal contemplation takes the whole invention out of the field of patentability, whether the subsequent applicant be the original patentee or some other person."

Further, that a new patent cannot cover matter inseparably involved in the matter claimed in a former patent, see *Railway Register Mfg. Co. v. Broadway & Seventh Ave. R. R. Co.* (1886), 26 Fed. Rep. 522; 34 O. G. 921; *Ex parte Holt* (1884), 29 O. G. 171; *Ex parte Ransom* (1884), 39 O. G. 119.

§ 465. ¹ That a patent for parts of a previously patented invention is void if the prior patent attempted to claim such parts, see *Stow v. Chicago* (1877), 3 Bann. & A. 83; 8 Bissell, 47.

parts, the monopoly which he has received is limited to these results of his inventive skill, and all other results are still proper subjects for new applications and new patents, unless he has meanwhile abandoned them to the public.² That in his former patent he described these other inventions as elements of the one then patented, or as associated with it in that concrete invention in which all unite, cannot affect his right to base on them new applications and new patents.³

² That a combination and its elements are distinct inventions, and a patent for the former does not cover the latter, see *Rowell v. Lindsay* (1885), 113 U. S. 97; 31 O. G. 120; *Corn Planter Patent* (1874), 23 Wall. 181; 6 O. G. 392.

That unless abandoned by two years' public use and sale a sub-combination may be covered by a later patent, see *Cahn v. Wong Town On* (1884), 9 Sawyer, 630; 19 Fed. Rep. 424; 27 O. G. 299.

That separate parts of the same invention may be separately patented, see *Jones v. Sewall* (1873), 3 Clifford, 568; 6 Fisher, 843; 3 O. G. 630.

³ It has been sometimes held that no new patent could be granted for an invention described but not claimed in a former patent, and that the only mode of bringing such unclaimed inventions within the protection of the law is by a re-issue of the former patent. Thus in *Mathews v. Flower* (1885), 25 Fed. Rep. 830, Brown, J.: (830) "If it were true that complainants had previously obtained a patent for the same invention secured to them by the patent in suit, and that this prior patent had expired, it would doubtless be a complete answer to this bill, since a man cannot have two patents for the same invention. *James v. Campbell*, 104 U. S. 356; *Suffolk Co. v. Hayden*, 3 Wall. 315; *Morris v. Huntington*, 1 Paine, 348. And this disability extends, not only to what is

claimed in the first patent, but to that which is described therein as the patentee's invention. If a man cannot have a patent for what another has claimed or described in a prior patent, much less can he have one for what he himself has claimed or described; for he thus shows that he has anticipated himself. *James v. Campbell*, 104 U. S. 356, 382." 33 O. G. 887 (887).

In *Ex parte Long* (1883), 25 O. G. 1189, Marble, Com.: (1190) "An applicant is entitled to fully describe, show, and claim his invention; but having shown and described it in a patent he has no right to thereafter file an application and obtain a patent for subject-matter shown and described in such patent. If he have any remedy in such case it is by re-issuing his patent. In *Ex parte Atwood* (C. D., 1869, p. 98), Mr. Commissioner Fisher said: 'When an application is filed every invention contained in that application must be patented under it or under such division of it as the wishes of the applicant and the rules of the Office may permit.' Since said decision the practice of the Office has been uniform in requiring an applicant, if he desires to obtain a patent for subject-matter shown and described in his application, but not properly patentable therein, to file another application for such matter during the pendency of the former application. This practice has been sustained by the courts, and none other seems to have been adopted or insisted

Being entitled under the law to a monopoly for each invention, he cannot be precluded from receiving it by anything

upon until the present time. An applicant has the right to file his application and claim so much of his invention as he wishes or sees fit; but he has no right to reserve a portion of it, and thereafter claim such reserved portion, and thus, in fact, extend the life of his patent. If this could be done, the actual term of a patent would not be seventeen years, but a longer term. A party cannot prevent abandonment by simply stating that he does not abandon a certain invention. Abandonment is always a question of fact. Parties are presumed to intend what they do, and if they expressly reserve, or by oversight or negligence fail to claim, subject-matter shown and described in a patent, the presumption is that they intend to abandon it, especially if they do not file an application therefor prior to the issuance of the patent wherein it is shown and described."

See also *Swift v. Jenks* (1887), 29 Fed Rep. 642; 38 O. G. 1017; *Hill v. Commissioner* (1885), 4 Mackay, 266; 33 O. G. 757; *Ex parte Derby* (1884), 26 O. G. 1208; *Ex parte Hill* (1883), 24 O. G. 1176; *Marvin v. Lillie* (1867), 27 O. G. 299.

These cases, except the last, base their assertions upon a hasty and mistaken interpretation of *Campbell v. James* (1882), 104 U. S. 356; 21 O. G. 337. The passage usually quoted in support of this position does at first blush, perhaps, appear to sustain it. But more careful scrutiny would have shown that the learned Justice employed the words "embraced or described" as synonymous with "patented" and "claimed;" and would further have disclosed the following statement on page 370 (104 U. S.), which places the whole doctrine in its proper light: "If he was the author of any other invention than that which

he specifically describes and claims, though he might have asked to have it patented at the same time and in the same patent, yet if he has not done so, and afterward desires to secure it, he is bound to make a new and distinct application for that purpose and make it the subject of a new and different patent." That this is the true construction of this entire decision, see *Vermont Farm Machine Co. v. Marble* (1884), 27 O. G. 621; 22 Blatch. 32; 19 Fed. Rep. 307.

But apart from authority this doctrine is manifestly incorrect in principle, as well as inapplicable in practice. For were it true, every intentional omission to claim any invention which the application had described would operate as an abandonment of the invention to the public, since no intentional omission can be cured by a re-issue; and thus an applicant would be compelled to claim every invention which a proper delineation of his principal invention required him to disclose, whatever violations of the rules of joinder he might thus commit, or however premature the submission of the invention to the public as a practically operative means might be. To avoid this dilemma, a qualification has been introduced into the doctrine, permitting a subsequent patent for inventions described but not claimed in the former patent, provided a reservation of the right to apply for and obtain the subsequent patent were inserted in the former, and the later application were filed within a reasonable time after the issue of the prior patent. This modification of the doctrine is discussed and sustained in *Ex parte Roberts* (1887), 40 O. G. 573, by Hall, Com.: (573) "It is undoubtedly true that when a patent issues for an invention, all of which is shown but only part of which is claimed,

short of its bestowal on him by the government, or by his abandonment of the invention to the public; and until one or

there is a dedication to the public of that part which is unclaimed. In such case the law conclusively infers an intention to make the dedication, and the inference cannot be overcome by evidence; the applicant, however, always has it in his power, in a certain class of cases, to prevent this inference from arising if he acts in time. In cases which are divisional, -- that is, when, as in the present case, the features not claimed in the first application are independent of those claimed, -- an applicant may expressly assert in his application a reservation of his right to claim them in another or subsequent application, and he should present and prosecute such application without delay. He may also file his second application so as to have it pending concurrently with the first. Such course anticipates and prevents the inference of dedication. This proposition is fully sustained by many authorities."

See also *Adams v. Bellaire Stamp- ing Co.* (1886), 28 Fed. Rep. 360; 36 O. G. 567; *Ex parte Derby* (1884), 26 O. G. 1208; *Ex parte Rohn* (1883), 25 O. G. 1190.

But even with this qualification the doctrine is not in harmony with the general spirit and theory of the Patent Law, nor with the requirements of inventors and the public. The general theory of the Patent Law contemplates every invention as a separate entity, wholly independent of every other invention, and entitled to a distinct monopoly if it possesses the necessary attributes of a patentable invention. That in the application for a patent for a different invention it may become expedient to describe this also cannot affect its patentable character, nor does it raise a conclusive presumption of abandonment. If such description is followed by a

two years' public use or sale, or is coupled with any other circumstances indicating a dedication of the invention to the public, the right to a monopoly will be lost; but this loss is not occasioned by the previous description of the invention in the former patent, nor by the failure to reserve the invention for a future patent, these being but single links in the chain of facts from which an intention to abandon is inferred. Moreover it is to the advantage both of the inventor and the public that he should be entirely free to patent his inventions separately and in such order as his inventive prudence may suggest, since on the whole it is far more probable that he will bestow the invention on the public as soon as it is ripe for beneficial use, than that after disclosing it in the description of a former patent he should withhold it after it becomes available for their employment and his own profit. Thus as no evil can result to the community by the application to his described but not claimed inventions of the same rule of reasonable diligence which governs cases of re-issue and other cases arising under the common doctrine of abandonment, the consistency of the law would seem to require that matter described but not claimed in a former patent may be the subject of a later patent unless it has been in some manner already dedicated to the public. This is the position maintained in *Vulcanite Paving Co. v. American Artificial Stone Paving Co.* (1887), 42 O. G. 828; *Wilson v. Cubley* (1886), 26 Fed. Rep. 156; 35 O. G. 257; *Ex parte Holt* (1884), 29 O. G. 171; *Vermont Farm Machine Co. v. Marble* (1884), 19 Fed. Rep. 307; 27 O. G. 621; 22 Blatch. 32; *Graham v. McCormick* (1880), 11 Fed. Rep. 859; 21 O. G. 1533; 10 Bissell, 39; 5 Bann.

the other of these events has taken place his application must be entertained and his claim for an exclusive privilege be

& A. 214; *Graham v. Genova Lake Crawford Mfg. Co.* (1880), 11 Fed. Rep. 138; 21 O. G. 1536.

In *Ex parte Holt* (1884), 29 O. G. 171, are discussed three classes of cases:—

1. Those holding that no patent can issue for an invention actually covered by a former patent though the terms of their Claims may differ, viz., *Sickels v. Falls Co.*, 4 Blatch. 508; *O'Reilly v. Morse*, 15 How. 62; *Odiorne v. Amesbury Nail Factory*, 1 Robb, 300; *Smith v. Ely*, 5 McLean, 76.

2. Those where the second patent contained a broad or generic Claim covering the more specific matter protected by the former patent, viz.: *Jones v. Sewall*, 3 Clifford, 575; *James v. Campbell*, 104 U. S. 356; 21 O. G. 337; *McKay v. Jackman*, 22 O. G. 85, overruling *McKay v. Dibert*, 19 O. G. 1351; *Ex parte Atwood*, C. D. 1869, 98; *Ex parte Lowe*, C. D. 1870, 39; *Ex parte Hyde*, C. D. 1871, 100.

3. Those where the new patent covers matter described in the prior patent but essentially distinct and separable from anything claimed therein. Concerning the latter cases, *Dyrenforth*, Act. Com., says: (177) "It has, it is true, been held that a person can independently patent that which has been shown and described but not claimed in a previous patent upon a concurrent application. Authorities upon this subject are, *The Suffolk Co. v. Hayden* (3 Wall. 315); *Singer & Clark v. Braunsdorf and Weil* (7 Blatch. 521); *McMillen et al. v. Reese et al.* (17 O. G. 1222); *Graham v. McCormick et al.* (11 Fed. Rep. 859); *Hatch v. Moffit* (15 Fed. Rep. 252); *Ex parte Emerson* (17 O. G. 1451); *Ex parte Derby* (26 O. G. 1208). These cases, however, are easily distinguishable from the case

of *James v. Campbell* and that here involved. In all of them that which was independently patented was either a distinct and separate part of the invention or a distinct improvement thereon. It was not substantially the same thing comprehended in the first patent. There was not a mere distinction of breadth or scope of Claim. The remedy where a broad Claim is omitted is pointed out in the *Derby* case, *supra*."

In the first and second of these classes the later patent, so far as it covers the matter protected by the former patent, must be absolutely void; and if the new matter is inseparable from that already patented, the whole grant must fail. In such cases no reservation in the former patent can aid the inventor, but as *Dyrenforth*, Act. Com., in the same decision remarks: (177) "It is clear that if the law prohibits a separate patent for anything but a distinct and separate part of the thing invented, the applicant may not evade the prohibition by reserving the broad claims by a statement in his specific patent; he cannot reserve that which the law forbids him to reserve."

That reservation clauses tend to mislead the public and should not be allowed in applications, see *Ex parte Blair* (1888), 43 O. G. 113.

That where the subject-matter is properly divisible the inventor may file his separate applications at any time without any reservation clause, and each will be judged on its own merits, see *Ex parte Blair* (1888), 43 O. G. 113.

That where the subject-matter is not divisible the second application must be filed while the first is pending, that both may be adjudged together, see *Ex parte Blair* (1888), 43 O. G. 113.

That where one application fully dis-

recognized. To compel him in such cases to have recourse to a re-issue would not only be contrary to the fundamental ideas on which the doctrine of re-issue rests, but would deprive him of a greater or less portion of that term for which the law provides that his monopoly shall endure.

§ 466. Subject-Matter may be an Invention Dependent on or Collateral to an Invention already Patented in the United States by the same Inventor.

Again, this rule does not apply to cases where the same inventive act produces two concrete results, each of which is a separate patentable invention. A single exercise of the inventive faculties may produce both a process and its product, a machine and the manufacture it creates, a composition of matter and the art by which it is applied to its intended use. In all such cases, if the inventions are truly separable, the inventor is entitled to a monopoly for each, although neither could have been discovered and been made available without the other.¹ A patent for but one, though it may necessarily

closes the invention claimed in the other, cross-references should be inserted in each to distinguish one from the other, see *Ex parte Blair* (1888), 43 O. G. 113.

That a description in a prior patent without a Claim of the invention is not a bar to a subsequent patent, if the second application is made within two years, see *Eastern Paper Bag Co. v. Standard Paper Bag Co.* (1887), 41 O. G. 231; 30 Fed. Rep. 63.

See also § 352 and notes, *ante*, and § 506 and notes, *post*. The doctrine stated in §§ 687-692 and notes, *post*, in reference to re-issues is equally applicable to the present subject, since any patentable matter which could be inserted in a re-issue may, if constituting a complete invention in itself, be protected by a separate patent.

§ 466. ¹ That a process and its product may be separately patented, see *Ex parte Lupton* (1874), 5 O. G. 489 ;

Jones v. Sewall (1873), 3 Clifford, 563 ; 3 O. G. 630 ; 6 Fisher, 343 ; *Brass Co. v. Miller* (1871), 5 Fisher, 48 ; 9 Blatch. 77 ; *Goodyear v. Providence Rubber Co.* (1864), 2 Clifford, 351 ; 2 Fisher, 499.

That no patent can be granted for the product after one for the process from which that product necessarily results, the second patent being in effect a duplication of the first, see *Ex parte Holt* (1884), 29 O. G. 171.

That a patent having issued for a product as made by a certain process, a later patent cannot be granted for the process which results in the product, see *Mosler Safe & Lock Co. v. Mosler* (1888), 127 U. S. 354 ; 43 O. G. 1115.

That a machine and its product may be separately patented, see *Ex parte Lupton* (1874), 5 O. G. 489 ; *Brass Co. v. Miller* (1871), 5 Fisher, 48 ; 9 Blatch. 77.

That where a patent has been granted

describe the other, is thus no hindrance to an application for a patent for the unsecured invention ; but the new application must be judged according to its own intrinsic merits, as if no previous patent had been granted.²

§ 467. Subject-Matter must not be an Invention already Claimed in a Pending Application by the same Inventor.

The rules which in this manner limit the scope of applications by the monopolies previously granted to the same inventor define the relations which two or more applications by the same person must sustain toward each other. As two patents cannot be granted to the same inventor for the same invention, so two applications attempting to secure patents for the same patentable subject-matter are equally objectionable. An inventor, having prepared and filed an application for a patent, cannot file another application for the same concrete invention, except as an amendment to the former, unless he first withdraws from the earlier the matter which he wishes to incorporate into the later.¹ This, for some purposes to be

for a machine which produces a certain article, a subsequent patent cannot be granted for the article, though it might have been covered by the machine-patent, see *Excelsior Needle Co. v. Union Needle Co.* (1885), 32 Fed. Rep. 221.

That a second patent for a special application of the force to the object named in a rejected Claim of the former application is valid, see *O'Reilly v. Morse* (1853), 15 How. 62.

² That the description of a process in an application for a patent for the apparatus does not prevent a patent for the process, if applied for within two years, see *Eastern Paper Bag Co. v. Standard Paper Bag Co.* (1887), 41 O. G. 231 ; 30 Fed. Rep. 63.

§ 467. ¹ That an inventor cannot file a second application, after the patent is ready to issue on the first, for a device rejected on the prior application, but must re-issue the first patent and claim it there, see *Ex parte Arkell* (1877), 11 O. G. 1111.

That where two applications describe the same invention and the later one does not claim it, a patent not covering it may issue on the later application, and a patent covering it on the earlier application, see *Ex parte Emerson* (1879), 16 O. G. 1232.

That an applicant cannot claim matter covered by the Claim of a previous application, see *Ex parte Holt* (1884), 29 O. G. 171.

That after an application has passed to issue no other one covering the same matter should be passed, see *Ex parte Gaboury* (1886), 37 O. G. 217.

That a second application will not be rejected merely because a prior one by the same applicant is still pending, see *Ex parte Gaboury* (1886), 37 O. G. 217.

That matter described and not claimed in one application can be claimed in a second application filed pending the prior one, but not if the whole patentable matter is indivisible, see *Ex parte Holt* (1884), 29 O. G. 171.

hereafter stated, he is allowed to do; but in such cases each of his applications must clearly show, by proper allegations of disclaimer, that the limits of the monopoly for which it prays do not include any part of the subject-matter of the others.²

§ 468. **Joinder of Inventions not Consistent with the Nature of the Patent Privilege: but nevertheless Permitted.**

The joinder of several inventions in a single application is not altogether consistent with the principles or the policy of Patent Law, however nearly related to each other such inventions may be. A right to the exclusive use of one invention is entirely distinct from a right to the exclusive use of any other, and the monopolies created in favor of an inventor must therefore always be as numerous as the inventions upon which they are based. That several monopolies can be created by one granting act, and can be witnessed by one instrument of grant, is undeniable; but the symmetry of the law and the avoidance of unnecessary confusion would require that each invention be protected by a separate patent, in which the limits of the single monopoly conferred thereby might be clearly and perpetually defined. A contrary practice, however, has arisen, and out of consideration for its convenience and its economy to applicants has been sanctioned by the Patent Office and the courts.

§ 469. **Joinder of Inventions Differently Viewed in the Courts and in the Patent Office.**

The rules by which the limitations of this practice are declared, and the evils naturally flowing from it are as far as possible avoided, are not in all respects the same in the

² That where two applications describe, and one of them claims an invention, the one not claiming must disclaim it, and refer to the other by its date and number, see *Ex parte Blair* (1888), 43 O. G. 113; *Ex parte Finch* (1883), 26 O. G. 273.

That the rules requiring cross-disclaimers in two pending applications for the same general invention are strictly

enforced, see *Drawbaugh v. Blake* (1883), 23 O. G. 1221.

That the rule requiring disclaimers where two pending applications describe but only one claims an invention is merely directory, and the issue of the first patent is no bar to the second, unless the subject-matter is one, integral, and indivisible, see *Ex parte Roberts* (1887), 40 O. G. 572.

Patent Office as in the courts.¹ The practice was adopted before the re-organization of the patent system in 1836, and when the only questions involved in it, of importance to the public, related to the intelligibility of the specification and the amount of fees received for patents by the government. In their disposition to encourage inventors by every means that the language of the statutes would permit, the courts sustained patents covering several different inventions, and laid down rules for their own guidance in the matter which there has been no later judicial occasion to disturb. But when the present method of examining the novelty and utility of an invention before the issue of a patent was inaugurated, the liberality shown by the courts toward this practice was found to be irreconcilable with the proper fulfilment of its duties by the Patent Office; and as these duties have increased, and a greater subdivision of its operations has from time to time become essential, the introduction of more rigid rules has been inevitable, in order that the work of examining an application might not have to be repeated in several different divisions of the department, and that after the patent issued the specifications and drawings might be placed for future reference in some specific group of inventions, without unnecessary re-duplication.² To present a complete view of this subject a

§ 469. ¹ In *Ex parte Bancroft* (1881), 20 O. G. 1893, Marble, Com. : (1894) "I am aware that the courts have sustained patents where two inventions embraced therein were made to accomplish the same end and purpose. See *Wyeth et al. v. Stone et al.*, 1 Story, 273. Also, patents containing an invention which might be applied in different ways. See *Hogg et al. v. Emerson*, and cases cited, 6 How. 437. It is also true that the courts have sometimes sustained patents which ought never to have been granted, in order to protect the rights of parties. My attention has been called to the fact that patents have been issued for a process and product, a machine, process, and product, and a machine and product; and, as I think,

in many cases improperly. The fact that the courts will sustain patents in order to protect the rights of parties, or that patents have been improperly issued, furnishes no rule of action for this Office."

² That joinder does not follow the same rules in the courts as in the Patent Office, and the former will rarely declare a patent void for misjoinder, though the necessities of the Patent Office may often require separation, see *Ex parte Herr* (1887), 41 O. G. 463.

That it is for the Patent Office to determine whether a joinder shall be allowed, see *Ex parte Sartell* (1888), 42 O. G. 295; *Sessions v. Romadka* (1884), 21 Fed. Rep. 124; 28 O. G. 721; *McKay v. Dibert* (1881), 19 O. G. 1351;

statement of the rules as they appear in the judgments of the courts and in the decisions of the Patent Office must be made, both generally and in their application to particular classes of inventions.

§ 470. Joinder of Inventions: Rule in the Courts.

The general rule adopted by the courts and sanctioned by the uniform current of decisions permits the joinder of several inventions in one patent where the inventions are kindred and auxiliary, — that is, where they are capable of being used in connection with each other to serve a common end.¹ It is

5 Fed. Rep. 587; *Ex parte Möller* (1879), 16 O. G. 358; *Bennet v. Fowler* (1869), 8 Wall. 445.

That doubt as to joinder is resolved in favor of the applicant, see *Ex parte Herr* (1887), 41 O. G. 463.

That the question of joinder must be determined to some extent by the Office classification, but not by the matter of fees, see *Ex parte Mefford* (1883), 25 O. G. 881.

That the arts are necessarily classified as the statute recites them and subordinate classes are constantly arising as the arts advance, which the Patent Office must distinguish, see *Ex parte Herr* (1887), 41 O. G. 463.

That the classification referred to in *Ex parte Herr* was not based on mere Office divisions but on the distinctions recognized in the arts as actually subsisting between inventions, see *Ex parte Sartell* (1888), 42 O. G. 295.

That inventions of different statutory classes cannot be joined, unless inseparable, see *Ex parte Herr* (1887), 41 O. G. 463; *Ex parte Blythe* (1884), 30 O. G. 1321.

That dependent inventions may be joined though the Office classification must give way, see *Ex parte Mefford* (1883), 25 O. G. 881.

That no inflexible rule of joinder is possible, see *Ex parte Young* (1885), 33 O. G. 1390.

§ 470. ¹ In *Densmore v. Schofield* (1868), 4 Fisher, 148, Swayne, J. : (154) "Now, undoubtedly, independent things, separable and separate things, where any combination arises, provided they be cognate, relate to the same invention, and have relation to the same subject, the same object to be accomplished, — undoubtedly these separate claims can be made in the same patent. If they have no such tie of connection as I have mentioned, if they are for separate and entirely different things, then the patent would be void, because it attempted to unite what cannot be united; but if they be connected by a common tie, a common object or purpose, then undoubtedly these different claims can be united in one and the same patent."

In *Hogg v. Emerson* (1850), 11 How. 587, Woodbury, J. : (606) "It is well settled . . . that a patent for more than one invention is not void if they are connected in their design and operation."

In *Wyeth v. Stone* (1840), 1 Story, 273, Story, J. : (287) "But it has been said that if each of the machines patented is independent of the other, then separate patents should have been taken out for each; and that they cannot both be joined in one and the same patent; and so there is a fatal defect in the plaintiff's title. And for this position

not necessary that this common and connected use should be the sole use to which any of these inventions can be applied,

the doctrine stated in *Barrott v. Hall* (1 Mason R. 473), and *Evans v. Eaton* (3 Wheat. R. 454, 506), is relied on. I agree that, under the general patent acts, if two machines are patented which are wholly independent of each other, and distinct inventions for unconnected objects, then the objection will lie in its full force, and be fatal. The same rule would apply to a patent for several distinct improvements upon different machines, having no common object or connected operation. For, if different inventions might be joined in the same patent for entirely different purposes and objects, the patentee would be at liberty to join as many as he might choose, at his own mere pleasure, in one patent, which seems to be inconsistent with the language of the patent acts, which speak of the thing patented, and not of the things patented, and of a patent for an invention, and not of a patent for inventions; and they direct a specific sum to be paid for each patent. Besides, there would arise great difficulty in applying the doctrines of the common law to such cases. Suppose one or more of the supposed inventions was not new, would the patent at the common law be void *in toto*, or only as to that invention, and good for the rest? Take the case of a patent for ten different machines, each applicable to an entirely different object, — one to saw wood, another to spin cotton, another to print goods, another to make paper, and so on; if any one of these machines were not the invention of the patentee, or were in public use, or were dedicated to the public before the patent was granted, upon the doctrines of the common law the patent would be broader than the invention, and then the consideration therefor would fail, and the patent be void for the whole. But if such distinct

inventions could be lawfully united in one patent, the doctrine would lead to consequences most perilous and injurious to the patentee; for, if any one of them were known before, or the patent as to one was void, by innocent mistake or by priority of invention, that would take away from him the title to all the others, which were unquestionably his own exclusive inventions. On the other hand, if the doctrine were relaxed, great inconvenience and even confusion might arise to the public, not only from the difficulty of distinguishing between the different inventions stated in the patent and specification, but also of guarding themselves against fraud and imposition by the patentee, in including doubtful claims under cover of others which were entirely well founded. In construing statutes upon such a subject, these considerations are entitled to no small weight. At least, they show that there is no ground, founded in public policy or in private right, which calls for any expanded meaning of the very words of the statute; and that to construe them literally is to construe them wisely. It is plain, also, that the act of 1837, ch. 45, in the ninth section, contemplated the rule of the common law as being then in full force; and, therefore, it seeks to mitigate it, and provides, 'that whenever, by mistake, accident, or inadvertence, and without any intent to defraud or mislead the public, any patentee shall have, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing invented' (not of different things invented) 'of which he was not the first and original inventor, and shall have no legal or just right to claim the same, in every such case the patent shall be good and valid for so much of the invention or dis-

nor that it be their ordinary use, nor even that they should ever have been thus employed. 'Their capacity for such use is

covery' (not inventions or discoveries) 'as shall be truly and *bona fide* his own; provided it shall be a material and substantial part of the thing patented, and be definitely distinguishable from the other parts so claimed without right as aforesaid.' This language manifestly points throughout to a definite and single invention, as the 'thing patented,' and does not even suppose that one patent could lawfully include divers distinct and independent inventions, having no common connection with each other, nor any common purpose. It may, therefore, fairly be deemed a legislative recognition and adoption of the general rule of law in cases not within the exceptive provision of the act of 1837. And this is what I understand to have been intended by the court in the language used in *Barrett v. Hall* (1 Mason, 447, 475, 478). It was there said (p. 475) that 'a patent under the general patent act cannot embrace various distinct improvements and inventions; but in such a case the party must take out separate patents. If the patentee has invented certain improved machines, which are capable of a distinct operation, and has also invented a combination of these machines to produce a connected result, the same patent cannot at once be for the combination, and for each of the improved machines; for the inventions are as distinct as if the subjects were entirely different.' And again (p. 478), 'If the patent could be construed as a patent for each of the machines severally, as well as for the combination, then it would be void, because two separate inventions cannot be patented in one patent.' It is obvious, construing this language with reference to the case actually before the court, that the court were treating of a case where each of the patented machines

might singly have a distinct and appropriate use and purpose, unconnected with any common purpose, and therefore each was a different invention. In *Moody v. Fiske* (2 Mason, 112, 119), the judge alluded still more closely to the distinction, and said: 'I wish it to be understood in this opinion that though several distinct improvements in one machine may be united in one patent, [yet] it does not follow that several improvements in two different machines, *having distinct* and independent operations, can be so included; much less that the same patent may be for a combination of different machines and for distinct improvements in each.' It is perhaps impossible to use any general language in cases of this sort, standing almost upon the metaphysics of the law, without some danger of its being found susceptible of an interpretation beyond that which was then in the mind of the court. The case intended to be put in each of these cases was of two different machines, each applicable to a distinct object and purpose, and not connected together for any common object or purpose. And, understood in this way, it seems to me that no reasonable objection lies against the doctrine. Construing, then, the present patent to be a patent for each machine, as a distinct and independent invention, but for the same common purpose and auxiliary to the same common end, I do not perceive any just foundation for the objection made to it. If one patent may be taken for different and distinct improvements made in a single machine, which cannot well be doubted or denied, how is that case distinguishable in principle from the present? Here there are two machines, each of which is or may be justly auxiliary to produce the same general result, and each is applied to the same

sufficient to entitle their inventor to embrace them in a single patent, since when contemplated as co-operating toward this common end they may be properly regarded as parts of one invention. But separate and distinct inventions, not capable of such connected use, cannot be joined in the same patent.² Their design and operation being independent of each other there is no point of view from which they can be considered as one invention; and patents embracing two or more such inventions will not be sustained.

common purpose. Why then may not each be deemed a part or improvement of the same invention? Suppose the patentee had invented two distinct and different machines, each of which would accomplish the same end, why may he not unite both in one patent, and say, I deem each equally useful and equally new; but, under certain circumstances, the one may, in a given case, be preferable to the other? There is a clause in the Patent Acts which requires that the inventor, in his specification or description of his invention, should 'fully explain the principle and the several modes in which he has contemplated the application of that principle or character, by which it may be distinguished from other inventions.' Now this would seem clearly to show that he might lawfully unite in one patent all the modes in which he contemplated the application of his invention, and all the different sorts of machinery or modifications of machinery by which or to which it might be applied; and if each were new there would seem to be no just ground of objection to his patent reaching them all. *A fortiori*, this rule would seem to be applicable where each of the machines is but an improvement or invention conducing to the accomplishment of one and the same general end." 2 Robb, 23 (37).

That two related and auxiliary inven-

tions may be joined in the same patent, see *McComb v. Brodie* (1872), 1 Woods, 153; 2 O. G. 117; 5 Fisher, 384; *Lee v. Blandy* (1860), 2 Fisher, 89; 1 Bond, 361; *Hogg v. Emerson* (1848), 6 How. 437; 2 Robb, 655.

That several inventions which may be, though they are not, used together may be joined, see *Emerson v. Hogg* (1845), 2 Blatch. 1.

That inventions appropriate for use in the same article for a common purpose of making the article may be joined, see *Maxheimer v. Meyer* (1881), 20 O. G. 1162; 20 Blatch. 17; 9 Fed. Rep. 460.

That related inventions, if invented by different inventors, cannot be joined, see *Potter v. Wilson* (1860), 2 Fisher, 102.

² That separate and independent inventions cannot be joined in one patent either under the law or the rules of the Patent Office, see *Ex parte Heginbotham* (1875), 8 O. G. 237.

That distinct and separate inventions, not connected in design and operation, cannot be joined, see *Sessions v. Romadka* (1884), 21 Fed. Rep. 124; 28 O. G. 721.

That a joinder of separate and distinct but not independent inventions is proper, see *Mosler Safe & Lock Co. v. Mosler* (1885), 31 O. G. 1689; 22 Fed. Rep. 901.

§ 471. Joinder of Inventions : Rule in the Patent Office.

The general rule established in the Patent Office by the regulations and decisions of successive Commissioners permits the joinder of distinct inventions in an application where one of such inventions is dependent on the other and where they thus mutually contribute to produce a single result.¹

§ 471. ¹ In *Ex parte Young* (1885), 33 O. G. 1390, Montgomery, Com. : (1391) "All will agree that an application should not ordinarily embrace matters which belong to absolutely distinct, independent, and unconnected official classes or sub-classes where the inventions involved are separate, independent, and not connected together in their nature, design, or operation, but that in such cases a division should undoubtedly be insisted upon. The first inquiry, therefore, should be as to whether or not the inventions, if there be more than one included in the application, can reasonably and properly be said to be independent inventions — *separate* inventions. If they are so independent and separate, they should not be joined, and a division should be called for. If they are not so independent and separate, but are only distinct, but still 'kindred and auxiliary,' or connected in their design and operation, or in their nature or operation connected together, then ordinarily a division should not be required."

That distinct inventions can be joined if one is dependent on the other, see *Ex parte Hogan* (1879), 16 O. G. 907.

That distinct inventions are not necessarily independent, see *Ex parte Young* (1885), 33 O. G. 1390.

That devices subserving a common end and contributing to a unitary result may be joined, see *Ex parte Sol Kuh* (1876), 10 O. G. 587 ; *Ex parte Clinton & Knowlton* (1876), 9 O. G. 249 ; *Ex parte Jopling* (1875), 8 O. G. 1032.

That devices adapted to each other,

if belonging to the same class and used to serve a common end, may be joined, see *Ex parte Noyes* (1875), 8 O. G. 818.

That where the parts of an invention are intimately connected, and co-operate in the result, they may be joined, see *Ex parte Freese* (1880), 17 O. G. 1095.

That when devices, in their nature distinct, form a complete set which operate together, they may be joined, see *Ex parte Gokey* (1878), 15 O. G. 295.

That connected inventions may be joined, though a separate foreign patent has been granted for each, see *Ex parte Unsworth* (1879), 15 O. G. 882.

That no joinder is permitted in the Patent Office unless the inventions directly act in producing a resultant operation due to all the inventions, see *Ex parte Herr* (1887), 41 O. G. 463.

That it is for the Patent Office to judge whether inventions are separate and distinct, see *Ex parte Bancroft* (1881), 20 O. G. 1893.

That separate and independent inventions cannot be joined, see *Ex parte Young* (1885), 33 O. G. 1390 ; *Ex parte Van Matteson* (1883), 24 O. G. 389 ; *Ex parte Bancroft* (1881), 20 O. G. 1893 ; *Ex parte Hogan* (1879), 16 O. G. 907 ; *Ex parte Law* (1877), 12 O. G. 940 ; *Ex parte Howland* (1877), 12 O. G. 889 ; *Ex parte Sol Kuh* (1876), 10 O. G. 587 ; *Ex parte Elbers* (1875), 12 O. G. 2.

That inventions which do not co-operate, or depend on each other for their operation, cannot be joined, see

Since in these cases the dependent invention cannot be contemplated by the mind as complete and practically operative unless in connection with the other, and cannot be examined and passed upon by the Patent Office without inquiring into and determining its limits with respect to the other, their joinder is not inconsistent with the division of duties in the Office, though the spirit of its regulations, as well as of the law itself, still demands a separate patent and a separate application for each invention. In judging of inventions with reference to this general rule, their dependency or independency is determined by the scope and relation of the concrete inventions, not by the unity or diversity of the ideas of means as they were developed in the mind of the inventor.² That the inventions pertain to the same subject, or belong to the same genus, or are by nature adapted to a common use should

Ex parte Dieterich (1877), 11 O. G. 195.

That inventions which co-operate neither in function nor result cannot be joined, see *Ex parte* Westcott (1876), 10 O. G. 546.

That independent inventions, whether arts or instruments, cannot be joined, see *Ex parte* McDougall (1880), 18 O. G. 130.

In examining the foregoing cases, or any others upon this subject, it should be borne in mind that inventions are here regarded as "inseparable" whenever either one of them is necessarily dependent on the other. A product which can be created only by a specific process is "inseparable" from that process, although the process, being capable of an application which does not result in that product, is not "inseparable" therefrom. An apparatus which has no other use than in performing a certain art may also be "inseparable" from that art, while the art itself may be entirely separable from the apparatus and as easily performed by many others. "Inseparability" or "dependence," as a ground of joinder,

may thus be predicable of either or both of the conjoined inventions, — the invention being single for the purposes of an application or a patent whenever any of its component or subordinate or resultant arts or instruments could not exist as operative means without the others. This limitation of "inseparability" serves to reconcile with each other all the discordant positions which, by their too comprehensive language, the decisions appear to have maintained.

² In *Ex parte* Murray (1873), 3 O. G. 659, Leggett, Com. : (660) "It might be supposed, because the inception and perfection of a process and the product to be treated and improved by it, or of a machine and its product, are often conjoined in the mind of the inventor, that in this is to be found a reason why the two ought to be regarded as constituting one subject of invention to be embraced in a single patent. But this is not the proper criterion by which to judge of them. The inventions are to be contemplated when completed, and if they are then distinct, it is immaterial how intimately they may have been blended in their production."

any one desire so to employ them, does not constitute such dependence as to justify their joinder.³ But where the ultimate end for which one was created cannot be reached without the employment of the other, or where the operation of the one results in the production of the other, or where the use of one involves the concurrent or co-operating use of all the rest, or where one is generic and the other a particular species of that genus,⁴ this dependence exists and the inventions may be joined.

³ That distinct inventions cannot be joined though they pertain to the same things, see *Ex parte Van Matteson* (1883), 24 O. G. 389; *Ex parte Hamilton* (1877), 13 O. G. 122.

That distinct inventions cannot be joined, though they belong to the same genus, see *Ex parte Stow* (1873), 3 O. G. 322.

That the capability of use by application to some outside article does not warrant a joinder where there is no mutual dependence and intercommunication, see *Ex parte Law* (1877), 12 O. G. 940.

⁴ In *Ex parte Kent* (1880), 17 O. G. 686, Doolittle, Act. Com. : (686) "It is true that a discoverer of a genus in mechanics is entitled to a Claim in a patent co-extensive with the genus, and to which all subsequent Claims for species of that genus must be subordinate. As each genus, however, constitutes a separate invention, but one can be claimed in the same application. A genus is defined as 'a precisely defined and exactly divided class,' and as 'an assemblage of species possessing certain characteristics in common,' but not as including different classes of objects having simply general resemblances and functions; and in a Claim for a genus those common characteristics must be distinctly pointed out. . . . In addition to a generic Claim, one who has invented the genus may, under the established practice of the Office, claim a

particular species illustrative or typical of the genus."

In *Ex parte Kook* (1870), 16 O. G. 543, Paine, Com. : (544) "While it is easy to distinguish theoretically between those cases in which several different forms constitute different species of one genus and those in which they constitute only a single species, the practical discrimination between the two classes of cases is not always easy. The principle is this : When the different forms are such that the substitution of one for another involves invention, the differences are patentable, and the several forms constitute different species of the genus, all subject to one generic patent, but each legally patentable in a distinct and specific patent. On the other hand, when the substitution of one for the other involves no invention, but only mechanical skill, the differences are not patentable, and the forms do not constitute several species of the genus, but are all modifications of a single species."

In *Ex parte Howland* (1877), 12 O. G. 889, Doolittle, Act. Com. : (889) "It may be stated, in brief, that whenever a generic Claim can be predicated which is good in view of the state of the art, and which will include the modifications or specific devices described or exhibited in the drawings, then these may all be retained in a single application; for it is manifest, from the fact that the Claim applies with equal apti-

§ 472. Joinder of Inventions: Combinations: Sub-combinations: Elements.

Out of the application of these general rules to the various classes of inventions have grown certain special rules by which the joinder of two or more inventions of the same class or of different classes is also governed. Before discussing those special rules, however, a peculiar doctrine relating to combinations, which are found in all these classes, may properly be stated. A combination, its sub-combinations, and the elements of which each sub-combination is composed are dependent inventions whenever such elements and sub-combinations are considered in reference to the principal combination in which all unite. Although this principal combination is a true invention, distinct in law as well as in fact from all the subordinate inventions which enter into it, no idea of it can be formed in the mind, no embodiment of that idea can be made practically operative in the arts, and no examination as to its novelty or utility can take place in the Patent Office, without embracing in this idea, in its embodiment, and in this examination each of the elements and sub-combinations of which it consists. Hence, whenever any of these sub-combinations or their elements have been invented by the inventor of the principal combination and have not been previously patented in this country, they may be joined in one application

tude to each, that there are generic features of identity which indicate the same basis of invention. On the other hand, where no Claim of the character indicated can be maintained, it is equally true that there is such diversity as will require a division of the application; this restriction being pursued until the matter retained in any single case can be safely said to relate to but one invention, or, in other words, can be contained in the broadest patentable Claim that is capable of being drawn to it."

Further, that a generic invention and one species under the genus may be joined, see *Ex parte* Heaton (1879), 15 O. G. 1054; *Ex parte* Smith (1879),

16 O. G. 630; *Ex parte* Cowper (1879), 16 O. G. 499.

That two or more distinct species under the same genus cannot be joined, see *Ex parte* Ewart (1880), 17 O. G. 448; *Ex parte* Heaton (1879), 15 O. G. 1054; *Ex parte* Dinkelbilher (1879), 16 O. G. 810; *Ex parte* Cowper (1879), 16 O. G. 499; *Ex parte* Morrison (1879), 16 O. G. 359.

That two distinct species under the same genus, if requiring different inventive acts, cannot be joined, though all will be covered by a patent for the genus, see *Ex parte* Kook (1879), 16 O. G. 543.

For an excellent discussion of joinder and kindred subjects, see *Ex parte* Herr, (1887), 41 O. G. 463.

with the principal combination.¹ And this is equally true whether these elements and sub-combinations are, in their own nature as separately considered, similar or dissimilar to each other either in name, in class, or in mode of operation. This doctrine applies, however, only to cases where the principal combination is itself the subject-matter of the application. It is this combination which constitutes the link between the different sub-combinations and their elements, and thus forms the ground of their dependence on each other. Apart from this combination these subordinate members may or may not be wholly independent of one another, and may be joined or not joined according to the rules which govern simple inventions of their peculiar class.² Different combinations of the same group of elements, combinations of one or more

§ 472. ¹ In *Stevens v. Pritchard* (1876), 2 Bann. & A. 390, Clifford, J. : (390) "Cases arise where a patentee, having invented a new and useful combination, consisting of several elements, which in combination compose an organized machine, also claims to have invented new and useful inventions, consisting of fewer members of the same elements ; and in such cases the law is well settled that, if the several combinations are new and useful, and will severally produce new and useful results, the inventor is entitled to a patent for the several combinations, provided he complies with the requirements of the patent act, and files in the Patent Office a written description of each of the alleged new and useful combinations, and of the manner of making, constructing, and using the several inventions. He may, if he sees fit, give the description of the several combinations in one specification, and in that event he can secure the full benefit of the exclusive right to each of the several inventions by separate Claims, referring to the specification for the description of the inventions, without the necessity of filing separate applications for each of the inventions. Separate descriptions of the respective

inventions in one application are as good as if made in several applications ; but the Claims must be separate, and it would follow that if the patentee, by inadvertence, accident, or mistake, should fail to claim any one of the described combinations, he might surrender the original patent, and have a re-issue not only for the combinations claimed in the original specification, but for any which were so omitted in the Claims of the original patent." 4 Clifford, 417 (418); 10 O. G. 505 (505).

See also *Banks v. Snediker* (1880), 17 O. G. 508 ; *Gill v. Wells* (1874), 22 Wall. 1 ; 6 O. G. 881.

That the elements of a combination may be joined with it unless they have become known in the arts as separate inventions and possess utility in other relations, see *Ex parte Sartell* (1888), 42 O. G. 295.

That elements already in general use in other connections cannot be joined with the combination, see *Ex parte La Borde* (1888), 44 O. G. 700.

² That aggregated devices cannot be joined unless the joinder would be proper when they are considered as distinct inventions, see *Ex parte Cardwell* (1878), 15 O. G. 293.

elements with several different groups of additional elements,³ a single element and several different combinations into which it enters, a combination and distinct improvements in its different elements not affecting the operation of the combination as a whole, one improvement in one element and another improvement in a different element,⁴ — all these are also, for the same reason, outside this peculiar doctrine. An application in which such a joinder should be made would embrace no separate subject-matter which could bring them into relations of dependence. Whenever, therefore, they are capable of being joined in any application which does not embrace the principal combination, it must be on the ground that they are in their own nature dependent on each other and mutually contribute to produce a single result, — a state of facts which allows their joinder under the general rule.

§ 473. Joinder of Inventions : Arts : Apparatus : Product.

The special rules which govern the joinder of arts or processes with each other or with related inventions of a different class, are more stringent in the Patent Office than in the courts. The decisions of the courts permit two processes to be covered by one patent when they are so related to each other that they are capable of being used for the attainment of a common end. They also allow a process to be embraced in the same patent with the apparatus by which it is performed and the product in which it results, where all originate in the inventive genius of the same inventor, although the process, the apparatus, and the product are so far separable from each other that the process might be otherwise performed, the apparatus otherwise employed, and the product otherwise produced.¹ But in the Patent Office arts cannot be

³ That different combinations of the same elements cannot be joined, nor combinations of the same invention with different elements, see *Ex parte* Shepard (1872), 3 O. G. 522.

⁴ See § 478 and notes, *post*.

§ 473. ¹ That the statute allows the joinder of Claims for an art and its apparatus, see *Ex parte* Young (1885), 33 O. G. 1390.

That a Claim for a process cannot be joined with a Claim for a machine where the process consists in the operation of the machine, there being in such case but one invention, viz: the machine, see *Gage v. Kellogg* (1885), 23 Fed. Rep. 891 ; 32 O. G. 381.

In *United States v. Butterworth* (1884) 27 O. G. 717, it is doubted whether the process performed by apparatus can be

joined merely because they relate to the same subject, or can be used for the promotion of a single ultimate result. Either, one must be in its own nature dependent on the other, or taken together they must constitute a combination-process which is also made the subject-matter of the application.² Nor can a process be joined with the apparatus that performs it,³ nor

patented as a separate invention from the apparatus. This doubt must be solved in the affirmative, if the process can be performed by other apparatus or the apparatus can be used for other purposes; in the negative, if they are so related that the process is the function of this apparatus and of this apparatus only.

That one patent may cover the process and another the apparatus, see *Philips v. Kochert* (1887), 40 O. G. 1341; 31 Fed. Rep. 39; *Tilghman v. Proctor* (1880), 102 U. S. 707; 19 O. G. 859; *Cochrane v. Deener* (1876) 94 U. S. 780; 11 O. G. 687; *Corning v. Burden* (1853), 15 How. 252.

That a process and its product may be joined, see *Sewall v. Jones* (1875), 91 U. S. 171; 9 O. G. 47; *Merrill v. Yeomans* (1874), 5 O. G. 267; *Holmes*, 331; 1 Bann. & A. 47; *Goodyear v. Providence Rubber Co.* (1864), 2 Fisher, 499; 2 Clifford, 351.

That a process and its product may be joined if the specification shows that the inventor had both results in his mind, see *Welling v. Rubber Coated Harness Trimming Co.* (1875), 2 Bann. & A. 1; 7 O. G. 608.

That if a process and product are joined each must be fully described, see *Kelleher v. Darling* (1878), 4 Clifford, 424; 14 O. G. 673; 3 Bann. & A. 438.

That processes and their products are to be joined or not as the Patent Office may decide, see *Goodyear v. Wait* (1867), 3 Fisher, 242; 5 Blatch. 468.

² In *Ex parte McDougall* (1880), 18 O. G. 130, Marble, Com. : (131) "The rule that several distinct inventions cannot be included in a single applica-

tion is a well-settled one, and is alike applicable whether such inventions be improvements in processes or in machinery. . . . Each of the several 'acts' of 'the series of acts' constituting the process may be capable of performing separately its own peculiar function, and may be used independently of the others; but if together they co-act in producing the final result they may be joined in a single application. In such a case a Claim can be made to the process as an entirety, and separate Claims can also be made to the sub-processes which go to make up the same. So, also, where one has discovered that a desired result can be attained by a process consisting of a series of steps or acts, and that certain of the steps in such process may be replaced by others which will operate in an equivalent manner in attaining the same end, these several modifications can be embraced in one application, for they cannot be regarded as distinct inventions. In such case the applicant would be entitled to a broad or generic Claim, which would include all the modifications, and would also be allowed to claim separately any one of these modifications or species."

That several processes cannot be joined merely because they relate to the same subject, see *Ex parte McDougall* (1880), 18 O. G. 130.

³ That a process and its apparatus cannot be joined, see *Ex parte Herr* (1887), 41 O. G. 463.

That the process and the apparatus that performs it may be joined, though other apparatus will perform it, if the apparatus is inseparable from the process

either of these with the product in which they result, unless they are to such an extent inseparable that the existence of some one of them is dependent upon that of the others.⁴

and cannot be used except in performing the process, see *Ex parte Tyne* (1880), 17 O. G. 56.

That a process, the apparatus, and the product can be joined if inseparable, not otherwise, see *Ex parte Dailey* (1877), 13 O. G. 228.

In *Ex parte Simonds* (1888) 44 O. G. 445, it is held that where the process and the apparatus are inseparable the former must be the mere function of the latter. This is true where the process can be performed only by the apparatus in question, not where other apparatus can be employed in the process, although the apparatus in question, being capable of no other use than in this process, may be truly inseparable therefrom.

That an art and its apparatus cannot be joined in one patent, being separable inventions wherever the art is not the mere function of the apparatus, see *Ex parte Blythe* (1884), 30 O. G. 1321. But see preceding case and remarks.

Where a process can be performed by different apparatus it is a separate patentable entity from the apparatus which performs it, and therefore must be separately patentable. But it does not follow from this that if any one apparatus can be used for no other purpose than the performance of this process, the process is the mere function of such apparatus, and consequently not a patentable art. Every process may be regarded as a function in its relation to the apparatus which performs it, though it be a means in its relation to the object acted on, and where it is capable of existence apart from one specific apparatus, *i. e.* where it can be performed by various apparatus, it is a separately patentable invention. But an apparatus

which can do nothing except perform a specific process is inseparable from that process, though the process may not be inseparable from the apparatus; and if the process and apparatus are both new inventions they may be joined in one application, not on the ground that the process is the function of the apparatus, but because the apparatus cannot be invented, examined, nor adjudged apart from the single process it performs.

⁴ In *Ex parte Tyne* (1880), 17 O. G. 56, Doolittle, Com. : (56) "It is a settled practice of the Office that a process and its product or a machine and its product may be united in the same application and patent when the product is the necessary result of the process or machine, and can only be produced in that way, or where distinct machines are associated and are necessary to produce a single result. The connection, in all cases, between the means and result must be inseparable. *Ex parte Cobb*, 16 O. G. 175; *Wintherlich*, 16 O. G. 404; 16 O. G. 808. Now a mechanical process, which is only another name for an art, is inseparable from the means by which it is operated. These means may vary, but if the same improvement in the art is produced in substantially the same way the different means are necessarily equivalents, just as two machines producing the same product in substantially the same way are equivalents. And it is no objection to joinder in the same application of inseparably connected distinct inventions that some other equivalent invention may be substituted in place of one of the former."

In *Ex parte Murray* (1873), 3 O. G. 659, Leggett, Com. : (660) "A machine is a distinct subject of invention, and

Thus a process may be joined with its inevitable product or with the apparatus by which alone it can be performed, or a product may be joined with the process on which it depends for its production, or an apparatus with the process whose performance constitutes the sole method in which it can be used; and when either the process or the apparatus or the product are so connected with the other two that its existence as a concrete invention is derived from, or results in, theirs an application for a patent for the former may include the others also.

§ 474. Joinder of Inventions : Machines : Processes : Products.

A similar difference between the Patent Office and the courts obtains in reference to the rules relating to the joinder of machines. Under the decisions of the courts, two machines can be covered by one patent whenever they are kindred in their nature and capable of a connected use toward a common

its product, or the article which it is employed to make, is another distinct subject of invention, if new in itself. They are classified separately in the portfolios of the Office, and require separate examinations, and to grant both in the same patent complicates and increases the work of examiners and greatly augments the danger of making mistakes and improperly duplicating patents. . . . The same is true of a process and the article produced by it. The two are entirely independent. The process may be new and the product old, or both may be new, and yet the product be capable of being produced by other processes. . . . Notwithstanding the precedents which exist, and admitting that such a practice as they indicate, if not strictly correct, is not fatal to the validity of patents, I think the time has come when, leaving out of consideration the perspicuity of the patents themselves, and the revenue to be derived under the law for examinations, a proper classification in the Office, so as to facilitate examinations and prevent mis-

takes in the issue of patents, requires that processes, machines, and their products be presented for patent in separate applications."

That a product and process may be joined, see *Ex parte Stow* (1873), 3 O. G. 322.

That where a process and its product are inseparable, and the sub-process and its product are also inseparable, all may be joined, and if these constitute a generic invention, one species under the genus may be added, see *Ex parte Du Motay* (1879), 16 O. G. 1002.

That a process and product cannot be joined unless inseparable, see *Ex parte O'Neill* (1879), 16 O. G. 1049.

That where a process and product are inseparable they should be joined, see *Ex parte Young* (1885), 33 O. G. 1390 ; *Ex parte O'Neill* (1879), 16 O. G. 1049.

That a process and a product which requires another process to complete it cannot be joined, see *Ex parte Chamberlin* (1874), 6 O. G. 544.

end.¹ Machines and their integral parts, or a machine and the product in which its use results, or a machine and the process it performs, are also proper subjects-matter for a single patent.² The Patent Office rules, however, require a separate application for each machine unless one cannot be contemplated as an operative instrument without the other, or unless they constitute the elements or sub-combinations of a principal machine which is also the subject-matter of the application.³ A machine and its product, a machine and its process, or a machine with both its process and its product, may be joined when either one cannot exist as a concrete and practical invention without the others.⁴

§ 474. ¹ That two distinct machines cannot be joined, see *Root v. Ball* (1846), 4 McLean, 177 ; 2 Robb, 513.

That machines capable of a common use may be joined, see *Wyeth v. Stone* (1840), 1 Story, 273 ; 2 Robb, 23.

² That a machine and its integral parts may be joined, see *Wheeler v. McCormick* (1873), 4 O. G. 692 ; 11 Blatch. 334 ; 6 Fisher, 551 ; *Foss v. Herbert* (1856), 1 Bissell, 121 ; 2 Fisher, 31.

That the parts may be separately patented, see *Jones v. Sewall* (1873), 3 O. G. 630 ; 6 Fisher, 343 ; 3 Clifford, 563 ; *Wheeler v. McCormick* (1873), 4 O. G. 692 ; 11 Blatch. 334 ; 6 Fisher, 551.

That if the parts are separately patented, each patent may describe the whole, see *McMillin v. Rees* (1880), 1 Fed. Rep. 722 ; 17 O. G. 1222 ; 5 Bann. & A. 269.

That where the product of a machine is new it may be claimed in a patent for the machine, see *Excelsior Needle Co. v. Union Needle Co.* (1885), 32 Fed. Rep. 221.

That a machine, its process, and product are separately patentable, see *McKay v. Dibert* (1881), 19 O. G. 1351 ; 5 Fed. Rep. 587.

That a machine having been pat-

ented, its process and product may be separately patented at any subsequent period unless barred by two years' public use, see *McKay v. Dibert* (1881), 19 O. G. 1351 ; 5 Fed. Rep. 587. But see *McKay v. Jackman* (1882), 12 Fed. Rep. 615 ; 20 Blatch. 466 ; 22 O. G. 85.

³ That subordinate devices may be joined with the principal device, see *Ex parte Bigelow* (1878), 13 O. G. 913.

That all parts of a machine which co-operate to produce a single result may be joined, see *Ex parte Cauhape* (1880), 17 O. G. 327.

That where two machines together produce a result which they could not separately produce they may be joined, see *Burke v. Partridge* (1878), 58 N. H. 349 ; *Ex parte Lones* (1873), 4 O. G. 582.

That machines used as elements of a combination may be joined, see *Ex parte Holub* (1880), 17 O. G. 854 ; *Ex parte Shippen* (1875), 8 O. G. 727.

⁴ In *Ex parte Bancroft* (1881), 20 O. G. 1893, Marble, Com. : (1894) "Various opinions have been expressed by my predecessors as to what constitutes a single invention or discovery. It has been held, and as I think properly, that a die and its product, a pro-

§ 475. Joinder of Inventions: Manufactures: Processes: Apparatus.

The courts permit two manufactures to be joined whenever they are appropriate for use in the same article to serve a common purpose, or when they stand to each other in the relation of a combination and its elements, or when they are the elements of a combination which is itself embraced in the same patent. When any new manufacture is the result of a new process, or is made by a new machine, these also may be joined, although the manufacture might be otherwise produced. The Patent Office, however, applies here the same restrictions as in the cases of a process or machine. One of the two manufactures must be intrinsically dependent upon the other and co-operate with it to some unitary result, or one must represent the genus of which the other is a species, or

cess and its product, the different parts of the same machine co-operating to produce a unitary result, and a machine and its product are respectively sometimes one and the same invention, and therefore may be included in the same patent. The true rule in the latter case, I think, was properly stated by my predecessor, Mr. Commissioner Paine, in the case of *Ex parte Wintherlich* (16 O. G. 404), as follows: 'If the machine and the manufacture are so related that the former cannot operate without producing the latter, and the latter can only be produced by the former, both may be united in one patent; but this is an exception to the general rule, which forbids the joinder of the machine and its product in one application.' The rule above stated also applies in the case of a die and its product or a process and its product. It is *only* when the product can be produced by the die or the process that the die and its product or the process and its product can be considered one and the same invention. In a case where different parts of a machine may be embraced in the same patent they may be

so embraced only because they help to make up one entire whole. In all the cases decided by my predecessors which I have been able to find, the idea of a single invention was always kept in view. Different opinions have been expressed as to what constitutes a single invention; but I have been unable to find that it has been held that two distinct and independent inventions can be embraced in one patent."

That a machine and its product cannot be joined, see *Ex parte Murray* (1873), 3 O. G. 659.

That a machine and its product cannot be joined unless they are inseparable, see *Ex parte Wintherlich* (1879), 16 O. G. 404, 808.

That when the machine and its product are so related that the former cannot operate without producing the latter, and the latter can only be produced by the former, they can be joined, see *Ex parte Wintherlich* (1879), 16 O. G. 404, 808.

That if the product can be made only by the machine they may be joined, see *Ex parte Cobb* (1879), 16 O. G. 175.

they must be members of a combination which is covered by the same application.¹ The manufacture and the process or the machine which produces it must be inseparable as concrete inventions; so that either, on one hand, the manufacture implies the process or machine, or, on the other hand, the process or machine implies the manufacture, and the investigation of the one thus necessarily involves that of the other.²

§ 476. Joinder of Inventions : Compositions : Ingredients : Processes : Apparatus.

Compositions of matter are subject to the same rules as manufactures, both in the Patent Office and before the courts. When wholly independent they cannot be joined; when capable of co-operating to a common end the courts sanction their joinder, although the rules of the Patent Office forbid it unless one is dependent on the other and their co-operation is inevitable.¹ As every composition is a true combination, its elements and sub-combinations may be joined with it in an application for a patent;² and where it stands toward a process or machine in the relation of a product, the courts permit it to be joined with them as in the case of any other product, while the Office limits such a joinder to instances in which the composition and machine or process are inseparable.³

§ 477. Joinder of Inventions : Designs.

Owing to the peculiar character and functions of a design, it is scarcely conceivable that any two designs could be de-

§ 475. ¹ That a manufacture may be joined with a combination into which it enters, see *Ex parte Adams* (1873), 3 O. G. 150.

² See notes in §§ 473, 474, *ante*, as to joinder of product with processes or machines.

§ 476. ¹ That two compositions cannot be joined where one contains all the ingredients of the other with additional ingredients, see *Ex parte Lippincott*

(1879), 16 O. G. 632. This is not true where one composition is a sub-combination of the other.

² That the joinder of Claims for the associations of ingredients in a composition is proper, if they contribute to the single result and are not in different classes, see *Ex parte Hentz* (1884), 26 O. G. 437.

³ See §§ 473, 474, and notes, *ante*, covering joinder of product.

pendent on each other or capable of acting toward a common end except as elements in a combination; and therefore but one separate design can be included in a patent, although where several subordinate designs unite to form a new one the application for a patent for the new design may embrace all the elements and sub-combinations of which it consists.¹ It is equally foreign to the idea of a design that it should be dependent on, or inseparably connected with, those qualities in its object which make that object a new manufacture; and hence although the object be the same it cannot be protected by one patent both as a manufacture and as a design.

§ 478. Joinder of Inventions: Improvements.

The joinder of improvements is also regarded by the Patent Office and the courts from different points of view. Two improvements may be related either directly through the dependence of one upon the other or indirectly through their individual dependence upon the same original invention. Where neither of these relations exists, the improvements cannot be joined. Distinct improvements in distinct arts or machines are as independent of each other as any two inventions of the same class can ever be, and all the rules, both of the Office and the courts, require for each of these a separate

§ 477. ¹ That the joinder of designs is governed by the usual rules, see *Ex parte Patitz* (1883), 25 O. G. 980.

That two independent designs cannot be joined, see *Ex parte Beattie* (1879), 16 O. G. 266.

That the capability of being associated does not make two designs dependent, see *Ex parte Patitz* (1883), 25 O. G. 980.

That a design patent can cover but one design and such modifications of it as do not affect its identity, see *Ex parte Gerard* (1888), 43 O. G. 1240.

That several aggregated designs cannot be joined, see *Ex parte Gerard* (1888), 43 O. G. 1235.

That a joinder of a combination design and its elemental designs is

proper in the courts if the Patent Office will permit it, see *Dobson v. Hartford Carpet Co.* (1885), 114 U. S. 439; 31 O. G. 787; *Ex parte Pope* (1883), 25 O. G. 290; *Ex parte Beattie* (1879), 16 O. G. 267; *Ex parte Rogers* (1878), 13 O. G. 596.

That in the Patent Office the elements of a design cannot be joined with the design, see *Ex parte Gerard* (1888), 43 O. G. 1235.

That in an application for a design a Claim for a separable part of it, which is not a complete design, cannot be inserted, see *Ex parte Pope* (1883), 25 O. G. 290.

That the relation of genus and species does not exist in designs, see *Ex parte Gerard* (1888), 43 O. G. 1240.

application.¹ But two improvements in the same art or machine, though as improvements merely they may be wholly independent of each other, are so connected through the original invention that they are capable of serving a common end, and hence, according to the doctrine of the courts, may be covered by the same patent and joined in the same application.² An improvement in a given art or machine may not,

§ 478. ¹ In *Emerson v. Hogg* (1845), 2 Blatch. 1, Betts, J. : (7) "In *Evans v. Eaton* (3 Wheat. 454, 506), and in *Barrett v. Hall* (1 Mason, 447, 475), doubts are started whether, under the general Patent Law, improvements on different machines can regularly be comprehended in the same patent, so as to give a right to the exclusive use of the several machines separately, as well as a right to the exclusive use of them in combination. But the special statute (6 U. S. Stat. at Large, 70) applicable to the first case furnished a rule in itself, and the doctrine intimated by the court must accordingly be accepted as put hypothetically, and not laid down as a settled principle to govern the construction of specifications. The case of *Barrett v. Hall* attempts a generalization of the doctrines of the Patent Law, and, in the particular now under inquiry, the definition there adopted has no necessary connection with the case decided. Judge Story, in *Moody v. Fiske* (2 Mason, 112, 119), enters a caveat against his reasoning in that case being held to authorize the including in one specification several improvements in separate machines, having distinct and independent operations; much less the claiming in the same patent a combination of different machines; and distinct improvements in each. The suggestions advanced in all these cases were by way of caution, and were probably designed to avoid the conclusion that the court had prejudged or was committed upon that particular

form of the question. No one of the cases demanded a judgment upon the specific point. In *Wyeth v. Stone* (1 Story, 278, 292) the court reviews those cases, and restricts their application to such inventions as are necessarily distinct from each other, and not contemplated to be used in connection, and holds that a patent for several machines, each being a distinct and independent invention, is valid where they have a common purpose and are auxiliary to the same common end. (*Phillips on Pat.* 216, 217; *Pitts v. Whitman*, 2 Story, 609, 620, 621.) The principle seems to be, that the inventions should be capable of being used in connection, and to subserve a common end (*Wyeth v. Stone*, 1 Story, 273, 289, 290), though their actual employment together does not seem to be required to sustain the validity of the patent in which they may be united."

See also *Evans v. Eaton* (1818), 3 Wheat. 454; 1 Robb, 243.

That Claims covering several and distinct improvements relating to one article are not allowed, and all but one may be ordered disclaimed by the court as a condition of granting relief as to the others, see *Sessions v. Romadka* (1884), 28 O. G. 721; 21 Fed. Rep. 124.

² That several improvements on the same original machine may be joined, see *Burke v. Partridge* (1878), 58 N. H. 349; *Lee v. Blandy* (1860), 1 Bond, 361; 2 Fisher, 89; *Adams v. Jones* (1859), 1 Fisher, 527; *Morris v. Barrett* (1859), 1 Fisher, 461; 1 Bond, 254;

however, always be applicable to that original alone, or be useful only in connection with the other improvements which may be made by the same inventor on the same original invention, but may be equally operative for different purposes apart from them. Under the general rules of the Office, such improvements cannot be joined in the same application; a joinder of improvements being forbidden unless one so depends upon the other that they mutually co-operate to produce a given result.³ Distinct and independent improvements in separate parts of the same original invention therefore cannot be joined;⁴ but several improvements in the different elements of a combination affecting the action of the combination as a whole, or improvements which so operate upon each other as to increase their joint efficiency, may be united in one application and be protected by the same patent.⁵

§ 479. Joinder of Inventions: Application of these Rules often Difficult.

Although these various rules are reasonable in theory and clear in statement, their application to practical inventions is often difficult, from the obscurity which may exist in regard to the actual relations of the inventions to each other. Differences of opinion frequently arise between inventors and the Patent Office on this subject; and as the authority of the Office is supreme and finally determines what is a single in-

Pitts v. Whitman (1843), 2 Story, 609; 2 Robb, 189; *Wyeth v. Stone* (1840), 1 Story, 273; 2 Robb, 23; *Moody v. Fiske* (1820), 2 Mason, 112; 1 Robb, 312.

³ That devices, improving a machine as a whole, may be joined, see *Ex parte Clinton* (1876), 9 O. G. 249.

That two or more improvements on a machine, each contributing to the common result, may be joined, see *Ex parte Sergeant* (1876), 9 O. G. 963.

That improvements in the separate parts of a machine cannot be joined unless they co-operate in the new invention, see *Ex parte Gillies* (1876), 10 O. G. 415.

That several improvements in the parts of a device may be joined if they co-operate to improve it as a whole, and the improvements are not distinct subjects of invention or manufacture, see *Ex parte Herr* (1887), 41 O. G. 463.

⁴ That independent improvements on the different parts of a machine cannot be joined, see *Ex parte Van Matteson* (1883), 24 O. G. 389.

⁵ That improvements in the elements of a combination may be joined if the elements co-operate in the original combination, though there are other elements, see *Ex parte Möller* (1879), 16 O. G. 358.

vention and whether or not an attempted joinder is permissible, an application may be found defective on account of an improper joinder, and a patent upon it may be refused. In such cases the inventor may amend his application by striking out such of the inventions as it has been decided cannot be joined with the others, and may then make them the subject-matter of separate applications, inserting into each, where the inventions all relate to a common object, specific disclaimers of the inventions severally covered by the others.¹ When this amendment appears necessary on the face of the original application, it may be ordered before any action on the merits; otherwise, at any time before the final issue of the patent.

SECTION V.

OF THE APPLICATION: THE DESCRIPTION OF THE INVENTION.

§ 480. The Specification: its Importance.

The specification is the most important portion of the application. Not only does it serve as the basis of all the proceedings in the Patent Office and thus determine the right of the inventor to a patent, it also becomes a portion of the patent when granted, and as such fixes and defines the rights of the inventor and the public as against each other. In view of its importance, and in order to secure to it such characteristics as shall enable it to perform its proper functions both before and after the issue of the patent, numerous rules have been established concerning its form and contents which must be strictly observed.¹

§ 479. ¹ That where distinct inventions are embraced in the same application the application must be divided, see *Ex parte* Preston (1880), 17 O. G. 853; *Ex parte* Siemens (1877), 11 O. G. 969.

That on a division of the application disclaimers must be filed with each division, excluding the matter not claimed therein, see *Ex parte* Finch

(1883), 26 O. G. 273. See also § 467, note 2, *ante*.

That a division being once made the excluded matter cannot be reinstated, see *Ex parte* Preston (1880), 17 O. G. 853.

§ 480. ¹ That the rules of the Patent Office assume that all parts of the specification will conform to the statutes and rules, see *Ex parte* Crandall (1886), 35 O. G. 625.

§ 481. **The Specification Sets Forth the Contract between the Public and the Patentee : its Twofold Object.**

The functions of a specification and the propriety of the rules which govern it are evident from the nature of a patent. A patent is a contract between the inventor and the public, by which the inventor, in consideration that the exclusive use of his invention is secured to him for a limited period of time, confers upon the public the knowledge of the invention during that period and an unrestricted right to use it after that period has expired.¹ The public, on the other hand, acting through the government, agree with the inventor that, in consideration of his immediate bestowal upon them of a full knowledge of the invention and of the entire right to use it after the term named in his patent is at an end, they will protect him in its exclusive use during the life of his patent. In this contract resides the whole force and benefit of the patent to both parties. The specification is the instrument in which the terms of these mutual considerations and promises are declared, and on its completeness and accuracy depends the validity and the value of the contract itself. Its object is thus twofold: (1) To place the invention fully within the knowledge of the public; (2) To define the exact limits of that exclusive use which the public has undertaken to protect. All the rules into whose discussion we are now about to enter are intended to secure the accomplishment of these two objects.²

§ 481. ¹ In *Page v. Ferry* (1857), 1 Fisher, 298, Wilkins, J. : (306) "The patent may be considered in the light of a deed from the government, the consideration of which is the invention specified; and the patentee is bound to communicate it, by so full, clear, and exact a description, with drawings and models, that it shall be within the comprehension of the public at the expiration of the patent; for at that period his invention becomes public property. The exclusive privilege is not conferred merely as a reward of genius, and for the encouragement of useful inventions and improvements in arts and manu-

factures, but also embraces the public benefit." See also *Wintermute v. Redington* (1856), 1 Fisher, 239; *Gibson v. Brand* (1842), 1 Web. 627; *Walton v. Potter* (1841), 1 Web. 585.

² In *Tucker v. Tucker Mfg. Co.* (1876), 4 Clifford, 397, Clifford, J. : (400) "Exactitude in the description of an invention is required for three reasons: 1. That the government may know what they have granted, and what will become public property when the term of the monopoly expires; 2. That licensed persons desiring to practise the invention may know during the term how to make, construct, and

§ 482. The Specification: its Two Divisions the Description and the Claim.

Having these two objects to fulfil, a specification is naturally divided into two parts, not wholly independent of each other, but sufficiently distinct to be capable of, and to require, a separate consideration. These two parts are known as the Description, and the Claim.¹ It is the office of the Description to communicate to the public the knowledge of the invention. It is the office of the Claim to define the limits beyond which the public cannot pass without invading the exclusive rights of the inventor. These two parts are not simple repetitions of each other.² While the Description necessarily

use the invention; 3. That other and subsequent inventors may know what part of the field of invention is unoccupied." 10 O. G. 464 (464); 2 Bann. & A. 401 (403).

See also *Mabie v. Haskell* (1865), 2 Clifford, 507; *Forbes v. Barstow Stove Co.* (1864), 2 Clifford, 379; *Judson v. Moore* (1860), 1 Bond, 285; 1 Fisher, 544; *Wayne v. Holmes* (1856), 2 Fisher, 20; 1 Bond, 27; *Morton v. Middleton* (1863), 1 Cr. S. 3d Series, 725; *Hills v. London Gas Light Co.* (1860), 5 H. & N. 312; *Holmes v. London & N. W. R. R. Co.* (1852), Macrory, P. C. 13; *Neilson v. Thompson* (1841), 1 Web. 278; *Hornblower v. Boulton* (1799), 8 T. R. 95; 1 Abb. P. C. 98; *Arkwright v. Nightingale* (1785), 1 Web. 60; 1 Abb. P. C. 24.

§ 482. ¹ That the applicant for a patent must fully describe and exactly claim his actual invention; and when he has done this the requirements of the law are satisfied, see *Ex parte Skinner* (1881), 19 O. G. 662; *Wyeth v. Stone* (1840), 1 Story, 273; 2 Robb, 23.

That the primary object of a specification is to describe the invention, see *Aultman v. Holley* (1873), 11 Blatch. 317; 6 Fisher, 534; 5 O. G. 3.

That both Description and Claims are required in a specification, see *Ex parte Crandall* (1886), 35 O. G. 625.

That whether a Claim can also answer the purpose of a Description is doubtful, see *Smith v. Murray* (1886), 27 Fed. Rep. 69; 36 O. G. 1045.

² In *Ex parte Holt* (1884), 29 O. G. 171, Dyrenforth, Act. Com.: (178) "The description of an invention by a specification alone is not now, as formerly, all-sufficient; but the Description must be supplemented by a specific and well-defined Claim to the part, improvement, or combination which the inventor regards as his property. The aim, end, and purpose of *the specification*, under the present statute, is to *describe* the invention sought to be covered by the patent, and the manner of making, constructing and using the same. The aim, the end, the purpose of *the Claim* is to *point out particularly and distinctly define* the invention to be secured to the individual. The *Claim* is the measure of the patent, and the day has passed when the courts will search through the specification for information which it is the very office of the *Claim* to impart."

The words "description" and "claim" being used in Patent Law not only to denote the two parts of the specification but also in their common acceptation, and the rules applied to them in these different uses being in many respects dissimilar, an endeavor is made in this work to avoid the con-

contains allusions to and delineations of many other arts or instruments besides the real invention, in order to enable the latter to be clearly understood, the Claim states the invention only, enumerating its essential characteristics and excluding everything for which the protection of the patent is not desired, with an implied or express reference to the Description for a fuller explanation of such features of the invention as the brevity of the Claim may leave obscure. The purposes of the two parts being thus distinct, their form and nature will be found to differ in a corresponding manner.

§ 483. **The Description: its Object and General Requisites.**

The Description is intended to render the invention accessible to the public. By this is meant that the knowledge of the invention communicated through the Description must be so complete and accurate that during the life of the patent the scope of the protected invention shall be clearly discernible, and that after the patent has expired the public can make it available for immediate practical use without the further exercise of inventive skill.¹ A Description failing in any respect to accomplish this purpose is defective, and if the defect is incurable the patent based on the specification which embraces it is void.² The rules which have been established by the statutes, the courts, and the Patent Office for securing this completeness and accuracy in the Descrip-

fusion which would otherwise result by beginning the words with a capital letter whenever they are employed in their technical sense, as signifying parts of the specification.

§ 483. ¹ In *Parks v. Booth* (1880), 102 U. S. 96, Clifford, J. : (101) "Inventors . . . are required, before they secure a patent, to deliver a written Description of the improvement, and of the manner and process of making, constructing, and using the same, in such full, clear, and exact terms as to enable one skilled in the art or science to make, construct, and use the invention. . . . Requirements of the kind may be regarded as conditions precedent to the

right of the Commissioner to grant such an application." 17 O. G. 1080 (1090).

See also *Sullivan v. Redfield* (1825), 1 Paine, 441 ; 1 Robb, 477.

That the patent, by its very terms, must confer a useful invention on the public, see *Carr v. Rice* (1856), 1 Fisher, 198 ; Opinion Atty. Gen. (1796), 1 Op. At. Gen. 64.

That the entire invention must be specified in the most unequivocal and unambiguous language, see *Ex parte Williams* (1876), 10 O. G. 748.

² That an imperfect Description makes a patent void, see *Wayne v. Holmes* (1856), 1 Bond, 27 ; 2 Fisher, 20.

tion relate to its substance, or what it must contain, and to its form, or the mode in which what it contains must be expressed. These are now to be examined in detail in their order, — first, in reference to inventions in general; and second, in reference to each of the particular classes of inventions.

§ 484. **The Description must Disclose the Attributes of the Invention.**

According to the statutes, the Description must contain full explanations of three different subjects: the invention itself; the manner of making it; and the mode of putting it to practical use, — a complete knowledge upon all these points being necessary to render the invention available to the public without further experiment or exercise of inventive skill.¹ In describing the invention itself, each of its essential parts must be clearly and exactly delineated, and the relation of each to the others definitely portrayed.² That some are to be found

§ 484. ¹ That the Description must explain the principle of the invention and state the best known mode of constructing and operating it, see *Grier v. Castle* (1883), 17 Fed. Rep. 523; 24 O. G. 1176; *Union Sugar Refinery v. Matthiesson* (1865), 2 Fisher, 600; 3 Clifford, 639; *Page v. Ferry* (1857), 1 Fisher, 298; *Teese v. Phelps* (1855), 1 McAllister, 48; *Thomas v. Welch* (1866), L. R. 1 C. P. 192; *Morgan v. Seaward* (1836), 1 Web. 170; 2 Abb. P. C. 262; *Brunton v. Hawkes* (1821), 4 B. & Ald. 541; 1 Abb. P. C. 336.

That the invention described and claimed must correspond in principle, if not in form, with the actual invention, see *Weir v. North Chicago Rolling Mill Co.* (1883), 23 O. G. 191; 9 Bissell, 508; 14 Fed. Rep. 42.

² That the exact new invention must be described, see *Ex parte Cornell* (1872), 1 O. G. 573.

That the description of the invention varies in definiteness according to its nature, but must be sufficient to inform those skilled in the art, see *Mowry v.*

Whitney (1872), 14 Wall. 620; 1 O. G. 492; 5 Fisher, 494.

That a description of the mode of using an invention is not a description of the invention itself, see *Ex parte Doten* (1877), 12 O. G. 841.

That the description of a result does not describe the means by which it is attained, see *Burrall v. Rumsey* (1877), 13 O. G. 123.

That the Description of an invention, whose utility is dependent on some property of matter, must describe that property, see *Andrews v. Hovey* (1883), 5 McCrary, 181; 16 Fed. Rep. 387; O. G. 1011.

That the patentee is not bound by the qualities of the article described as the result of his process, but by those which actually exist in it when produced, see *Goodyear v. New York Gutta Percha & India Rubber Vulcanite Co.* (1862), 2 Fisher, 312.

That the principle to be explained is the idea of means, not the scientific principle of the invention, see *Eames v. Andrews* (1887), 122 U. S. 40; 39 O. G. 1319; *Andrews v. Cross* (1881), 8 Fed.

in the Description, and others in the drawings or models referred to in the Description, does not satisfy the requirements of this rule. The written Description must be complete in itself, although its language may be illustrated and applied by means of a model or the drawings which accompany it.³ Whatever features of the invention are indispensable to its performance of the functions which it was intended to discharge are to be described in words as accurately as the nature of the case admits; while features not thus indispensable, although in the inventor's mind inextricably connected with the others, may safely be omitted.⁴ Hence details of shape, size, quality, proportion, arrangement, and materials require delineation when essential to the operation of the art or instrument described, but otherwise are superfluous except so far as their mention may become necessary in order to set forth its essential characteristics. Besides this delineation of the parts of the invention and their mutual relations, the state of the art to which it belongs must be sufficiently de-

Rep. 269; 19 Blatch. 294; 19 O. G. 1705; *St. Louis Stamping Co. v. Quinby* (1879), 4 Bann. & A. 192; 16 O. G. 135.

That the theory on which the invention operates need not be explained, see *Eames v. Andrews* (1887), 122 U. S. 40; 39 O. G. 1319.

³ That it is not enough that the invention appears in the drawings, — it must also appear in the written Description and Claim, — see *Gunn v. Savage* (1887), 30 Fed. Rep. 366; *Roemer v. Neumann* (1885), 26 Fed. Rep. 102; *Tinker v. Wilber Eureka Mower & Reaper Mfg. Co.* (1880), 1 Fed. Rep. 138; 5 Bann. & A. 92; *Ex parte Fox* (1812), 1 Web. 431; 1 Abb. P. C. 185. *Contra*, *Poupard v. Fardell* (1869), 18 W. R. 127; *Brunton v. Hawkes* (1820), 1 Carp. P. C. 410; 1 Abb. P. C. 336.

That drawings may show the form and position of parts of the invention where the Description fails to do so, see *Banker v. Bostwick* (1880), 18 O. G. 61; 3 Fed. Rep. 517; 5 Bann. & A. 463.

That drawings cannot supply the place of a written Description to such an extent that a Claim can be construed to cover matter indicated only by the drawings, see *Gunn v. Savage* (1887), 30 Fed. Rep. 366.

That a model showing the invention cannot supply the place of a written Description, see *Barry v. Gugenheim* (1872), 1 O. G. 382; 5 Fisher, 452.

⁴ That the failure to describe an essential element renders the patent useless to the public and void, see *Carr v. Rice* (1856), 1 Fisher, 198.

That the means described must be the essential necessary means, not mere accidental adjuncts, see *Russell v. Dodge* (1876), 93 U. S. 460; 11 O. G. 151.

That a failure to describe an element embraced in the inventor's conception of his invention, but still without which the new machine will work, is not fatal to the patent, see *Carr v. Rice* (1856), 1 Fisher, 198.

scribed to show its real place in the art, and to disclose the precise points in which it differs from all inventions previously known, — thus distinguishing the new matter, to be covered by the patent, from the old which is already in the possession of the public.⁵ When several inventions are joined in one application, the same particularity of description is necessary in regard to each; and where the invention is generic, at least one species of the genus must be delineated in the manner here prescribed.

§ 485. The Description must Disclose the Manner of Making the Invention.

The manner of making the invention is the method by which the idea of means conceived by the inventor is reduced to practice. While this idea, which is the principle of the invention, is a unit and invariable, the modes of its embodiment in the concrete invention may be numerous and, in appearance, very different from each other. The applicant is not required to describe all possible forms in which this principle may be reduced to practice, or even all such forms as he may have himself adopted. These belong to the skill of the mechanic, not the inventor; and having one embodiment before them, the public are presumed to be able to construct such others as they may desire. But one mode of reducing the idea to practical utility must be described, and this must be the best one known to the inventor, since to withhold, for his own use or that of his licensees, a better form than that which he bestows upon the public would be a fraud upon them and render the patent void.¹ This description of the manner of

⁵ That the Description must distinguish the new from the old, see *Grier v. Castle* (1883), 17 Fed. Rep. 523; 24 O. G. 1176; *Sawyer v. Miller* (1882), 12 Fed. Rep. 725; 4 Woods, 472; *Phillips v. Page* (1860), 24 How. 164; *Teese v. Phelps* (1855), 1 McAllister, 48; *Dangerfield v. Jones* (1865), 13 L. T. Rep. n. s. 142; *Newall v. Elliott* (1864), 10 Jur. n. s. 954; *Holmes v. London & N. W. R. R. Co.* (1852), Macrory, P. C. 13; *Crane v.*

Price (1842), 4 M. & G. 580; 1 Web. 393; *Carpenter v. Smith* (1841), 1 Web. 530; *Manton v. Manton* (1815), Dav. P. C. 333; 1 Abb. P. C. 189.

§ 485. ¹ That the specification must describe some practicable method of carrying the invention into effect, see *Ex parte Schoonmaker* (1878), 13 O. G. 595; *Union Sugar Refinery v. Matthiesson* (1865), 2 Fisher, 600; 3 Clifford, 639.

That the specification must describe

making must embrace such a statement of the idea or principle of the invention, and of its application to the materials employed in the practice of the concrete art or the construction of the concrete instrument, that the public, following its directions, may produce from it alone a practically operative invention, performing in the best method known to the inventor the functions which it was intended to discharge.² Abstract or theoretical principles, however, being mere truths of science or speculative methods of accounting for results, need not be mentioned.³ The inventor himself is not required to understand them, nor is an acquaintance with them necessary to enable the public to reap the entire benefits of his invention.

§ 486. The Description must Disclose the Mode of Use of the Invention.

The modes of putting an invention to practical use are also often numerous and varied. They belong to the mechanical rather than the inventive side of the invention, although some mode of use must inevitably be contemplated by the inventor while employed in the development of his idea of means, and must, for the same reasons, be stated to the public in order that their knowledge of the invention, as a practically operative art or instrument, may be complete.¹ But having ex-

the best mode of applying the principle of the invention, see *Grier v. Castle* (1883), 17 Fed. Rep. 523; 24 O. G. 1176.

That to conceal the best mode for the benefit of the inventor and his licensees avoids the patent, see *Dyson v. Danforth* (1865), 4 Fisher, 133.

² That the Description is sufficient if, from it alone, a competent mechanic can construct the invention, see *Wayne v. Holmes* (1856), 2 Fisher, 20; 1 Bond, 27.

That the statement in the Description of each different method of doing a thing must be so clear that it can be done in each way by those skilled in the art, and if any such way is vaguely stated it must be erased, see *Ex parte Howe* (1883), 24 O. G. 1090.

³ That the scientific principle need not be stated, see *Eames v. Andrews* (1887), 122 U. S. 40; 39 O. G. 1319; *Andrews v. Cross* (1881), 19 O. G. 1705; 8 Fed. Rep. 269; 19 Blatch. 294; *St. Louis Stamping Co. v. Quinby* (1879), 4 Bann. & A. 192; 16 O. G. 135; *Woodward v. Dinsmore* (1870), 4 Fisher, 163.

That the reason given by the inventor for the operation of his invention is not conclusive, see *Stow v. Chicago* (1877), 3 Bann. & A. 83; 8 Bissell, 47.

§ 486. ¹ That the Description must disclose a method of putting the invention to practical use, see *American Hide & Leather Splitting & Dressing Mach. Co. v. American Tool & Mach. Co.* (1870), 4 Fisher, 284; *Holmes*, 503;

plained one mode, all other possible modes are assumed to be suggested by it, unless they depend upon the further exercise of inventive skill, in which case they become new and separate inventions.² The mode explained must be the best within the knowledge of the applicant;³ and must be described, not by asserting that a given result can be obtained by using the invention, but by prescribing certain fixed and definite rules of action by following which the given result will be accomplished.⁴

§ 487. **The Description to be Confined to these Three Points.**

To these three subjects the Description ought to be confined. Whatever matters of narration or assertion pass beyond these limits are surplusage, and if they do not render the delineation fatally ambiguous, are at least unnecessary and objectionable. Especially is this true of all expressions praising the art or instrument described, and disparaging competing inventions. The sole object of the Description is to confer knowledge upon the public concerning the intrinsic character of the new device or process and the mode of making it available in practice; and no argument as to its merits, either actual or comparative, can be appropriate in such an instrument.¹

Pitts v. Wemple (1855), 2 Fisher, 10; 1 Bissell, 87; *Felton v. Graves* (1829), 3 C. & P. 611; 1 Abb. P. C. 416; *R. v. Wheeler* (1819), 2 B. & Ald. 345; 1 Abb. P. C. 317.

² That having described one mode others need not be mentioned, see *Pike v. Potter* (1859), 3 Fisher, 55; *Derosne v. Fairie* (1835), 1 Web. 154; 2 Abb. P. C. 78.

³ That the mode described must be the best mode known to the inventor, see *Lorillard v. McDowell* (1877), 11 O. G. 640; 2 Bann. & A. 531; 13 Phila. 461.

That the patent is valid if the invention serves any use, though it will not fulfil all the uses claimed for it in the patent, see *Phillips v. Risser* (1885), 26 Fed. Rep. 308.

⁴ That the Description must not state merely a result but a mode of at-

taining it, see *Burrall v. Rumsey* (1877), 13 O. G. 123.

§ 487. ¹ In *Aultman v. Holley* (1873), 11 Blatch. 317, Woodruff, J.: (325) "The object of a specification is to describe the thing invented, so as to enable a mechanic of ordinary skill to construct it and apply it to practical use; and the Claim declares what the patentee claims as his invention. Beyond this, all essays eulogistic of its utility, and assertions of its capacity, are immaterial and useless." 6 Fisher, 534 (543); 5 O. G. 3 (7).

In *Ex parte Williams* (1872), 1 O. G. 225, Leggett, Com.: (226) "It is proper and desirable that an applicant should briefly, and in a well-condensed form, set forth clearly the present state of the art to which his invention relates; but in doing so he should not ask the

§ 488. The Description is Sufficient if Sufficient for Persons Skilled in the Art.

The language and the methods of statement employed in the description of these three subjects must be such as to place the invention fully in the possession of the public. To render an invention accessible to the public, it is not necessary that it should be so described as to be understood by all the individuals of whom the public is composed. Probably no implement, however simple and however long in use, can be comprehended and applied in practice without some previous knowledge, on the part of him who uses it, as to the end which it is designed to accomplish and the general modes in which such ends must be attained. Every invention is a single step forward in the progress of the industrial arts, and cannot be intelligible except to those who are familiar with the steps already taken and with the object which this new advance is intended to subserve. It would be impossible as well as useless for the inventor, in his application for a patent, to furnish to the general public such a complete knowledge of all past achievements in the arts as would enable them to understand the precise place occupied by his invention, and thus perceive its character, its method of construction, and its mode of use. Each of these arts has its especial votaries, men whose lives are spent in acquiring information concerning the appliances which relate to their own industry, and in putting them in practical operation both for their personal and the public good. The possession of an invention by these artisans is its possession by the public for all beneficial purposes, and the inventor who renders it accessible to them makes it as available to the community at large as, in the nature of things, it could ever be. It is to these persons, skilled in the art to which the invention appertains, that the Description of it in the specification is addressed.¹ The inventor has a right to

Office to indorse his claim to superiority over other inventions by name, nor to disparage patents granted to others. A discussion of the merits or demerits of other patents or inventions in the body of a specification is improper, and should not be indulged by the Office. While

such a discussion may be proper in an argument, it is out of place in a specification. A specification should be descriptive, not argumentative."

§ 488. ¹ In *Plimpton v. Malcolmson* (1876), L. R. 3 Ch. 531; *Jessel, M. R.*: (568) "Now what is the meaning of it

assume that all those who have recourse to his patent for their knowledge of his invention bring with them such an acquaintance with the state of the art as the ordinary prac-

being a sufficient specification? Upon that there has been a very great deal of authority. Judges have stated it in different ways, no doubt, but I do not think there is much difference in substance. In the first place, it is plain that the specification of a patent is not addressed to people who are ignorant of the subject-matter. It is addressed to people who know something about it. But then there are various kinds of people who know something about it. If it is a mechanical invention, as this is, you have, first of all, scientific mechanics of the first class, — eminent engineers; then you have scientific mechanics of the second class, — managers of great manufactories, great employers of labor, persons who have studied mechanics — not to the same extent as the first class, the scientific engineers, but still to a great extent — for the purpose of conducting manufactories of complicated and unusual machines, and who therefore must have made the subject a matter of very considerable study; and in this class I should include foremen, being men of superior intelligence, who like their masters would be capable of invention, and like the scientific engineers would be able to find out what was meant even from slight hints, and still more from imperfect descriptions, and would be able to supplement, so as to succeed even from a defective description, and even more than that, would be able to correct an erroneous description. That is what I would say of the two first classes, which I will call the scientific classes. The other class consists of the ordinary workman, using that amount of skill and intelligence which is fairly to be expected from him, — not a careless man, but a careful man, though not possessing that great scientific knowl-

edge or power of invention which would enable him by himself, unaided, to supplement a defective description or correct an erroneous description. Now, as I understand, to be a good specification it must be intelligible to the third class I have mentioned, and that is the result of the law. It will be a bad specification if the first two classes only understand it, and if the third class do not. I do not think, when the cases come to be examined, there is really any difference between the judges on this point. Their language differs, but I do not think the cases differ."

In *Mowry v. Whitney* (1871), 14 Wall. 620, Strong, J.: (644) "The specification, then, is to be addressed to those skilled in the art, and is to be comprehensible by them. It may be sufficient, though the unskilled may not be able to gather from it how to use the invention." 5 Fisher, 494 (502); 1 O. G. 492 (495).

That the Description of the invention is addressed to, persons skilled in the art, see *Roberts v. Schreiber* (1880), 5 Bann. & A. 491; 18 O. G. 125; 2 Fed. Rep. 855; *Klein v. Russell* (1873), 19 Wall. 433; *Woodward v. Morrison* (1872), 5 Fisher, 357; 2 O. G. 120; *Holmes*, 124; *Tilghman v. Mitchell* (1871), 4 Fisher, 599; 9 Blatch. 1; *Whitney v. Mowry* (1867), 3 Fisher, 157; 2 Bond, 45; *Forbes v. Barstow Stove Co.* (1864), 2 Clifford, 379.

That if the Description is sufficient to enable those skilled in the art to make and use the invention the requirement of the law is satisfied, see *Loom Co. v. Higgins* (1882), 105 U. S. 580; 21 O. G. 2031; *Roberts v. Schreiber* (1880), 5 Bann. & A. 491; 18 O. G. 125; 2 Fed. Rep. 855; *St. Louis Stamping Co. v. Quinby* (1879), 16 O. G. 135; 4

tical workmen in that art possess;³ and if he affords to them such information as enables them to practise his invention, he satisfies all the requirements of the law, although to the unskilled his statements may be wholly unintelligible.

Bann. & A. 192; *Calkins v. Bertraud* (1875), 6 Bissell, 494; 9 O. G. 795; 2 Bann. & A. 215; *Ives v. Hamilton* (1875), 92 U. S. 426; 10 O. G. 336; *Dorsey Harvester Rake Co. v. Marsh* (1873), 6 Fisher, 387; *Singer v. Walmsley* (1860), 1 Fisher, 558; *Judson v. Moore* (1859), 1 Bond, 285; 1 Fisher, 544; *Wayne v. Holmes* (1856), 1 Bond, 27; 2 Fisher, 20; *Allen v. Hunter* (1855), 6 McLean, 303; *Hogg v. Emerson* (1850), 11 How. 587; *Brooks v. Jonkins* (1843), 3 McLean, 250; 2 Robb, 118; *Whitney v. Emmott* (1831), Baldwin, 303; 1 Robb, 567; *Heath v. Unwin* (1852), 2 Web. 236; *Neilson v. Harford* (1841), 1 Web. 295; *Bickford v. Skewes* (1841), 1 Web. 214; *Elliott v. Aston* (1840), 1 Web. 222; *Galloway v. Blerden* (1839), 1 Web. 521; *Morgan v. Seaward* (1833), 1 Web. 170; 2 Abb. P. C. 262; *Crossley v. Beverly* (1829), 1 Web. 106; 1 Abb. P. C. 409; *Sturtz v. De La Rue* (1828), 5 Russ. 322; 1 Web. 83; 1 Abb. P. C. 399; *Manton v. Manton* (1815), Dav. P. C. 333; 1 Abb. P. C. 189; *Harmar v. Playne* (1809), Dav. P. C. 311; 11 East, 101; 1 Abb. P. C. 171; *Hornblower v. Boulton* (1799), 8 T. R. 95; 1 Abb. P. C. 98; *Boulton v. Bull* (1795), 2 H. Bl. 463; 1 Abb. P. C. 59; *R. v. Arkwright* (1785), 1 Web. 64; 1 Abb. P. C. 29; *Arkwright v. Nightingale* (1785), 1 Web. 60; 1 Abb. P. C. 24.

That the Description must be sufficient to enable persons skilled in the art to construct and use the invention from it alone, see *Downton v. Yaeger Milling Co.* (1879), 17 O. G. 906; 1 Fed. Rep. 199; 1 McCrary, 26; 5 Bann. & A. 112; *Keith v. Hobbs* (1878), 69 Mo. 84; *Jenkins v. Walker* (1872), 1 O. G. 359; 5 Fisher, 347; *Holmes*, 120;

Wood v. Underhill (1847), 5 How. 1; 2 Robb, 588; *Brooks v. Jenkins* (1843), 3 McLean, 250; 2 Robb, 118.

That persons "skilled in the art" are those of ordinary and fair information, not of special excellence, see *Ex parte Kerr* (1884), 28 O. G. 95; *Foxwell v. Bostock* (1864), 10 L. T. Rep. N. S. 144; *Househill Co. v. Neilson* (1842), 1 Web. 678; *Neilson v. Harford* (1841), 1 Web. 295; *Morgan v. Seaward* (1833), 1 Web. 170; 2 Abb. P. C. 262; *Sturtz v. De La Rue* (1828), 5 Russ. 322; 1 Web. 83; 1 Abb. P. C. 399; *Manton v. Manton* (1815), Dav. P. C. 333; 1 Abb. P. C. 189.

³ That the inventor has a right to assume that those who read his Description have a knowledge of the art, see *Royer v. Coupe* (1886), 29 Fed. Rep. 358; 39 O. G. 239; *Tompkins v. Gage* (1865), 2 Fisher, 577; 5 Blatch. 268.

That though the Description is to be read by persons skilled in the art, yet only known equivalents are covered by it, see *Woodward v. Morrison* (1872), 2 O. G. 120; *Holmes*, 124; 5 Fisher, 357; *Heath v. Unwin*, (1855), 25 L. T. C. P. 19.

That if, on the assumption that certain matters are known to those skilled in the art, the specification is intelligible, it is sufficient, see *Hancock Inspirator Co. v. Lally* (1886), 27 Fed. Rep. 88; 35 O. G. 1001.

That the specification of a pioneer invention is addressed to persons skilled in the art as the art existed at the date of the invention, and it cannot be supplemented by a knowledge of subsequent events or of another's invention of the same thing, see *Voelker v. Gray* (1885), 30 O. G. 1091.

That if a Description is sufficient at

§ 489. The Description Sufficient if Sufficient when Construed with the other Parts of the Application.

The inventor also has a right to assume that those who seek for information in his patent will examine it in the manner usually employed in reference to other legal documents. Every instrument, whether it be a statute, a grant, or a contract, is construed as a whole, not by detached passages; and the imperfections and obscurities of one part are thus removed or interpreted by the others. The same method must be followed in reading the specification of a patent.¹ Lan-

the date of the patent subsequent discoveries cannot make it less so, see *Celluloid Mfg. Co. v. American Zylonite Co.* (1887), 40 O. G. 1453; 30 Fed. Rep. 437.

§ 489. ¹ In *Howes v. Nute* (1870), 4 Clifford, 173, Clifford, J.: (174) "Evidently the question as to the sufficiency of the Description and specification must be determined, like a question of construction, from what is written, aided by the drawings, and, if need be, by the Patent Office model. Particular passages in the Description must not be separated from what precedes or follows them in the same connection, but one part of the instrument must be compared with another, and the whole considered together, in order to determine whether it is incomplete and ambiguous, or sufficient to uphold the Claim of the patent." 4 Fisher, 263 (265).

In *Singer v. Walmsley* (1860), 1 Fisher, 558, Giles, J.: (582) "In examining the question the jury are to look at the drawings as well as the specifications, for they are a part of the description of the thing patented; also to the state of the art at the time of the invention, and the knowledge of previous improvements in sewing-machines which were then in general use. But if, from the specifications and drawings taken as a whole, any person skilled as aforesaid could construct and use the sewing machine or device therein described

without invention of his own, which would attain the result claimed for it in the said patent, then the said patent is good although there may be a mistake in describing the action of some part of the machinery, but which mistake could be easily discovered by the mechanic when he came to examine the same."

In *Whitney v. Emmett* (1831), Baldwin, 303, Baldwin, J.: (314) "In deciding on its sufficiency, the court inspect the whole description as one paper, which they assume to be true in fact, and if found to be in conformity with the requisitions of the law, so that it appears with reasonable certainty, either from the words used or by necessary implication, in what the invention or improvement consists, as claimed by the patentee, they will adjudge it sufficient. 1 Mason's Rep. 188, 189. A description, though in some respects obscure, imperfect, or not so intelligible as to fully answer all the objects of the law, is good if it enables the court to specify the improvement or invention patented, from the face of the patent and accompanying papers. It is enough if there is a substantial description of the thing patented, though defective in form or mode of explanation. In this respect the papers will be viewed in the same light as a declaration in a suit at law; the court, looking on them as a statement of the patentee's right and title, will overlook all defects in the mode of

guage is to be considered in connection with its context; one clause of description with others relating to the same subject; delineations of the parts of the invention with directions for its construction, or its use; the written Description with the drawings and the model; the entire specification and its adjuncts with the petition, oath, and other portions of the application; and if from them, all together, the necessary knowledge can be gained by those to whom the specification is addressed, the Description is sufficient.²

§ 490. The Description must be Correct: Correctness Defined.

Having regard to the persons to whom the specification is addressed, and the interpretation which it may receive from accompanying documents, the description of each one of its three subjects-matter must be correct, complete, and intelligible.¹ A description is correct when the idea expressed by

setting it out, if it contains a substantial averment of such matter as suffices in law to make out a cause of action. This is a question of law which the court decides; it is a question for the jury to decide, whether the statements are true in fact; the court does not look beyond the patent and the other papers, but the jury decide from the papers, the evidence of the witnesses, an inspection of the old and new machine and the model, to ascertain whether in point of fact the specification, as made out at the trial, is sufficient." 1 Robb, 567 (583).

That the Description is sufficient if from it, aided by the drawings, model, and other parts of the application; the invention can be fully ascertained, see *Judson v. Moore* (1860), 1 Fisher, 544; 1 Bond, 285; *Goodyear v. Railroad* (1853), 2 Wall. Jr. 356; 1 Fisher, 626; *Kneass v. Schuylkill Bank* (1820), 4 Wash. 9; 1 Robb, 303.

That the drawings may aid the Description, see *Banker v. Bostwick* (1880), 18 O. G. 61; 3 Fed. Rep. 517; 5 Bann. & A. 463; *Swift v. Whisen* (1867), 2 Bond, 115; 3 Fisher, 343; *Judson v. Moore* (1860), 1 Fisher, 544; 1 Bond,

285; *Foss v. Herbert* (1856), 2 Fisher, 31; 1 Bissell, 121; *Earle v. Sawyer* (1825), 4 Mason, 1; 1 Robb, 490; *Daw v. Eley* (1867), 13 L. T. Rep. N. S. 399; *Hastings v. Brown* (1853), 1 E. & B. 450; *Morgan v. Seaward* (1838), 1 Web. 170; 2 Abb. P. C. 262; *Bloxam v. Elsee* (1825), 1 C. & P. 558; 1 Abb. P. C. 373.

That an imperfect Description coupled with incomplete drawings does not disclose the invention, see *New Process Fermentation Co. v. Koch* (1884), 29 O. G. 535; 21 Fed. Rep. 580.

That a mistake in copying the specification in a re-issue which is corrected by the other parts of the description is of no consequence, see *Kendrick v. Emmons* (1875), 2 Bann. & A. 208; 9 O. G. 201.

That a caveat not recited in the specification belongs to the history of the invention, not to its description, see *Ex parte Chubb* (1872), 2 O. G. 519.

² See further as to the interpretation of the Description, etc., §§ 735-745 and notes, *post*.

§ 490. ¹ In *O'Reilly v. Morse* (1853), 15 How. 62, Taney, C. J. : (119) "Who-

the words of which it consists corresponds exactly with the real nature of the thing described. The law requires this correspondence between the actual invention, or the acts by which it is constructed or put into practical use, and the language in which these several matters are portrayed.² The

ever discovers that a certain useful result will be produced, in any art, machine, manufacture, or composition of matter, by the use of certain means, is entitled to a patent for it; provided he specifies the means he uses in a manner so full and exact that any one skilled in the science to which it appertains can, by using the means he specifies, without any addition to or subtraction from them, produce precisely the result he describes. And if this cannot be done by the means he describes, the patent is void. . . . And it makes no difference, in this respect, whether the effect is produced by chemical agency or combination, or by the application of discoveries or principles in natural philosophy known or unknown before his invention, or by machinery acting altogether upon mechanical principles. In either case he must describe the manner and process as above mentioned, and the end it accomplishes.

The present statute declares that the Description must be in terms that are "full, clear, concise, and exact." The act of 1836 prescribed that the language shall be "full, clear, and exact, without unnecessary prolixity." The act of 1793 simply required terms "full, clear, and exact." The qualities intended to be secured in the Description by these provisions were evidently the three mentioned in the text, viz.: correctness, completeness, and intelligibility.

That the Description must be correct, complete, and intelligible, see *Parks v. Booth* (1880), 102 U. S. 96; 17 O. G. 1089; *Schneider v. Thill* (1880), 5 Bann. & A. 565; *Judson v. Moore* (1860), 1 Fisher, 544; 1 Bond, 285; *Brooks v.*

Jenkins (1844), 3 McLean, 432; *Park v. Little* (1813), 3 Wash. 196; 1 Robb, 17.

² In *Lowell v. Lewis* (1817), 1 Mason, 182, Story, J.: (188) "A patent is grantable only for a new and useful invention; and, unless it be distinctly stated in what that invention specifically consists, it is impossible to say whether it ought to be patented or not; and it is equally difficult to know whether the public infringe upon or violate the exclusive right secured by the patent. The patentee is clearly not entitled to include in his patent the exclusive use of any machinery already known, and if he does, his patent will be broader than his invention, and consequently void. If, therefore, the description in the patent mixes up the old and the new, and does not distinctly ascertain for which, in particular, the patent is claimed, it must be void; since if it covers the whole it covers too much, and if not intended to cover the whole, it is impossible for the court to say what, in particular, is covered as the new invention. The language of the patent act itself is decisive on this point. . . . It is, however, sufficient if what is claimed as new appear with reasonable certainty on the face of the patent, either expressly or by necessary implication. But it ought to appear with reasonable certainty, for it is not to be left to minute inferences and conjectures from what was previously known or unknown; since the question is not, what was before known, but what the patentee claims *as new*; and he may, in fact, claim as new and patentable what has been long used by the public. Whether the invention itself be thus

difficulty of framing such a Description does not dispense with its production. As no inventive act is performed until the inventor so fully comprehends his own invention that he is able to communicate its essential characteristics to other men, so nothing can be said to be invented unless it can also be described.³ This rule is, however, satisfied when the Description corresponds substantially with the necessary attributes of the subject delineated. Absolute precision, even in essentials, is not possible, owing in part to the various senses in which the same words may be employed, and in part to the different impressions made by the same object upon different minds.⁴ Slight errors in essential points and grave mistakes on immaterial points are therefore overlooked unless they would mislead a cautious reader of the whole Description. Wrong names applied to subjects or their qualities; erroneous theories as to the causes which produce a given effect;

specifically described with reasonable certainty is a question of law upon the construction of the terms of the patent, of which the specification is a part." 1 Robb, 131 (136). See also *Tucker v. Tucker Mfg. Co.* (1876), 4 Clifford, 397; 10 O. G. 464; 2 Bann. & A. 401; *Langdon v. De Groot* (1822), 1 Paine, 203; 1 Robb, 433.

That failure to describe an essential element avoids the patent, see *Schneider v. Thill* (1880), 5 Bann. & A. 565; *Carr v. Rice* (1856), 1 Fisher, 198; *Liardet v. Johnson* (1778), 1 Web. 53; 1 Abb. P. C. 22.

³ That nothing can be patented unless it can be described, and that a patentee cannot have invented what he cannot describe, see *Smith v. Downing* (1850), 1 Fisher, 64.

⁴ In *Goodyear v. Railroad* (1853), 1 Fisher, 626, Grier, J.: (634) "On account of the great vagueness and indefiniteness of the language used in describing the various arts, machines, manufactures, and compositions of matter, it is almost impossible to describe the real nature of many discoveries or

processes in language free from ambiguity or misconstruction. Different persons, looking at it from different points of view, would describe it in different terms. In the present case, one would describe it as 'the art of curing India rubber;' another, 'the art of rendering caoutchouc, and manufactures in which it is used, insensible to heat or cold, or the action of most of its known solvents;' another, as a 'fabric, manufacture, or new composition of matter, having qualities never before combined in any other known substance, being elastic, water-proof, insensible to acids, to heat, or to cold.'" 2 Wall. Jr. 356 (363).

That the description of the subject-matter must vary in definiteness according to its nature, see *Mowry v. Whitney* (1872), 14 Wall. 620; 5 Fisher, 494; 1 O. G. 492.

That absolute precision is not required, see *Dorsey Harvester Rake Co. v. Marsh* (1873), 6 Fisher, 387.

That immaterial errors are not regarded, see *McKesson v. Carnrick* (1881), 19 Blatch. 158; 21 O. G. 137; 9 Fed. Rep. 44.

unfounded statements in regard to the results which the invention will accomplish; defects which are apparent to those skilled in the art and which their ordinary mechanical information would enable them to remedy, — all these inaccuracies, and others of a similar character, are consistent with that substantial correctness in essentials without which a knowledge of the invention cannot be communicated to the public.⁵

§ 491. The Description must be Complete: Completeness Defined.

A description is complete when it embraces every essential part and attribute of the thing described. The Description in a specification is complete, within the meaning of the law, when by following it precisely as it reads, without addition or subtraction, a person skilled in the art could make and use the invention. But here, also, a perfect agreement between the language employed by the inventor and the facts and acts which it endeavors to express is not always attainable. Immaterial parts are often so connected with the material that the description of the latter inevitably draws after it the delineation of the former; and on the other hand, many material objects and operations are so familiar to the inventor

⁵ That the Description is sufficient, in spite of technical defects, if the invention clearly appears, see *Adams v. Joliet Mfg. Co.* (1877), 12 O. G. 93; 3 Bann. & A. 1.

That mistakes in naming the invention, or in assigning it to its proper class, as by calling it a product when it is a process, do not render the Description insufficient, see *Foye v. Nichols* (1882), 8 Sawyer, 201; 22 O. G. 2243; 13 Fed. Rep. 125; *Goodyear v. Railroad* (1853), 2 Wall. Jr. 356; 1 Fisher, 626; *Neilson v. Harford* (1841), 1 Web. 331; *Minter v. Mower* (1835), 1 Web. 138; 2 Abb. P. C. 178; *Derosne v. Fairie* (1835), 1 Web. 154; 2 Abb. P. C. 78.

That though the Description states that the invention will do some trifling thing which it will not do, it is still

sufficient, see *Blanchard Gun Stock Turning Factory v. Warner* (1848), 1 Blatch. 258.

That the omission to state that a certain function is the leading feature of the invention is not fatal, see *Burden v. Corning* (1864), 2 Fisher, 477.

That defects which those skilled in the art would remedy from their own knowledge are not fatal, see *Whitney v. Mowry* (1867), 3 Fisher, 157; 2 Bond, 45; *Swift v. Whisen* (1867), 3 Fisher, 343; 2 Bond, 115; *Singer v. Walmsley* (1860), 1 Fisher, 558.

That the Description is sufficient if it corresponds in principle, though not in form, with the actual invention, see *Weir v. North Chicago Rolling Mill Co.* (1883), 23 O. G. 191; 9 Bissell, 508; 14 Fed. Rep. 42.

and his readers that their specific description, or even an allusion to them, would be superfluous. The law recognizes these difficulties in the way of an absolutely complete Description, and overlooks the defects which they occasion. Though the Description is excessive it is still sufficient, unless the redundancy is fraudulent or renders the essential parts of the Description uncertain and obscure. Though it omits appliances, modifications, or processes which persons skilled in the art would know were necessary and would themselves supply; though it fails to describe implements and materials that are in common use, or methods of construction generally practised in the arts, — it may still be complete enough to put before the already trained and informed intelligence of the reader an accurate and entire picture of the invention, from which he can understand it, construct it, and use it as easily as if all these familiar acts and objects were particularly described.¹

§ 491. ¹ That the Description need not describe what is in common use, see *Thompson v. Gildersleeve* (1888), 43 O. G. 886; *Burrall v. Jewett* (1830), 2 Paige (N. Y.) 134; *Kneass v. Schuylkill Bank* (1820), 4 Wash. 9; 1 Robb, 303.

That modifications and appliances which would suggest themselves to ordinary mechanics need not be mentioned, see *Union Paper Bag Co. v. Nixon* (1873), 4 O. G. 31; 6 Fisher, 402; *Wayne v. Holmes* (1856), 2 Fisher, 20; 1 Bond, 27.

That if a process can be performed by those skilled in the art by following the directions given in the Description, using their own knowledge of the art, it is sufficient, see *Lawther v. Hamilton* (1888), 42 O. G. 487.

That well-known processes and devices need not be described, see *Mulford v. Pearce* (1875), 9 O. G. 204; 13 Blatch. 173.

That it is not necessary to describe all the uses of the invention, see *Pike v. Potter* (1859), 3 Fisher, 55.

That the Description need not men-

tion all that is necessary to secure the best effect if a good effect can be secured by what is described, see *Sewall v. Jones* (1875), 91 U. S. 171; 9 O. G. 47.

That unless a good effect can be obtained by using what is described, the patent is void, see *Sewall v. Jones* (1875), 91 U. S. 171; 9 O. G. 47.

That if persons skilled in the art can practise the invention from the description given the omission of minor details is not important, see *Burrall v. Jewett* (1830), 2 Paige (N. Y.), 134.

That the Description must show a new invention in fact, see *Head v. Stevens* (1838), 19 Wend. 411.

That the Description must be so complete that one skilled in the art can practise the invention from it alone, see *Webster Loom Co. v. Higgins* (1879), 16 O. G. 675; 15 Blatch. 446; 4 Bann. & A. 88.

That the Description need not mention all things that may be used if those which are named will answer the purpose, see *Bickford v. Skewes* (1841), 1 Web. 214; 2 Abb. P. C. 528.

§ 492. The Description must be Intelligible: Intelligibility Defined.

A description is intelligible when the language and the methods of statement which it employs convey to the mind of the reader the exact ideas embodied in the subject or the act described. A Description may be correct and complete and yet not be intelligible, either because of its undue brevity, or its excessive prolixity, or the strangeness of its words, or the confused arrangement of its sentences. Such a Description in a specification is not permissible.¹ It must not only be correct in what it states, and state completely the entire invention, but its phraseology and the collocation of its sentences must make these statements clear and plain to those skilled artisans to whom it is addressed.² The inventor may assume that they will understand the technical terms peculiar to their art, and that they will be able to follow such direc-

§ 492. ¹ That if the Description is unintelligible the patent is void, see *Sawyer v. Miller* (1882), 4 Woods, 472; 12 Fed. Rep. 725; *Hovey v. Stevens* (1846), 3 W. & M. 17; 2 Robb, 567; *Hovey v. Stevens* (1846), 1 W. & M. 290; 2 Robb, 479; *Kneass v. Schuylkill Bank* (1820), 4 Wash. 9; 1 Robb, 303; *Newberry v. James* (1817), 1 Carp. P. C. 368; 1 Abb. P. C. 282.

That vagueness of language in the Description does not defeat the patent, if the real invention can be known by it, see *Goodyear v. Railroad* (1853), 1 Fisher, 626; 2 Wall. Jr. 356.

² In *Lowell v. Lewis* (1817), 1 Mason, 182, Story, J. : (189) "A question nearly allied to the foregoing is whether (supposing the invention itself be truly and definitely described in the patent) the specification is in such full, clear, and exact terms, as not only to distinguish the same from all things before known, but 'to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same.' This is another re-

quisite of the statute (§ 3), and it is founded upon the best reasons. The law confers an exclusive patent-right on the inventor of anything new and useful, as an encouragement and reward for his ingenuity, and for the expense and labor attending the invention. But this monopoly is granted for a limited term only, at the expiration of which the invention becomes the property of the public. Unless, therefore, such a specification was made as would at all events enable other persons of competent skill to construct similar machines, the advantage to the public which the act contemplates would be entirely lost, and its principal object would be defeated. It is not necessary, however, that the specification should contain an explanation, level with the capacities of every person (which would, perhaps, be impossible); but, in the language of the act, it should be expressed in such full, clear, and exact terms, that a person skilled in the art or science of which it is a branch would be enabled to construct the patented invention." 1 Robb, 131 (137).

tions as a master-workman would give to his subordinates;⁸ but he must, in any event, bring the terms of his Description down to the level of their understanding, and in it give to

⁸ In *Mowry v. Whitney* (1871), 14 Wall. 620, Strong, J.: (644) "And it is evident that the definiteness of a specification must vary with the nature of its subject. Addressed as it is to those skilled in the art, it may leave something to their skill in applying the invention, but it should not mislead them. The objection here is that in describing the degree of heat to be applied after the wheels have been deposited in the heated chamber the patentee states it to be such that the temperature of all parts of the wheels 'may be raised to the same point, say a little below that at which fusion commences,' and the defendant insists that this amounts to a direction to raise the heat to a degree that must destroy the chill of the tread, and thus render the casting valueless as a railroad car-wheel. But it is obvious that only vague and uncertain directions could have been given respecting the extent to which the heat is necessary to be raised. It must differ with the difference in the progress of cooling which has taken place before the wheels are removed from the moulds. The process requires this removal before they have become so much cooled as to produce such inherent strain on any part as to impair its ultimate strength. Precisely when such a strain begins cannot be known. Cooling commences the instant the casting is made, and with cooling commences contraction, and strain must soon follow. Plainly it is impossible to describe the point of time when the strain has proceeded so far as to impair the ultimate strength of any part of the wheel. That, in the nature of things, must be left to the judgment of the operator." 5 Fisher, 494 (503); 1 O. G. 492 (495).

In *Judson v. Moore* (1860), 1 Fisher,

544, Leavitt, J.: (548) "The statute must have a fair and reasonable construction; and if the jury believe, from the evidence before them, that this invention can be constructed by the exercise of skill and judgment on the part of a mechanic, they will come to the conclusion that these specifications are sufficient in the aspect of the case to which I now refer. It may be remarked that in carrying out any invention the exercise of some skill and judgment on the part of the mechanic called to construct it will always be required. Something must necessarily be left to him. If with the exercise, therefore, of ordinary intelligence and skill, the jury believe that the invention could be constructed from the information given by the patent, there would be no doubt that the specifications answered the requisites of the statute." 1 Bond, 285 (290).

That if the Description uses terms intelligible to persons skilled in the art it is sufficient, see *Loom Co. v. Higgins* (1881), 105 U. S. 580; 21 O. G. 2031; *Anilin v. Higgin* (1878), 15 Blatch. 290; 14 O. G. 414; 3 Bann. & A. 462; *Monce v. Adams* (1874), 12 Blatch. 1; 7 O. G. 177; 1 Bann. & A. 126; *Singer v. Walmsley* (1860), 1 Fisher, 558.

That a Description is to be read as if the invention were present and the reader skilled in the art, see *Loom Co. v. Higgins* (1881), 105 U. S. 580; 21 O. G. 2031.

That the Description, being addressed to persons skilled in the art, is to be modified as they would modify it, see *Klein v. Russell* (1873), 19 Wall. 433.

That the ability of the inventor or his attorney to understand the Description is no proof of its intelligibility, see *Ex parte Kerr* (1884), 28 O. G. 95.

them a practical, intelligible, and reliable guide to the character of his invention, and the best method of constructing it and employing it in the arts.

§ 493. **The Description : Ambiguity, when Fatal.**

When a Description fails in either of these requisites of correctness, completeness, and intelligibility, it is said to be ambiguous; and where this ambiguity exists to any considerable degree it is fatal to the patent.¹ The courts are properly inclined to protect the inventor in spite of any errors into which he may have fallen through his own unskilfulness in the use of language, or through a too great dependence on the supposed knowledge of others. Early decisions in this country, indeed, went so far as to declare his patent valid even where his Description was so imperfect as to be practically useless as a guide to the public, unless its imperfection was intentional and fraudulent;² and though this doctrine has

§ 493. ¹ That no ambiguous or equivocal Description can be permitted, see *Ex parte Gould* (1876), 10 O. G. 203.

That when the Description is ambiguous and calculated to mislead, the patent is void, see *Carlton v. Bokee* (1872), 17 Wall. 463; 2 O. G. 520; 6 Fisher, 40; *Walton v. Potter* (1841), 1 Web. 585; 1 Abb. P. C. 345; *Campion v. Benyon* (1821), 6 Moore, 71; 1 Abb. P. C. 345.

That the consequences of uncertainty in the Description must fall on the plaintiff, see *Poppenhusen v. Falke* (1861), 2 Fisher, 181; 4 Blatch. 493.

² In *Whitney v. Emmett* (1831), Baldwin, 303, Baldwin, J. : (321) "Here the patent contains no proviso declaring it void, if the specification is not in conformity with the law; this is provided for in the sixth section as a substitute for the proviso, and defines the causes for which a circuit court can adjudge a patent void, in a civil suit, for defects in the specification. These are concealment or addition, fully appearing to have been made for the pur-

pose of misleading the public, which is wilful fraud clearly proved; but the court cannot bring within this definition a patent with a specification defective on other grounds, still less act upon the English principle, that the specification is for the purpose of giving the public the benefit of the invention after the expiration of the patent, as that would be in contradiction to the act of Congress expressly assigning other reasons. Such has been the uniform construction of the law in the circuit courts, that a patent can be declared void for no other defect in the specification than fraudulent concealment or addition. 1 Peters C. C. Rep. 401; 1 Wash. 171; 3 Wash. 198; 1 Mason, 189, 190; 1 Gall. 434; 7 Wheat. 429, 430. No discretion is left to the circuit courts to annul a patent for any reason not contained in the acts of Congress; they have not left us free to infer motives, objects, and grounds of supposed policy for requiring specifications; the third section of the act of 1793 defines them without any declaration that the

been overruled by sounder judgments, indulgence is still shown to the mistakes of inventors so far as a due regard

patent shall be void if the specification is defective. English decisions, therefore, founded on the assumed reason for the grant of a patent, are not of authority here where the Constitution and laws give other reasons, and omit the one founded on the public benefit to result from the disclosure after the expiration of the privilege. You will therefore not make that a subject of deliberation, for it is not material whether the public can profit by the invention during or after the term of the patent. The true inquiry is whether, in the spirit of the law, the plaintiffs have made such a description of the thing patented as to distinguish it from all others before known, and to enable others skilled in the matter to make, compound, or use it, and to explain the principle and mode of application by which it can be so distinguished from other inventions. If from the patent, specification, drawings, model, and old machine, clear ideas are conveyed to men of mechanical skill in the subject-matter, by which they could make or direct the making of the machine by following the directions given, the specification is good within the act of Congress." 1 Robb, 567 (591).

In *Gray v. James* (1817), Peters, C. C. 394, Washington, J. : (401) "But if the jury should be of opinion that the specification is materially defective, the objection will not be sufficient to invalidate the plaintiff's patent, unless they should also be satisfied that the concealment of the circumstances not described was intended to deceive the public. What degree of evidence ought to be required to prove such fraudulent intention must rest with the jury to decide. Positive evidence can seldom be expected, nor is it necessary. The law, it is true, requires that such intention

should fully appear ; but still it may be presumed from circumstances entirely to the satisfaction of the jury, which would be sufficient to authorize them to find the fact. As if the parts concealed are so essential and so obviously necessary to be disclosed that no mechanic skilled in the art could reasonably be expected to understand the subject, so as from the description given to make the machine, it would be difficult to impute the omission of the patentee to a fair motive. But this presumption would seem to be much weakened in a case like the present, where so many practical mechanics have testified that they could not hesitate in supplying the omissions in this specification." 1 Robb, 120 (128).

In *Whittemore v. Cutter* (1813), 1 Gallison, 429, Story, J. : (435) "It is therefore argued that if the specification be materially defective, or obscurely or so loosely worded that a skilful workman in that particular art could not construct the machine, it is a good defence against the action, although no intentional deception has been practised. And this is beyond all question the doctrine of the common law ; and it is founded in good reason ; for the monopoly is granted upon the express condition that the party shall make a full and explicit disclosure, so as to enable the public, at the expiration of his patent, to make and use the invention or improvement in as ample and beneficial a manner as the patentee himself. If, therefore, it be so obscure, loose, and imperfect that this cannot be done, it is defrauding the public of all the consideration upon which the monopoly is granted. And the motive of the party, whether innocent or otherwise, becomes immaterial, because the public mischief remains the same. It is said that the

to the rights of the public will permit.³ However vague may be the representation of his invention given by the Description, if from it, taken in connection with its accompanying drawings and model, a person skilled in the art to which it belongs can by the exercise of his mechanical powers and information alone construct and use the invention, the ambiguity is not fatal.⁴ But if experiment or inventive skill on

law is the same in the United States, notwithstanding the wording of the sixth section, for there is a great distinction between a concealment of material parts, and a defective and ambiguous description of all the parts; and that in the latter case, although there may be no intentional concealment, yet the patent may be avoided for uncertainty as to the subject-matter of it. There is considerable force in the distinction at first view; and yet, upon more close examination, it will be difficult to support it. What is a defective description but a concealment of some parts necessary to be known in order to present a complete view of the mechanism? In the present case the material defects were stated, among other things, to consist in a want of a specific description of the dimensions of the component parts, and of the shapes and position of the various knobs. Were these a concealment of material parts, or a defective and ambiguous disclosure of them? Could the Legislature have intended to pronounce that the concealment of a material spring should not, unless made with design to deceive the public, avoid the patent, and yet that an obscure description of the same spring should at all events avoid it? It would be somewhat hazardous to attempt to sustain such a proposition. It was probably with a view to guard the public against the injury arising from defective specifications that the statute requires the letters-patent to be examined by the attorney general, and certified to be in conformity to the law, before the great

seal is affixed to them. In point of practice, this must unavoidably be a very insufficient security, and the policy of the provision that has changed the common law may be very doubtful. This, however, is a consideration proper before another tribunal. We must administer the law as we find it. And, without going more at large into this point, we think that the manifest intention of the Legislature was, not to allow any defect or concealment in a specification to avoid the patent, unless it arose from an intention to deceive the public. There is no ground, therefore, on which we can support this objection." 1 Robb, 28 (34).

In *Park v. Little* (1813), 3 Wash. 196, Washington, J. : (198) "It is true that the thing for which the patent is granted should be truly and fully described in the specification; but if this is done, so as clearly to distinguish it from all other things before known, and so as to enable any person skilled in the art of which it is a branch, or with which it is most nearly connected, to make and use the same, it is sufficient, — the matters not disclosed must appear to have been concealed for the purpose of deceiving the public, to invalidate the patent." 1 Robb, 17 (19).

³ That ambiguity in the Description is fatal irrespective of the intent of the inventor, see *Blake v. Stafford* (1868), 3 Fisher, 294; 6 Blatch. 195; also §§ 969, 970, 972, 1035, 1037 and notes, *post*.

⁴ In *Ames v. Howard* (1833), 1 Sumner, 482, Story, J. : (485) "The

the part of the constructor or the user is necessary to render the invention available in practice, the Description is fatally ambiguous, and the patent granted on the specification which contains it is invalid.⁶

Constitution of the United States, in giving authority to Congress to grant such patents for a limited period, declares the object to be to promote the progress of science and useful arts, an object as truly national, and meritorious, and well-founded in public policy as any which can possibly be within the scope of national protection. Hence it has always been the course of the American Courts (and it has latterly become that of the English courts also) to construe these patents fairly and liberally, and not to subject them to any over-nice and critical refinements. The object is to ascertain what, from the fair sense of the words of the specification, is the nature and extent of the invention claimed by the party; and when the nature and extent of that claim are apparent, not to fritter away his rights upon formal or subtile objections of a purely technical character. Now let us see what is the invention, as claimed by the plaintiff in the specification in this case. I agree that if he has left it wholly ambiguous and uncertain, so loosely defined, and so inaccurately expressed that the court cannot, upon a fair interpretation of the words and without resorting to mere vague conjecture of intention, gather what it is, then the patent is void for this defect. But if the court can clearly see what is the nature and extent of the claim, by a reasonable use of the means of interpretation of the language used, then the plaintiff is entitled to the benefit of it, however imperfectly and inartificially he may have expressed himself. And for this purpose we are not to single out particular phrases standing alone, but to

take the whole in connection." 1 Robb, 680 (392).

That ambiguity is not fatal unless the Description is rendered unintelligible, see *Swift v. Whisen* (1867), 2 Bond, 115; 3 Fisher, 343; *Judson v. Moore* (1860), 1 Fisher, 544; 1 Bond, 285.

That ambiguity may be removed by the oath or other parts of the application, see *Pettibone v. Derringer* (1818), 4 Wash. 215; 1 Robb, 152.

That if the Description has no apparent meaning when construed by the court, the patent is void, see *Emerson v. Hogg* (1845), 2 Blatch. 1.

That any ambiguity, which is sufficient to perplex persons skilled in the art, is fatal, see *Page v. Ferry* (1857), 1 Fisher, 298.

See also §§ 969, 970, 1034, 1035 and notes, *post*.

⁶ That the Description must so disclose the invention that no further exercise of inventive skill is necessary in order to practise it, see *Neilson v. Harford* (1841), 1 Web. 331; *Morgan v. Seaward* (1836), 1 Web. 170; 2 Abb. P. C. 262; *R. v. Arkwright* (1785), 1 Web. 64; 1 Abb. P. C. 29.

That no further experiment must be needed to practise the invention, see *Lockwood v. Faber* (1886), 27 Fed. Rep. 63; *Simpson v. Holliday* (1865), 12 L. T. Rep. n. s. 99; *Muntz v. Foster* (1844), 2 Web. 96; *McNamara v. Hulse* (1842), 2 Web. 128; 1 Coll. 477; *Neilson v. Harford* (1841), 1 Web. 331; *R. v. Wheeler* (1819), 2 B. & Ald. 345; 1 Abb. P. C. 317; *R. v. Arkwright* (1785), 1 Web. 64; 1 Abb. P. C. 29.

§ 494. **The Description: False Suggestion Fatal.**

A wilful false suggestion or concealment, in any point material to the invention or to the mode of making or using it, is also fatal to the interests of the inventor. He is obliged to keep faith with the public; and as he seeks to obtain the widest protection which it is in their power to bestow, he is, in his turn, bound to confer on them his entire secret in its most available and beneficial form. If for the purpose of misleading them and securing some advantage to himself, he states in his Description less than the whole truth, or asserts that things are necessary to produce the desired effect when he knows that they are not so, the fact that some degree of benefit may be derived from what he has described will not prevent the forfeiture of all right to any patent for the invention.¹ Such wilful fraud is never presumed from any defect in the Description which can be otherwise accounted for, but is to be established by direct or circumstantial evidence.²

§ 495. **The Description: its Form.**

Subject to the foregoing rules, the Description is left to the judgment and choice of the inventor. No particular form of words is prescribed to him, though where two or more phrases

§ 494. ¹ That a false suggestion in a material part of the specification avoids the patent, see *Delano v. Scott* (1834), *Gilpin*, 439; 1 *Robb*, 700; *Simpson v. Holliday* (1864), 20 *Newt. L. J. N. S.* 108; *Galloway v. Bleaden* (1839), 1 *Web.* 521; *Bloxam v. Elsee* (1825), 1 *C. & P.* 558; 1 *Abb. P. C.* 373.

That if the patent describes a false principle while the true one is disclosed to licensees, the patent is fraudulent and void, see *Dyson v. Danforth* (1865), 4 *Fisher*, 133.

That a concealment by which the patentee obtains an advantage over the public, if wilful, avoids the patent, see *Heath v. Unwin* (1852), 2 *Web.* 236; *Tetley v. Easton* (1852), *Macrory*, *P. C.* 48; *Walton v. Bateman* (1842), 1 *Web.* 613; *Neilson v. Harford* (1841), 1 *Web.* 295; *Morgan v. Seaward* (1836), 1

Web. 170; 2 *Abb. P. C.* 262; *Lewis v. Marling* (1829), 1 *Web.* 493; 1 *Abb. P. C.* 421; *Crompton v. Ibbotson* (1828), 1 *Web.* 83; 1 *Abb.* 394; *Bovill v. Moore* (1816), *Dav. P. C.* 361; 1 *Abb. P. C.* 231; *Wood v. Zimmer* (1815), 1 *Web.* 82; 1 *Abb. P. C.* 202; *Turner v. Winter* (1787), 1 *Web.* 77; 1 *Abb. P. C.* 43; *R. v. Arkwright* (1785), 1 *Web.* 64; 1 *Abb. P. C.* 29.

That if the Description asserts that things are necessary when they are known to the patentee to be useless, the patent is void, see *Lewis v. Marling* (1829), 1 *Web.* 493; 1 *Abb. P. C.* 421; *Huddart v. Grimshaw* (1803), 1 *Web.* 85; 1 *Abb. P. C.* 128; *R. v. Arkwright* (1785), 1 *Web.* 64; 1 *Abb. P. C.* 29.

See also § 969 and notes, *post.*

² See § 1034 and notes, *post.*

are open to his use the clearest and most easily understood is to be selected.¹ His modes of definition may vary according to the nature of the subject to which they relate, stating the characteristics and qualities of his invention in express language, or causing them to appear by necessary implication.² At the outset he should specify the particular art to which the invention appertains, and may then describe it either by concrete illustrations or the enumeration of its peculiar properties.³ The old and the new may be distinguished from each other by separate delineations, or both may be embraced in one general Description and the line be subsequently drawn between them by the Claim; and in describing the old, if patented, the prior patent may be referred to and be incorporated by such reference into the new specification.⁴ Words of recommendation may be used instead of words of direction, and will be regarded as essential parts of

§ 495. ¹ In *Wyeth v. Stone* (1840), 1 Story, 273, Story, J.: (286) "I agree that the patentee is bound to describe, with reasonable certainty, in what his invention consists, and what his particular claim is. But it does not seem to me that he is to be bound down to any precise form of words; and that it is sufficient, if the court can clearly ascertain, by fair interpretation, what he intends to claim, and what his language truly imports, even though the expressions are inaccurately or imperfectly drawn." 2 Robb, 23 (36).

That where there is a choice of expressions the inventor must select the clearest, see *Ex parte Gould* (1876), 10 O. G. 203.

² That the language and definitions of a Description vary with the subject-matter, see *Mowry v. Whitney* (1872), 14 Wall. 620; 5 Fisher, 494; 1 O. G. 492.

That the ordinary meaning of words, such as "tempering," is governed by the general language of the specification, see *Cary v. Lowell Mfg. Co.* (1887), 40 O. G. 1239; 31 Fed. Rep. 344.

³ That the Description ought to point out, at the beginning, the particular art.

machine, article, or composition to which the invention relates, in order that the whole specification may be read as applicable thereto, see *Ex parte Thompson* (1879), 16 O. G. 588.

That concrete and illustrative descriptions are as proper as abstract ones, see *Goodyear v. Railroad* (1853), 2 Wall. Jr. 356; 1 Fisher, 626.

⁴ That old parts may be distinguished from new by describing all and claiming the whole when so constructed as to produce the given effect, see *Gottfried v. Phillip Best Brewing Co.* (1879), 17 O. G. 675; 5 Bann. & A. 4.

That it is proper to describe the whole invention and point out what is new and what old, see *Wintermute v. Redington* (1856), 1 Fisher, 239.

That in distinguishing the new from the old the patentee is bound by the description as he gives it, see *Goodyear v. Railroad* (1853), 1 Fisher, 626; 2 Wall. Jr. 356.

That a prior patent may be referred to in the Description to show differences between it and the present invention, see *Ex parte Chubb* (1872), 2 O. G. 519.

the Description or not, as the actual nature of the invention may require.⁵ The application of a new natural force may be described either by describing the result with the mode of obtaining it, or by describing the means employed to produce it.⁶ But indirect methods of description should not be re-

⁵ In *Sewall v. Jones* (1875), 91 U. S. 171, Hunt, J. : (185) "Farther on, the patentee, Winslow, says, 'I recommend the following method.' This is not of the substance of the patent. A recommendation is quite different from a requirement. The latter is a demand, an essential, a necessity. The former is a choice or preference between different modes or subjects, and is left to the pleasure or the judgment of the operator. He may adopt it. He will do well if he does. But he may reject it, and still accomplish his object by means of the patent. The principle is this : The omission to mention in the specification something which contributes only to the degree of benefit, providing the apparatus would work beneficially and be worth adopting without it, is not fatal, while the omission of what is known to be necessary to the enjoyment of the invention is fatal. Curtis, sect. 248. An excess of description does not injure the patent, unless the addition be fraudulent. Id. sect. 250. Accordingly, when the inventor says, 'I recommend the following method,' he does not thereby constitute such method a portion of his patent. His patent may be infringed although the party does not follow his recommendation, but accomplishes the same end by another method." 9 O. G. 47 (49).

That the phrase "it is desirable, etc.," may make the thing referred to a part of the invention, see *Klein v. Russell* (1873), 19 Wall. 433.

⁶ In *Andrews v. Hovey* (1883), 5 McCrary, 181, Shiras, J. : (193) "It is not necessary to extend these quotations to show that the principle which

it is claimed constitutes the discovery or invention of Colonel Green, as described in the re-issued patent, is that the production of a vacuum in the earth by means of an air-tight tube driven into the earth, to which is attached a suction pump, will greatly increase the supply of water. To produce this vacuum it is necessary that the tube forming the lining of the well should be in such close contact with the surrounding earth as to be air-tight; and it is claimed that driving the tube into the ground, whether with or without originally perforating the earth with a rod, constitutes a mode of constructing a well which practically results in producing a well whose lining, — to wit, the tube — is in air-tight connection with the earth. In other words, in order to successfully apply the principle, it is absolutely essential that the tube forming the lining of the well should be in such close contact with the earth that the air cannot pass down around the outside of the tube, and the pump used in drawing up the water must also be attached to the end of the tube by an air-tight connection. Unless both of these conditions are fulfilled it is impossible to create a vacuum in the tube, and about the portion of it inserted in the water-bearing stratum; and as the creation of this vacuum is the essential and only means of applying the principle which it is claimed constitutes the chief merit of Colonel Green's invention or discovery, it follows that in order to protect such a discovery by a patent it must be included within the specifications. This may be done by either a proper description of the result to be obtained, with the mode

sorted to where the same degree of correctness and completeness is not attainable by them as might be reached by the direct.⁷ General words describing an effect do not describe the cause, unless the cause and the effect are indissolubly connected and are commensurate with each other.⁸ The description of a class of substances as an element in the invention is not correct except when each substance in the class will serve the purpose.⁹ A device is not portrayed by the delineation of its mode of use, nor is the use itself described unless a practical rule is given by following which the desired result can be obtained.¹⁰ In describing a generic

or means to be employed in producing the same, or by simply describing the means employed to accomplish the result; that is to say, it would be sufficient if it was stated that, by the use of certain prescribed means, a vacuum in and about the tube would be created, and thereby the supply of water would be increased, or if it was stated that the tubing of the well was so driven as to be made air-tight by contact with the surrounding earth, and the pump to be used was affixed to the tube by an air-tight connection. In the latter case the result reached or the principle put into operation would not be described; but as the means described must necessarily produce the result, or apply the principle, it is held sufficient to describe the means employed, without specifying the principle which is thereby brought into play. Indeed, it is not necessary that the inventor, to be entitled to a patent, should himself understand the abstract principle which his invention brings into use. It is sufficient if he is the inventor of a means whereby a new and useful application of the abstract principle is brought about. Still, as already remarked, it is necessary that in the patent and specifications the new and useful application of the principle must be described, either by setting forth the result obtained, with the means of its accomplishment, or else by

such a description of the means employed as will, if followed, necessarily produce a result which embodies the practical application of the principle involved." 16 Fed. Rep. 387 (395); 26 O. G. 1011 (1014).

That it is not enough to describe a result, — its mode of attainment must be shown, — see *Burrall v. Rumsey* (1877), 13 O. G. 123.

That a product may be described by describing its mode of production if no clearer way exists, see *Anilin v. Higgin* (1878), 15 Blatch. 290; 14 O. G. 414; 3 Bann. & A. 462.

⁷ That a Description is sufficient if it contains a proper designation of the invention, a clear statement of its parts, its operation, and its relation to surrounding matters, a distinct separation of the new from the old, and is followed by well-defined Claims, see *Ex parte Thompson* (1879), 16 O. G. 588.

⁸ That general words indicating an effect become descriptive of the cause only when the cause invariably produces the effect, see *Ex parte Carlock* (1875), 8 O. G. 191.

⁹ That if a class of substances be described as forming an element in the invention, the patent is void if any substance of the class will not answer the purpose, see *Schneider v. Thill* (1880), 5 Bann. & A. 565.

¹⁰ That to describe a mode of use is

invention, one species of the genus must be also described, and more may be, though but one species can be claimed and covered by the patent.¹¹

§ 496. **The Description when the Invention is a Combination.**

The general rules already stated are appropriate to the Description of all classes of inventions. Their application to particular classes has resulted in the establishment of subordinate rules in reference to each class, with the view of securing in its Description the necessary correctness, completeness, and intelligibility. These we shall now consider, commencing with those which relate to combinations. The essential features of a combination are its several elements and their co-operative law. Each of these must, therefore, be specifically described, and the drawings as well as the written matter must represent the elements in combination. This is no less imperative where the elements which enter into the combination are old and well known than where they are original with the inventor of the combination and have never been communicated to the public.¹ But beyond these essential features the Description need not go. The mechanism by which the elements of the combination are connected

not a description of the thing used, see *Ex parte Doten* (1877), 12 O. G. 841.

That the Description must give a fixed rule which can be successfully followed, though variations from it may be possible in practice, see *Tilghman v. Werk* (1862), 1 Bond, 511; 2 Fisher, 229.

¹¹ That a specification for a generic invention need describe but one species, though it may describe more, see *Ex parte Ewart* (1880), 17 O. G. 448.

That constructions illustrating generic Claims, but not themselves the basis of any Claim, may be described, see *Ex parte Howe* (1883), 25 O. G. 1189.

§ 496. ¹ That the specification of a combination of old elements must describe the old elements and the mode of combining them, see *Merrill v. Yeo-*

mans (1877), 94 U. S. 568; 11 O. G. 970.

That a vague description of a combination element or its total omission are vital defects of form, see *Ex parte Mill* (1887), 40 O. G. 918.

That a class of objects cannot be described as an element unless every object of that class will answer the purpose, see *Schneider v. Thill* (1880), 5 Bann. & A. 565; *Turner v. Winter* (1787), 1 Web. 77; 1 Abb. P. C. 43.

That where a specification confines the invention to one article as an element in a combination and says or implies that no other article will answer, no other article can be its equivalent, see *Schillinger v. Cranford* (1885), 4 Mackay, 450; 37 O. G. 1349.

with each other, those parts of the entire device which are either useless or serve incidental purposes not within the scope of the co-operative law, and the general invention of which the present combination might be a subordinate factor, may be omitted, except when its description is required in order to render that of the new invention sufficiently intelligible.²

§ 497. **The Description when the Invention is an Art.**

The essential characteristics of an art reside in the acts of which it is composed. These acts must, therefore, be correctly, completely, and intelligibly described. Physical means of some kind being required for the performance of these acts, such means and the mode of using them must also be particularly delineated, unless from the nature of the acts described they are sufficiently obvious to those to whom the specification is addressed.¹ But the Description need not include all the different physical means by which the art may be exercised, nor declare all the modes in which such means may be employed, provided the art can be successfully practised by using the apparatus actually described according to the rule laid down by the inventor.²

² That useless parts of a combination are not elements, see *Ex parte West* (1872), 2 O. G. 30. See also § 278 and notes, *ante*.

That a Description is good though it includes useless parts, if it does not state that they are essential, see *Lewis v. Marling* (1829), 1 Web. 493; 4 C. & P. 56; 1 Abb. P. C. 421.

That where the elements of a combination are clearly pointed out, other particulars of construction do not belong in it as an invention, see *Temple Pump Co. v. Goss Pump & Rubber Bucket Mfg. Co.* (1887), 39 O. G. 467; 30 Fed. Rep. 440; 31 Fed. Rep. 292.

§ 497. ¹ That the Description of an art must disclose the means, by which it can be successfully practised, with sufficient clearness to enable those skilled in the art to carry it into effect, unless

such means are obvious, see *The Telephone Cases* (1888), 126 U. S. 1; 43 O. G. 377; *Tilghman v. Proctor* (1881), 102 U. S. 707; 19 O. G. 859; *Downton v. Yaeger Milling Co.* (1880), 5 Bann. & A. 112; 1 McCrary, 26; 1 Fed. Rep. 199; 17 O. G. 906; *Ex parte Elbers* (1877), 12 O. G. 2; *Booth v. Kennard* (1837), 2 H. & N. 84; *Rex v. Wheeler* (1819), 2 B. & Ald. 345; 1 Abb. P. C. 317; *Boulton v. Bull* (1795), 2 H. Bl. 463; 1 Abb. P. C. 59.

That the Description of a chemical process is not addressed to persons ignorant of chemistry, see *Allen v. Hunter* (1855), 6 McLean, 303; *Heath v. Unwin* (1852), 2 Web. 236.

² That where the Description of a process gives a fixed rule which can be successfully followed it is sufficient, though variations from it are possible,

§ 498. The Description when the Invention is a Machine.

A machine is a mode of operation embodied in tangible materials. Its essence or principle is its structural law, and this must, therefore, be correctly and intelligibly explained. As this principle can be made available for use only by its expression in some actual mechanism, the best mode of constructing and employing such a mechanism must also be described. Every integral part of the machine, with its position and relation to the other parts, and with all those details of shape, proportion, and materials which are essential to the operation of the mechanism as a whole, should be delineated in such a manner as to distinguish the principle of this machine from those which underlie and govern all previous machines.¹ Other matters serve only the purposes of illustration, and may be omitted if the machine and its principle can be fully understood without them.²

see *Tilghman v. Werk* (1862), 1 Bond, 511 ; 2 Fisher, 229.

That a rule requiring heat "not less than 310°" does not limit the invention to that degree if the process is the same, see *Buchanan v. Howland* (1863), 2 Fisher, 341.

That where the Description of a chemical process uses terms applicable to several substances only one of which will answer, it is insufficient, see *Anilin v. Levinstein* (1884), L. R. 29 Ch. 366.

That where some heat is needed and no exact degree can be given because dependent on the condition of the substance treated, if a *maximum* and *minimum* are stated, the rest may be left to the judgment of the operator, see *Mowry v. Whitney* (1871), 14 Wall. 620 ; 5 Fisher, 494 ; 1 O. G. 492.

That a process may be described by describing either the result with the mode of obtaining it, or the means employed to produce it, see *Andrews v. Hovey* (1883), 16 Fed. Rep. 387 ; 5 McCrary, 181 ; 26 O. G. 1011.

That a process cannot be inferred by the court or the public from a descrip-

tion of its product, see *Western Electric Co. v. Ansonia Co.* (1885), 114 U. S. 447 ; 31 O. G. 1305.

§ 498. ¹ That the Description of a machine is sufficient when it contains a proper designation of the invention, a clear description of its parts, its operation, and its relation to surrounding matters, a distinct separation of the new and old, and is followed by well-defined Claims, see *Ex parte Thompson* (1879), 16 O. G. 588.

That a Description of the mode of using a machine is not a Description of the machine itself, see *Ex parte Doten* (1877), 12 O. G. 841.

That the failure to describe an essential element renders the whole Description defective, see *Carr v. Rice* (1856), 1 Fisher, 198 ; *Felton v. Greaves* (1829), 3 C. & P. 611 ; 1 Abb. P. C. 416.

That a failure to describe an element embraced in the idea of the inventor, but without which the new machine will work, is not a fatal defect, see *Carr v. Rice* (1856), 1 Fisher, 198.

² In *Page v. Ferry* (1857), 1 Fisher, 298, Wilkins, J. : (307) "Where the

§ 499. *The Description when the Invention is a Manufacture.*

A manufacture is the most indefinite of all the different classes of inventions. Its essential qualities are, of course, those without which it would cease to be the particular invention that it now is; but what these qualities are it is often difficult to ascertain and to declare. Various methods of describing manufactures have therefore been adopted, to suit the varying character of these inventions. Where its essential qualities are discernible these may be enumerated, and if this can be so clearly and precisely done as not only to give a complete knowledge of the new manufacture, but also to distinguish it from all others, it is the best mode of describing it. Where this is impossible, the process by which the manufacture is produced may be particularly delineated and the manufacture described as the result of that peculiar process. If the manufacture is obtained by using chemicals, the substances employed and their mode of use may be stated and the nature of their product thus defined.¹ But in all cases

object of the patent may be obtained by a competent mechanic of ordinary skill, one acquainted with the structure of similar machines, or structures involving the same principle, by fairly following out the specifications and drawings, without other inventions or additions or experiment, the patent is valid and unimpeached, and the rule of law is sufficiently met."

In *Brooks v. Jenkins* (1844), 3 McLean, 432, the court say: (447) "The utmost precision in the Description of the machine is not to be expected, nor is it essential. Parts of machinery and processes generally known need not be described. A wedge, pulleys, rollers, rack and pinion, and other things, known to all mechanics, will be supplied by the mechanist without stating their size or structure. Nor is it essential to state the proportionate parts of a machine, nor the velocity of its operations. These are matters of adjustment for the eye and judgment of the constructor. Whether a machine be large in its parts

or small, its motion slow or quick, makes no difference in the principle of it." See also *Temple Pump Co. v. Goss Pump & Rubber Bucket Mfg. Co.* (1887), 39 O. G. 467; 30 Fed. Rep. 440; *Singer v. Walmsley* (1860), 1 Fisher, 558; *Crossley v. Beverly* (1827), 1 Web. 106; 1 Abb. P. C. 409.

That the Description of a machine need not include modifications and appliances which practical use or their general knowledge would suggest to mechanics, see *Union Paper Bag Co. v. Nixon* (1873), 4 O. G. 31; 6 Fisher, 402.

That the phrase "vertical or nearly so" is certain enough for skilled mechanics, see *Swift v. Whisen* (1867), 2 Bond, 115; 3 Fisher, 343.

§ 499. ¹ That a manufacture may be described by describing its mode of production, if no better way exists, see *Anilin v. Higgin* (1878), 15 Blatch. 290; 14 O. G. 414; 3 Bann. & A. 462.

That a product may be described and claimed as the result of a described pro-

the manufacture must, in some way, be fully explained and be distinguished from all other inventions, and this being done, other assertions regarding it are immaterial. Thus when the manufacture can be understood without it, the process or machine by which it is produced need not be mentioned;² and if their description is attempted, a defect therein will not impair the validity of that by which the manufacture is explained.³

§ 500. **The Description when the Invention is a Composition of Matter.**

A composition of matter is a group of ingredients intermingled in a specific manner and producing a specific result which has new properties of its own. Thus it presents three essential subjects for description: the ingredients, their mode of intermixture, and the resulting composition. Each of the ingredients must be completely and exactly described, either by the name given to it in the arts or by an enumeration of its qualities, or in some other way intelligible to those who are to use it. Nothing must be left to experiment either as to their nature or their number, and no substance should be specified as an ingredient unless it is essential to the composition, since the inventor will be so far concluded by it that he cannot claim that any composition is identical with his un-

cess or "any process which will produce a like result," see *Pickhardt v. Packard* (1884), 23 Blatch. 23; 30 O. G. 179; *Anilin v. Higgin* (1878), 15 Blatch. 290; 14 O. G. 414; 3 Bann. & A. 462.

That unless a product is so described that it can be recognized apart from the description of the process of making it the patent will cover it only when made by that process, see *Cochrane v. Anilin* (1884), 111 U. S. 293; 27 O. G. 813.

That if the manufacture as disclosed by the Description is useful it is sufficient, though if better described it could be made to be more useful, see *McNamara v. Hulse* (1842), Car. & M. 471; 2 Web. 129.

² That a Description of a manufacture

need not describe the mode of producing it, see *McCloskey's Application* (1879), 3 MacArthur, 14; *Cohn v. United States Corset Co.* (1876), 93 U. S. 366; 11 O. G. 457; *Cohn v. United States Corset Co.* (1874), 12 Blatch. 225; 1 Bann. & A. 340; 6 O. G. 259.

³ That a specification may be sufficient for a product when it would not suffice if the invention were a machine, see *Brass Co. v. Miller* (1871), 5 Fisher, 48; 9 Blatch. 77.

That if the product be fully described and also the machine for making it, the description of the product will be sufficient though the machine prove useless, see *Magic Ruffle Co. v. Douglass* (1863), 2 Fisher, 330.

less it employs such substance or its equivalent.¹ In describing the mode of intermixture, the quantity and proportions of the several ingredients, and the process of compounding them, must be correctly and precisely stated. Here, also, nothing must be left open to be determined by experiment.² Where quantities and proportions must be exact in order to produce the composition, the Description must furnish this exact rule.³ Where variations in proportions or quantity are

§ 500. ¹ That ingredients must be so described that no further experiment to discover them will be needed, see *Tyler v. Boston* (1868), 7 Wall. 327; *Wood v. Underhill* (1847), 5 How. 1; 2 Robb, 588.

That the general description of a class of objects as ingredients is insufficient if one member of the class will not answer, see *Bickford v. Skewes* (1839), 1 Web. 214; *Turner v. Winter* (1787), 1 Web. 77; 1 Abb. P. C. 43.

That where "water" is mentioned as an ingredient any water must answer the purpose, see *Keith v. Hobbs* (1878), 69 Mo. 84.

That ingredients must be called by their usual names so as not to mislead, see *Strutz v. De La Rue* (1828), 1 Web. 83; 5 Russ. 323; 1 Abb. P. C. 399; *Savory v. Price* (1823), 1 Ry. & Mo. 1; 1 Web. 83; 1 Abb. P. C. 366.

² In *Jenkins v. Walker* (1872), Holmes, 120, Shepley, J.: (123) "When the specification of a new composition of matter gives only the names of the substances which are to be mixed together, without stating any relative proportion, undoubtedly it would be the duty of the court to declare the patent to be void; and the same rule would prevail when it was apparent that the proportions were stated ambiguously or vaguely; for in such cases it would be evident on the face of the specification that no one could use the invention without first ascertaining by experiment the exact proportions of the different ingredients required to produce

the result intended to be obtained. The specification must be in such full, clear, and exact terms as to enable any one skilled in the art to which it appertains to compound and use the invention; that is to say, to compound and use it without making any experiments of his own." 1 O. G. 359 (361); 5 Fisher, 347 (351).

In *Tyler v. Boston* (1868), 7 Wall. 327, Grier, J.: (330) "Now a machine which consists of a combination of devices is the subject of invention, and its effects may be calculated *a priori*, while a discovery of a new substance by means of chemical combinations of known materials is empirical and discovered by experiment. Where a patent is claimed for such a discovery, it should state the component parts of the new manufacture claimed with clearness and precision, and not leave the person attempting to use the discovery to find it out 'by experiment.' The law requires the applicant for a patent right to deliver a written Description of the manner and process of making and compounding his new-discovered compound. The art is new; and therefore persons cannot be presumed to be skilled in it, or to anticipate the result of chemical combinations of elements not in daily use."

That the proportions of ingredients must be so described that no further experiment will be needed to discover them, see *Wood v. Underhill* (1847), 5 How. 1; 2 Robb, 588.

³ That the phrase "about" in a

consistent with the attainment of the desired result, the limits of such variations must be definitely given.⁴ If differences in the quality or strength of the ingredients as commonly found existing in the arts require differences of proportion, this must be disclosed and a rule given which can be practically followed. The intermixture of ingredients is an art or process, and must be described in the same manner as any other art, each act with the physical means for performing it being specified unless already obvious to those skilled in the art.⁵ The composition itself may be described in the same method as a manufacture, either by enumerating its essential qualities, or where it is inseparably connected with the mode of production, by stating it as the result of the particular intermingling of the ingredients before described.⁶ In these descriptions

Description is uncertain, and the quantity or degree named will be taken as exact, the word "about" being disregarded, see *Davis v. Palmer* (1827), 2 Brock. 298 ; 1 Robb, 518.

⁴ That it is sufficient to describe the proportions of ingredients as lying within certain limits (e. g., "from $\frac{1}{4}$ lb. to 1 lb.") if any quantity within these limits will answer, see *Goodyear v. Wait* (1867), 5 Blatch. 468 ; 3 Fisher, 242.

That where the Description says that the proportions of ingredients may be varied, it does not cover all proportions, but only those within proximate limits, see *Francis v. Mellor* (1871), 5 Fisher, 153 ; 1 O. G. 48.

That the Description need not prescribe exact and unvarying proportions of ingredients, nor state that all the substances employed for collateral purposes (as coloring matter, etc.), if not true ingredients, must invariably be used, see *Klein v. Russell* (1873), 19 Wall. 433.

That if the Description states what the inventor considers the best proportions it is sufficient though others will answer, see *Patent Type Founding Co. v. Richard* (1859), 6 Jur. N. S. 39.

⁵ That the Description must enable

one skilled in the art to mix the ingredients, and produce the composition, without further experiment, see *Jenkins v. Walker* (1872), 5 Fisher, 347 ; 1 O. G. 359 ; Holmes, 120.

⁶ In *Goodyear v. Railroad* (1853), 1 Fisher, 626, Grier, J. : (635) "If the patentee has set forth fully the materials, their various proportions, and the processes necessary to the production of this composition of matter, he has done all that the law requires, and should be entitled to its protection. The patent should be carefully examined to find the thing discovered, and if it be clearly set forth, the patentee should not suffer for the imperfection or vagueness of the language used in describing its true extent and nature." 2 Wall. Jr. 356 (364).

That a composition may be described by enumerating its qualities, see *Ex parte Tweddle* (1876), 10 O. G. 747.

That a composition may be described as the result of a described process when there is no clearer way of delineating it, see *Anilin v. Higgin* (1878), 15 Blatch. 290 ; 14 O. G. 414 ; 3 Baum. & A. 462 ; *Ex parte Tweddle* (1876), 10 O. G. 747 ; *Goodyear v. Railroad* (1853) 1 Fisher, 626 ; 2 Wall. Jr. 356.

That the patentee is not bound by

and directions the inventor may employ such technical terms as are customary in the art to which the composition belongs, however narrow may be the circle of persons familiar with that art;⁷ a general rule, indeed, but one especially applicable to this class of inventions.

§ 501. **The Description when the Invention is a Design.**

A design is an appearance imposed upon some physical substance for the purpose of making a given impression on the eye. Being addressed particularly to the sense of sight, it would hardly be expected that a correct and complete idea of this invention could be conveyed to the mind through words, which, though perhaps read by the eye, are really addressed to the ear. Still, so far as practicable, the written Description of a design must point out its characteristic qualities and accurately distinguish between what is claimed as new and what is conceded to be old.¹ Taken in connection with the drawings, it must impart to the public a knowledge of the design and of the method of producing it, as complete and available as is required respecting other classes of inventions. Where the design embraces two configurations, as in the obverse and the reverse of the same article, both may and ought to be described.² But if the shape impressed upon the substance endows it with new mechanical properties, as well as with a new appearance, only the latter should be embraced in the Description;³ the former, when constituting a new inven-

the qualities of his composition as given in the Description, but as they actually exist in the composition when produced according to his method, see *Goodyear v. N. Y. Gutta Percha & India Rubber Vulcanite Co.* (1862), 2 Fisher, 312.

⁷ That the Description of a chemical composition is not addressed to persons ignorant of chemistry, see *Allen v. Hunter* (1855), 6 McLean, 303.

§ 501. ¹ That a design can be delineated on paper, and known forms can be expressed in words, see *Ex parte Traitel* (1883), 25 O. G. 783.

That the Description of a design must

be clear, exact, and particular, see *Ex parte Niedringhaus* (1874), 7 O. G. 171.

² That both the obverse and reverse of a design may be described, see *Ex parte Diffenderfer* (1872), 2 O. G. 57.

³ That the Description of a design ought not to set forth the mechanical functions of the invention, see *Ex parte Norton* (1882), 22 O. G. 1205; *Ex parte Diffenderfer* (1872), 2 O. G. 57.

That a design application must confine itself to the characteristics of a design, not inserting those of a useful article, see *Ex parte Traitel* (1883), 25 O. G. 783.

tion, as it sometimes may, belonging to the class of manufactures, not designs.

§ 502. **The Description when the Invention is an Improvement.**

An improvement, although a complete invention in itself, is always dependent upon some original invention, without a knowledge of which, and of its relation to the improvement, the latter cannot be understood. The improvement in itself must, therefore, be described in all its essential characteristics like any other invention of its class; and in addition to this, the original invention, of whose idea of means this is a new development, must be delineated sufficiently to show the nature of the whole invention as improved.¹ With what

§ 502. ¹ In *Merrill v. Yeomans* (1876), 94 U. S. 568, Miller, J. : (570) "When a man supposes he has made an invention or discovery useful in the arts, and therefore the proper subject of a patent, it is, nine times out of ten, an improvement on some existing article, process, or machine, and is only useful in connection with it. It is necessary, therefore, for him, in his application to the Patent Office, to describe that upon which he engrafts his invention, as well as the invention itself; and, in cases where the invention is a new combination of old devices, he is bound to describe with particularity all these old devices, and then the new mode of combining them, for which he desires a patent. It thus occurs that, in every application for a patent, the descriptive part is necessarily largely occupied with what is not new, in order to an understanding of what is new." 11 O. G. 970 (971).

In *Isaacs v. Cooper* (1821), 4 Wash. 259, Washington, J. : (261) "The last, and by no means the least fatal, objection is to the patent and specification, which are so manifestly defective that the court ought not to interpose until the plaintiff shall have established his right at law, if he can do so. The pat-

ent is for an improvement on the horizontal wheel invented by the plaintiff. But what the nature of the invention was, upon which this is alleged to be an improvement, is not stated. Was it patented; and if not, is there any other source of information to which others can resort in order to find it out, so as to enable them to distinguish the improvement from the original invention, and in that way to discover in what the improvement consists? Neither the patent or specification affords the slightest information upon those points. The invention alluded to may, for aught that appears, be known to no other person than the plaintiff. How, then, can any human being, however skilful in the art, find out with certainty or even conjecture in what the improvement consists from the patent itself, or from the records in the Patent Office? If the original invention had been patented, the specification should at least have referred to and plainly described it. If it was not, it should have stated what that invention was, and in what the improvement consists. As the matter stands, the nature of the improvement is altogether unintelligible." 1 Robb, 332 (335).

Further, that a specification for an

particularity the old invention is to be portrayed depends upon the knowledge which those skilled in the art already have concerning it, and the obviousness of the relation which subsists between it and the new improvement. To put the entire invention, old and new, before the public, and at the same time to distinguish clearly between the old and the new, in order that it may appear that the claims of the inventor to an exclusive right are limited to the improvement, is the object to be accomplished.² This must be done by the Descrip-

improvement must describe the original sufficiently to distinguish the improvement from it, see *Wintermute v. Redington* (1856), 1 Fisher, 239; *Hovey v. Stevens* (1846), 3 W. & M. 17; 2 Robb, 567; *Brooks v. Jenkins* (1844), 3 McLean, 432; *Peterson v. Wooden* (1843), 3 McLean, 248; 2 Robb, 116; *Sullivan v. Redfield* (1825), 1 Paine, 441; 1 Robb, 477; *Dixon v. Moyer* (1821), 4 Wash. 68; 1 Robb, 324; *Kneass v. Schuylkill Bank* (1820), 4 Wash. 9; 1 Robb, 303; *Evans v. Hettick* (1818), 3 Wash. 408; 1 Robb, 166; *Evans v. Eaton* (1818), 3 Wash. 443; 1 Robb, 193; *Barrett v. Hall* (1818), 1 Mason, 447; 1 Robb, 207; *Lowell v. Lewis* (1817), 1 Mason, 182; 1 Robb, 131.

That the exact new feature must be described, see *Dangerfield v. Jones* (1865), 13 L. T. Rep. N. S. 142.

That the Description must show wherein the improvement consists and not merely the device as improved, see *Head v. Stevens* (1838), 19 Wend. 411; *Bovill v. Moore* (1816), Dav. P. C. 361; 1 Abb. P. C. 231; *McFarlane v. Price* (1816), 1 Web. 74; 1 Abb. P. C. 227; *Hornblower v. Boulton* (1799), 8 T. R. 95; 1 Abb. P. C. 98; *Williams v. Brodie* (1785), Dav. P. C. 96; 1 Web. 75.

² In *Evans v. Hettick* (1818), 3 Wash. 408, Washington, J. : (425) "What then is the plaintiff's invention, as asserted by the plaintiff, conceded by

the defendant, and sanctioned by the Supreme Court, in the case of *Evans v. Eaton*? The answer is, an improvement on the hopperboy, or an improved hopperboy, which that court have declared to be substantially the same. If this be so, then the section of the law before mentioned has declared that he must specify this improvement in full, clear, and exact terms. If he has not done so he has no valid patent on which he can recover. The English decisions correspond with the injunctions of our law. The American decisions, so far as we have any report of them, maintain the same doctrine. Mr. Justice Story, in the case of *Lowell v. Lewis*, lays it down that, 'if the patent be for an *improvement* in an existing machine, the patentee must in his specification distinguish the new from the old, and confine his patent to such parts only as are new; for, if both are mixed together, and a patent is taken for the whole, it is void.' What is the reason for all this? In the first place, it is to enable the public to enjoy the full benefit of the discovery, when the patentee's monopoly is expired, by having it so described upon record, that any person skilled in the art of which the invention is a branch may be able to construct it. The next reason is to put every citizen upon his guard, that he may not through ignorance violate the law, by infringing the rights of the patentee, and subjecting himself to the consequences of litigation.

tion and Claim in connection with the drawings and model, for it is not sufficient that by comparing the old and the im-

The inventor of the original machine, if he has obtained a patent for it, and all persons claiming under him, may lawfully enjoy the full benefit of that discovery, notwithstanding the improvement made upon it by a subsequent discoverer. If he has not chosen to ask for a monopoly, but abandons it to the public, then it becomes public property, and any person has a right to use it. The inventor of the improvement may also obtain a patent for his discovery, which cannot legally be invaded by the inventor of the original machine, or by any other person. The rights of each are secured by law, and there is no incompatibility between them. But if a man, wishing to use the original invention, and honestly disposed to avoid an infraction of the improver's right, is unable to ascertain from any certain and known standard where the original invention ends and where the improvement commences, how is it possible for him to exercise his own acknowledged right, freed from the danger of invading that of another? — and to what acts of oppression might not this lead? Might not the patentee of this mysterious improvement obtain from the ignorant, the timid, and even the prudent members of society, who wish to use the original discovery, the price he chooses to ask for a license to use his improvement, and in this way compel them to purchase it rather than incur expenses and inconveniences far greater than the sum demanded would pay for or compensate? If this may happen, then the improver enjoys in a degree the benefit of a discoverer both of the original machine and also of the improvement. In short, the patentee of the improvement may, to a certain extent, keep all others at arm's length as to the original invention, or make them

pay him for it in derogation of the rights of the inventor of the original machine." 1 Robb, 100 (184).

In *Evans v. Eaton* (1818), 3 Wash. 443, Washington, J.: (452) "3. An improvement on a former machine. This is a fair subject for a patent, and the plaintiff has laid before you strong evidence to prove that his hopperboy is a more useful machine than the one which is alleged to have been previously discovered and in use. If, then, you are satisfied of this fact, the point of law which has been raised by the defendant's counsel remains to be considered; which is, that the plaintiff's patent for an improvement is void, because the nature and extent of his improvement are not stated in his specification. The patent is for an improved hopperboy, as described in the specification which is referred to and made part of the patent. Now, does the specification express in what his improvement consists? It states all and each of the parts of the entire machine, — its use and mode of operating; and claims as his invention the machine, the peculiar properties or principles of it, viz. the spreading, turning, and gathering the meal, and the raising and lowering of its arm by its motion to accommodate itself to the meal under it. But does this description designate the improvement, or in what it consists? Where shall we find the original hopperboy described, either as to its construction, operation, or use, or by reference to anything by which a knowledge of it may be obtained? Where are the improvements on such original stated? The undoubted truth is that the specification communicates no information whatever upon any of these points. This being so, the law as to ordinary cases is clear that the plaintiff cannot recover for an improvement.

proved inventions, as they exist practically in the arts, the

The first section of the general Patent Law speaks of an improvement as an invention, and directs the patent to issue for his said invention. The third section requires the applicant to swear, or affirm, that he believes himself to be the true inventor of the art, machine, or improvement for which he asks a patent; and further, that he shall deliver a written Description of his invention, in such full, clear, and exact terms that any person acquainted with the art may know how to construct and use the same, etc. That it is necessary to the validity of a patent that the specification should describe in what the improvement consists is decided by Mr. Justice Story, in the cases referred to in the appendix to 3 Wheaton, and in the English cases of *Boulton v. Bull*, *Boville v. Moore*, *McFarlane v. Price*, *Harmar v. Playne*, and perhaps some others. What are the reasons upon which this doctrine is founded? They are to guard the public against unintentional infringements of the patent during its continuance, and to enable an artist to make the improvement by a reference to some known and certain authority, to be found among the records in the office of the Secretary of State, after the patent has run out. But it is contended by the plaintiff's counsel, that the law would be unreasonable to require, and therefore that it does not require, this to be done, unless the improvement is upon a *patented* machine, a description of which can be obtained by a reference to the records of the office of the Secretary of State, — that it might often be impossible for the patentee to discover, and consequently to describe, the parts of a machine in use, perhaps, only in some obscure part of the world. The answer to this is that an improvement necessarily implies an original, and unless the patentee is

acquainted with the original which he supposes he has improved, he must talk idly when he calls his invention an improvement. If he knows nothing of an original, then his invention is an original, or nothing; and the subsequent appearance of an original, to defeat his patent, is one of the risks which every patentee is exposed to under our law. As to the supposed distinction between an improvement on a machine patented and one not so, there is nothing in it. In both cases the improvement must be described, but with this difference, — that in the former case it may be sufficient to refer to the patent and specification for a description of the original machine, and then to state in what the improvements on such original machine consist — whereas in the latter case it would be necessary to describe the original machine and also the improvement. The reason for this distinction is too obvious to require explanation." 1 Robb, 193 (203).

That the specification of an improvement need not describe the original further than is necessary to understand the new matter, see *Many v. Jagger* (1848), 1 Blatch. 372; *Emerson v. Hogg* (1845), 2 Blatch. 1; *Harmar v. Playne* (1809), 11 East, 101; 1 Abb. P. C. 171.

That if the original is well known it need not be particularly described, nor even the mode of attaching the improvement to it if this is apparent without description, see *Loom Co. v. Higgins* (1882), 105 U. S. 580; 21 O. G. 2031.

That the Description must distinguish the old from the new, and binds the patentee as he makes it, see *Goodyear v. Railroad* (1853), 1 Fisher, 626; 2 Wall. Jr. 356.

That in order to distinguish old parts from new the specification may describe each and all the parts and then claim the whole when so constructed as to

nature of the latter and its characteristic differences from the former could be ascertained.³

§ 503. **The Description: its Sufficiency a Question of Fact.**

The sufficiency of the Description is a question of fact, to be investigated by experience, elucidated by evidence, and decided by a jury.¹ Only persons skilled in the art are usually capable of judging whether its delineations are correct, complete, and intelligible, and whether from it alone they could construct and use the invention. The inventor, having adopted it as his method of communicating his discovery to the public as represented by such persons, is bound by it and must abide the result of their endeavors to make the art or instrument available for practical use by following the directions he has given. But where a Description is, upon

produce the given effect, see *Gottfried v. Phillip Best Brewing Co.* (1879), 17 O. G. 675; 5 Bann. & A. 4.

That an application for an improvement must distinguish it from the original but need not disclaim the original, see *Ex parte Firm* (1887), 39 O. G. 1199.

³ That the specification for an improvement must describe its nature and extent, and it is not sufficient that by comparing the old and the improved machines the difference might be detected, see *Evans v. Eaton* (1822), 7 Wheat. 356; 1 Robb, 336; *Foxwell v. Bostock* (1864), 10 L. T. Rep. n. s. 144.

§ 503. ¹ In *Forbes v. Barstow Stove Co.* (1864), 2 Clifford, 379, Clifford, J.: (392) "The specifications are required for two principal purposes: first to inform the public what the thing is of which the patentee claims to be the inventor; and, secondly, to enable the public, after the expiration of the patent, to practise the invention from the specification, as therein described. Whether the patentee has described the subject-matter, or what he claims to have invented, so as to enable the public to know what his claim is, is in gen-

eral a question of law for the court on the construction of the patent. Cur. on P. § 130, p. 130. But whether he has described the invention in such full, clear, and exact terms as to enable the public to practise it from the specification is in general a question of fact to be determined, in common-law cases, by a jury. The act of Congress does not require the patentee to address himself to the uninformed upon the particular subject, but allows him to speak to persons of competent skill in the art; and it only requires him to use such full, clear, and exact terms, as will enable that class of persons to reproduce the thing described from the description given in the specification."

See also *Page v. Ferry* (1857), 1 Fisher, 298; *Reutgen v. Kanowrs* (1804), 1 Wash. 168; 1 Robb, 1; *Morton v. Middleton* (1863), 1 Cr. S. 3d Series, 721; *Wallington v. Dale* (1852), 7 Exch. 888; *Beard v. Egerton* (1848), 19 L. J. C. P. 38; *Walton v. Bateman* (1842), 1 Web. 613; *Neilson v. Harford* (1841), 1 Web. 295; *Bickford v. Skewes* (1839), 1 Web. 214; *Hill v. Thompson* (1817), 1 Web. 235; 1 Abb. P. C. 299.

its face, so incomplete or unintelligible as to be evidently useless for purposes of public information, the court may decline to hear the testimony of witnesses and on its own judgment declare the patent void.²

SECTION VI.

OF THE APPLICATION: THE CLAIM.

§ 504. The Claim: its Objects and General Requisites.

It is the office of the Claim to define the limits of that exclusive use which is secured to the inventor by the patent, and thus to draw the line between those arts or instruments that are open to the public, and those whose employment by it is forbidden until the patent has expired. The Claim is, therefore, an essential part of the specification; and without it one of the two great purposes of that instrument would remain unfulfilled.¹ Hence the statutes require not only that the inventor shall fully *describe* his invention in the specification, so that any person skilled in the art can practise it, but also that he shall "particularly point out and distinctly *claim* the part, improvement, or combination which he claims as his invention or discovery." And the rules of the Patent Office prescribe that the specification shall conclude with a specific and distinct Claim or Claims of every separate sub-

² In *Wood v. Underhill* (1847), 5 How. 1, Taney, C. J.: (4) "In patents for machines the sufficiency of the Description must, in general, be a question of fact to be determined by the jury. And this must also be the case in compositions of matter where any of the ingredients mentioned in the specification do not always possess exactly the same properties in the same degree. But when the specification of a new composition of matter gives only the names of the substances which are to be mixed together, without stating any relative proportion, undoubtedly it would be the duty of the court to de-

clare the patent to be void. And the same rule would prevail where it was apparent that the proportions were stated ambiguously and vaguely." 2 Robb, 588 (593).

See also *Brooks v. Jenkins* (1844), 3 McLean, 432.

§ 504. ¹ That where there is no Claim there is no application, see *Ex parte Lasscell* (1884), 28 O. G. 1274; 29 O. G. 861; *Ex parte Holt* (1884), 29 O. G. 171.

That a thing is not claimed when shown only in the drawings and not in the Description or Claim, see *Couse v. Johnson* (1879), 16 O. G. 719.

ject-matter that the applicant desires to protect by the patent for which he has applied.²

§ 505. **The Claim the Life of the Patent and the Measure of the Patent Privilege.**

The Claim is thus the life of the patent so far as the rights of the inventor are concerned, and by it the letters-patent, as a grant of an exclusive privilege, must stand or fall.¹ The

² That each Claim is an independent patent, see *Celluloid Mfg. Co. v. Zylonite Brush & Comb Co.* (1880), 27 Fed. Rep. 291; 35 O. G. 1228; *United Nickel Co. v. California Electrical Works* (1885), 25 Fed. Rep. 475; 11 Sawyer, 250.

§ 505. ¹ In *Railroad Co. v. Mellon* (1881), 104 U. S. 112, Woods, J.: (117) "The act of July 4, 1836, c. 357 (5 Stat. 117), under which this patent was issued, requires that an applicant for a patent shall not only 'deliver a written description of his invention or discovery,' but 'shall also particularly specify and point out the part, improvement, or combination which he claims as his own invention or discovery.' This provision is substantially re-enacted in the act of July 8, 1870, c. 230 (16 Stat. 198), Rev. Stat. sect. 4838, and remains in force. As a rule, therefore, the specification filed with the application for letters-patent contains a general Description of the invention sought to be patented, which is followed by what is technically called the 'Claim.' In reference to this latter part of the specification this court, speaking by Mr. Justice Bradley, has said: 'It is well known that the terms of the Claim in letters-patent are carefully scrutinized in the Patent Office. Over this part of the specification the chief contest generally arises. It defines what the Office, after a full examination of previous inventions and the state of the art, determines the applicant is entitled to.' *Burns v. Meyer*, 100 U. S. 671.

See also *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 id. 274, 278. In view, therefore, of the statute, the practice of the Patent Office, and the decisions of this court, we think that the scope of letters-patent should be limited to the invention covered by the Claim, and that though the Claim may be illustrated, it cannot be enlarged by the language used in other parts of the specification." 20 O. G. 1891 (1892).

In *Masury v. Anderson* (1873), 11 Blatch. 162, Blatchford, J.: (165) "The rights of the plaintiff depend upon the Claim in his patent, according to its proper construction, and not upon what he may erroneously suppose it covers. If at one time he insists on too much, and at another on too little, he does not thereby work any prejudice to the rights actually secured to him." 6 Fisher, 457 (460); 4 O. G. 55 (56).

In *Pitts v. Wemple* (1855), 1 Bissell, 87, Drummond, J.: (90) "The Patent Law requires the inventor to set forth the nature and extent of his discovery, so that, by referring to his letters-patent, a mechanic of competent skill may be able, in the state of the art as then understood, to construct the machine or improvement, if the invention relate to a machine. And he must particularly specify and point out the part, improvement, or combination which he claims as his own invention or discovery. He is restricted to this Claim. It is true that the whole patent, including specifications and drawings, is to be taken into considera-

thing patented is the thing claimed, whatever the patentee may suppose or assert that he has invented; and though the statement of the Claim comes short of the true limits of the invention, the inventor must abide by them, as he has described and published them in this written definition of its character and scope.² The courts will not go into the history of the art

tion, but we look at them only for the purpose of placing a proper construction upon the Claim.' 2 Fisher, 10 (13).

That a patent must stand or fall by its Claims, see *Meissner v. Devoo Mfg. Co.* (1872), 2 O. G. 545; 5 Fisher, 285; 9 Blatch. 333; *Parker v. Sears* (1850), 1 Fisher, 93.

That where the only patentable feature in the invention is dormant and unclaimed the patent is invalid, see *Ingham v. Pierce* (1887), 31 Fed. Rep. 822; 42 O. G. 1062.

That the scope of a patent is governed by the Claim, see *Yale Lock Co. v. Greenleaf* (1886), 117 U. S. 555; 35 O. G. 386; *Ex parte Holt* (1884), 29 O. G. 171.

That if the Claim does not define the invention the courts can give no relief, see *Delaware Coal & Ice Co. v. Packer* (1880), 24 O. G. 1273; 1 Fed. Rep. 851; 5 Bann. & A. 296.

That the identity of patents is determined by their Claims, see *Adams v. Bellaire Stamping Co.* (1886), 28 Fed. Rep. 360; 36 O. G. 567; *McMillin v. Rees* (1880), 17 O. G. 1222; 1 Fed. Rep. 722; 5 Bann. & A. 269.

That where a Claim sets forth a certain arrangement as essential, no other arrangement is the same invention, see *Tate v. Thomas* (1885), 30 O. G. 345.

² That the invention patented is the invention set forth in the Claim, and that only, see *Toohy v. Harding* (1880), 4 Hughes, 253; 1 Fed. Rep. 174; *McMillin v. Rees* (1880), 5 Bann. & A. 269; 17 O. G. 1222; 1 Fed. Rep. 722; *Delaware Coal & Ice Co. v. Packer* (1880), 5 Bann. & A. 296; 24 O. G.

1273; 1 Fed. Rep. 851; *Ex parte Emerson* (1880), 17 O. G. 1451; *Couso v. Johnson* (1870), 4 Bann. & A. 501; 16 O. G. 719; *Ex parte Locke* (1870), 16 O. G. 1140; *Keystone Bridge Co. v. Phoenix Iron Co.* (1877), 95 U. S. 274; 12 O. G. 980; *Welling v. Rubber Coated Harness Trimming Co.* (1875), 2 Bann. & A. 1; 7 O. G. 608; *Fuller v. Yentzer* (1874), 6 Bissell, 203; 1 Bann. & A. 520; *Wheeler v. McCormick* (1873), 4 O. G. 692; 6 Fisher, 551; 11 Blatch. 334; *Brown v. Hinkley* (1873), 3 O. G. 384; 6 Fisher, 370; *Rich v. Close* (1870), 4 Fisher, 279; 8 Blatch. 41; *Haselden v. Ogden* (1868), 3 Fisher, 378; *Blake v. Stafford* (1868), 3 Fisher, 294; 6 Blatch. 195; *Hayden v. Suffolk Mfg. Co.* (1862), 4 Fisher, 86; *Morris v. Barrett* (1859), 1 Bond, 254; 1 Fisher, 461; *Johnson v. Root* (1858), 1 Fisher, 351; *Sickels v. Gloucester Mfg. Co.* (1856), 1 Fisher, 222; *Rich v. Lippincott* (1853), 2 Fisher, 1; *O'Reilly v. Morse* (1853), 15 How. 62; *Kneass v. Schuylkill Bank* (1820), 4 Wash. 9; 1 Robb, 303.

That the claimed invention alone is covered by the patent, though it be less than the real invention, see *Brass Co. v. Miller* (1871), 5 Fisher, 48; 9 Blatch. 77; *Kidd v. Spence* (1859), 4 Fisher, 37; *Detmold v. Reeves* (1851), 1 Fisher, 127.

That parts which are indispensable to the invention are not covered by the patent unless mentioned in the Claim, see *McMillin v. Rees* (1880), 5 Bann. & A. 269; 17 O. G. 1222; 1 Fed. Rep. 722.

That if a patentee inserts an unes-

to ascertain what he has really discovered and what he might have patented if he had chosen, but will take him at his word and protect him according to the terms in which he has himself demanded such protection.³ Even where he confines the language of his Claim to a mere reference to the letters affixed to the drawings, the rigidity of the rule is not relaxed, and only the devices shown in the drawings thus referred to are regarded as constituting his invention.⁴

essential feature in his Claim he cannot afterwards deny its materiality, see *Le Fever v. Remington* (1882), 21 Blatch. 80; 22 O. G. 1537; 13 Fed. Rep. 86.

³ In *Keystone Bridge Co. v. Phoenix Iron Co.* (1877), 95 U. S. 274, Bradley, J. : (278) "When a Claim is so explicit, the courts cannot alter or enlarge it. If the patentees have not claimed the whole of their invention, and the omission has been the result of inadvertence, they should have sought to correct the error by a surrender of their patent and an application for a re-issue. They cannot expect the courts to wade through the history of the art, and spell out what they might have claimed, but have not claimed. Since the act of 1836, the patent laws require that an applicant for a patent shall not only, by a specification in writing, fully explain his invention, but that he 'shall particularly specify and point out the part, improvement, or combination which he claims as his own invention or discovery.' This provision was inserted in the law for the purpose of relieving the courts from the duty of ascertaining the exact invention of the patentee by inference and conjecture, derived from a laborious examination of previous inventions, and a comparison thereof with that claimed by him. This duty is now cast upon the Patent Office. There his Claim is, or is supposed to be, examined, scrutinized, lim-

ited, and made to conform to what he is entitled to. If the Office refuses to allow him all that he asks, he has an appeal. But the courts have no right to enlarge a patent beyond the scope of its Claim as allowed by the Patent Office, or the appellate tribunal to which contested applications are referred. When the terms of a Claim in a patent are clear and distinct (as they always should be), the patentee, in a suit brought upon the patent, is bound by it. *Merrill v. Yeomans*, 94 U. S. 568. He can claim nothing beyond it. . . . (279) As patents are procured *ex parte*, the public is not bound by them, but the patentees are. And the latter cannot show that their invention is broader than the terms of their Claim; or, if broader, they must be held to have surrendered the surplus to the public." 12 O. G. 980 (981).

That the court will not go into the history of the art, but will abide by the Claims, see *James v. Campbell* (1882), 104 U. S. 356; 21 O. G. 337.

That the court will not enlarge the Claim by the Description, see *Yale Lock Co. v. Greenleaf* (1886), 117 U. S. 554; 35 O. G. 386; *Lehigh Valley R. R. Co. v. Mellon* (1881), 104 U. S. 112; 20 O. G. 1891.

⁴ That if a Claim is a mere reference to the drawings, only the device shown in the drawings is protected, see *Ex parte Marsh* (1872), 2 O. G. 197.

§ 506. The Claim: its Effect, as an Abandonment or otherwise, upon the Matter not Claimed.

As a consequence of this limitation of the patent to the matter claimed, all matters not claimed are considered as excluded from the particular invention which forms the subject of the application. It has been sometimes stated that a failure to claim an art or device admits it to be old;¹ or, if it is really new, that the omission to protect it abandons it to the public.² These statements need qualification. From the nature of the invention itself all that is essential to it must be new, and it can properly be claimed only by excluding all that is old. But it does not follow that other features, described in the specification and omitted from the Claim, are already known to the public; for it may often happen that each one of several new inventions can be understood only by describing it in connection with the others. Nor is it true that by thus describing and not claiming any one of them, the inventor, *ipso facto*, dedicates it to the public use. He is at liberty to patent each of them, if he desires to do so, either in separate patents, or in the same patent when their joinder would be consistent with the rules relating to that subject; and the patenting of one before he makes an application for the others cannot be regarded as abandoning the rest unless this be his intention, as shown by all the circumstances of

§ 506. ¹ That to describe and not claim admits the unclaimed matter to be old, see *Rowell v. Lindsay* (1881), 19 O. G. 1565; 10 Bissell, 217; 6 Fed. Rep. 290; *Corn Planter Patent* (1874), 23 Wall. 181; 6 O. G. 392; *Kirby v. Dodge & Stevenson Mfg. Co.* (1872), 10 Blatch. 307; 6 Fisher, 156; 3 O. G. 181; *Conover v. Roach* (1857), 4 Fisher, 12; *Winans v. N. Y. & Erie R. R. Co.* (1856), 1 Fisher, 213.

² That failure to claim described matter dedicates it to the public, see *Swift v. Jenks* (1884), 19 Fed. Rep. 641; 27 O. G. 621; *Miller v. Brass Co.* (1881), 104 U. S. 350; 21 O. G. 201; *Giant Powder Co. v. California Vigorit Powder Co.* (1880), 18 O. G. 1339; 6

Sawyer, 508; 4 Fed. Rep. 720; *Batten v. Taggart* (1851), 2 Wall. Jr. 101.

That the claiming of one specific device, and the omission to claim others which are apparent on the face of the specification, is an abandonment of the latter, see *Hill v. Commissioner* (1885), 33 O. G. 757; 4 Mackay, 266.

That the claiming of a specific device, and an omission to claim other devices apparent on the face of the Description, is a dedication of the latter, unless the patentee surrenders, proves inadvertence, etc., and re-issues with due diligence, see *Combined Patents Can Co. v. Lloyd* (1882), 15 Phila. 481; 21 O. G. 713; 11 Fed. Rep. 149; *Miller v. Brass Co.* (1881), 104 U. S. 350; 21 O. G. 201.

the case or by that public use or sale from which the law presumes such an abandonment. To describe and not to claim is a proper method of admitting that to be old which really is old. It is also a proper method of abandoning new inventions to the public, when such is the evident intention of the inventor. It is also a proper method of distinguishing the new invention, which forms the subject-matter of the present application, from other new inventions which are to be the subject-matter of future applications.³ The sole inevitable conclusion from the omission is that the omitted features do not enter into the essence of the present invention, and are not claimed as protected by the present patent.⁴ What further conclusions may be drawn from it depends on other considerations, relating either to the novelty of the omitted feature in itself, or to its actual or presumed abandonment by its inventor.

§ 507. The Claim: its Form and Contents Governed by Strict Rules.

The paramount importance of the Claim, and the necessity for such exactness and completeness in its statements as will precisely define the invention to be protected by the patent, have led to the establishment of numerous rules for framing it, some of which are common to all classes of inventions, while others have reference to particular classes. These

³ That to describe and not claim is a method of postponing the unclaimed matter for a future patent, see *Ex parte Emerson* (1880), 17 O. G. 1451; *Giant Powder Co. v. California Vigorit Powder Co.* (1880), 18 O. G. 1339; 6 Sawyer, 508; 4 Fed. Rep. 720; *Corn Planter Patent* (1874), 23 Wall. 181; 6 O. G. 392.

That the description of a process in an application for a machine patent does not abandon the process to the public if the process patent be applied for within two years, see *Eastern Paper Bag Co. v. Standard Paper Bag Co.* (1887), 30 Fed. Rep. 63; 41 O. G. 231.

That where an applicant intends to obtain a future patent for the matter

described but not claimed in the present application, he must expressly reserve in this one the right to do so, and apply for the other within a reasonable time, see *Ex parte Roberts* (1887), 40 O. G. 573; *Adams v. Bellaire Stamping Co.* (1886), 28 Fed. Rep. 360; 36 O. G. 567; *Ex parte Derby* (1884), 26 O. G. 1208; *James v. Campbell* (1882), 104 U. S. 353; 21 O. G. 337.

⁴ That a failure to claim described matter simply excludes it from the patent, leaving it to be covered by a subsequent patent or not, at the option of the inventor without any previous reservation, see *Corn Planter Patent* (1874), 23 Wall. 181; 6 O. G. 392; and cases cited in the notes to §§ 465, 466, *ante*.

general rules relate to the contents, the form, the joinder, and the construction of Claims. Those which govern the contents of a Claim, prescribing what it must include, what it must omit, and what may be included or omitted at the option of the inventor, will be first discussed.

§ 508. **The Claim must Claim a Practically Operative Means.**

Every Claim must set forth and claim a practically operative means.¹ An inventor is not obliged to claim all that he may have invented.² His idea of means may be susceptible of different stages of development, the more advanced of which it may not yet seem proper to him to disclose. Or his invention may embrace subordinate inventions, which he may determine either to surrender to the public or to reserve for the protection of future patents. But he must, at least, so far describe and claim what he has invented as to place before the public, and to ask protection for, some art or instrument capable of practical use.³ Nothing less than this is a patentable invention, and no Claim can be sustained unless

§ 508. ¹ That a Claim must be for an operative means, see *Ex parte* Cornell (1872), 1 O. G. 573; *American Pin Co. v. Oakville Co.* (1854), 3 Blatch. 190.

That a Claim for certain devices as the means for producing a certain result is proper, though under some circumstances they will not so operate, see *Wheeler v. Clipper Mower & Reaper Co.* (1872), 10 Blatch. 181; 6 Fisher, 1; 2 O. G. 442.

² That the Claim may be as narrow as the patentee chooses, if it covers an operative means, see *Ex parte* Emerson (1880), 17 O. G. 1451; *Russell & Erwin Mfg. Co. v. Mallory* (1872), 2 O. G. 495; 5 Fisher, 632; 10 Blatch. 140.

That the inventor need not claim all he describes, though new, provided that which he claims will operate apart from the rest, though thereby he may secure the whole, see *Ex parte* Sturges (1872), 1 O. G. 204.

That a Claim for an entire invention

will be taken as covering all that is described as entering into the invention unless the Claim itself shows the contrary, see *Evans v. Kelly* (1880), 5 Bann. & A. 71; 9 Bissell, 251; 23 O. G. 192; 13 Fed. Rep. 903; *Tetley v. Easton* (1883), *Macrory's P. C.* 82.

³ That the Claim must be for matter so described that any one skilled in the art can use it, see *Vogler v. Semple* (1877), 11 O. G. 923; 7 Bissell, 382; 2 Bann. & A. 556.

That an article patentable only when used in certain connections must be claimed only as to such connections, see *Stewart v. Mahoney* (1878), 5 Fed. Rep. 302; 4 Bann. & A. 84.

That the occasional accidental operation of a device, varying from its usual operation, and inconsistent with its principle, is not a basis for a Claim for a device uniformly producing similar effects, see *Voelker v. Gray* (1885), 30 O. G. 1091.

the exclusive privilege which it endeavors to define is one which can lawfully be granted.

§ 509. **The Claim must Claim a Concrete Art or Instrument.**

Again, every Claim must be for a concrete invention. Patents are not granted for the protection of abstract ideas or scientific theories, but for practical arts to be performed, or for physical instruments available for use on physical objects.¹ Underlying every invention is the idea of means of which the operative art or instrument is the tangible embodiment; and ultimately this idea of means receives complete protection from the patent. But the thing patented is the concrete expression of this idea, the art or mechanism or product in which the idea is reduced to practice; and it is this which must be set forth in the Claim, in distinction from the discovery or conception which it embodies.

§ 510. **The Claim must Claim a Single and Distinct Invention.**

Again, every Claim must be confined to some single and distinct invention. Two arts or instruments cannot be embraced in one Claim.¹ Where a general invention is capable of modifications which differ substantially from each other, embodying different ideas of means or the same idea in different stages of development, each one of these is a distinct invention, and if claimed at all must be claimed separately

§ 509. ¹ That the Claim must state a concrete invention, not an abstraction, see *Ex parte* Designolle (1877), 13 O. G. 227; *Burr v. Duryee* (1863), 1 Wall. 531.

That the Claim must not cover a principle, see *Ex parte* Fairbanks (1873), 3 O. G. 65; *Burr v. Duryee* (1863), 1 Wall. 531; *Walton v. Bateman* (1842), 1 Web. 613.

That a Claim for the use of a natural force for a special purpose is improper, — the special method of using it for such purpose must alone be claimed, — see *O'Reilly v. Morse* (1853), 15 How. 62.

That general truths and forces belong

to all men, and cannot be claimed, see *Opinion Atty. Gen.* (1856), 8 Op. At. Gen. 269; *Detmold v. Reeves* (1851), 1 Fisher, 127.

See §§ 133-143 and notes, *ante*.

§ 510. ¹ That but one invention can be embraced in a single Claim, see *Ex parte* Bland (1879), 15 O. G. 775.

That a process and its product cannot be embraced in a single Claim, see *Ex parte* Bates (1879), 16 O. G. 266; *Merrill v. Yeomans* (1874), 1 Bann. & A. 47; 5 O. G. 267; *Holmes*, 331.

That a machine and its product, an art and its apparatus, etc., cannot be covered by one Claim, see *Ex parte* Bates (1879), 16 O. G. 266.

from the rest. When the parts of a device, as well as the device itself, are new inventions, the device as a whole and each subordinate part of it must be made the subject of as many separate Claims. Thus every Claim becomes complete within itself; exactly commensurate with the single invention it purports to cover, and capable of being allowed or disallowed in the Patent Office, and sustained or defeated in the courts, without prejudice to any other invention than the one therein specifically described.

§ 511. The Claim must Indicate the Class of Patentable Inventions to which the Claimed Invention Belongs.

Again, every Claim must define the invention it includes in such a manner as to indicate the class of inventions to which it belongs. While the Claim need not state in terms whether the invention claimed is an art, a machine, a manufacture, a composition of matter, a design, or an improvement, it must be apparent to which of these great classes the invention does pertain.¹ Thus, if the real invention is an art or process, it must be claimed as such and not as the means by which the art is practised, nor as the product in which it results.² If it is a machine, the mechanism, not the mode of operating it, is the true subject-matter of the Claim.³

§ 512. The Claim must Precisely Define the Invention Claimed.

Again, every Claim must precisely define the exact limits of the invention claimed.¹ This may be done by the enumeration

§ 511. ¹ That the Claims of a patent must clearly show whether the claimed invention is an art, machine, manufacture, composition, design, or improvement, see *Ex parte* Mayall (1873), 4 O. G. 210.

² That an apparatus must be claimed as such, not as a means for practising the art, see *Ex parte* Bates (1879), 16 O. G. 266.

That the exact invention, not the art of using it, must be claimed, see *Ex parte* Cornell (1872), 1 O. G. 573.

³ That a machine must be claimed as

such, not as a "mode of operation," see *Hatch v. Moffitt* (1883), 15 Fed. Rep. 252; *Burr v. Duryee* (1863), 1 Wall. 531.

That where an effect is produced by mechanical means, the means should ordinarily be claimed as a machine or manufacture, not as a process, see *Piper v. Brown* (1870), 4 Fisher, 175; *Holmes*, 20. See also § 529 and notes, *post*.

§ 512. ¹ That the claimed invention must be precisely and completely covered by the Claim, see *Ex parte* Thompson (1879), 16 O. G. 588; *Ex parte*

of its essential characteristics, or, when these are fully stated in the Description, by such a delineation of the invention claimed as identifies it with the one described.² When the invention is a complete art or instrument, new and patentable in itself without relation to other things, it must be claimed as such without any reference to the objects or the purposes for which it may be employed.³ On the other hand, where

Funck (1878), 14 O. G. 158; Scott v. Ford (1878), 14 O. G. 413; Merrill v. Yeomans (1877), 94 U. S. 568; 11 O. G. 970; *Ex parte* Hopper (1872), 2 O. G. 4; Davis v. Bell (1837), 8 N. H. 500; Whittemore v. Cutter (1813), 1 Gallison, 478; 1 Robb, 40; Rushton v. Crawley (1870), L. R. 10 Eq. 522; Gibson v. Brand (1842), 1 Web. 613; Carpenter v. Smith (1841), 1 Web. 530.

That each substantially different modification of the invention which the inventor intends to protect must be definitely described, see Sargent v. Carter (1857), 1 Fisher, 277.

That if the patentee intends to claim only a part of what he has described as entering into the invention the Claim must show it, or all will be considered as claimed, see Evans v. Kelly (1880), 5 Bann. & A. 71; 9 Bissell, 251; 23 O. G. 192; 13 Fed. Rep. 903; Tetley v. Easton (1857) 2 C. B. N. s. 706.

That where the invention is described as consisting in the peculiar construction of one or more parts only such construction can be claimed, see Phoenix Caster Co. v. Spiegel (1886), 26 Fed. Rep. 272.

That the adjunctive devices referred to in all the Claims for an invention must be the same in themselves and in their relation to the invention, see *Ex parte* Stanbridge (1888), 43 O. G. 1345.

² That the enumeration of such elements as constitute the operative invention is a proper mode of claiming it, see *Ex parte* Farrow (1872), 2 O. G. 57.

That elements not essential to the invention should not be stated in the

Claim, see *Ex parte* Kitson (1881), 20 O. G. 1750; *Ex parte* Farrow (1872), 2 O. G. 57; Furbush v. Cook (1857), 2 Fisher, 668.

That when the new invention does not embrace the entire concrete art or instrument only the new parts invented must be stated by the Claim, see Seymour v. Osborne (1870), 11 Wall. 516.

That when a device as claimed is useful only as part of a whole, the other parts will be understood as implied in the Claim, see *Ex parte* West (1872), 2 O. G. 30.

That elements which are described as essential to the invention are not covered by the patent unless stated or implied in the Claim, see *McMillin v. Rees* (1880), 5 Bann. & A. 269; 17 O. G. 1222; 1 Fed. Rep. 722.

³ That a Claim must not include any parts, features, or other matters not embraced in the invention intended to be claimed, see *Ex parte* Skinner (1881), 19 O. G. 662; *Ex parte* Wheat (1879), 16 O. G. 360; *Ex parte* Wilber (1872), 1 O. G. 379.

That if new devices are claimed as specifically arranged, the Claim covers them only when thus arranged, see Tate v. Thomas (1885), 30 O. G. 345; Carlton v. Bokee (1873), 17 Wall. 463; 6 Fisher, 40; 2 O. G. 520.

That what is described as merely auxiliary must not be claimed, see *Ex parte* Wheat (1879), 16 O. G. 360.

That a Claim covering useless things is not void unless they are claimed as essential to the invention, see Lewis v.

the invention is new and patentable only when considered with reference to certain purposes or objects, it must be claimed only in connection with such purposes or objects, and a Claim for it without this limitation would be void.⁴ The importance of this rule becomes especially evident in cases where the real invention consists in the new use of some art or instrument already known. A Claim for the art or instrument itself would be improper, since the new use does not change its character as a patentable invention. The use itself must be set forth and claimed, this being the only new product of inventive skill; and in the Claim for this new use, the objects upon which the art or instrument is now to be employed, or the mode of operation in which it is now to be applied, must be particularly described.

§ 513. The Claim must Distinguish the Invention Claimed from all Known Inventions.

Again, every Claim must distinguish the art or instrument which it embraces from every art or instrument already known.¹

Marling (1829), 1 Web. 493; 1 Abb. P. C. 421.

That a Claim for certain devices as a means to produce certain results is good, though under peculiar circumstances the results would not follow, see *Wheeler v. Clipper Mower & Reaper Co.* (1872), 10 Blatch. 181; 6 Fisher, 1; 2 O. G. 442.

⁴ That if the invention is patentable only when used in certain connections, it must be claimed only in such connections, see *Stewart v. Mahoney* (1879), 5 Fed. Rep. 302; 4 Bann. & A. 84.

§ 513. ¹ In *Ex parte Funck* (1878), 14 O. G. 158, Spear, Com. : (159) "The office of the Claim is to clearly and distinctly set forth what an applicant regards to be peculiarly his own invention. If the improvement consists in some addition to or alteration of an existing structure, whether it be by the introduction of new features having no

conjoint function with the old parts, or by substantial re-organization in which new elements may or may not enter as co-operative factors, in either event the Claim should express no more and no less than is necessary to convey an accurate understanding of the actual invention which had been made. If, for example, an additional feature, valuable in its way, and yet entirely independent of the old elements, so far as co-acting with them, is incorporated in a device, it must be manifest that the Claim should cease when it had specified the single feature. To continue beyond this, and enumerate other parts belonging to the old structure improved upon, is as much an offence against clearness and precision as to state, as elements of a combination Claim, parts which have no office whatever to perform in accomplishing the specific result. The retention of the old elements in the Claim, when there is nothing in common be-

A Claim including any matter before patented, or in possession of the public, is fatally defective. Such matter should not be mentioned in the Claim if the invention claimed can be sufficiently defined without it, and if mentioned must be expressly disclaimed.² Though the invention is worthless

tween them and the one newly added to the machine, is a misstatement of the invention, giving a fictitious importance to the improvement, and defeating any accurate judgment of its merit because of the obscurity resulting from the erroneous association."

In the Corn Planter Patent (1874), 23 Wall. 181, Bradley, J.: (223) "It is objected to several of the patents under consideration that they do not state what parts of the machine patented are new and what parts are old, and that they are therefore void. There is nothing in the Patent Law which, in terms, requires the patentee to do this. The language of the act of 1836, under which these patents were drawn, is that before any inventor shall receive a patent for his invention or discovery he shall deliver a description thereof, and of the manner and process of making, constructing, using, and compounding the same, in such full, clear, and exact terms as to enable a person skilled in the art to reproduce it; and the act directs that the inventor shall 'particularly specify and point out the part, improvement, or combination which he claims as his own invention or discovery.' This, of course, involves an elimination of what he claims as new from what he admits to be old. But what can be a more explicit declaration of what is new and what is old than the summary of the patentee's claim at the close of the specification, if that is made in clear and distinct terms, or in terms so clear and distinct as to be fairly understood. It implies that all the rest is old, or, if not old, that the applicant does not claim it so far as that patent is concerned. If the patentee by his speci-

fication, including the summary Claim at its close, points out and distinguishes what he claims as his own invention, it is all that is required. That, if we can find it without difficulty or embarrassment, is what he claims as new; the rest he impliedly, if he does not expressly, disclaims as old. No particular form of words is necessary if the meaning is clear." 6 O. G. 392 (400).

That the Claim must clearly distinguish between the new matter and the old, see *Terry Clock Co. v. New Haven Clock Co.* (1878), 17 O. G. 908; 3 Bann. & A. 332; *Ex parte Hobson* (1872), 1 O. G. 141; *Brown v. Solby* (1871), 2 Bissell, 457; 4 Fisher, 363; *Bray v. Hartshorn* (1860), 1 Clifford, 538; *Hovey v. Stevens* (1846), 3 W. & M. 17; 2 Robb, 567; *Dangerfield v. Jones* (1865), 13 L. T. Rep. n. s. 142; *Newall v. Elliott* (1864), 10 Jur. n. s. 954; *Booth v. Kennard* (1857), 2 H. & N. 84; *Holmes v. London & N. W. R. R. Co.* (1852), *Macrory's P. C.* 13; *Crane v. Price* (1842), 4 M. & G. 580; *Carpenter v. Smith* (1841), 1 Web. 530; *McFarlane v. Price* (1816), 1 Web. 74; 1 Abb. P. C. 227; *Manton v. Manton* (1815), *Dav. P. C.* 333; 1 Abb. P. C. 189.

That the new and old may be distinguished by describing both and claiming only the former, see *Rowell v. Lindsay* (1881), 19 O. G. 1565; 10 Bissell, 217; 6 Fed. Rep. 290; *Gottfried v. Phillip Best Brewing Co.* (1879), 17 O. G. 675; 5 Bann. & A. 4; *Corn Planter Patent* (1874), 23 Wall. 181; 6 O. G. 392; *Winans v. N. Y. & Erie R. R. Co.* (1856), 1 Fisher, 213; and other cases cited in § 506, note 1, *ante*.

² That a Claim including old matter

apart from certain other arts or instruments before communicated to the public the Claim should not describe them, for to whatever extent its utility may be dependent upon its connection with them they form no portion of its essence as a patentable invention.

§ 514. The Claim must Set Forth the Invention Claimed in its Most Perfect Concrete Form.

Again, every Claim must set forth the invention it purports to describe in that form which, according to the judgment of the inventor, the most perfectly embodies it. An inventor who seeks protection for his invention from the public is obliged to place it before the public in the form best fitted for practical use, and both in his Description and his Claim it is his duty to disclose his conception through that concrete

is void, see *Milligan v. Lalanco & Grosjean Mfg. Co.* (1884), 29 O. G. 367 ; 21 Fed. Rep. 570 ; *Maguire v. Eames* (1880), 18 Blatch. 321 ; 8 Fed. Rep. 761 ; *Scott v. Ford* (1878), 14 O. G. 413 ; *Ex parte Funck* (1878), 14 O. G. 158 ; *Corn Planter Patent* (1874), 23 Wall. 181 ; 6 O. G. 392 ; *Blake v. Stafford* (1868), 3 Fisher, 294 ; 6 Blatch. 195 ; *Phillips v. Page* (1860), 24 How. 164 ; *Holliday v. Rheem* (1852), 18 Pa. St. 465 ; *Hovey v. Stevens* (1846), 3 W. & M. 17 ; 2 Robb, 567 ; *Davis v. Bell* (1837), 8 N. H. 500 ; *Whitney v. Emmett* (1831), Baldwin, 303 ; 1 Robb, 567 ; *Watson v. Bladen* (1826), 4 Wash. 580 ; 1 Robb, 510 ; *Sullivan v. Redfield* (1825), 1 Paine, 441 ; 1 Robb, 477 ; *Kneass v. Schuylkill Bank* (1820), 4 Wash. 9 ; 1 Robb, 303 ; *Thomas v. Foxwell* (1858), 5 Jur. n. s. 37 ; *Gamble v. Kurtz* (1846), 3 C. B. 425 ; *Minter v. Mower* (1837), 1 Web. 138 ; 2 Abb. P. C. 178 ; *Campion v. Benyon* (1821), 6 Moore, 71 ; 1 Abb. P. C. 345 ; *Brunton v. Hawkes* (1821), 4 B. & Ald. 541 ; 1 Abb. P. C. 336 ; *Hill v. Thompson* (1817), 1 Web. 235 ; 1 Abb. P. C. 299 ; *Bovill v. Moore* (1816), Dav. P. C. 361 ;

1 Abb. P. C. 231 ; *Huddart v. Grimshaw* (1803), 1 Web. 85 ; 1 Abb. P. C. 128 ; *R. v. Else* (1785), 1 Web. 76 ; 1 Abb. 40.

That a Claim covering old matter is void, though the applicant has invented a new part which is useless without the old, see *Winans v. N. Y. & Erie R. R. Co.* (1856), 1 Fisher, 213.

That a Claim for the whole device, where the invention is merely an improvement, claims old matter and is void, see *Maguire v. Eames* (1880), 18 Blatch. 321 ; 8 Fed. Rep. 761 ; *Sullivan v. Redfield* (1825), 1 Paine, 441 ; 1 Robb, 477.

That a Claim covering three things, one being old, is void, see *Heinrich v. Luther* (1855), 6 McLean, 345.

That a Claim covering old matter is curable by disclaimer, see *Hovey v. Stevens* (1846), 3 W. & M. 17 ; 2 Robb, 567. See also §§ 537, 642-646, and notes, *post*.

That a disclaimer in a pending application must explain, not contradict, the Claim, and distinguish the new from the old, see *Ex parte Hobson* (1872), 1 O. G. 141.

art or instrument which most accurately expresses his idea. Having done this, all other forms are presumed to be embraced in the one claimed, unless they are disclaimed.¹ Thus a Claim for the making of an instrument or the doing of an act, describing the best mode of making the one or doing the other, covers all modes in which the former can be made or the

§ 514. ¹ In *Murphy v. Eastham* (1872), 2 O. G. 61, Shepley, J. : (62) "The patentee does not, as is sometimes done, claim in terms the thing patented, however its form and proportions may be varied ; but the law so interprets his Claim without the addition of these words. In contemplation of law, after he has fully described his invention and shown its principles, and claimed it in a form which perfectly embodies it, unless he disclaims other forms he is deemed to claim every form in which his invention may be copied." 5 Fisher, 306 (309) ; Holmes, 113 (116).

In *Winans v. Denmead* (1853), 15 How. 330, Curtis, J. : (343) "Patentees sometimes add to their Claims an express declaration, to the effect that the Claim extends to the thing patented, however its form or proportions may be varied. But this is unnecessary. The law so interprets the Claim without the addition of these words. The exclusive right to the thing patented is not secured if the public are at liberty to make substantial copies of it, varying its form or proportions. And, therefore, the patentee, having described his invention, and shown its principles, and claimed it in that form which most perfectly embodies it, is, in contemplation of law, deemed to claim every form in which his invention may be copied, unless he manifests an intention to disclaim some of those forms."

That a Claim to the invention in one form covers it in all forms, see *Grier v. Castle* (1883), 17 Fed. Rep. 523 ; 24 O. G. 1176 ; *McComb v. Brodie* (1872), 2 O. G. 117 ; 5 Fisher, 384 ; 1 Woods,

153. See also §§ 130, 237-244, and notes, *ante*.

That all qualities of the invention are covered by the Claim, though they are not specially stated, see *Ex parte Tweddle* (1876), 10 O. G. 747.

That a Claim for a device as an "attachment" to something else is a Claim for the device however used, see *McClain v. Ortmyer* (1888), 42 O. G. 724.

That additional Claims for different forms of the invention are unnecessary and improper, see *Ex parte McDougall* (1880), 18 O. G. 130 ; *Carver v. Braintree Mfg. Co.* (1843), 2 Story, 432 ; 2 Robb, 141.

That a Claim for a material having certain qualities does not cover subsequently discovered material having the same qualities, see *Goodyear v. Berry* (1868), 2 Bond, 189 ; 3 Fisher, 439 ; *Tetley v. Easton* (1852), Macrory's P. C. 48.

That a Claim for a chemical composition covers only the same use of the same or equivalent ingredients, see *Goodyear v. Berry* (1868), 2 Bond, 189 ; 3 Fisher, 439.

That the Claim of an invention in one form does not cover other forms when these are disclaimed, see *Union Paper Bag Mach. Co. v. Pultz & Walkley Co.* (1878), 15 O. G. 423 ; 15 Blatch. 160 ; 3 Bann. & A. 403 ; *Murphy v. Eastham* (1872), 5 Fisher, 306 ; 2 O. G. 61 ; Holmes, 113 ; *Winans v. Denmead* (1853), 15 How. 330.

That colorable variations may be covered by the Claim by using language sufficiently broad, see *Ex parte Demming* (1884), 26 O. G. 1207.

latter can be done.² Or where the invention consists in the new shape given to an object, such shape expressing an idea of means, all other shapes embodying the same idea are protected by the Claim for that alone.³ In this manner the protection of the patent, though not granted directly to the idea of means conceived by the inventor, as fully embraces it as if it were distinctly and expressly stated in the Claim.

§ 515. **The Claim must Correspond with the Description.**

Finally, as the Claim is the request of the inventor for the protection of the invention communicated to the public in the Description, it must entirely correspond with the Description and be based upon the matter therein contained.¹ No invention can be claimed in any specification unless it has

² That a Claim for the making of a thing or the doing of an act covers all modes of making or doing it, although only one mode is described, see *Union Paper Bag Mach. Co. v. Nixon* (1876), 1 Flippin, 491; 9 O. G. 691; 2 Bann. & A. 244.

³ That a Claim for a new shape of an object covers all other shapes expressing the same idea of means, see *Winans v. Denmead* (1853), 15 How. 330.

See also § 238 and notes, *ante*.

§ 515. ¹ That the invention claimed must be identical with the invention described, see *Knox v. Quicksilver Mining Co.* (1880), 4 Fed. Rep. 809; *Ex parte Designolle* (1877), 13 O. G. 227; *Ex parte Gould* (1876), 10 O. G. 203; *Ex parte Fairbanks* (1873), 3 O. G. 65; *Page v. Ferry* (1857), 1 Fisher, 298; *Corning v. Burden* (1853), 15 How. 252; *Seed v. Higgins* (1860), 8 E. & B. 755.

That the Claim and Description are distinct, and each must be complete and exact, and the Claim must be more than a mere reference to the Description, see *Ex parte Rice* (1874), 5 O. G. 522.

That the Claim is distinct from the Description, and represents such parts

of the described matter as constitute the invention to be patented, see *Merrill v. Yeomans* (1877), 94 U. S. 568; 11 O. G. 970.

That the Claim may be illustrated but not enlarged by the Description, see *Yale Lock Co. v. Greenleaf* (1886), 117 U. S. 555; 35 O. G. 386; *Railroad Co. v. Mellon* (1881), 104 U. S. 112; 20 O. G. 1891.

That the Claim can neither save a bad Description nor invalidate a good one, see *Kay v. Marshall* (1836), 2 Web. 39.

That a Claim cannot cover means substantially different from those described, though they produce substantially the same results, see *Ex parte Demming* (1884), 26 O. G. 1207.

That when the Description and Claim disagree, the Claim controls, see *McKesson v. Carndick* (1881), 21 O. G. 137; 19 Blatch. 158; 9 Fed. Rep. 44.

That when the Claim and Description are repugnant the whole invention must be found in one or the other, and the two may so contradict each other as to make the whole void, see *Smith v. Murray* (1886), 27 Fed. Rep. 69; 36 O. G. 1045.

been previously described in such a manner that any person skilled in the art could practise it from such Description, without experiment or the exercise of his own inventive skill.² Features of the invention not delineated in the Description cannot be inserted in the Claim, even though a mechanic in endeavoring to construct or employ the invention would inevitably discover them.³ Matter described as auxiliary, but not essential to the invention, cannot be stated in the Claim.⁴ A Claim for what has been described as a new part of an existing invention should not mention any other parts of such invention, unless they are necessarily connected with or related to the new, and when thus mentioned it must be apparent from the Claim itself that it does not attempt to cover them.⁵ A Claim for all modes of effecting a result when the invention has been previously described as a single mode of effecting it,⁶ or which embraces the natural

² That the invention claimed must have been so described that any one skilled in the art could practise it, see *Vogler v. Semple* (1877), 7 Bissell, 382; 11 O. G. 923; 2 Bann. & A. 556.

That a Claim based on an insufficient Description is void, see *Simpson v. Holliday* (1865), 12 L. T. Rep. N. S. 99.

³ That a Claim for a method not shown in the Description is void, see *Needham v. Washburn* (1874), 4 Clifford, 254; 7 O. G. 649; 1 Bann. & A. 537.

That a Claim for features not described, but which a maker of the article might discover by using it, is invalid, see *Kelleher v. Darling* (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438.

⁴ That the Claim must not contain matter described as auxiliary, see *Ex parte Wheat* (1879), 16 O. G. 360.

⁵ That where the described invention is a new part of an existing invention, the other parts should be omitted from the Claim if the new can be intelligibly stated without them, see *Ex*

parte Skinner (1881), 19 O. G. 662; *Ex parte Kitson* (1881), 20 O. G. 1750; *Ex parte Wilber* (1872), 1 O. G. 379; *Furbush v. Cook* (1857), 2 Fisher, 668.

⁶ In *O'Reilly v. Morse* (1853), 15 How. 62, Taney, C. J.: (112) "We perceive no well-founded objection to the description which is given of the whole invention and its separate parts, nor to his right to a patent for the first seven inventions set forth in the specification of his claims. The difficulty arises on the eighth. It is in the following words: 'Eighth, I do not propose to limit myself to the specific machinery or parts of machinery described in the foregoing specification and Claims; the essence of my invention being the use of the motive power of the electric or galvanic current, which I call electro-magnetism, however developed, for marking or printing intelligible characters, signs, or letters, at any distances, being a new application of that power of which I claim to be the first inventor or discoverer.' It is impossible to misunderstand the extent of this Claim. He claims the exclusive

force applied when the invention is a method of applying it, or which claims a principle of operation apart from the mechanism through which the operation is performed or the process in which it is employed, also violates this rule, since in each case the invention claimed is broader than the one described.⁷ The Claim may, however, be narrower than the invention set forth in the Description, provided the subject-matter of the Claim is a practically operative art or instrument.⁸ Thus, if

right to every improvement where the motive power is the electric or galvanic current, and the result is the marking or printing intelligible characters, signs, or letters at a distance. If this Claim can be maintained, it matters not by what process or machinery the result is accomplished. For aught that we now know, some future inventor, in the onward march of science, may discover a mode of writing or printing at a distance by means of the electric or galvanic current without using any part of the process or combination set forth in the plaintiff's specification. His invention may be less complicated, less liable to get out of order, less expensive in construction and in its operation. But yet if it is covered by this patent the inventor could not use it nor the public have the benefit of it without the permission of this patentee. Nor is this all; while he shuts the door against inventions of other persons, the patentee would be able to avail himself of new discoveries in the properties and powers of electro-magnetism which scientific men might bring to light. For he says he does not confine his claim to the machinery or parts of machinery which he specifies; but claims for himself a monopoly in its use, however developed, for the purpose of printing at a distance. New discoveries in physical science may enable him to combine it with new agents and new elements, and by that means attain the object in a manner superior to the present process

and altogether different from it. And if he can secure the exclusive use by his present patent he may vary it with every new discovery and development of the science, and need place no description of the new manner, process, or machinery, upon the records of the Patent Office. And when his patent expires the public must apply to him to learn what it is. In fine, he claims an exclusive right to use a manner and process which he has not described, and indeed had not invented, and therefore could not describe when he obtained his patent. The court is of opinion that the Claim is too broad, and not warranted by law."

That all modes of effecting an end cannot be claimed, see *Lawther v. Hamilton* (1884), 29 O. G. 449; 21 Fed. Rep. 811; *Ex parte Demming* (1884), 26 O. G. 1207; *Marsh v. Dodge & Stevenson Mfg. Co.* (1873), 5 O. G. 398; 6 Fisher, 562; *Stone v. Sprague* (1840), 1 Story, 270; 2 Robb, 10; *Wyeth v. Stone* (1840), 1 Story, 273; 2 Robb, 23.

⁷ That the Claim must not cover a force of nature, see *Detmold v. Reeves* (1851), 1 Fisher, 127.

That the Claim must not cover a principle, see *Ex parte Fairbanks* (1873), 3 O. G. 65; *Burr v. Duryee* (1863), 1 Wall. 531; *Walton v. Bateman* (1842), 1 Web. 613.

See §§ 133-143 and notes, *ante*.

⁸ That the invention claimed may be narrower than that described if it be

a single new element in the described invention be a complete operative means it may be claimed alone, and if it is essential to the operation of the invention as a whole, the entire invention may be indirectly protected by this restricted Claim.⁹ When the different parts of a device, as well as the device itself, have been described as new, the inventor may claim one part alone, or all parts separately, or the device alone, or both the parts and the device, as he deems best;¹⁰ and where he has described certain features of his invention as capable of being omitted without impairing its practical efficiency, these may be either inserted in the Claim or omitted from it without affecting its validity.

§ 516. The Claim : no Particular Form Required.

No particular form of words is required for the statement of the Claim.¹ The language used must be sufficiently clear and accurate to define the invention to the mind of the reader and convey to him a precise idea of its essential character,

an operative means, see *Ex parte* Emerson (1880), 17 O. G. 1451; *Russell & Erwin Mfg. Co. v. Mallory* (1872), 2 O. G. 495; 10 *Blatch.* 140; 5 *Fisher* 632.

⁹ That where a part of the described invention is practically operative alone, it may be claimed alone; and if essential to the operation of the rest, a Claim for it alone will protect the whole invention, see *Ex parte* Sturges (1872), 1 O. G. 204.

¹⁰ That where the Description shows several ways of applying a substance to new uses the Claim may cover all, see *Ex parte* Floyd (1874), 6 O. G. 541.

That where the parts of an invention are separately operative, a Claim for each may be inserted with that for the invention as a whole, see *Ex parte* Smith (1872), 2 O. G. 117.

That a Claim for each subordinate part is proper in connection with a Claim for the whole, though the parts are inoperative except in connection

with each other, see *Wells v. Jacques* (1874), 5 O. G. 364; 1 *Bann. & A.* 60.

See also § 472 and notes, *ante*.

That where the Description restricts the invention to a certain arrangement of parts, the Claim for the union of such parts must be correspondingly limited, see *Ex parte* Marsh (1872), 2 O. G. 197.

§ 516. ¹ That no particular form of Claim is required, see *Ex parte* Desig-nolle (1877), 13 O. G. 227; *Ex parte* Dahne (1875), 7 O. G. 1095; *Wyeth v. Stone* (1840), 1 *Story*, 273; 2 *Robb*, 23. ..

That the Claim is a whole and must stand or fall as such, being incapable of partial acceptance or rejection, see *Ex parte* Smith (1872), 1 O. G. 403.

That differences in the language of Claims do not necessarily show a difference in the inventions, see *Sharp v. Tiffit* (1880), 18 *Blatch.* 132; 17 O. G. 1282; 2 *Fed. Rep.* 697; 5 *Bann. & A.* 399.

neither exceeding the limits of the invention actually made, nor falling short of that operative means which the inventor intends to secure. A general and ambiguous Claim, leaving it uncertain what the inventor really wishes to protect, is void, but inartificial and ungrammatical expressions, not producing such uncertainty, do not render it invalid.² Useless words should not be inserted nor synonymous words be multiplied; since the former tend to create unnecessary ambiguity, while the latter are calculated to mislead the reader by suggesting to him that each word may be used by the inventor to express a different idea from that denoted by the others.³ Equivocal words are, of course, never permitted; for by their employment the meaning of the Claim is at once rendered doubtful.⁴

² That any terms properly qualified may be used in a Claim, see *Ex parte Holt* (1884), 29 O. G. 171.

That every element claimed must be clearly stated, not merely inferred, see *Ex parte Holt* (1884), 29 O. G. 171.

That a Claim must assert, not rest in doubtful implications, see *Fricke v. Hum* (1877), 22 Fed. Rep. 302.

That vague Claims are not allowable, see *Ex parte Paige* (1887), 40 O. G. 807.

That an ambiguous Claim is void, see *Edgerton v. Furst & Bradley Mfg. Co.* (1881), 9 Fed. Rep. 450; 21 O. G. 261; 10 Bissell, 402; *Merrill v. Yeomans* (1877), 94 U. S. 568; 11 O. G. 970; *Sargent v. Burge* (1877), 11 O. G. 1055; *Blake v. Stafford* (1868), 3 Fisher, 294; 6 Blatch. 195; *Rich v. Lippincott* (1853), 2 Fisher, 1.

That a Claim cannot use such indefinite expressions as "means," "mechanism," etc., see *Ex parte Holt* (1884), 29 O. G. 171; *Ex parte Wilkin* (1884), 29 O. G. 950; *Ex parte Demming* (1884), 26 O. G. 1207.

That a Claim must set out the invention, not merely refer to the Description, see *Ex parte Demming* (1884), 26 O. G. 1207.

That a Claim to what is described in the specification is too vague, see

Albany Steam Trap Co. v. Felthousen (1884), 22 Blatch. 169; 20 Fed. Rep. 633.

That where an invention consists in the peculiar arrangement of certain parts, a Claim stating the parts in a general manner and referring to the Description as showing the arrangement, is not sufficient, see *Ex parte Kerr* (1884), 28 O. G. 95.

That the casual misuse of words does not make a Claim defective, if it can be cured by examining the Description, see *Reed v. Street* (1885), 34 O. G. 339.

That a Claim will be sustained, though inaccurately expressed, if the court can see what the invention really is, see *Stover v. Halsted* (1875), 8 O. G. 558; 13 Blatch. 95; *Ames v. Howard* (1833), 1 Sumner, 482; 1 Robb, 689.

³ That the repetition of synonymous words is improper in a Claim, see *Ex parte Smith* (1872), 2 O. G. 117.

⁴ That equivocal words must not be used, see *Ex parte Designolle* (1877), 13 O. G. 227.

That the words "means," "mechanism," "connections," are proper when used to denote appliances which are not part of the invention, but are not to be used with reference to essential elements of the patentable subject-mat-

Of this character is the word "equivalent;" for as a true "equivalent," in the sense of the Patent Law, is always covered by the Claim, though not mentioned, the insertion of the word in the Claim implies matter outside its ordinary meaning and appears to widen the scope of the invention, while leaving its actual limits undefined.⁶

§ 517. The Claim: Technical Phrases.

In stating Claims certain phrases are frequently employed to which a special importance seems to be attached by applicants. Among these are the phrase "substantially as de-

ter, see *Ex parte* Stoughton (1888), 43 O. G. 1345; *Ex parte* Stanbridge (1888), 43 O. G. 1345.

⁶ In *Ex parte* Haasz (1873), 4 O. G. 610, Leggett, Com. : (611) "I know of no rule or reason for prescribing or proscribing the use of any particular word or phrase in connection with a specification or Claim. Anything of the sort would necessarily be arbitrary and unreasonable. All the words of our language are, of course, as free to the intelligent and appropriate use of inventors in their specifications and Claims as to anybody else; but there are some words and phrases which are capable of being used equivocally, and perhaps the words *equivalent* and *equivalents* are the most conspicuous examples. Whenever they occur in such a connection as to have an equivocal signification, their employment in that connection must be inhibited. This is as far as a rule of practice in the matter can go. Under this rule judicious care must be exercised in the consideration of each particular case, where these words recur, to the end that the Claims shall clearly, definitely, and correctly comprehend the alleged subject-matter of invention and nothing more. No ambiguous or useless word or phrase ought ever to be allowed in a Claim. It is well known to those versed in Patent Law, that equivalents are compre-

hended in every Claim, whether specified or not, and that the use of the word in a Claim cannot enlarge its legal scope. Wherever its use would merely serve to convey a magnified idea of the scope of the patent to the uninformed, it surely ought not to be allowed."

That a Claim covers all equivalents, see *Burden v. Corning* (1864), 2 Fisher, 477, and notes to § 257, *ante*.

That equivalents are covered though the inventor never thought of them, see *McNamara v. Hulse* (1842), 2 Web. 128.

That a Claim cannot cover matters subsequently discovered, see *Tetley v. Easton* (1852), Macrory's P. C. 48.

That equivalents should not be expressly claimed, see *Ex parte* Reid (1879), 15 O. G. 882; *Ex parte* Bogart (1876), 10 O. G. 113.

That the words "or equivalent devices." must not be used in a Claim unless the equivalents are described in the specification, or unless a patent for one would be a complete bar to a patent for the other, see *Ex parte* Dolph (1887), 39 O. G. 239.

That the examiner may require the words "or equivalents" to be erased, and the applicant cannot then amend by inserting a particular Claim for the alleged equivalent, see *Ex parte* Johnson (1888), 43 O. G. 507.

scribed," and others of the same meaning. These phrases import the same thing when used in a Claim as when elsewhere employed. They are neither necessary nor technical. The reference they make to the Description is always implied, and relates only to the essential features of the invention as therein delineated. They add nothing, therefore, to the certainty of the Claim, nor do they detract from it unless the claimant carelessly inserts them as a substitute for a more clear and definite statement of his invention.¹ When used, the word "described" refers to the Claim as well as the Description, and either may thus aid in the interpretation of the other.² Whether expressed or implied, they limit the general

§ 517. ¹ In *Mitchell v. Tilghman* (1873), 19 Wall. 287, Clifford, J.: (391) "Usually the Claim contains the words 'as described' or 'substantially as described,' or words of like import, which are everywhere understood as referring back to the descriptive parts of the specification. Words of such import, if not expressed in the Claim, must be implied, else the patent in many cases would be invalid as covering a mere function, principle, or result, which is obviously forbidden by the Patent Law, as it would close the door to all subsequent improvements." 5 O. G. 299 (303).

In *Ex parte Collins Co.* (1872), 2 O. G. 617, Leggett, Com.: (617) "These words should be regarded precisely as other words should be,—that is, as having their ordinary meaning,—when used in a Claim, as elsewhere, and nothing more. There is no artificial significance to be set up for them by which they are to be considered either as desirable or dangerous. There is no objection whatever to their use where they make sense; but they have no legal effect either to enlarge or limit a Claim properly drawn, and, so far as the grant of a patent is concerned, they should have no influence one way or the other. The Claim should be sufficient in its

terms either with or without them, because either with or without them its meaning and effect are to be determined in the courts by the light of the specification."

That Claims always refer to the Description, whether so expressed or not, see *Westinghouse v. Gardner & Ranson Air Brake Co.* (1875), 9 O. G. 538; 2 Bann. & A. 55.

That the phrase "substantially as described" has no efficacy unless the Description is clear, see *Ex parte Skinner* (1881), 19 O. G. 662.

That a Claim depending on the phrase "mechanism substantially as described" is too vague, see *Ex parte Wilkin* (1884), 29 O. G. 950.

That where the Description is specific the words "substantially as described," render the Claim specific, see *Ex parte Ewart* (1880), 17 O. G. 448.

That the phrase "substantially as described and shown" relates only to the material features of the invention, see *Waterbury Brass Co. v. Miller* (1871), 9 Blatch. 77; 5 Fisher, 48.

² That the word "described" refers to the Claim as well as the Description, see *Pearl v. Ocean Mills* (1877), 2 Bann. & A. 469; 11 O. G. 2.

terms of the Claim to the specific features set out in the Description, though neither these phrases, nor the one "as specified," confines the Claim to that mode of using the invention which has been previously described.³ The phrase "substantially as and for the purposes set forth" is of a different character. These are words of limitation, and should not be used unless they are intended to have their special signification. They refer to the Description for a qualification of the general statements of the Claim, and confine the invention within the purposes and operations there specifically named.⁴

§ 518. The Claim must not Claim a Mere Function.

One of the most objectionable forms in which a Claim can be stated is that of a Claim for the function of the invention. A functional Claim is one which claims the producing of an effect as distinguished from the means by which it is produced.¹ Such a Claim is void, since it neither covers a patentable invention nor corresponds with the Description previously given.² The language of a functional Claim is usually parti-

³ That a Claim for a combination "substantially as described" is limited to the elements described as composing it, see *Hailes v. Van Wormer* (1873), 20 Wall. 353; 5 O. G. 89.

⁴ That the phrase "in the manner . . . mentioned," limits the process to the manner described, see *Barker v. Grace* (1847), 1 Exch. 339.

That in a Claim the words "as specified" do not limit the Claim to the described mode of using the invention, see *Lorillard v. McDowell* (1877), 2 Bann. & A. 531; 11 O. G. 640; 13 Phila. 461; *Betts v. Menzies* (1861), 10 H. L. Cas. 117.

⁴ That the words "substantially as and for the purposes set forth" refer to the Description for a limitation of the general words employed, see *Corn Planter Patent* (1874), 23 Wall. 181; 6 O. G. 392; *Ex parte Sperry* (1872), 2 O. G. 387.

§ 518. ¹ In *Ex parte Hahn* (1875), 8 O. G. 597, Spear, Act. Com. : (597) "It is clear from the numerous decisions of the courts and Office on that point that what is known as a functional Claim is one that has for its subject the performance of an act merely, and not the means by which that act is executed. It is not for a substantive thing, but for the *result* which that thing accomplishes. Its language is usually in the participial form, as 'producing,' 'operating,' 'determining,' 'so combining,' 'so constructing,' etc."

² That a Claim for a function is void, see *Matthews v. Schoneberger* (1880), 4 Fed. Rep. 635; 18 Blatch. 357; 18 O. G. 1464; *Ex parte Ives* (1878), 15 O. G. 385; *Ex parte Arnold* (1874), 5 O. G. 553; *Wheeler v. Simpson* (1874), 1 Bann. & A. 420; 6 O. G. 435; *Sickels v. Falls Co.* (1861), 4 Blatch. 508; 2 Fisher, 202; Opin-

cipial; and if construed according to its terms the matter claimed would be the operation of the invention on its object, not the invention itself. In order to sustain the patent the courts construe such Claims, if possible, as Claims for the means by which the act is performed, and not for the performance of the act itself.³ Thus a Claim for the "so forming" a thing is treated as a Claim for the thing formed; a Claim for the application of means by which a certain thing is done is held to be a Claim for the means applied; a Claim for producing a given effect, by means of a peculiar arrangement of the instruments employed, is considered as a Claim for the instruments as so arranged; and a Claim for the "doing" of an act is interpreted to be a Claim for the means or apparatus by which the act is done.⁴ But where the Claim is unequivocally functional,—as, for example, where it claims the "operating of" a machine, or the "imparting motion" to an object,—it is fatally defective.⁵ It must not be forgotten,

ion Atty. Gen. (1856), 8 Op. At. Gen. 269.

See also §§ 144–146 and notes, *ante*.

That participial Claims are improper, see *Ex parte Cox* (1873), 3 O. G. 2.

That an apparatus must not be claimed as a "means of doing," but as a specific device, see *Ex parte Bates* (1879), 16 O. G. 266.

That a Claim for a design must not cover a mere function, see *Ex parte Diffenderfer* (1872), 2 O. G. 57.

³ That a Claim, when functional in form, is treated, if possible, as a Claim for the means performing the function, see *Royer v. Schultz Belting Co.* (1886), 28 Fed. Rep. 850; 38 O. G. 898; *Coffin v. Ogden* (1869), 3 Fisher, 640; 7 Blatch. 61; *Minter v. Wells* (1834), 1 Web. 134; 2 Abb. P. C. 47.

That the courts do not sanction functional Claims by relieving patentees from their consequences, see *Ex parte Ives* (1878), 15 O. G. 385.

That functional Claims may often be cured by inserting a reference to the

mechanism described, see *Ex parte Holmes* (1874), 6 O. G. 360.

⁴ That a Claim for the "so forming," etc., is not functional, but claims the thing formed, see *Parham v. American Buttonhole, Overseaming, & Sewing Mach. Co.* (1871), 4 Fisher, 468.

That a Claim for the application of means by which an effect is accomplished is a Claim for the means applied, see *Hitchcock v. Tremaine* (1871), 4 Fisher, 508; 8 Blatch. 440.

That a Claim for such an arrangement of elements as will produce a certain effect is a Claim for the elements as so arranged, not for the function, see *Renwick v. Pond* (1872), 2 O. G. 392; 5 Fisher, 569; 10 Blatch. 39.

That a Claim for "doing" an act or thing is treated as a Claim for the means of doing it, see *Fuller v. Yentzer* (1876), 94 U. S. 288; 11 O. G. 551; *Seymour v. Osborne* (1869), 3 Fisher, 555.

⁵ That a Claim for the "operating of," etc., is void, see *Ex parte Ives* (1878), 15 O. G. 385.

That a Claim for "imparting mo-

however, that the function of one invention may be itself a different invention, as an art may stand in the relation of function to the apparatus by which it is performed. Where such an invention is the one described, it may be claimed in any language suitable for its definition, although the same Claim, if based on a Description of the instruments employed, would be clearly functional and void. In a Claim properly defining the real invention, its functions may be referred to and its operation set forth without impairing the validity of the Claim.⁹

§ 519. **The Claim must not Claim a Mere Effect.**

Another objectionable form of Claim is that which claims the result accomplished by the use of the invention, instead of the invention by whose use the result is attained. Where a result is a new product and constitutes the real invention, it is, of course, the proper subject of the Claim.¹ But where it is a mere effect of the means devised by the inventor, it cannot be claimed in his patent. It is not in its nature a patentable invention, nor, if it were, could it be monopolized by an inventor who had simply discovered one means of producing it.² Such Claims are, therefore, void, although, as in

tion," etc., is void, see *Sickels v. Falls Co.* (1861), 2 Fisher, 202; 4 Blatch. 508.

That in a machine patent a Claim for the "mode of operation" is void, see *Hatch v. Moffitt* (1883), 15 Fed. Rep. 252.

That a Claim for a mechanical process, which is a mere function of the described devices, is void, see *Case v. Hastings* (1875), 7 O. G. 557.

⁹ That a Claim for the means does not become a functional Claim by stating the operation of the means, if it is otherwise sufficient, see *Ex parte Gray* (1877), 11 O. G. 329; *Ex parte Kieth* (1876), 9 O. G. 744.

§ 519. ¹ That a Claim for a result as a product is valid, see *Anilin v. Higgin* (1878), 15 Blatch. 290; 14 O. G. 414; 3 Bann. & A. 462.

² That a Claim for a result as an effect is void, see *Ex parte Beavis* (1879), 16 O. G. 1233; *Marsh v. Dodge & Stevenson Mfg. Co.* (1874), 5 O. G. 398; 6 Fisher, 562; *Wheeler v. Simpson* (1874), 6 O. G. 435; 1 Bann. & A. 420; *Bailey Washing & Wringing Mach. Co. v. Lincoln* (1871), 4 Fisher, 379; *Sickels v. Falls Co.* (1861), 4 Blatch. 508; 2 Fisher, 202.

See also §§ 147-149 and notes, *ante*.

That a Claim for all means of accomplishing a result is a Claim for the result itself and therefore void, see *Lawther v. Hamilton* (1884), 29 O. G. 449; 21 Fed. Rep. 811; *Ex parte Demming* (1884), 26 O. G. 1207; *Marsh v. Dodge & Stevenson Mfg. Co.* (1874), 5 O. G. 398; 6 Fisher, 562; *O'Reilly v. Morse* (1853), 15 How. 62; *Stone v. Sprague* (1840), 1 Story, 270; 2 Robb, 10;

the case of functional Claims, the courts construe them, if possible, as Claims for the art or instrument by which the effect is accomplished.³ Thus a Claim for so forming an object that a certain result is attained, or for the production of an effect by arranging certain devices in the manner described, is regarded as a Claim for the object so formed, or the devices so arranged.⁴

§ 520. The Claim must not be Alternative.

A Claim stated in the alternative is invalid when the language of the Claim either covers nothing positively, or leaves it uncertain which of several things the inventor intends to claim.¹ The use of the disjunctive conjunction does not, of itself, render a Claim uncertain. Where the essential characteristics of the invention are properly set forth, and some of its connections or modes of use are described in the alternative, the Claim is good, since the matters described in the alternative form no part of the invention, and may be eliminated from the Claim without impairing the completeness of its statement of the real invention. Or where in setting forth the invention itself the disjunctive conjunction is employed in its enumerative sense, and the Claim thus becomes the equiva-

Wyeth v. Stone (1840), 1 Story, 273 ;
2 Robb, 23.

That a Claim for the use of a natural force for a special purpose is too broad, being equivalent to a Claim for the purpose thereby effected, see O'Reilly v. Morse (1853), 15 How. 62.

That where a structure produces results the Claim must be for the structure, not the result, see *Ex parte* Roloson (1879), 15 O. G. 471.

³ That where a Claim in terms is for a result it will be construed, if possible, to cover the means by which the result is effected, see Coes v. Collins Co. (1882), 22 O. G. 417 ; 20 Blatch. 221 ; 9 Fed. Rep. 905 ; Palmer v. Gatling Gun Co (1881), 19 Blatch. 392 ; 20 O. G. 815 ; 8 Fed. Rep. 513 ; Henderson v. Cleveland Co-operative Stove Co.

(1877), 12 O. G. 4 ; 2 Bann. & A. 604 ; Fuller v. Yentzer (1876), 94 U. S. 299 ; 11 O. G. 597 ; Corn Planter Patent (1874), 23 Wall. 181 ; 6 O. G. 392 ; Evarts v. Ford (1873), 5 O. G. 58 ; 6 Fisher, 587.

⁴ That a Claim for the "so forming . . . that" a given result is attained is a Claim for the means, not the result, see Lull v. Clark (1882), 22 O. G. 1535 ; 13 Fed. Rep. 456 ; 21 Blatch. 95.

§ 520. ¹ That alternative Claims are not allowable, see *Ex parte* Holt (1884), 29 O. G. 171 ; *Ex parte* McDougall (1880), 18 O. G. 130 ; *Ex parte* Reid (1879), 15 O. G. 882 ; Union Paper Bag Mach. Co. v. Nixon (1873), 4 O. G. 31 ; 6 Fisher, 402 ; Carr v. Rice (1858), 1 Fisher, 325.

lent for as many separate Claims as it contains enumerative clauses, the Claim, although irregular in form, is still allowable. Thus to claim both of two alternatives, or to claim different arrangements of the same elements in a combination where each arrangement is an operative means, has been permitted.² But the danger of ambiguity in all uses of the disjunctive, and the ease and security with which each of several devices or arrangements may be stated in separate Claims, causes alternative Claims to be disfavored by the Patent Office, although the courts may manifest a disposition to sustain them where the language is capable of an intelligible construction.

§ 521. The Claims must not be Unnecessarily Multiplied.

The law prescribes no limit to the number of Claims which may be inserted in a single specification. But a repetition of the same Claim, or the multiplication of Claims for the same invention, is not allowed except in cases where the nature of the invention renders it necessary to describe it in different methods, in order to make it clear or to state all that can rightfully be claimed. Claims are not like counts in a declaration, varied in terms to meet the possible phases of evidence or legal interpretation; they are conclusions from the specification, and must neither be fictitious, nor redundant, nor appear to cover more than fairly can be claimed.¹ The need-

² That a Claim to both of two alternatives is valid, see *Union Paper Bag Mach. Co. v. Nixon* (1873), 4 O. G. 31; 6 Fisher, 402.

That an alternative Claim is good only when it is the equivalent of two Claims, one for each alternative, see *Tuck v. Bramhill* (1868), 3 Fisher, 400; 6 Blatch. 95.

That a patent cannot claim alternative forms of a combination unless each is an operative machine, see *Brown v. Whittemore* (1872), 5 Fisher, 524; 2 O. G. 248.

That Claims cannot be for independent alternative constructions or for mere modifications of the construction

set up in other Claims, see *Ex parte Holt* (1884), 29 O. G. 171.

§ 521. ¹ In *Ex parte Woodruff* (1880), 17 O. G. 453, Doolittle, Act. Com. : (453) "The general doctrine heretofore in vogue in the Office that it is admissible, under proper restrictions, for parties to put their Claims in different forms to prevent misconstruction of them by the public or the courts must be construed, as the Examiner contends, to have reference, not to unnecessary repetition of Claims for the same thing, but to those cases which are difficult of definition, and where one set or form of words would be inadequate to clearly cover the invention

less repetition of the same matter in different Claims tends to mislead by conveying the idea that some substantial difference exists between the subjects of the several Claims; and if this is carried to such an extent as to create ambiguity, or cover more than is really invented, the entire patent may be rendered void.² Where one Claim will be sufficient no others should be made; and where two or more are inserted, without necessity, the one which best protects the invention will be retained and the others will be rejected.³ But several

and prevent misconstruction. Another difficulty arises from the inability of an applicant to set forth in a single Claim the device broadly, so that it will cover all other devices which are the same in principle of operation, and therefore equivalents, and, at the same time, the specific device he has invented and described to carry out the improvement in the art of manufacture. But where the invention is simple in nature and can be clearly stated in simple language and in one Claim, there is no justification for setting out the invention in a series of Claims which all mean the same thing. Claims are not like counts in pleadings, which are often repetitions of the same cause of action in different forms of language to provide against the hazard of the proofs varying materially from the statement of the cause of action, but they are the conclusion of the specification, and their object is to set forth distinctly and concisely just what the invention is which the applicant asks to be secured to him by his patent, and they should not consist of fictitious, redundant, or amplified allegations of matters by which it is hoped to secure protection for something more than the applicant has actually invented or contemplated. Where the terms of a Claim in a patent are clear and distinct, as they always should be, no necessity arises for repeating such Claim in different forms of language, and subjecting the Office and the courts

to great labor in scrutinizing them, and to doubt and annoyance as to their limitations and construction."

That the duplication of Claims does not necessarily avoid a patent, see *Tompkins v. Gage* (1865), 5 Blatch. 268; 2 Fisher, 577.

That divided and multiplied Claims are disapproved, see *Bostock v. Goodrich* (1884), 21 Fed. Rep. 316; 29 O. G. 278.

That Claims for the same thing may be repeated in different language in order to prevent misunderstanding, see *Ex parte Hahn* (1875), 8 O. G. 597; *Ex parte Shippen* (1875), 8 O. G. 727.

² In *Carlton v. Bokee* (1873), 17 Wall. 463, Bradley, J. : (471) "We think it proper to reiterate our disapprobation of these ingenious attempts to expand a simple invention of a distinct device into an all-embracing Claim, calculated by its wide generalizations and ambiguous language to discourage further invention in the same department of industry and to cover antecedent inventions. Without deciding that a repetition of substantially the same Claim in different words will vitiate a patent, we hold that where a specification by ambiguity and a needless multiplication of nebulous Claims is calculated to deceive and mislead the public, the patent is void." 2 O. G. 520 (523); 6 Fisher, 40 (48).

³ That two Claims for the same thing are improper, and that which

Claims for the same art or instrument as serving different purposes, or as employed in different modes, or as accomplishing different results, may be properly made, since such a separation tends to prevent confusion and to preserve the essential characteristics of the invention distinct from those of its objects and its uses.⁴

§ 522. **The Claim: Joinder of Claims for Different Inventions.**

The joinder of several Claims for different inventions in the same specification is governed by the rules heretofore considered in reference to the joinder of inventions.¹ The Claims, being the life of the patent, the central point to which all the other parts converge and from which they derive their value to the inventor, may embrace every invention for whose protection he may lawfully apply; and must embrace all those which his patent is destined to secure. A Claim may, therefore, be inserted in the specification for each of the described inventions whose nature and dependence on the principal invention is such as to permit its joinder in the same application. The Claims for each of these inventions must possess all the characteristics, and fulfil all the requirements which would be necessary to their validity were it the sole invention claimed.

§ 523. **The Claim Interpreted by other Parts of the Application.**

While the rules governing the scope and language of the Claim are thus numerous and rigid, the attitude of the courts toward the inventor, in its interpretation, is just and liberal.

best protects the invention will be retained, the other rejected, see *Dederick v. Cassell* (1881), 20 O. G. 1233; 9 Fed. Rep. 306; 14 Phila. 503.

That a Claim embracing only a feature or quality which is covered by another Claim, as inseparable from its particular subject-matter, is void, see *Combined Patents Can Co. v. Lloyd* (1882), 15 Phila. 485; 11 Fed. Rep. 153.

That a Claim cannot be so changed by construction as to make it the same as another Claim of the same patent, see *Filley v. Littlefield Stove Co.* (1887), 39 O. G. 1203; 30 Fed. Rep. 434.

⁴ That several Claims for the same device as accomplishing several results may be inserted, see *Ex parte Smith* (1880), 17 O. G. 271.

§ 522. ¹ That Claims for separate but dependent inventions may be joined, see *Ex parte Smith* (1872), 2 O. G. 117.

That a second Claim for an inseparable feature of the invention previously claimed is not proper, see *Combined Patents Can Co. v. Lloyd* (1882), 11 Fed. Rep. 153; 15 Phila. 485.

See also §§ 468-479 and notes, *ante*.

In construing the Claim the whole specification is taken together, and if the terms in which the Claim is stated are consistent with those of the Description, the latter with its accompanying drawings is treated as an amplification and explanation of the former, illustrating and applying its more concise and definite expressions. Thus, though the Claim is distinct from the Description and as such must be complete in itself and not merely refer to the Description for a statement of the invention claimed, yet every feature of the invention which the Description has declared to be essential, and all the modes of using it therein prescribed, are covered by the Claim, whether or not they are particularly mentioned.¹ Without departing from the rule that the Claim must clearly limit and define the exact invention for which a patent is desired, or assuming the power to alter or enlarge a Claim, the courts sustain it whenever in connection with its proper exponent, the Description, and in view of the state of the art, it renders the nature of the claimed invention evident to those to whom the specification is addressed.²

§ 523. ¹ That the Claims are interpreted and limited by the Description, see *Snow v. Lake Shore & Mich. Southern R. R. Co.* (1887), 121 U. S. 617; 39 O. G. 1081; *Ex parte Holt* (1884), 29 O. G. 171; *Fuller v. Yentzer* (1874), 6 Bissell, 203; *Ex parte Marsh* (1872), 2 O. G. 197.

That parts shown in the Description to be essential to the invention must be understood, though not mentioned in the Claim, see *Ex parte Richardson* (1875), 7 O. G. 1053.

That a Claim may be limited by the drawings, where it describes the device only by letters referring to them, see *Ex parte Marsh* (1872), 2 O. G. 197.

That drawings cannot so far supply the place of a written Description that a Claim can be construed to cover matter shown only in the drawings, see *Gunn v. Savage* (1887), 30 Fed. Rep. 366.

That the Claim cannot be enlarged by the Description, see *Yale Lock Co.*

v. Greenleaf (1886), 117 U. S. 554; 35 O. G. 386; *Lehigh Valley R. R. Co. v. Mellon* (1881), 104 U. S. 112; 20 O. G. 1891.

That where the Description and Claims disagree, the Claims control, see *McKesson v. Carndick* (1881), 21 O. G. 137; 19 Blatch. 158; 9 Fed. Rep. 44.

² That whenever the nature of the invention can be ascertained by construing the specification in view of the state of the art, the Claim will be construed to cover it, if its language will permit, see *Andrews v. Carman* (1876), 9 O. G. 1011; 13 Blatch. 307; 2 Bann. & A. 277; *Turrill v. R. R. Co.* (1863), 1 Wall. 491; *Whipple v. Middlesex Co.* (1859), 4 Fisher, 41; *Le Roy v. Tatham* (1852), 14 How. 156; *Haworth v. Harcastle* (1854), 1 Web. 480; 2 Abb. P. C. 19.

That a Claim for a device which is useless in itself, but is useful in connection with other things mentioned in

§ 524. The Claim for a Combination: Combinations not Covered by Claims for their Elements.

By the application of these general rules to Claims for different classes of inventions many special rules have been developed, to which from time to time new rules are added as new cases are presented for determination. In examining these attention must be first directed to the rules concerning combinations. A combination is the union of several elements under one co-operative law. It is an invention distinct both from the elements of which it is composed and from the law by which their co-operation is controlled. It must, therefore, be claimed as an invention by itself, not being covered by a Claim for each of the elements separately, nor by a Claim for all of them collectively, nor by a Claim for all of them co-operatively under a different co-operative law.¹

§ 525. The Claim for a Combination: its General Requisites.

A Claim for a combination must include all its essential characteristics, and embrace enough to produce a distinct and useful result, but must, at the same time, be confined to that union of one element with another which the inventor has created and described.¹ It must distinguish clearly between

the Description, is good, see *Wells v. Jacques* (1874), 1 Bann. & A. 60; 5 O. G. 364.

That where the specification describes several ways of applying a substance to new uses, the Claim will be so construed as to cover all, see *Ex parte Floyd* (1874), 6 O. G. 541.

§ 524. ¹ That a Claim for the elements alone does not cover the combination, see *Delaware Coal & Ice Co. v. Packer* (1880), 5 Bann. & A. 296; 1 Fed. Rep. 851; 24 O. G. 1273. See also § 527 and notes, *post*.

§ 525. ¹ That a Claim including an element not co-acting as part of the combination is invalid, see *Van Camp v. Maryland Pavement Co.* (1888), 43 O. G. 884; *Kerosene Lamp Heater Co. v.*

Littell (1878), 13 O. G. 1009; 3 Bann. & A. 312.

That a patent for a combination of old elements cannot claim any other union of the elements than the one invented and described, see *Larabee v. Cortlan* (1851), 3 Fisher, 5; Taney, 180.

That a patent cannot claim alternative combinations unless both are operative means, see *Brown v. Whittemore* (1872), 5 Fisher, 524; 2 O. G. 248.

That where a Claim for a combination attributes to it a certain motion, it is the means by which the motion is produced and not the motion that forms the subject of the patent, see *Royer v. Schultz Belting Co.* (1886), 28 Fed. Rep. 850; 38 O. G. 898.

the new and the old, either by expressly disclaiming the latter or by totally omitting it;² and if the real invention consists only in the new arrangement of an existing combination, improving its operation or effect, the Claim must point out the new arrangement as the limit of its request for protection, or the Claim will be too broad.³ Features not essential to the combination should not be introduced into the Claim.⁴ If the new combination forms merely a part of some art or instrument of wider scope, the other portions of the art or instrument should not be mentioned, where the new combination can be adequately set forth without them; and when their statement becomes necessary they should be disclaimed. Nor should the Claim embrace the connecting mechanism by which the new combination is united to the principal invention, except under the same necessity and coupled with a similar disclaimer.⁵

² In *The Corn Planter Patent* (1874), 23 Wall. 181, Bradley, J. : (224) "Where a patentee, after describing a machine, claims as his invention a certain combination of elements, or a certain device, or part of the machine, this is an implied declaration, as conclusive, so far as that patent is concerned, as if it were expressed, that the specific combination or thing claimed is the only part which the patentee regards as new. True, he or some other person may have a distinct patent for the portions not covered by this; but that will speak for itself. So far as the patent in question is concerned, the remaining parts are old, or common and public." 6 O. G. 392 (400).

That all unclaimed elements of the described combination are thereby conceded to be old, see *Rowell v. Lindsay* (1881), 10 Bissell, 217; 19 O. G. 1565; 6 Fed. Rep. 290; *Conover v. Roach* (1857), 4 Fisher, 12; *Batten v. Taggart* (1851), 2 Wall. Jr. 101. This concession relates only to the patent in question; the unclaimed matter in itself may really be new and reserved for a future patent. See § 506 and notes, *ante*.

³ That where the Claim covers a combination which in its general character is old, the special construction in which the novelty consists must be pointed out or it will be too broad, see *Terry Clock Co. v. New Haven Clock Co.* (1878), 17 O. G. 908; 3 Bann. & A. 332.

⁴ That a Claim for a combination should not cover non-essential elements, see *Rapid Service Store R. R. Co. v. Taylor* (1887), 42 O. G. 721; *Royer v. Schultz Belting Co.* (1886), 28 Fed. Rep. 850; 38 O. G. 898; *Hancock Inspirator Co. v. Jenks* (1884), 21 Fed. Rep. 911; *Ex parte Kitson* (1881), 20 O. G. 1750; *Furbush v. Cook* (1857), 2 Fisher, 668.

That an unessential part is not an element unless claimed as such, see *Bradley v. Dull* (1884), 27 O. G. 625; 19 Fed. Rep. 913. See also § 278 and notes, *ante*.

⁵ That a Claim for a combination should not include the connecting mechanism unless it is an element in the combination or is essential to the comprehension of what is claimed, see *Ex parte Skinner* (1881), 19 O. G. 662.

§ 526. The Claim for a Combination may be Stated in any Intelligible Form.

Any form of words may be employed in a Claim for a combination provided it accurately describes the real invention. To enumerate the elements, and to state explicitly the method of their combination and the law of their co-operation, constitutes a perfect Claim; but such a statement is not always possible. The inventor is not obliged to understand, sufficiently to formulate in words, the mode in which these elements unite and act upon each other or upon their common object. It is enough that he has actually combined them and thereby produced a new and useful operative means; and any language in which he can make his invention so far intelligible to the public that they can practise it themselves, and can perceive the limits of the exclusive privilege he claims, answers the requirements of the law.¹ Thus a Claim for the described elements in such a combination as will achieve a certain result, or a Claim for such an arrangement of the elements as will produce a given effect, or a Claim for so much of the mechanism described as accomplishes a particular purpose,—have been allowed, where the Description indicated to those skilled in the art such combinations, arrangements, or portions of the mechanism as gave clearness and precision to the Claim.² No such Claim can be con-

§ 526. ¹ That a Claim for a combination must embrace enough to produce a distinct, definable, and unitary result, though not necessarily enough to produce the entire result aimed at, see *Ex parte Rheutan* (1874), 5 O. G. 521; *Ex parte Farrow* (1872), 2 O. G. 57.

That a Claim for an inoperative combination is void, see *Tarrant v. Duluth Lumber Co.* (1887), 39 O. G. 1425; 30 Fed. Rep. 830.

² In *Renwick v. Pond* (1872), 10 Blatch. 39, Blatchford, J.: (49) "Claiming the arrangement of a combination, when the arrangement is such as to produce a given mechanical result of the combination, is not a Claim to a function. The result is not claimed ir-

respective of the means producing it. The means alone are claimed, and claimed only when specially arranged to produce a given result. This is very far from claiming a function." 2 O. G. 392 (395); 5 Fisher, 569 (579).

In *Silby v. Foote* (1852), 14 How. 218, Curtis, J.: (226) "When a Claim does not point out and designate the particular elements which compose a combination, but only declares, as it properly may, that the combination is made up of so much of the described machinery as effects a particular result, it is a question of fact which of the described parts are essential to produce that result; and to this extent, not the construction of the Claim, strictly speak-

strued to extend beyond the matter previously described. Whether it contains the phrase "substantially as described" or not, it must be limited to the elements and mode of union already set forth at length in the Description.³

§ 527. **The Claim for a Combination Covers only the Precise Combination Claimed.**

A Claim for a combination covers the exact combination claimed and nothing more. It does not protect the elements of the combination, nor their mode of union, nor their co-operative law, separately considered.¹ It does not embrace any other union of the same elements with each other, or with additional elements, nor a combination of a portion of these elements among themselves.² Where it omits certain

ing, but the application of the Claim should be left to the jury."

That the Claim may state that the combination consists of the described elements when so constructed as to produce the given effect, see *Gottfried v. Phillip Best Brewing Co.* (1879), 17 O. G. 675; 5 Bann. & A. 4.

That a Claim for the combination as a whole may be stated as covering the described elements in combination, see *Wicke v. Ostrum* (1881), 103 U. S. 461; 19 O. G. 867.

That "means," "mechanism," and similar comprehensive terms are not proper in Claims for combinations for the purpose of pointing out the invention, see *Ex parte Paige* (1887), 40 O. G. 807; *Ex parte Wilkin* (1884), 29 O. G. 950; *Ex parte Holt* (1884), 29 O. G. 171; *Ex parte Kerr* (1884), 28 O. G. 95; *Ex parte Demming* (1884), 26 O. G. 1207.

³ That a Claim for a combination "substantially as described" will be limited to the elements described as composing it, see *Hailes v. Van Wormer* (1873), 20 Wall. 353; 5 O. G. 89.

That the words "or other part" in a Claim for a combination of elements means other equivalent part and is

sufficiently certain, see *Babcock & Wilcox Co. v. Pioneer Iron Works* (1888), 43 O. G. 756.

§ 527. ¹ That a Claim for a combination does not cover its elements, see *Evans v. Kelly* (1880), 13 Fed. Rep. 903; 23 O. G. 192; 9 Bissell, 251; 5 Bann. & A. 71; *Mowry v. Whitney* (1871), 14 Wall. 620; 5 Fisher, 494; 1 O. G. 492; *Lister v. Leather* (1858), 8 E. & B. 1031.

² That a Claim for a combination of old elements does not cover any combination in which one element is new and essentially different, see *Babcock v. Judd* (1880), 17 O. G. 1351; 1 Fed. Rep. 408; 5 Bann. & A. 127.

That a Claim for such a combination of the described elements as will produce a given result covers only the combination actually stated in the Description, see *Case v. Brown* (1864), 2 Wall. 320.

That a patent for a combination of old elements cannot claim any union of one element with another except the union invented and described, see *Larabee v. Cortlan* (1851), 3 Fisher, 5; Taney, 180.

That the Claim must be limited to the arrangement described in the Claim,

elements it excludes them from the combination, though they are in fact essential to it as an operative means; and where it treats certain elements as necessary they cannot afterwards be declared by the inventor to be unnecessary, although his real invention was complete without them.³

§ 528. The Claim for a Combination may be Joined with Claims for its Elements and Sub-combinations.

The specification of a combination may contain several different Claims. Besides the Claim for the combination as a whole, each of its elements and sub-combinations, if new and patentable inventions, may be also claimed, even where they are useless except as portions of the principal invention.¹ But Claims for the same element or sub-combination, as performing functions not relating to the combination as a whole, and Claims for different combinations though composed of the same elements, cannot be inserted, unless they come within the general rules concerning the joinder of inventions.²

see *Tate v. Thomas* (1885), 30 O. G. 345; *Ex parte Marsh* (1872), 2 O. G. 107.

³ That elements omitted from the Claim are thereby excluded from the combination, see § 156, note 2, and §§ 278, 282 and notes, *ante*.

That when devices are described as useful only in combination with other devices a Claim for the former as a combination includes the latter also, see *Ex parte West* (1872), 2 O. G. 30.

That a Claim including non-essential elements makes them essential, and the patentee cannot afterwards assert that they are unnecessary, see *Van Camp v. Maryland Pavement Co.* (1888), 43 O. G. 884; *Royer v. Schultz Belting Co.* (1886), 28 Fed. Rep. 850; 38 O. G. 898; *Fay v. Cordesman* (1883), 109 U. S. 408; 25 O. G. 1277; *Le Fever v. Remington* (1882), 22 O. G. 1537; 13 Fed. Rep. 86; 21 Blatch. 80; *Coolidge v. McCone* (1874), 2 Sawyer, 571; 5 O. G. 458.

That a Claim for a combination makes essential all parts which are named as, or must be necessarily inferred to be, elements, but not parts used as connecting or moving factors alone, see *Thompson v. Gildersleeve* (1888), 43 O. G. 886.

§ 528. ¹ That the elements, if new, may be separately claimed, see *Stevens v. Pritchard* (1876), 2 Bann. & A. 390; 4 Clifford, 417; 10 O. G. 505. See also § 472 and notes, *ante*.

That the elements may be claimed, though useless out of the combination, see *Henderson v. Cleveland Co-operative Stove Co.* (1877), 12 O. G. 4; 2 Bann. & A. 604.

² That different combinations of the same elements cannot be covered by one patent, see *Ex parte Shepard* (1872), 3 O. G. 522.

That different combinations of the same elements as performing different functions, cannot be claimed in one patent, see *Pattee v. Moline Plow Co.*

§ 529. The Claim for an Art: its General Requisites.

A Claim for an art should enumerate the acts in which its essential character resides, and set them forth in such a manner as to identify them with the acts delineated in the Description. The mode of doing this is left to the discretion of the inventor, and to the peculiar nature of the process he attempts to claim. But in claiming this class of inventions there is especial danger of a departure from the terms of the Description. A Description relating to the production of an effect by the use of mechanism should conclude with a Claim for the machine only, not for the art of using it, unless its use for the purpose named is a distinct invention and has been so described.¹ On the other hand, a Description setting forth a new process, and referring to the apparatus employed in practising it merely as illustrating and explaining the new art, should be followed by a Claim for the art only, not for the apparatus so employed.² Where an effect is produced by new chemical forces, or by the new application of some natural force, the effect though new is not the proper subject of a Claim; the use of the new forces and the new use of the natural force are arts and must be so claimed.³ A Claim for

(1881), 22 O. G. 173 ; 9 Fed. Rep. 821; 10 Bissell, 377.

That each Claim must cover a complete and operative combination in the general direction of the invention, see *Ex parte* Holt (1884), 29 O. G. 171.

§ 529. ¹ That a Claim for a mechanical process, which is a mere function of the described machine, is not proper, see *Ex parte* Simonds (1888), 44 O. G. 445 ; *Case v. Hastings* (1875), 7 O. G. 557 ; *Piper v. Brown* (1870), 4 Fisher, 175 ; *Holmes*, 20.

That a Claim for a combination of mechanical elements cannot be construed to cover a process, but must be limited to the mechanical parts and equivalents, see *Grier v. Wilt* (1887), 120 U. S. 412 ; 38 O. G. 1365.

That when the functions of a machine constitute a new process, the process may be claimed though no other

machines will perform it, see *Ex parte* Wintherlich (1879), 17 O. G. 55. See also § 172 and notes, *ante*.

That a Claim for a process, consisting in the operation of a machine, is only a Claim for the machine, see *Dederick v. Cassell* (1881), 20 O. G. 1233 ; 9 Fed. Rep. 306 ; 14 Phila. 503.

See also §§ 466, 473, 474, and notes, *ante*.

² That where a new process is described but the Claim is limited to the apparatus which performs it, the patent is void unless the apparatus is also new and patentable, see *Boston Elastic Fabrics Co. v. East Hampton Rubber Thread Co.* (1874), 5 O. G. 696 ; *Holmes*, 372 ; 1 Bann. & A. 222.

³ That where the effect is obtained by the new use of natural forces, the new use should be claimed as an art, see *Piper v. Brown* (1870), 4 Fisher,

an art covers all ways of practising it, and if its elements possess equivalents, a general Claim may cover it under every form; and a specific Claim, following the particular method of performing it laid down in the Description, will cover it under the method thus described.⁴ But the Claim for a process does not embrace the product, although no other mode of producing it is yet discovered; nor does a Claim for several arts in combination protect these arts except as thus co-operating to a common end.⁵ A Claim for each step of an art may be joined with the Claim for the art itself whenever such steps are true sub-processes and are complete inventions in themselves, but not where they are incapable of use as operative means when severed from each other.⁶

§ 530. The Claim for a Machine: its General Requisites.

A machine must be claimed as a specific piece of mechanism, not as a mode of operation, a principle, an idea, a means of producing an effect, or an effect produced.¹ If the inven-

175; Holmes, 20; O'Reilly v. Morse (1853), 15 How. 62.

That where an effect is produced by chemical action the Claim should be for a process, see Piper v. Brown (1870), 4 Fisher, 175; Holmes, 20.

That a Claim for the "process of constructing" by doing certain acts is a Claim for a process, see Andrews v. Cross (1881), 8 Fed. Rep. 269; 19 Blatch. 294; 19 O. G. 1705.

⁴ That a general Claim for a process covers all ways of performing it, see Tilghman v. Proctor (1880), 102 U. S. 707; 19 O. G. 859; Bridge v. Brown (1871), Holmes, 53.

That a Claim for a process to whatever substance, known or unknown, it may be applied is too broad, see Bailey Washing & Wringing Mach. Co. v. Lincoln (1871), 4 Fisher, 379.

⁵ That a Claim for the process does not necessarily cover the product, see Goodyear v. Wait (1867), 5 Blatch. 468; 3 Fisher, 242.

That a Claim for a process does not

protect the product if the product can be made in any other way, see Goodyear v. Railroad (1853), 1 Fisher, 626; 2 Wall. Jr. 356.

That the product and process cannot be expressly embraced in one Claim, see *Ex parte* Bates (1879), 16 O. G. 266; Merrill v. Yeomans (1874), 1 Bann. & A. 47; 5 O. G. 267; Holmes, 331.

⁶ That each stage of a process, if a true sub-process, may be also covered by a separate Claim, see *Ex parte* Wilson (1879), 16 O. G. 95; *Ex parte* Smith (1879), 16 O. G. 630.

That different steps of an entirety process cannot be covered by separate Claims, see *Ex parte* Wheat (1879), 16 O. G. 360.

That a Claim for a process does not cover either the separate steps or the materials used unless they are clearly pointed out and described in the specification, see Western Electric Co. v. Ansonia Co. (1885), 114 U. S. 447; 31 O. G. 1305.

§ 530. ¹That a machine must be

tion does not embrace an entire machine, the parts invented must be clearly pointed out and claimed, and the parts not invented must not be mentioned, or if mentioned must be disclaimed.² The function of the machine must not be claimed, nor its mode of operation; though if this function constitutes a new process it is patentable as an art, and a Claim for it may be joined with those for the machine unless the general rules regarding the joinder of inventions would be thereby infringed.³ Claims for each subordinate piece of mechanism may be joined with those for the principal machine, though not capable of use in any other known connection.⁴

§ 531. The Claim for a Manufacture: its General Requisites.

A manufacture must be claimed as a new product, apart from any Claim for the process of making it or for the pur-

claimed as such, and not as a principle, a mode of operation, or an idea, see *Burr v. Duryee* (1863), 1 Wall. 531.

That an apparatus should not be claimed as a "means of doing," but as a distinct instrument, see *Ex parte Bates* (1879), 16 O. G. 266.

² That if the invention does not embrace an entire machine, the parts invented must be distinctly claimed, see *Seymour v. Osborne* (1870), 11 Wall. 516.

That the new parts must be distinctly claimed, and if claimed only in connection with other parts they are protected only in such connection, see *Graham v. Mason* (1869), 5 Fisher, 1; 4 Clifford, 88.

That a Claim for a device having certain capabilities covers only the instrumentalities by which the effect is produced, see *Anders v. Gilliland* (1880), 19 O. G. 177.

³ That in a machine patent a Claim for the "mode of operation" is void, see *Hatch v. Moffitt* (1883), 15 Fed. Rep. 252.

That when an effect, not in itself a new invention, is produced by the

operation of a machine, the Claim must be for the machine, not the process, see *Dederick v. Cassell* (1881), 20 O. G. 1233; 9 Fed. Rep. 306; 14 Phila. 503; *Piper v. Brown* (1870), 4 Fisher, 175; Holmes, 20.

That where the Description covers a process and the Claim covers only a machine, unless the machine is new the patent is void, see *Boston Elastic Fabrics Co. v. East Hampton Rubber Thread Co.* (1874), 5 O. G. 696; Holmes, 372; 1 Bann. & A. 222.

That when the functions of a machine are a new process the latter may be claimed as a process, though no other machine will perform it, see *Ex parte Wintherlich* (1879), 17 O. G. 55. See also §§ 473, 474, and notes, *ante*.

⁴ That several Claims for the same device, as accomplishing several results, may be made in the same patent, see *Ex parte Smith* (1880), 17 O. G. 271.

That each subordinate mechanism may be separately claimed, though not useful by itself, see *Wells v. Jacques* (1874), 5 O. G. 364; 1 Bann. & A. 60.

pose for which it is employed.¹ If the product is new in itself, it should be set forth in the Claim by a simple enumeration of its essential qualities, without reference to the mode in which it is produced; but where such a statement is impossible it may be defined as the product resulting from a described process, or in any other sufficient manner.² When the character of the product depends upon its method of production, it must be claimed only as produced by that specific process, and the same form of Claim must be employed when the process and the product are inseparable.³ The words "article of manufacture" have no particular significance in a Claim, and do not aid nor impair its validity.⁴ The name of the product claimed refers to it as it is delineated in the Description, not as it is in itself or may become known in the arts.⁵ A Claim for a new product resulting from the use of substances having certain described qualities does not cover a product resulting from the use of subsequently discovered substances having the

§ 531. ¹ That a new product may be claimed by itself, see *Glue Co. v. Upton* (1874), 4 Clifford, 237; 6 O. G. 837; 1 Bann. & A. 497.

That the manufacture must be claimed independently of the process, see *Ex parte Mayall* (1873), 4 O. G. 210.

That a Claim for the manufacture should not explain nor set forth the process by which it is made, see *Ex parte Shalters* (1879), 15 O. G. 970; *Ex parte Cobb* (1874), 5 O. G. 751; *Ex parte Mayall* (1873), 4 O. G. 210.

² That a product may be claimed by enumerating its qualities, and setting forth the mode of its production, in the Description and referring to these in the Claim, see *Ex parte Tweddle* (1876), 10 O. G. 747.

That a product may be claimed by describing it, and the mode of making it, and stating it to be new, see *United Nickel Co. v. Pendleton* (1883), 15 Fed. Rep. 739; 24 O. G. 704; 21 Blatch. 226.

³ That where product and process

are inseparable the product may be claimed as the result of employing the process, see *Glue Co. v. Upton* (1874), 4 Clifford, 237; 6 O. G. 837; 1 Bann. & A. 497.

That the Claim may be for the product however made, or as the result of a given process, see *Merrill v. Yeomans* (1874), 1 Bann. & A. 47; *Holmes*, 331; 5 O. G. 267.

That a Claim for a product as produced by any process which will produce a like result covers it only when made by equivalent processes, see *Pickhardt v. Packard* (1884), 22 Fed. Rep. 530; 23 Blatch. 23; 30 O. G. 179.

⁴ That the phrase "article of manufacture" has no special significance in a Claim, see *Ex parte Adams* (1873), 3 O. G. 150; *Ex parte Wattles* (1873), 3 O. G. 291.

⁵ That the name of the product claimed refers to it as described, not as it actually exists, see *Anilin v. Cummins* (1879), 4 Bann. & A. 489; *Anilin v. Hamilton Mfg. Co.* (1878), 3 Bann. & A. 235; 13 O. G. 273.

same qualities;⁶ nor is any product so embraced in the process which produces it that a Claim for the process will protect the product when produced in any other manner.⁷ Claims for a new manufacture and the means of making it, whether the means be an art or a machine, may be joined subject to the limitations of the general rules already stated.⁸

§ 532. **The Claim for a Composition of Matter: its General Requisites.**

A single composition of matter requires only a single Claim, in which the invention is set forth, like any other combination, by enumerating its elements, and stating the mode of their union, and the essential qualities of the resulting composition.¹ If such a Claim cannot be framed, whatever defines and distinguishes the composition from all others will suffice, — as where it describes the compound as the result of mixing certain ingredients in a certain manner. A Claim for a composition formed of specific known ingredients should mention each of them, and if it states no definite proportions, or mode of intermixture, those named in the Description are presumed to be referred to in the Claim.² A Claim for a chemical composition covers only the same use of the same or equivalent chemical ingredients.³ A Claim for any union of less than the whole group of ingredients employed in the production of

⁶ That a Claim for a product formed of certain described substances having certain qualities does not cover products formed of subsequently discovered substances having the same qualities, see *Goodyear v. Berry* (1868), 2 Bond, 189; 3 Fisher, 439.

⁷ That a Claim for the process does not cover the product, if it can be made in any other manner, see *Goodyear v. Wait* (1867), 5 Blatch. 468; 3 Fisher, 242; *Goodyear v. Railroad* (1853), 1 Fisher, 626; 2 Wall. Jr. 356.

⁸ That the article and the means of producing it may be separately claimed, see *Merrill v. Yeomans* (1877), 94 U. S. 568; 11 O. G. 970.

See also § 475 and notes, *ante*.

§ 532. ¹ That a composition of matter requires but a single Claim, see *Ex parte Wheat* (1879), 16 O. G. 360; *Ex parte Loeser*, (1876), 9 O. G. 837.

² That if the composition consists of well-known ingredients the Claim must enumerate them, see *Ex parte Williams* (1876), 10 O. G. 748.

That a general Claim for a composition of certain ingredients is a Claim for them in the proportions previously described, see *Loutrel v. Mellor* (1871), 1 O. G. 48; 5 Fisher, 153.

³ That a Claim for a chemical composition covers only the same use of the same or equivalent ingredients, see *Goodyear v. Berry* (1868), 2 Bond, 189; 3 Fisher, 439.

the principal composition is a Claim for a different invention, and can be inserted in the same application only when so related to the former that a joinder is permitted.⁴

§ 533. The Claim for a Design: its General Requisites.

A Claim for a design must be as distinct and specific as a Claim for any other invention, if the nature of the design will permit. Nothing beyond the configuration or ornamentation, which constitutes the invention, must be mentioned in the Claim; neither the qualities of the substance upon which the design is imposed, nor the mechanical functions which the substance may thus be enabled to perform, being any part of the design itself.¹ The Claim may consist either of a verbal description of the essential features of the design, or of such references to the drawings as indicate the lines and figures characterizing the invention.² Different designs cannot be embraced in a single Claim; and Claims for distinct designs cannot be joined unless so dependent on each other as to come within the usual rules.³

§ 534. The Claim for an Improvement: its General Requisites.

An improvement is an invention essentially distinct from the original art or instrument to which it pertains; and a Claim for an improvement must, therefore, not only define the improvement, like any other new invention, but also fully and accurately distinguish between it and the old invention.¹ In order

⁴ That a second Claim for a composition of fewer or different ingredients is a Claim for a different invention, and is improper unless the two inventions may be joined in one patent, see *Ex parte Loeser* (1876), 9 O. G. 837.

See also § 476 and notes, *ante*.

§ 533. ¹ That the Claims of a design patent should contain the phrase "as shown and described" so as to limit the patent to the exact design, see *Ex parte Gerard* (1888), 43 O. G. 1234.

That a Claim for a design must not cover a mere function, see *Ex parte Diffenderfer* (1872), 2 O. G. 57.

² That a Claim for "the configura-

tion of the design hereunto annexed when applied to carpeting" is proper, see *Dobson v. Dornan* (1886), 118 U. S. 10; 35 O. G. 750.

³ That there can be no joinder of separate designs, see *Ex parte Gerard* (1888), 43 O. G. 1240.

See also § 477 and notes, *ante*.

§ 534. ¹ That a Claim for an improvement must clearly state the exact improvement made, see *Ex parte McMurray* (1875), 8 O. G. 943; *Whittemore v. Cutter* (1813), 1 Gallison, 478; 1 Robb, 40; *Hill v. Thompson* (1818), 1 Web. 239; 1 Abb. P. C. 304.

That the Claim for an improvement

to accomplish this, such a Claim should confine itself entirely to the characteristics of the improvement made, embracing nothing which is not necessarily connected with or related to it, although the part or group of parts of which the improvement consists will not operate except in union with the original invention.² If it is requisite to the precise definition of the improvement that mention should be made of any features of the original invention, it must be apparent from the language used that these features of the original are not claimed.³ Two or more distinct improvements cannot be joined in the same Claim, though Claims for distinct improve-

must distinguish the new from the old, see *Brown v. Selby* (1871), 2 Bissell, 457 ; 4 Fisher, 363 ; *Bray v. Hartshorn* (1860), 1 Clifford, 538.

That an applicant for an improvement may be required to explicitly distinguish the old and the new, but not to acknowledge the old to be old or make any other admission, see *Ex parte Masicks* (1887), 38 O. G. 1489.

² In *Ex parte McMurray* (1875), 8 O. G. 943, Spear, Act. Com.: (943) "It is always a very difficult and delicate question to determine how subordinate Claims for an improvement in a mechanism of any considerable number of parts, or in any respect complicated, should be limited, and no exact rule can be laid down for such cases. Unquestionably, an applicant having made an improvement upon a previously existing machine may lay claim to the specific part which he has improved, or to any reasonably well-defined group of parts thus improved, even although that part or that group of parts do not alone operate to produce any beneficial result. No one is misled by any such Claim, but understands readily, even if it be not specifically stated, that the improvement is upon a specified part of the machine to which it relates. To require the applicant to specify all the parts necessary to the complete opera-

tion would be to defeat the very object for which he seeks a patent, and would be plainly against reason. But to how small a number of elements he shall reduce his Claim is not so easy to determine ; but each case must be judged in a great measure by itself, care only being taken that the Claim do not mislead."

³ That a Claim to improvements must be limited to them by express terms or fair construction, see *Troy Laundry Mach. Co. v. Bunnell* (1886), 27 Fed. Rep. 810 ; 23 Blatch. 558.

That it is not sufficient that persons skilled in the art can distinguish the improvement from the original invention, but the Claim itself must show it, see *Foxwell v. Bostock* (1864), 10 L. T. Rep. N. S. 144.

That a Claim for an improvement must be limited to the new arrangement, and cannot embrace substitutes different in character and form, merely because they perform the same functions and effect the same results, see *Dyer v. National Hod Elevating Co.* (1885), 24 Fed. Rep. 182.

That a Claim for one of a series of improvements must be restricted to the precise form and arrangement described, see *Bragg v. Fitch* (1887), 121 U. S. 478 ; 39 O. G. 829.

ments may be joined in the same application.⁴ Where several parts of the original have been improved, and such improvements can be so far treated as but one invention as to be properly included in a single Claim, the entire Claim is void if either of the alleged improvements happens to be old.⁵ A Claim for the whole invention, when the advance is only an improvement, is invalid, though limited to the invention "as improved."⁶ In construing a Claim for an improvement the original is always kept in view, and such an interpretation given to the Claim, if possible, as will protect the actual improvement made.⁷

§ 535. **The Claim for a Generic Invention: its Scope.**

Several distinct inventions often occupy toward some other invention the relation of species to a genus. A generic invention is one in which are represented the essential characteristics of a group of arts or instruments, each of which, in addition to the characteristics common to the group, possesses other specific characteristics which distinguish it from all the rest. The same invention may be generic to the individuals of its own genus, and specific in its relations to some wider invention representing the group to which itself belongs. Thus an invention consisting in the use of a class of substances for a certain purpose is generic as to an invention consisting in the use for the same purpose of some particular substance of that class; and the latter is, in its turn, generic toward an invention consisting in the use for the same purpose of some specific quality of that particular substance.¹ A patent for

⁴ See § 478 and notes, *ante*.

⁵ That when the Claim covers several associated improvements it is void if either be old, see *Heinrich v. Luther* (1855), 6 McLean, 345; *Moody v. Fiske* (1820), 2 Mason, 112; 1 Robb, 312.

⁶ That where the invention is an improvement it alone can be patented, and a Claim for the whole art or instrument is void, see *Johnston Ruffler Co. v. Avery Mach. Co.* (1886), 28 Fed. Rep. 193; *Phillips v. Page* (1860), 24 How. 164; *Woodcock v. Parker* (1813),

1 Gallison, 438; 1 Robb, 37; *contra*, *Goodyear v. Matthews* (1814), 1 Paine, 300; 1 Robb, 50. See also §§ 513 and notes, *ante*, and 537 and notes, *post*.

⁷ That if a fair interpretation shows that only the improvement is claimed the patent is valid, see *McAlpine v. Mangnall* (1846), 3 C. B. 496.

§ 535. ¹ That a patent for the use of a substance in a process is generic in relation to a patent for the use of that substance when of a certain quality, see *Slade v. Blair* (1880), 17 O. G. 261.

the genus always covers the species, and hence every subsequent inventor of a specific invention, though entitled to protection for what he has himself conceived, holds his exclusive privilege subject to the general rights of the inventor of the generic invention.² As the creation of each one of the specific inventions includes the creation of all the characteristics common to the group, the inventor of any of the species may obtain a patent covering the genus, unless some other inventor has previously conceived the same fundamental idea, and is using due diligence in reducing it to practice.³ These relations between inventions and the rights which grow out of them require attention when the Claims of patents are to be stated or construed.

§ 536. The Claim for a Generic Invention may be Joined with a Claim for One Species.

Where an invention possesses only the characteristics common to the group, it represents the genus as distinguished from the species, and its description will support only a generic Claim.¹ If in addition to these common characteristics it has special qualities of its own, it represents one species as well as the genus, and its description will support a specific as well as a generic Claim. In this case a generic Claim alone would leave the peculiar characteristics of the species unprotected; while a specific Claim alone would limit the patent to an invention having both the common qualities of

² That a patent claiming the genus covers all subsequent patents claiming only the species, see *Ex parte Ewart* (1880), 17 O. G. 448.

That a specific Claim is always subject to the generic, see *Walsh v. Shinn* (1879), 16 O. G. 1006.

That generic Claims do not cover functions and results, see *Ex parte Beavis* (1879), 16 O. G. 1233.

³ That an inventor of a species before any one else invents the genus, or any other species, may claim the genus also, see *Ex parte Gardner* (1880), 17 O. G. 626; *Ex parte Ewart* (1880), 17 O. G. 448.

That no patent with generic Claims can be granted after one with a Claim for the species, see *Ex parte Upton* (1884), 27 O. G. 99.

That a generic patent must describe one or more species, see *Ex parte Wilson* (1879), 16 O. G. 95.

§ 536. ¹ That a generic Description will support only a generic Claim, see *Ex parte McClintock* (1880), 17 O. G. 267.

That generic Claims do not cover effects, see *Ex parte Beavis* (1879), 16 O. G. 1233.

the genus and the particular qualities of the species, the genus being thus left open to the public.² The description of both genus and species will not prevent this result in the absence of a proper Claim for each; and where the description is either generic alone or specific alone the phrase "substantially as described" in the Claim confines the Claim to the generic or specific invention thus described.³ Where the common characteristics of the genus constitute an operative means the genus and each one of its species are distinct inventions, and every member of the group is also an invention by itself, apart from and independent of the others.⁴ The joinder of Claims for two or more of these must depend on their connection with each other under the usual rules upon that subject; though where the same invention represents the genus and one species, both a generic and a specific Claim may be inserted. That several species are described as embraced under the genus does not extend this power of joinder, nor does the statement in the Description that one of two described species is the best deprive the inventor of the right to claim the other and leave that unclaimed.⁵

² That no specific Claim can be made unless the species is described, see *Ex parte McClintock* (1880), 17 O. G. 267.

That a Claim for a species limits the patent to that species, though the Description covers a generic invention, see *Hawes v. Gage* (1871), 5 O. G. 494.

³ That when the Description is specific the Claim for the invention "substantially as described" covers the species only, see *Ex parte Ewart* (1880), 17 O. G. 448.

⁴ That a genus and each of its species are distinct inventions, see *Ex parte McClintock* (1880), 17 O. G. 267.

⁵ In *Ex parte Ewart* (1880), 17 O. G. 448, Paine, Com.: (449) "While two species can be set forth by way of illustration in one Description, they cannot both be set forth either in separate specific Claims in one patent or in one specific Claim; nor can both or either

of them be set forth in a generic Claim. Both cannot appear in separate specific Claims in one patent, for that would admit two distinct and independent inventions into one patent. Both cannot appear in one Claim, for that would make the Claim as well as the patent double. One cannot be so shown in a generic Claim, for that would transform it into a specific Claim. Both cannot appear in a generic Claim, for they would make the Claim double as well as specific. A Claim cannot be framed to cover generically several specific inventions by merely aggregating specific Claims for those inventions. Its terms must be broad enough to cover both without specifically claiming either, and yet not broad enough to trench upon any distinct genus."

See also *Ex parte McClintock* (1880), 17 O. G. 267; *Ex parte Morrison* (1879), 16 O. G. 359.

That when the steps of an entirety

§ 537. **The Claim, when Defective.**

A Claim is defective when it fails to define the real invention with sufficient completeness and precision, or when it claims more than belongs to the invention. In the former case the discovery of the inventor is not properly protected.¹ In the latter case the Claim is absolutely void.² Both these defects may be, however, remedied by a re-issue, and the latter one is also curable by a disclaimer.³ When several Claims are inserted in the specification, the presence of a void Claim does not affect those which are good, unless there is an evident intention to mislead the public or an unreasonable delay in filing a disclaimer.⁴

process have equivalents, a generic Claim may cover it under any form, and a specific Claim may cover the specific form, see *Ex parte McDougall* (1880), 18 O. G. 130.

That several devices constructed on the same principle may be described in one application and covered by one generic Claim, but only one device can be specifically claimed, see *Ex parte Howland* (1877), 12 O. G. 889.

That the designation of one of two species as the best does not debar the patentee from claiming the other, see *Ex parte McClintock* (1880), 17 O. G. 267. See also § 471, note 4, *ante*.

§ 537. ¹ That the Claim may be valid for what it claims, though it does not claim the full invention, see *Wilson v. Coon* (1880), 19 O. G. 482; 6 Fed. Rep. 611; 18 Blatch. 532; and § 508, note 2, *ante*.

² That a Claim exceeding the limits of the actual invention is void, see *Milligan v. Lalancé & Grosjean Mfg. Co.* (1884), 29 O. G. 367; 21 Fed. Rep. 570; *Scott v. Ford* (1878), 14 O. G. 413; *Winans v. N. Y. & Erie R. R. Co.* (1856), 1 Fisher, 213; *Heinrich v. Luther* (1855), 6 McLean, 345; *Holliday v. Rheem* (1852), 18 Pa. St. 465; *Davis v. Bell* (1837), 8 N. H. 500; *Whitney v. Emmett* (1831), Baldwin,

303; 1 Robb, 567; *Watson v. Bladen* (1826), 4 Wash. 580; 1 Robb, 510; *Kneass v. Schuylkill Bank* (1820), 4 Wash. 9; 1 Robb, 303.

³ That an excessive Claim is curable by re-issue or disclaimer, see *Silsby v. Footo* (1857), 20 How. 378; *Hovey v. Stevens* (1846), 3 W. & M. 17; 2 Robb, 567; *Peterson v. Wooden* (1843), 3 McLean, 248; 2 Robb, 116; *Stanley v. Whipple* (1839), 2 McLean, 35; 2 Robb, 1. See also §§ 642-646 and notes, *post*.

That an incomplete or inexact Claim may be cured by re-issue, see §§ 656, note 3, 668, notes 5 and 6, and 693 and notes, *post*.

That a disclaimer in a pending application must not contradict but explain and limit the Claim, see *Ex parte Hobson* (1872), 1 O. G. 141.

⁴ That the presence of void Claims in a patent does not impair the effect of good Claims, see *Tyler v. Galloway* (1882), 22 O. G. 2072; 12 Fed. Rep. 567; 20 Blatch. 445; *Christman v. Rumsey* (1879), 58 How. Pr. 114; 17 Blatch. 148; 17 O. G. 903; 4 Bann. & A. 506; *Burdett v. Estey* (1878), 15 O. G. 877; 15 Blatch. 349; *Russell v. Place* (1876), 94 U. S. 606; 12 O. G. 53; *Carlton v. Bokee* (1873), 17 Wall. 463; 2 O. G. 520; 6 Fisher, 40; *Ca-hart v. Austin* (1865), 2 Fisher, 543;

§ 538. The Claim, as Corrected or Allowed in the Patent Office, Determines the Validity and Scope of the Patent.

It is the duty of the Patent Office to secure the correct statement of the Claims before it allows the issue of a patent.¹ That the courts might sustain a defective Claim, in order to prevent the defeat of a granted patent, is no reason for permitting such a Claim to pass the scrutiny of the department.² The Claim is to define what the Patent Office, after due examination, has ascertained to be the real discovery of the inventor, and it must be amended or withdrawn according to the judgment of the officers to whom this duty is committed. Once settled in its terms by their decision, the courts will not disturb it, either by interfering with its language or by narrowing or enlarging it by construction.³

§ 539. The Specification: its Signature: Erasures and Corrections.

The specification must be signed by the inventor, or by his executor or administrator, and the signature must be attested

² Clifford, 528; *Singer v. Walmsley* (1860), 1 Fisher, 558.

That void Claims may be disclaimed, see *Tyler v. Galloway* (1882), 22 O. G. 2072; 12 Fed. Rep. 567; 20 Blatch. 445.

That where of two Claims one is too broad under one interpretation, and under another is a mere repetition of a former Claim, it is void and must be disclaimed, see *Tyler v. Galloway* (1882), 22 O. G. 2072; 12 Fed. Rep. 567; 20 Blatch. 445.

That unreasonable delay in disclaiming void Claims will vitiate the entire patent, see *McCormick v. Seymour* (1854), 3 Blatch. 209; *Hall v. Wiles* (1851), 2 Blatch. 194; and notes to § 646, *post*.

§ 538. ¹ That it is the duty of the Patent Office to see that Claims are correct, see *Keystone Bridge Co. v. Phoenix Iron Co.* (1877), 95 U. S. 274; 12 O. G. 980.

² That the courts may sustain Claims which the Patent Office ought not to allow, see *Ex parte Cornell* (1872), 1 O. G. 573.

That though the courts may sustain defective Claims the Patent Office has no right to permit them, see *Ex parte McDougall* (1880), 18 O. G. 130.

³ In *Burns v. Meyer* (1879), 100 U. S. 671, Bradley J. : (672) "It is well known that the terms of the Claim in letters-patent are carefully scrutinized in the Patent Office. Over this part of the specification the chief contest generally arises. It defines what the Office, after a full examination of previous inventions and the state of the art, determines the applicant is entitled to. The courts, therefore, should be careful not to enlarge, by construction, the Claim which the Patent Office has admitted, and which the patentee has acquiesced in, beyond the fair interpretation of its terms."

See also §§ 738-743 and notes, *post*.

That a Claim cannot be dissected and accepted or rejected piecemeal, but must stand or fall together, see *Ex parte Smith* (1872), 1 O. G. 403.

by two witnesses, each signing his full name, legibly written.¹ The Description and Claims, and all amendments thereof, must be written in a clear and readable hand on one side of the paper only; and all interlineations and erasures must be marked in marginal or foot notes written on the same sheet of paper, for which purpose a wide margin should be reserved on the left-hand side of the page. Legal-cap paper, with the lines numbered, is recommended by the Office.

SECTION VII.

OF THE APPLICATION: THE DRAWINGS AND MODEL.

§ 540. Drawings, Model, and Specimens: when Required.

In order to secure still greater accuracy and completeness in the description of that art or instrument for which the inventor claims the protection of a patent, the law requires him to furnish drawings, and a model or specimens, illustrating its distinctive characteristics, whenever in the judgment of the Patent Office the case demands them. The requirement of the statute in reference to drawings is positive, and the applicant must file them if the nature of the invention permits.¹ Those in reference to the model and specimens are conditional upon the order of the Commissioner, and the applicant is not obliged to furnish them unless especially directed. But as the question whether the nature of the case admits of drawings is finally determined by the Commissioner, and his decision as to their sufficiency, as well as that of the specimens or model, is conclusive,² the practical difference in this respect between these several requirements is insignificant, affecting merely the order of proceedings in the Office.

§ 539. ¹ That the applicant must sign his first name in full, see *Ex parte Gentry* (1888), 44 O. G. 822.

§ 540. ¹ That a drawing must be filed whenever the nature of the invention permits, see *Ex parte Chase* (1879), 16 O. G. 809.

² That the decision of the Commissioner that drawings were duly presented is final except on proceedings to avoid the patent, see *Hoe v. Cottrell* (1880), 17 Blatch. 546; 18 O. G. 59; 1 Fed. Rep. 597; 5 Bann. & A. 256.

See also § 423 and notes, *ante*.

§ 541. Drawings must Correspond with Specification.

The drawings filed must correspond with the specification in all the essential characteristics of the invention.¹ They are but another method of portraying the same art or instrument therein described in words, and a discrepancy between the two delineations may give rise to such an ambiguity in the entire description as renders the patent void.² They are connected with the specification by means of figures affixed to each drawing, and letters or figures affixed to each of its several parts, and so referred to in the language of the Description and the Claim that the verbal and pictorial representations will serve to illustrate and explain each other.³

§ 542. Drawings to be so Clear and Full as to Supply the Place of a Model.

The drawings filed must be so full and clear that, if the invention is a simple one, no model will be needed.¹ The model, being retained in the Patent Office after the patent issues, is inaccessible to the public without recourse to the place of its deposit. The drawings, on the contrary, through the copies annexed to the patent, and published in the "Gazette," or supplied on application by the Office, circulate in every direction and are open to inspection by all persons interested in the art to which the invention may belong. In pursuance of its duty to disseminate in the widest degree immediate information concerning all inventions, the Patent

§ 541. ¹ That the drawings must correspond in all essential points with the specification, see *Ex parte Witty* (1884), 29 O. G. 862; *Ex parte Schoonmaker* (1878), 13 O. G. 595.

That the drawings must show every feature claimed, see *Ex parte Crandall* (1886), 35 O. G. 625.

² That the drawings may show the invention where the specification fails to do so, see *Banker v. Bostwick* (1880), 18 O. G. 61.

That all patentable matter shown in the specification, drawings, or model is covered by the application, see

Singer v. Braunsdorf (1870), 7 Blatch. 521.

That an imperfect description coupled with incomplete drawings make the patent void, see *New Process Fermentation Co. v. Koch* (1884), 29 O. G. 535; 21 Fed. Rep. 580.

³ That under the act of 1793, the drawings need not have been referred to in the specification, see *Emerson v. Hogg* (1845), 2 Blatch. 1.

§ 542. ¹ That in simple inventions the drawings must be sufficient to supply the place of a model, see *Ex parte Jovè* (1880), 17 O. G. 801.

Office properly requires that the drawings shall, as far as possible, supply the place of a model; and this in simple inventions, with the present facilities for pictorial representation, they are fully competent to do. In complicated structures, incapable of complete perspective reproduction on a plane surface, a model becomes necessary.

§ 543. Drawings: General Requisites in each Class of Inventions.

The drawings must exhibit every feature of the invention covered by the Claims; otherwise the language of the specification would set forth a different art or instrument from that depicted in the drawings, resulting in an ambiguity which might be fatal to the patent. In the drawings which accompany the specification for an art, every stage or sub-process capable of illustration by a drawing must be shown; but the different steps of a sub-process do not require such delineation.¹ In a machine or manufacture, the drawing must disclose all the essential parts in their proper places, as they would appear in the practically operative instrument.² The drawings of an improvement must exhibit, in one or more views, the improvement itself disconnected from the old structure, and also in another view so much only of the old structure as will suffice to show the connection of the improvement therewith.³ A design must be shown by a drawing or a photograph, in which all the distinctive characteristics of the new configuration or ornamentation are depicted. But while the drawings must thus present every feature of the claimed invention to the eye, they need not be working-drawings nor on an operative scale.⁴ They are not intended as a guide to the

§ 543. ¹ That in an application covering an art every claimed stage or sub-process must, if possible, be illustrated by drawings, but not the several steps of each sub-process, see *Ex parte Carter* (1879), 16 O. G. 809.

² That a drawing must accompany an application covering an article of manufacture, see *Ex parte Chase* (1879), 16 O. G. 809.

³ That in a patent covering an improvement in machinery, drawings of

the improvement are necessary, see *Burrall v. Jewett* (1830), 2 Paige (N. Y.), 134.

That in an application covering an improvement, the improvement must be shown by a model and drawings, but not the original when it is well known to the public or its description is accessible, see *Ex parte Tracy* (1875), 8 O. G. 144.

⁴ That the drawings need not be working-drawings nor on an operative scale, see *American Hide & Leather*

mechanic in constructing the invention further than that, in connection with the written specification, they put him in possession of such knowledge of the essential attributes of the invention that through his own skill in the art he can practically create it and employ it.

§ 544. Drawings: Special Rules Governing their Artistic Perfection.

To render the drawings suitable for the various uses of the Patent Office they are required to attain, in their execution, to a uniform standard of excellence; and for this purpose they must conform to certain rules from time to time prescribed by the department. These rules relate chiefly to the size, materials, arrangement, and lettering of the several views given of the invention, and may be found stated at length in the published regulations of the Office. These rules are rigorously enforced, since unless it conforms to them a drawing is practically worthless; and until complied with by the applicant his case will not receive consideration. The drawing must be signed, like the specification, by the inventor or his attorney in fact, and attested by two witnesses;¹ their full names being given and legibly written.

§ 545. Model not Filed until Ordered by the Patent Office.

A model is not required until an examination of the application in the Patent Office shows it to be necessary to the full disclosure of the essential characteristics of the invention. When thus required, notice to that effect is sent to the applicant and proceedings on his application are suspended until it is furnished. A model filed, when not required, is returned to the inventor. No model of a design is requisite where it can be sufficiently represented by photographs or drawings.

§ 546. Model: its General Requisites.

A model must clearly exhibit every feature of the invention which forms the subject of a Claim, but should not include

Splitting & Dressing Mach. Co. v. American Tool & Mach. Co. (1870), 4 Fisher, 284; Holmes, 503. the act of 1836, could be signed either by the inventor or his authorized agent, see Opinion Atty. Gen. (1859), 9 Op.

§ 544. ¹ That the drawings, under At. Gen. 378.

any other matter than that covered by the actual invention, unless it be necessary to the representation of the invention in a working model.¹ A working model is often desirable in order to enable the examiner to understand the precise operation of the new invention. The model must be neatly and substantially made of durable material, metal being preferred, unless the material is an essential feature of the invention, in which case the model must, of course, conform to this as well as to the other characteristic attributes of the idea of means. The size and finish of the model, with various other minor requisites, must correspond with the regulations from time to time established by the Patent Office, by whose decision the sufficiency of the model is conclusively determined.²

§ 547. Model: its Final Disposition.

When an application is rejected in the Patent Office, and more than two years have elapsed since such rejection, the model will be returned to the applicant upon demand, at his expense, unless it is deemed necessary to preserve it in the Office. When an applicant formally abandons a pending application and files a certificate to that effect, duly signed by him, the model will be restored. Where a patent is granted, the model remains permanently in the Patent Office, and cannot be removed therefrom except in the custody of some sworn employee of the Office, authorized for that purpose by the Commissioner.

§ 548. Model: its Relation to other Parts of the Application.

The filing of a model does not constitute the filing of an application, nor is it any evidence that the application is complete.¹ Each portion of the application must be judged by

§ 546. ¹ That the model must correspond with the specification and drawings in all essential particulars, see *Ex parte* Schoonmaker (1878), 13 O. G. 595.

That the model must clearly show every feature claimed, see *Ex parte* Crandall (1886), 35 O. G. 625.

² That the decision of the Commissioner that the model was duly pre-

sented is conclusive except on proceedings to set the patent aside, see *Hoe v. Cottrell* (1880), 17 Blatch. 546; 18 O. G. 59; 1 Fed. Rep. 597; 5 Bann. & A. 256.

§ 548. ¹ That the filing of a model is not the filing of an application, see *Henry v. Francetown Soapstone Stove Co.* (1880), 17 O. G. 569; 5 Bann. & A. 108; 2 Fed. Rep. 78; *Draper v. Wat-*

itself so far as regards its correspondence with established rules, although on questions of interpretation the entire application is considered. A sufficient model does not validate an imperfect Description nor an improper Claim, nor supply the place of an accurate drawing. Only when the complete application is presented to the Patent Office, with every part perfect in itself, has the applicant any standing before the department or any right to have his application duly examined and adjudged.

§ 549. Specimens, instead of Drawings or Model, Required in Applications Covering Compositions of Matter.

A composition of matter not being capable of representation by drawings or model, the law requires the applicant to forward to the Patent Office, on the request of the Commissioner, such specimens of the ingredients and of the composition as will be sufficient for the purpose of experimentally showing the essential features of the invention.¹ In all cases where the article is not perishable, a specimen of the composition claimed, put up in proper form to be preserved by the Office, must be furnished.

SECTION VIII.

OF THE APPLICATION: FILING AND FEES.

§ 550. Filing of Application the Commencement of Proceedings to Obtain a Patent.

The act by which the attention of the Patent Office is directed to the claims of the inventor, and his right to an examination of those claims is secured, is the filing of the application with the Commissioner of Patents. This may be

ties (1878), 16 O. G. 629 ; 3 Bann. & A. 618.

That the filing of a model does not show that the application is complete, see *Draper v. Wattles* (1878), 16 O. G. 629 ; 3 Bann. & A. 618.

§ 549. ¹ That whether specimens of

ingredients shall be filed with an application is for the Patent Office to decide, see *Anilin v. Cochrane* (1879), 16 Blatch. 155 ; 4 Bann. & A. 215 ; *Tarr v. Folsom* (1874), Holmes, 312 ; 5 O. G. 92 ; 1 Bann. & A. 24.

done at any time after the invention is completed, provided no abandonment has taken place;¹ but until it is done the Office can take no notice of the invention further than to allow the inventor access to its library, records, and models, and to supply him with such copies of them as he may desire.

§ 551. **Filing of Application: in What it Consists.**

An application is filed when the petition, oath, and specification are presented in writing to the Commissioner, accompanied by such drawings as the nature of the case admits, and by such model or specimens as the Commissioner may himself require.¹ Neither the filing of a model, nor the writing of an application, nor the placing of the case in the hands of an attorney with instructions to apply for a patent, constitutes the filing of an application.² Nor is an application filed until all its parts have been received. It is desirable that these should be presented at the same time, and that all the papers embraced in the application should be attached together. If this is not done, each part must be accompanied by a letter accurately and clearly connecting it with the parts previously forwarded. An application not completed by the presentation of all its parts within two years from the lodgment

§ 550. ¹ That the application may be filed at any time after the invention is completed, unless it has been abandoned, see *Shaw v. Cooper* (1833), 7 Peters, 292; 1 Robb, 643.

See also § 351 and notes, *ante*.

§ 551. ¹ That the application is filed when presented to the Commissioner, see *Henry v. Francestown Soapstone Stove Co.* (1880), 5 Bann. & A. 108; 17 O. G. 569; 2 Fed. Rep. 78; *Graham v. McCormick* (1880), 5 Bann. & A. 244; 10 Bissell, 39; 21 O. G. 1533; 11 Fed. Rep. 859.

² That filing a model is not filing an application, see *Henry v. Francestown Soapstone Stove Co.* (1880), 5 Bann. & A. 108; 17 O. G. 569; 2 Fed. Rep. 78; *Draper v. Wattles* (1878), 16 O. G. 629; 3 Bann. & A. 618.

That writing an application is not

filing it, see *Henry v. Francestown Soapstone Stove Co.* (1880), 5 Bann. & A. 108; 17 O. G. 569; 2 Fed. Rep. 78.

That placing the invention in the hands of solicitors to have an application filed is not filing it, see *Graham v. McCormick* (1880), 10 Bissell, 39; 11 Fed. Rep. 859; 21 O. G. 1533; 5 Bann. & A. 244.

That to sign a blank application and forward it to solicitors to be filled out and filed, and their filing it is not such filing as the law requires, see *Ex parte Benton* (1882), 23 O. G. 341.

That the decision of the Commissioner that the application is properly filed cannot be collaterally attacked, see *Hoe v. Cottrell* (1880), 18 O. G. 59; 17 Blatch. 546; 1 Fed. Rep. 597; 5 Bann. & A. 256.

See also § 423 and notes, *ante*.

of the petition in the Patent Office is regarded as abandoned, unless the delay is shown to have been unavoidable.³

§ 552. Application, once Filed, thereafter Known by Date and Number.

When all the required parts of an application have been thus presented, it is placed on file for examination and a serial number given it, notice of which is sent to the applicant. Thenceforth the application is known both to the Office and to the inventor by its number, as well as by the title of the invention, and in all his correspondence with the Office concerning it, the inventor or his attorney must define the subject-matter of his communication by stating the name of the applicant, the title of the invention, the serial number of the application, and the date when it was filed.

§ 553. Application, once Filed, not Withdrawn: Preserved in Secrecy.

After an application is completed, the specification cannot be withdrawn from the Patent Office for any purpose whatever, though the model or the drawing may be returned to the applicant for such corrections as are deemed necessary. A copy of the specification may, however, be obtained by the inventor or his attorney. From all other persons outside of the department every part of the application is preserved in secrecy,¹ and no information is given concerning it to any one without due authority from the inventor, except in interference cases, or when the application has been rejected or

³ That under the act of 1861 (Sec. 4894, Rev. Stat.), providing that all applications must be completed within two years unless the Commissioner is satisfied that the delay is unavoidable, if the application is delayed longer than two years and is then allowed, the decision of the Commissioner in allowing it is conclusive on the question of the reasonableness of the delay, see *McMillin v. Barclay* (1872), 5 Fisher, 189; 4 Brews. (Pa.) 275. See also § 578 and notes, *post*.

That an invention is not abandoned while the application lies unfiled in the hands of the attorney, unless the inventor knows of the neglect, see *Birdsall v. McDonald* (1874), 1 Bann. & A. 165; 6 O. G. 682.

§ 553. ¹ That pending applications must be kept secret, see *Ex parte Neale* (1879), 15 O. G. 511.

That the rule requiring secrecy is reasonable and should be enforced, see *Dec. Sec. Int.* (1883), 23 O. G. 629.

abandoned, and in the judgment of the Commissioner its disclosure may be necessary.

§ 554. Payment of Fees.

The payment of the fees required by law is made by statute a condition of the issue of the patent, and the rules of the Patent Office prescribe their payment in advance, though when a patent issues before compliance with this requisite, it is not on that account invalid.¹ The fees may be paid to the Commissioner, or to the Treasurer or an Assistant Treasurer of the United States, or to any of the depositaries, national banks, or receivers of public money designated by the Secretary of the Treasury for that purpose, whose receipt, transmitted to the Patent Office, will be accepted as sufficient evidence of payment. Payment may also be made by postal order, or by money mailed to the Department. Money paid by mistake, or in excess of the required amount, will be refunded.

SECTION IX.

OF THE APPLICATION: PROCEDURE IN THE PATENT OFFICE IN UNCONTESTED CASES.

§ 555. Examination of Application: Objections to its Form.

All cases in the Patent Office are divided into certain classes for the purpose of examination and decision; those in the same class being examined and disposed of as far as practicable in the order in which the respective applications are completed, unless the invention is deemed of peculiar importance to some branch of the public service, and the head of a department of the government requests immediate attention to it upon that account. On the receipt of any application in the Office, and the payment of the fee, it is assigned to its proper class, and when its turn arrives is first subjected to an examination to determine whether it is in all respects in proper

¹ That a patent issued without payment of the fees is valid, see *Crompton v. Belknap Mills* (1869), 3 Fisher, 536.

form.¹ If found to be formally sufficient, an examination into the merits of the application, and the patentability of the invention therein claimed, is instituted. But if decided to be insufficient the applicant is notified of the defect, and such information is given to him as will enable him to judge of the propriety of the decision, and if possible to correct his error.² Upon this notice he may either supply the alleged defect, or he may insist upon the sufficiency of the application and file a written request for a reconsideration, distinctly and specifically pointing out the errors in the finding of the examiner. From an adverse decision of the examiner, after such reconsideration, the applicant may appeal to the Commissioner in person. Where the faults in the form of the application are not vital the examiner may, if he chooses, withhold the announcement of his decision upon those points, and proceed to consider the application on its merits;³ but must then, in

§ 555. ¹ That the examiner may insist on having the specification correspond with the forms given in the rules, if he does so when the application is first filed, see *Ex parte* Bate (1879), 15 O. G. 1012.

That an examiner ought not to allow cases when the papers are defective, whether the defect is mentioned in the rules or not, see *Ex parte* Benton (1882), 23 O. G. 341.

That where there is a vital defect of form, such as the omission of an element, etc., the application cannot be examined on its merits, see *Ex parte* Mill (1887), 40 O. G. 918; *Ex parte* Silliman (1886), 34 O. G. 1389.

² That the Patent Office must act as the friend, not the adversary, of an applicant, and its examiners must aid him to secure his actual invention, see *Ex parte* Donovan (1888), 44 O. G. 698.

That the objections of examiners must be definitely stated to the applicant and the mode of avoiding them be pointed out, see *Ex parte* Wilkins (1883), 24 O. G. 1270.

That for an examiner to say that the

defects are shown by "pencil notes" in the specification is not sufficient, see *Ex parte* Wilkins (1883), 24 O. G. 1270; *Ex parte* Evarts (1874), 5 O. G. 429.

That an applicant may insist on an examination of his application on its merits, in spite of defects in its form, unless the examiner gives him such information as will enable him to remove the defects, see *Ex parte* Templeton (1880), 17 O. G. 910.

³ That the examination of an application on its merits is not conclusive on the Patent Office as to its correctness of form, see *Ex parte* Farquharson (1876), 10 O. G. 702.

That where a design patent is applied for when a mechanical patent alone is proper, the examiner, if the case is clear, should hold the application and notify the applicant; but if the case, being doubtful, is examined and rejected, a new application must be filed and a new fee paid, see *Ex parte* Bailey (1886), 37 O. G. 781.

That an application for a design patent should be rejected if the examiner

his first letter to the applicant, state all his formal objections with their reasons, and until these are disposed of no judgment can be passed upon the merits, without an order of the Commissioner.⁴

§ 556. Objections on the Ground of Misjoinder: Division of the Application.

When a single application embraces several independent inventions in violation of the rules regarding the joinder of inventions, the applicant will be required to limit his present application to some one of them, and may then file separate applications for the others.¹ If the independence of the inventions is clear on the face of the application, this division must be ordered before any examination on the merits; if not clear, the division may be required at any time when its necessity becomes evident before final action.² Whether a division shall be made rests entirely within the judgment of the Patent Office,³ but none should be ordered unless each of the alleged

considers that the subject-matter is not a design, and from such rejection an appeal lies to the Board of Examiners, see *Ex parte Harris* (1886), 38 O. G. 104.

⁴ That the first letter of the examiner must advise the applicant of all formal requirements, cite all references, and instruct him that action on the merits is postponed until the objections are removed, see *Ex parte Mill* (1887), 40 O. G. 918; *Ex parte Silliman* (1886), 34 O. G. 1389.

That all formal matters must be settled before any Claim is rejected on the merits, and no rejection on the merits should be made in terms until all formal questions are determined, see *Ex parte Mill* (1887), 40 O. G. 918; *Ex parte Silliman* (1886), 34 O. G. 1389.

§ 556. ¹ That where separate and independent inventions are embraced in one application, it must be divided, see *Ex parte Mill* (1887), 40 O. G. 918; *Ex parte Young* (1885), 33 O. G. 1390; *Ex parte Martin* (1883), 25 O. G. 502; *Ex parte Preston* (1880), 17 O. G. 853;

Ex parte Siemens (1877), 11 O. G. 969.

See also §§ 468-479 and notes, *ante*.

That if a combination does not cooperate a division between the elements is necessary, see *Ex parte Herr* (1887), 41 O. G. 463.

That a division must be ordered when two independent inventions are covered, whether the divided inventions would come under any Office class or not, see *Ex parte Martin* (1883), 25 O. G. 502.

² That if an application is to be divided, it should be done before an examination on the merits, see *Ex parte Silliman* (1886), 34 O. G. 1389; *Ex parte Young* (1885), 33 O. G. 1390; *Ex parte Rice* (1874), 5 O. G. 522.

That division should not be ordered without sufficient examination to show its necessity, see *Ex parte Sanders* (1878), 13 O. G. 818.

³ That whether a division is necessary is a question for the Patent Office alone, see *Ex parte Herr* (1887), 41

independent inventions would be a proper subject-matter for a separate patent;⁴ and the examiner, in communicating the order to the applicant, must clearly point out to him the nature and extent of the required division, to enable him to file such separate applications if he so desires.⁵ The division is effected by an amendment of the original application, confining its Claims, and so far as practicable its Description, to a single invention, and the filing of such additional applications for the other inventions as may be deemed advisable.⁶ These additional applications are so far independent of the original that each must be attested by a new oath, and possess all the other prerequisites of a complete application;⁷ but

O. G. 463; *McKay v. Dibert* (1881), 5 Fed. Rep. 587; 19 O. G. 1351; *Ex parte Murray* (1873), 3 O. G. 659.

See also § 469 and note 2, *ante*.

That the Patent Office requires a division not merely for its own sake but in order that the patent may be valid, see *Ex parte Van Matteson* (1883), 24 O. G. 389.

⁴ That no division can be required unless each invention would be separately patentable, see *Ex parte Pintsch* (1877), 11 O. G. 597.

That in dividing applications the distinction between separable inventions must be regarded, not the mere distinctions between words, see *Ex parte Holt* (1884), 29 O. G. 171.

That where the Claims of two divisions must overlap each other the division is improper, see *Ex parte Holt* (1884), 29 O. G. 171.

That no division can be ordered where the process and product are inseparable, see *Ex parte Holt* (1884), 29 O. G. 171. See also § 473 and note 3, *ante*.

That divisions between parts of the same machine must not cover the same ground, see *Ex parte Holt* (1884), 29 O. G. 171.

That a divisional application cannot be based on new matter added to the

original after filing, see *Ex parte Buell* (1884), 26 O. G. 437.

⁵ That in notifying the applicant to divide his application, the examiner must point out clearly the nature and extent of such division, see *Ex parte Knott* (1875), 8 O. G. 238.

That in ordering a division between a process and a product on the ground that the product can be produced by other processes, such other processes must be pointed out by the examiner, see *Ex parte Pastor* (1887), 42 O. G. 95.

⁶ That where a division is ordered and matter is eliminated from the specification it must be removed from the drawings also unless necessary to the comprehension of what remains, see *Ex parte Simonds* (1888), 44 O. G. 449.

That where a division is required an amendment which simply reduces the number of the inventions, without removing the objections raised, should not be received, and if admitted only limits the right of the applicant to elect what inventions shall be covered by the application, see *Ex parte Maxim* (1888), 43 O. G. 506.

⁷ That each additional application for the divided inventions must be supported by a new oath and possess the

when the patents are allowed, the date of the original application is regarded as the date of all the others, in reference to the questions of priority and public use, in order that the rights of the inventor to his entire invention, as first applied for, may be fully preserved.⁸ Where all the inventions so divided relate to the same general subject-matter, and each of the applications thus describes the whole though claiming but a single part, each should disclaim all other portions, with proper references to the applications in which they are claimed.⁹

§ 557. **Model and Specimens Ordered when Found Necessary.**

No preliminary examination of the application is made in the Patent Office to ascertain whether or not a model will be necessary. The application, if complete in other respects, is subjected to an examination on its merits, and if in the course of this examination it appears to the examiner that a model will be useful, an order to furnish one is sent to the applicant, and proceedings are suspended until the order is obeyed. The same rule applies to specimens of a composition and of its ingredients.

other requisites of an independent application, see *Ex parte Tieman* (1877), 11 O. G. 1; *Ex parte Heginbotham* (1875), 8 O. G. 237.

That where an application is filed as a division of a former application, the first duty of the examiner is to see whether it is a legal continuation of the other, see *Ex parte Buell* (1884), 26 O. G. 437.

⁸ That where several divisions represent different parts of the same whole, to which all the parts are necessary, all the divisions should be pending at one and the same time, see *Ex parte Holt* (1884), 29 O. G. 171.

That all the divided applications bear the date of the original, see *Graham v. Geneva Lake Crawford Mfg. Co.* (1880), 11 Fed. Rep. 138; 21 O. G. 1536; *Graham v. McCormick* (1880), 11 Fed. Rep. 859; 10 Bissell, 39; 21 O. G. 1533; 5 Bann. & A. 244.

⁹ That all divisional applications

must disclaim what they do not claim, see *Ex parte Clarke* (1884), 26 O. G. 824.

That the rules requiring cross-disclaimers in two pending applications for the same general invention re strictly enforced, see *Drawbaugh v. Blake* (1883), 23 O. G. 1221.

That the rules requiring disclaimers in pending applications are directory only, and the issue of one patent is no bar to a second unless the matter is inseparable, see *Ex parte Roberts* (1887), 40 O. G. 573.

That where an application is once divided, the separated matter can never be re-instated, see *Ex parte Preston* (1880), 17 O. G. 853.

That no election binding on the applicant is made until he has complied with the order for a division and his action has been accepted by the Office, see *Ex parte Maxim* (1888), 43 O. G. 506.

§ 558. Examination of Application on its Merits: Two Questions Involved: their Decision.

When an application is complete in form it is entitled to an examination on its merits. This examination consists in an inquiry into the legal right of the applicant to a patent for the invention described and claimed in the application. It involves two questions: (1) Whether the subject-matter of the application is, in itself, a patentable invention; (2) Whether the applicant or his decedent was its true and first inventor. In uncontested cases the latter question is answered affirmatively by the oath of the applicant, and requires no further investigation unless the examiner has some knowledge to the contrary.¹ The former question is divisible into five subordinate ones: (1) Whether the subject-matter of the application is the result of a true and complete inventive act; (2) Whether it is embraced in either one of the six classes of inventions which are made patentable by the act of Congress; (3) Whether it is new, or, on the contrary, has been known or used in this country, or patented or published at home or abroad, before the date of the present application; (4) Whether it is useful; (5) Whether it has been abandoned to the public. In making this investigation the examiner is not compelled to observe the strict rules of evidence, but must ascertain, as best he can, from the publications, patents, and general knowledge at his command, whether the application should be rejected or allowed.² He is not bound by any conclusions of his predecessors, though he must follow the deci-

§ 558. ¹ That the application-oath is *prima facie* proof of the applicant's priority, see *Ex parte Hill* (1879), 16 O. G. 765.

See also § 457 and notes, *ante*.

² That the rules of evidence do not apply to uncontested cases, see *Hedges v. Daniels* (1880), 17 O. G. 394.

That the examiner must ascertain, as best he can, whether the invention is patentable, see *Hedges v. Daniels* (1880), 17 O. G. 394.

That the identity of two designs must be decided from inspection by the

experts in the Office, see *Ex parte Gerard* (1888), 43 O. G. 1235.

That matters of public notoriety, affecting the right of the applicant to a patent will be taken notice of, see *Anson v. Woodbury* (1877), 12 O. G. 1.

That if the examiner sees that the invention is impracticable he should reject the application for want of utility, see *Ex parte De Bausset* (1888), 43 O. G. 1583.

That a patent should not be allowed merely because it can do no harm, see *Ex parte Mixer* (1872), 1 O. G. 48.

sions of the Commissioner both on matters of law and fact, whatever may be his own judgment concerning their propriety.³ He is also required to conform to the rules laid down by the courts for determining the patentability of inventions. If it appears to him, as the result of his investigation, that the subject-matter of the application is patentable and that the applicant or his decedent was its true and first inventor, it is his duty to allow the application; if the contrary appears, it is his duty to reject it.⁴ Where the investigation leaves him in doubt, it is still incumbent on him to decide either for or against the applicant, in order that the patent may be granted, or else an opportunity be given for further inquiry on a reconsideration or an appeal.

§ 559. Rejection of Application: Notice and References.

When an application, or one of the Claims in an application, is rejected upon any ground whatever the examiner is required to notify the applicant of such rejection, stating all his reasons therefor fully and precisely, and giving him such information and references as may assist him in judging of the advisability of prosecuting his application or of altering his specification.¹ If the ground of the rejection be that the applicant is not the true and first inventor of the art or instrument described, the examiner must cite references establishing his assertion, or himself make oath to it, to overcome the presumption arising from the oath of the alleged inventor.²

³ That the conclusions of an examiner do not bind his successor, unless embodied in a formal judgment, see *Ex parte* Buell (1884), 26 O. G. 437; *Ex parte* Starr (1879), 15 O. G. 1053.

That the former erroneous decision of an examiner is to be departed from, see *Ex parte* Traitel (1883), 25 O. G. 783.

⁴ That the primary examiner when considering the merits of the application must look to the language of the application alone, see *Faure v. Bradley* (1888), 44 O. G. 945.

§ 559. ¹ That an examiner, in re-

jecting an application, should cite references, not give his own *dictum*, see *Ex parte* Fairbanks (1873), 3 O. G. 65.

That all the examiner's reasons for rejecting the application must be given at once, see *Ex parte* Proudfit (1876), 10 O. G. 585.

That all references and objections are to be cited and urged by the examiner on or before final rejection, though if he overlooks a reference he may urge it as soon after final rejection as he discovers it, as *e. g.* in his appeal-statement, see *Ex parte* Parker (1886), 36 O. G. 119.

² That if the examiner denies the

If the ground of the rejection be the absence of novelty in the subject-matter of the application, the examiner must disclose to the applicant all his own information on the subject, citing the best references at his command. When these references are prior patents, each must be designated by its date and number, and by the name of the patentee and the class of the invention. When the reference is a prior publication, its title, date, page or plate, and place of publication or place where a copy may be procured, must be given. When the reference is a fact within the knowledge of the examiner or the Patent Office, the data mentioned must be as precise as the nature of the case admits, and the reference must be supported by the affidavit of the person to whom the fact is known. The pertinence of the reference cited, if not obvious on inspection, must be clearly explained and the anticipated Claim particularly specified; and where a reference shows or describes inventions other than that claimed by the applicant, the part relied on to defeat his Claim must be as accurately designated as possible. Devices cited as references need not have commercial value, nor be identical in form, material, or mode of use with that described in the application; substantial correspondence constituting them the same invention.³ An abandoned or rejected application is not a public document, and cannot be referred to as disclosing prior knowledge of the invention.⁴ In all cases, pertinent references only should be

priority of the applicant and cannot cite a reference, he must support his denial by an affidavit, see *Ex parte Hill* (1879), 16 O. G. 765.

³ That devices, cited as references, need not have commercial value, see *Sargent v. Burge* (1877), 11 O. G. 1055.

That the device, cited as a reference, need not be identical with the one claimed in the application, either in material, shape, or mode of use, see *Ex parte Chatillon* (1872), 2 O. G. 115.

That a drawing without printing may be cited as a reference, see *Ex parte Borden* (1884), 26 O. G. 439.

⁴ That an abandoned application

cannot be cited as a reference, see *Webster v. Sanford* (1888), 44 O. G. 567; *Ex parte Borden* (1884), 26 O. G. 439; *Corn Planter Patent* (1874), 23 Wall. 181; 6 O. G. 392.

That a rejected application cannot be cited as a reference, see *Webster v. Sanford* (1888), 44 O. G. 567; *Blades v. Rand, McNally, & Co.* (1886), 27 Fed. Rep. 93; 37 O. G. 99; *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.* (1874), 6 O. G. 34.

That an abandoned or rejected application can be cited as a reference, see *Ex parte Gordon* (1874), 6 O. G. 543.

mentioned, and the best references should be cited first.⁵ The examiner is under no obligation to embody in his notice any suggestions as to the proper Claims to be inserted in the application, — this being a matter for the applicant upon the information afforded to him by the Patent Office.⁶

§ 560. Action of Applicant after Rejection: Insistence and Second Rejection.

On the receipt of this notice of rejection, the applicant may either insist on the allowance of his application as it stands, or he may amend it, or he may withdraw it altogether. If he insists, he may controvert by argument the position taken by the examiner upon matters of law or upon the identity of his invention with the references cited, or he may deny the existence of the facts contained in the reference itself. To facts stated and sworn to by the examiner as within his personal knowledge, he may oppose his own affidavit or those of other persons, and these may be met by counter-proofs on the part of the examiner. If the reference is a domestic patent, or if it is a foreign patent or a publication, the applicant may avoid the reference by an affidavit showing his completion of the invention before the filing of the application for the domestic patent, or before the date of the foreign patent or the publication, and averring that he does not know or believe that the invention has been in public use or on sale in this country for more than two years prior to his application, and that he has never abandoned the invention.¹ A rejection upon such references

⁵ That pertinent references only should be cited, see *Ex parte Brownlie* (1873), 3 O. G. 212.

That the best references must be cited first, see *Ex parte Sanders* (1878), 13 O. G. 818.

⁶ That the examiner need not suggest proper Claims, this being the duty of the applicant, see *Ex parte Evarts* (1874), 5 O. G. 429.

§ 560. ¹ That the applicant need show only such facts as will carry the date of his invention back of the references cited, see *Ex parte Lanfrey* (1881),

20 O. G. 892; *Ex parte Gasser* (1880), 17 O. G. 507.

That in order to overcome a prior patent or publication the applicant must show by competent legal proof that he had disclosed the invention to others, as fully as the patent or publication does, before the patent was granted or the publication made, see *Ex parte Saunders* (1883), 23 O. G. 1224.

That an affidavit, under the rule requiring an affidavit of prior invention after rejection on a patent or publication, must set out the facts on which

to domestic patents showing but not claiming the invention, or to foreign patents, or to publications, or on the ground of public use or sale, or that the device referred to is capable of performing the same operation in the same manner, or that the invention is inoperative or frivolous or injurious to public health or morals, opens the whole question of fact to investigation upon affidavits or depositions, denying or supporting these objections.² Upon the statement of the applicant that he insists on the allowance of his application in its original

the applicant bases his claim and if he asserts that he had made drawings or models, such drawings and models, or copies of them, must be produced, see *Ex parte Saunders* (1883), 23 O. G. 1224.

That the applicant, in his proof, must set forth the facts which show that his inventive act preceded the filing of the application named in the reference, though they need not be particularly stated nor need he allege that he made the invention before the inventor whose patent has been cited against him, see *Ex parte Gasser* (1880), 17 O. G. 507.

That the applicant's proof must show a reduction to practice or reasonable diligence in reducing, before the filing of the application for the patent cited against him, see *Ex parte Gasser* (1880), 17 O. G. 507.

That foreign inventors may show that their inventions were known in this country before the dates of their applications, but cannot show use abroad prior to the dates of their patents, see *Ex parte Lanfrey* (1881), 20 O. G. 892.

That affidavits claiming priority against an existing patent are secret, see *Ex parte Gasser* (1880), 17 O. G. 507.

In cases where the patent cited as a reference claims the invention covered by the rejected application, and is an unexpired domestic patent, an interference arises upon the filing of the affidavit described in the text, and the proceedings thenceforth follow the rules discussed in §§ 586-616, *post*.

² That the Patent Office may receive the affidavits of third persons in uncontested cases, but care must be taken to guard against fraud, and the applicant must have an opportunity to examine them and offer counter-proof, see *Hedges v. Daniels* (1880), 17 O. G. 394.

That the Commissioner may act on his personal knowledge of public use, see *Alteneck's Appeal* (1882), 23 O. G. 269.

That the inquiry of the Commissioner into the knowledge of others as to an alleged public use is a judicial inquiry, and there must be due notice and legal evidence, see *Ex parte Barricklo* (1886), 38 O. G. 417; *Alteneck's Appeal* (1882), 23 O. G. 269.

That the right and opportunity to offer rebutting evidence on the question of public use is no substitute for cross-examination of adverse witnesses, see *Alteneck's Appeal* (1882), 23 O. G. 269.

That a rejection on the ground of public use or sale on mere *ex parte* affidavits, without notice or examination, is improper, see *Ex parte Barricklo* (1886), 38 O. G. 417; *Alteneck's Appeal* (1882), 23 O. G. 269.

That affidavits, averring that the invention was in public use two years before the application was filed, authorize the Commissioner to call on the applicant to show cause why he should not prove the contrary, see *Ex parte Barricklo* (1886), 37 O. G. 672; 38 O. G. 417.

form, and the completion of the proofs and counter-proofs upon the disputed questions of fact, when such exist, the examiner is required to re-examine the case and communicate the result of this examination to the applicant. If he again rejects the application, his notice of such second rejection must, like that of the first, specifically and exhaustively allege the grounds of his adverse decision.

§ 561. Amendment of Application.

Amendments to the application may be offered at any time after it is taken up for examination and before final disposition of it has been made.¹ Amendments in form are optional with the applicant to any extent, and may be required by the Patent Office when necessary to correct inaccuracies of statement or undue prolixity, or to secure correspondence between the Claim and the Description. Amendments in substance can be made only within certain limits, and under certain prescribed conditions.² No new matter can under any circumstances be introduced by amendment.³ New matter is that which is not found in the specification, drawings, or model, as first filed, and which involves a departure from the original invention.⁴ Such matter must necessarily be a distinct art or

§ 561. ¹ That an inventor may amend or enlarge his Claims at any time pending his application, in order to embrace everything which was specified at the outset, see *Railway Register Mfg. Co. v. North Hudson Co. R. Co.* (1885), 24 Fed. Rep. 793 ; 33 O. G. 355.

That an amendment may be made at any time within two years from the date of the "last action," see *Ex parte Reynolds* (1883), 24 O. G. 993.

² That an amendment cannot be made unless a good reason for allowing it appears, see *Ex parte Winchester* (1880), 17 O. G. 453.

³ That new matter, changing the character of the invention, cannot be introduced by amendment, see *Ex parte Wharton* (1887), 40 O. G. 917 ; *Ex parte Dunn* (1879), 16 O. G. 1004 ; *Ex*

parte Lamb (1879), 16 O. G. 405 ; *Ex parte Temple* (1877), 12 O. G. 795.

That the phrase "new matter" applies to re-issues rather than amendments, see *Ex parte Holt* (1884), 29 O. G. 171.

⁴ That any amendment containing features not found in either the specification, the drawings, or the model, when the invention is capable of illustration by model or drawings, introduces new matter and must be made as a separate application, see *Ex parte Crandall* (1886), 35 O. G. 625 ; *Ex parte Temple* (1877), 12 O. G.

That no material amendment can be allowed, see *Chicago & Northwestern R. R. Co. v. Sayles* (1878), 97 U. S. 554 ; 15 O. G. 243.

That amendments enlarging the in-

instrument, or a new and separately patentable improvement on the old, and can be now presented only in a separate application.⁵ Amendments changing the construction or mode of operation of the invention, or describing a different embodiment of the idea, or re-instating Claims which have been eliminated to avoid certain references cited or to comply with an order for a division of the application, are all open to this objection and cannot be permitted.⁶ Amendments not intro-

vention are suspicious, see *Chicago & Northwestern R. R. Co. v. Sayles* (1878), 97 U. S. 554; 15 O. G. 243.

That an amendment cannot insert into the application matter which has been in public use more than two years, see *Kittle v. Hall* (1887), 39 O. G. 707; 29 Fed. Rep. 508; 24 Blatch. 184.

That amendments enlarging the scope of the application are not allowable, see *Eagleton Mfg. Co. v. West, Bradley, & Cary Mfg. Co.* (1880), 18 Blatch. 218; 17 O. G. 1504; 2 Fed. Rep. 774.

That an amendment cannot introduce a different invention but only set forth more fully the one already applied for, see *Ex parte Snyder* (1882), 22 O. G. 1975.

That amendments may illustrate but cannot alter the invention applied for, see *Ex parte Howe*, (1883), 25 O. G. 1189.

That an applicant cannot change his ground and secure successive examinations for a single fee, see *Ex parte Holt* (1884), 29 O. G. 171.

⁵ That where an amendment is not permitted a new application may be filed, see *Ex parte Thurmond* (1886), 37 O. G. 217.

⁶ That the essential character of the invention, as originally set forth, cannot be changed by amendment, see *Ex parte Dodge* (1872), 3 O. G. 179.

That Claims rejected to meet objections of the examiner cannot be re-inserted by amendment, either in the same or a different mode of statement, see *Ex parte Andrews* (1879), 15 O. G. 1056.

That Claims struck out because inconsistent with other Claims cannot be re-inserted by amendment, after such other Claims have been defeated in an interference, see *Ex parte Cobb* (1879), 16 O. G. 175.

That a Claim once voluntarily erased cannot be restored, but may be made the subject of a new application, see *Ex parte Johnston* (1887), 40 O. G. 574.

That matter eliminated by a division of the application cannot be re-instated by amendment, see *Ex parte Preston* (1880), 17 O. G. 853.

That an applicant having elected to claim one species cannot change though he finds it unpatentable, see *Ex parte Wharton* (1887), 40 O. G. 917.

That when an application contains a generic Claim and several specific Claims, of which one is imperfect, the applicant may amend his imperfect Claim and then elect which specific Claim he will retain, see *Ex parte Johnston* (1887), 40 O. G. 574.

That when an examiner is in doubt as to want of identity in the amended application he should examine it on the merits, and if he rejects it cite his references, see *Ex parte Bennett* (1886), 35 O. G. 1003.

That where an amended application shows want of identity, it should be rejected by the examiner and an appeal taken if desired, see *Ex parte Bennett* (1886), 35 O. G. 1003.

ducing new matter may be made without a new oath when the features of the invention therein described or claimed are already apparent in the application as originally filed, and the effect of the amendment is merely to supply suitable connections, add subordinate devices, remedy manifest defects, correct clerical errors, or declare further uses for which the art or instrument may be employed.⁷ Where drawings and a model accompanied the original specification, such amendments must conform to at least one of them as they were first filed; but if the invention does not admit of model or drawing the specification may be amended on proof satisfactory to the Commissioner that the proposed matter was part of the origi-

⁷ In *Ex parte Snyder* (1882), 22 O. G. 1975, Marble, Com.: (1975) "The applicant will not be permitted, under the guise of an amendment, to introduce into his application a wholly different invention, nor to change the construction and operation of an invention which has been fully described and shown, nor to present a different or preferable form of his invention. He may be permitted, upon proper occasion, to supply suitable connections, to add a spring to a pawl, a handle to a crank, a belt to a pulley, teeth to a wheel, an outlet to a closed receptacle, or other manifest defects or omissions in features essential to the operation of the invention or to the completeness of the disclosure, and which were caused by a clerical error of the draftsman or the unfamiliarity of the inventor with official forms. These amendments, supplemental in their nature, may be made as completing the invention imperfectly shown and described. They add to the invention disclosed some part or feature which agrees with the construction and operation already presented. An applicant cannot be permitted, however, to erase the lines of his drawing and delineate anew the construction and operation of a part fully shown and described,

or replace a well-described but inferior arrangement by a preferable form of his invention."

That any amendment, within the original sworn statement, may be made without a new oath, etc., see *Railway Register Mfg. Co. v. North Hudson Co. R. Co.* (1885), 24 Fed. Rep. 793; 33 O. G. 355; *Ex parte Eaton* (1873), 4 O. G. 525.

That an amendment may introduce a part of a Claim covering an element additional to the combination in which the invention was said to consist, if this element is shown in the specification or drawings, see *Hoe v. Cottrell* (1880), 18 O. G. 59; 17 Blatch. 546; 1 Fed. Rep. 597; 5 Bann. & A. 256.

That an amendment may claim the process as composed of certain sub-processes if the specification describes them, see *Ex parte Wohltmann* (1879), 16 O. G. 723.

That where the specification describes the old elements of a combination as new, an amendment distinguishing the new elements from the old must be filed, see *Ex parte Gilbert* (1879), 16 O. G. 763.

That an amendment may be made showing that the invention is applicable to additional uses, see *Ex parte Slotterbeck* (1875), 8 O. G. 1073.

nal invention.⁸ Amendments not introducing new matter, but containing features which are not substantially represented in the application as originally filed, and yet which might have been, and are claimed to be, a part of the original invention, must be accompanied by a new oath, averring that the subject of the amendment was a portion of the invention and was invented before the original application was presented;⁹ and the

⁸ That if the matter of an amendment can be found either in the specification, drawing, or model it suffices, see *Ex parte* Huck (1879), 16 O. G. 1052; *Ex parte* Dorman (1876), 9 O. G. 1061.

That amendments to the specification must be based on the drawing or model if any; and if none, then they must be shown by proper proof to have been embraced in the original invention, see *Ex parte* McDougall (1882), 21 O. G. 1783; *Ex parte* Shalters (1879), 15 O. G. 970.

That an invention not shown in the drawing or model, when capable thereof, cannot be inserted in an amendment, and an amendment embracing such matter should not be received, see *Ex parte* Vaile (1886), 37 O. G. 563; *Ex parte* Bennett (1886), 35 O. G. 1003.

That drawings must not be changed or erased in the Patent Office, being records of an important character, see *Ex parte* Wharton (1887), 40 O. G. 917.

That where there are neither drawings nor model the amendment must still be confined to the original invention, see *Ex parte* Crandall (1886), 35 O. G. 625.

That in cases not admitting of model or drawing an amendment must be accompanied by proof that the new matter is part of the original invention, and in the absence of such proof the amendment will not be considered, see *Ex parte* Bennett (1886), 35 O. G. 1003.

⁹ That Claims amended in matters of substance are to be treated as new

Claims just presented, — matters of substance being such as change the character of the invention, not merely the modes of describing it, — see *Ex parte* Winchester (1880), 17 O. G. 453.

That an amendment not fairly covered by the original oath must be duly verified, see *Ex parte* Foster (1885), 33 O. G. 113.

That where Claims are enlarged in subject-matter by an amendment a supplemental oath is necessary, see *Ex parte* Crandall (1886), 35 O. G. 625; *Ex parte* Clarke (1886), 36 O. G. 120.

See also § 455 and note 3, *ante*.

That an amendment introducing a part of the invention as originally made, but not appearing in the specification as first filed, must be supported by an oath that it belonged to the original invention, see *Ex parte* McDougall (1882), 21 O. G. 1783.

That an amendment introducing what was before shown only in the model requires a new oath, see *Ex parte* Eaton (1873), 4 O. G. 525.

That an amendment filed by an administrator after the death of the original applicant requires a new oath when the matter introduced covers more than the original application, and a patent issued on such amendment without a new oath is void, see *Eagleton Mfg. Co. v. West, Bradley, & Cary Mfg. Co.* (1883), 111 U. S. 490; 27 O. G. 1237; *Eagleton Mfg. Co. v. West, Bradley, & Cary Mfg. Co.* (1880), 18 Blatch. 218; 17 O. G. 1504; 2 Fed. Rep. 774.

That the decision of the Patent Office

date of this oath is then entered on the papers and is thereafter regarded as the true date of the amended application.¹⁰ By this mode of amendment a specific Claim may be inserted in an application for the generic invention, or the description of a mode of making a certain manufacture may be introduced into an application for the manufacture itself; or features essential to the invention, but not embraced within the original sworn statement, may be added to the Description and Claim already filed.¹¹ No amendment can be permitted to enlarge a specification to the prejudice of intermediate inventors;¹² and long delay in filing such amendments raises a strong presumption that the original application correctly limited the scope of the invention then made, and that the additions or variations disclosed by the amendment are of late discovery.¹³

that an attorney has been appointed with authority to amend is final, see *Hoe v. Cottrell* (1880), 17 Blatch. 546; 18 O. G. 59; 1 Fed. Rep. 597; 5 Bann. & A. 256.

¹⁰ That when an amendment which requires a new oath is filed, the date of the application is changed to that of the new oath, see *Ex parte McDougall* (1882), 21 O. G. 1783.

That when an amendment introduces matter evidently just thought of by the inventor, the date of his amendment is taken as the date of the invention, see *Hull v. Lowden* (1881), 20 O. G. 741.

That applications amended by order of the Patent Office are continuous, see *International Tooth Crown Co. v. Richmond* (1887), 39 O. G. 1550; 30 Fed. Rep. 775.

¹¹ That when an application contains generic Claims only, and the oath avers that the applicant invented the things claimed, a new specific Claim cannot be inserted by amendment, see *Ex parte Heaton* (1879), 15 O. G. 1054.

That where a Claim for a manufacture is rejected because no mode in which it could be made is described,

an amendment showing such a mode can be made with a new oath, see *Ex parte Benson* (1879), 15 O. G. 512.

¹² In *Railway Co. v. Sayles* (1878), 97 U. S. 554, Bradley, J. : (563) "The law does not permit such enlargements of an original specification, which would interfere with other inventors who have entered the field in the mean time, any more than it does in the case of re-issues of patents previously granted. Courts should regard with jealousy and disfavor any attempts to enlarge the scope of an application once filed, or of a patent once granted, the effect of which would be to enable the patentee to appropriate other inventions made prior to such alteration, or to appropriate that which has, in the mean time, gone into public use." 15 O. G. 243 (246).

¹³ That the insertion of an amendment broadening the Claims of the applicant after long delay tends to show that the real invention was properly presented in the original application, see *Chicago & Northwestern R. R. Co. v. Sayles* (1878), 97 U. S. 554; 15 O. G. 243.

§ 562. Amendments : when Made.

Though amendments may be made at any time when their necessity becomes apparent, they should be completed as far as possible before the Claims are passed upon by the examiner.¹ Amendments in substance cannot be filed, as of course, on or after an appeal from the examiner to the examiners-in-chief,² nor after a notice of the allowance of the patent has been given to the applicant ;³ since in the first case the amend-

§ 562. ¹ That amendments should be completed before the Claims are passed on by the examiner, but may be made at any later time if necessary, see *Ex parte Dodge* (1872), 3 O. G. 179.

That the application is open to amendment and addition, within the limits fixed by the drawings and model, until it is finally disposed of, see *Ex parte Dodge* (1872), 3 O. G. 179 ; *Singer v. Braunsdorf* (1870), 7 Blatch. 521.

That after a rejection the applicant cannot amend by claiming a different invention, see *Ex parte Zabel* (1888), 43 O. G. 627.

That after a second rejection an applicant cannot amend as a matter of course, but must satisfactorily explain why he did not earlier offer the correction, see *Ex parte Donovan* (1888), 44 O. G. 698.

That the filing of another application, claiming the same invention, does not prevent the prior applicant or patentee from amending his application or patent or doing any other rightful act, see *Ex parte Zay* (1881), 19 O. G. 1496.

That the object of limiting amendments is to determine when the application is complete, see *Ex parte Temple* (1877), 12 O. G. 795.

That when the examiner refuses to receive an amendment, the applicant may petition the Commissioner, and then unless it is clearly improper, the examiner may be ordered to receive it, see *Ex parte Vaile* (1886), 37 O. G. 563 ; *Ex parte Bennett* (1886), 35 O. G. 1003.

That where an amendment, received by the examiner under order of the Commissioner, contains matter which he regards as not embraced in the original invention, he must reject it, see *Ex parte Vaile* (1886), 37 O. G. 563 ; *Ex parte Bennett* (1886), 35 O. G. 1003.

² That Claims filed after an appeal to the examiners-in-chief cannot be considered unless sanctioned by the Commissioner, see *Ex parte Dodge* (1872), 3 O. G. 179.

That an amendment cannot be made in taking an appeal to the examiners-in-chief, see *Ex parte Hammond* (1872), 2 O. G. 57.

That a primary examiner cannot open a case for amendment after appeal and affirmance by the examiners-in-chief, on a mere suggestion of such examiners, but only on a clear recommendation, see *Ex parte Peterson* (1887), 40 O. G. 692.

That jurisdiction over such amendments is in the examiner with right of appeal, see *Ex parte Peterson* (1887), 40 O. G. 692 ; *Ex parte Pearson* (1887), 40 O. G. 244.

That an amendment of the specification, after the decision of the appellate tribunal, should be forwarded to the examiner, who will pass on its admissibility and merits, see *Ex parte Reynolds* (1883), 24 O. G. 993 ; *Ex parte Hitt* (1883), 25 O. G. 192.

³ That an application which has passed to issue in the form selected by the applicant will not be withdrawn for amendment unless great damage would

ment would change the issue presented by the appeal, and in the second case would cause the patent to protect a subject-matter not allowed by the examiner. Amendments in form may be made after the patent is ordered to issue, and after payment of the final fee, on recommendation of the examiner, approved by the Commissioner.

§ 563. Amendments: their Form.

Every amendment must be written in a fair and legible hand, on one side of the paper, and on a separate sheet. No erasures can be made in the original application, but the exact word or words to be stricken out must be indicated in the amendment, and the substitutions, if any, with the place of their insertion, must be distinctly stated.¹ When an amendatory clause is amended it must be wholly rewritten so that no erasure or interlineation may appear when the amendments are completed. If amendments are numerous or difficult to arrange, the examiner or Commissioner may require the entire specification to be rewritten. The specification cannot be taken from the Patent Office for the purpose of alteration, nor can the drawing and model both be withdrawn at the same time.

§ 564. Amendments Dependent on Original Application: their Scope.

An amendment, however extensive in substance or complete in form, must always be subordinate to, and connected

otherwise result, see *Ex parte Gaboury* (1886), 37 O. G. 217.

That a petition to amend and have a new hearing, after the patent has passed to issue, will be denied, and the claimant left to file a new application, unless irreparable injury would result, see *Ex parte Page* (1888), 43 O. G. 1455.

§ 563. ¹ That if a cancelled Claim is to be restored by amendment it must be done as a separate amendment, not by merely erasing the cancellation, see *Ex parte Mumler* (1883), 24 O. G. 1090.

That amended Claims may be inserted into an application by the attorney without the signature of the applicant, see *Railway Register Mfg. Co. v. North*

Hudson Co. R. Co. (1885), 24 Fed. Rep. 793; 33 O. G. 355.

That an attorney has no right to substitute a clean draft of a specification for the one signed and sworn to by the applicant, and if he does so it must be erased, see *Sheridan v. Latus* (1883), 25 O. G. 501.

That where the examiner decides that the invention is a mere aggregation and the applicant acquiesces and erases his Claim, he should also cancel all reference thereto from his specification and drawings, and cannot afterward restore his Claim by an amendment, see *Ex parte Gillette* (1888), 44 O. G. 819.

with, the original application. Two distinct applications cannot qualify or support each other.¹ Where a later application by the same inventor describes the same invention as an earlier one, and either claims it more precisely or alone claims it, the later application is not regarded as an amendment to the earlier, but is allowed or rejected on its own merits.² The earlier application stands also unaffected by the filing of the later, and may be amended and allowed without reference thereto. An amendment of one portion of the application does not always change the rest, except so far as, by construing the whole together, the meaning of the unaltered portions may be modified by the interpretation given to that which is amended.³ A Claim may thus be amended without affecting the Description, or the Description without influencing the Claims, or the drawings or model without revising the language of the specification.⁴

§ 565. Examination of Amended Application: its Rejection: Appeal.

In offering an amendment for the purpose of removing any of the grounds on which an application has been rejected by the examiner, the applicant must point out all the patentable novelty which he thinks the case presents in view of the state of the art, as disclosed by the references cited or objections made, and must show how his amendment avoids such references or objections.¹ As often as the examiner produces new

§ 564. ¹ That each application, by whomsoever filed, is regarded as that of an independent inventor, and is in no manner affected by any other, see *Ex parte* Langlois (1878), 14 O. G. 84.

² That a later application for the same invention by the same inventor neither amends nor abandons the former, see *Ex parte* Langlois (1878), 14 O. G. 84.

That a later application by the same inventor, claiming an invention described but not claimed in a former and still pending application, cannot be received as an amendment of the former, see *Ex parte* Emerson (1880), 17 O. G. 1451.

³ That Claims not affected by an improper amendment must be examined on their merits, see *Ex parte* Vaile (1886), 37 O. G. 563.

⁴ That a Claim may be amended without altering the Description if the new Claim is warranted by the drawings and present Description, see *Hoe v. Cottrell* (1880), 1 Fed. Rep. 597; 18 O. G. 59; 17 Blatch. 546; 5 Bann. & A. 256.

That where two applications describe the invention, but only one claims it, the patent issues on the latter, see *Ex parte* Emerson (1880), 17 O. G. 1451.

§ 565. ¹ That after a rejection on the merits a case cannot be reconsidered

references or arguments, the same process of amendment and explanation may be repeated. But after the final rejection of all the Claims no amendments are allowable, unless good cause is shown for permitting them, and satisfactory reasons are given for the delay in their presentation. From the refusal of the examiner to allow amendments an appeal lies to the Commissioner.² Upon the filing of any amendment to meet the references and objections of the examiner, it is his duty to examine the case presented by the amended application in the same manner as if it were an original application, and if he rejects it to communicate his rejection with its reasons to the applicant, to which reasons the applicant may reply by argument or amendment as before. After a second rejection of the Claims as originally filed, or, if amended in substance, of the amended Claims, the right of the applicant to a hearing before the examiner ceases, and any further action must be taken by an appeal from the decision of the examiner to the examiners-in-chief.³

§ 566. **Appeal in Uncontested Cases: Matters of Form and of Substance.**

Appeals in uncontested cases in the Patent Office are based either upon the decisions of the examiner as to some matter of form, or upon his decision as to some matter of substance.

on mere formal amendments of the Claims and titles, but from the refusal of the examiner to consider such amendments an appeal lies to the Commissioner, see *Ex parte Hitt* (1883), 25 O. G. 192.

² That from the refusal of an examiner to consider an amendment appeal lies to the Commissioner, see *Ex parte Bennett* (1882), 35 O. G. 1003.

³ That after a second rejection the examiner is not obliged to reconsider a Claim unless he thinks he has made a mistake, see *Ex parte Starr* (1879), 15 O. G. 1053.

That all the Claims of an application having been twice rejected on the same references, and no material intervening amendment being made, the

applicant cannot amend again without showing good reason for it, and why he did not sooner amend, see *Ex parte Thurmond* (1886), 37 O. G. 217.

That the rejection of Claims may be appealed from, but the rejected matter cannot be made the subject of a new application, see *Ex parte Ransom* (1884), 39 O. G. 119.

That a rejected applicant must appeal within reasonable time or he will not be permitted to stand in the way of other applicants, see *Ex parte Lombard* (1888), 43 O. G. 1347.

That by taking an appeal from the rejection of one Claim the applicant forfeits no rights as to the others, see *Ex parte Gillette* (1888), 44 O. G. 819.

An appeal upon a question of form lies to the Commissioner in person. An appeal upon a question of substance lies to the board of examiners-in-chief.¹ A matter of form is one that relates to the fitness of the application for an examination on its merits, or involves merely some rule of Office practice.² A matter of substance is one that pertains to the patentability of the invention as described and claimed in the application, or to the right of the inventor to a patent upon the application as presented by him.³ Thus, whether a combination is a true combination or a mere aggregation, whether the Claims cover operative constructions, whether the invention is practicable, whether it is new and useful, whether it has been abandoned to the public, whether an amendment is a departure from the original application or whether it affects the form or the substance of the application,⁴ — all these and

§ 566. ¹ That an interlocutory appeal to the Commissioner is not based on the merits of the application, — such appeals are taken to the examiners-in-chief, — see *Ex parte* Edward (1876), 9 O. G. 794.

That petitions and motions are addressed to the Commissioner, see *Ex parte* Baker (1886), 36 O. G. 1149.

That interlocutory appeals to the Commissioner are really petitions for orders, see *Ex parte* Baker (1886), 36 O. G. 1149.

² That matters of form are those which put the application into condition to be examined on its merits, see *Ex parte* Kitson (1881), 20 O. G. 1750.

That a question of joinder is a question of form, see *Ex parte* Gillette (1888), 44 O. G. 819; *Ex parte* Mill (1887), 40 O. G. 918.

That whether a Claim is intelligible is a question of form, see *Ex parte* Doten (1877), 12 O. G. 841; *Ex parte* Reynolds (1874), 6 O. G. 641.

That whether a Claim is functional is a question of form, see *Ex parte* Barrett (1888), 45 O. G. 125.

That matters of Office practice are appealable only to the Commissioner, see *Ex parte* Proudfit (1876), 10 O. G. 585.

That whether an appeal from an examiner ordering a division is to be made to the Commissioner or the examiners-in-chief is a matter for the Patent Office to decide, see *U. S. v. Butterworth* (1884), 27 O. G. 717.

³ That the question of the patentability of the invention is one of substance, and from an adverse decision thereon appeal lies to the examiners-in-chief, see *Barney v. Kellogg* (1880), 17 O. G. 1096; *Ex parte* Pressprich (1877), 11 O. G. 195; *Ex parte* Ellis (1876), 9 O. G. 1110.

⁴ That whether an invention is a true combination is a question of substance, see *Ex parte* Gillette (1888), 44 O. G. 819; *Ex parte* Barcellos (1880), 17 O. G. 110.

That whether an invention is operative is a question of substance, see *Ex parte* Kitson (1881), 20 O. G. 1750; *Ex parte* Muhl (1880), 17 O. G. 744; *Ex parte* Keith (1876), 9 O. G. 793.

That whether an invention is a design or a mechanical invention is a

others of the same character are questions involving the merits of the application, from an adverse decision upon which an appeal lies to the examiners-in-chief.

§ 567. **Appeal, on Matters of Form, to Commissioner.**

An appeal to the Commissioner from an adverse decision of an examiner upon a matter of form, once repeated, is taken by a written petition, setting up the decision complained of and the reasons for the appeal, and signed by the applicant or his attorney.¹ The examiner is then required to file a written statement disclosing the grounds of his decision;² and upon hearing had, either orally or by written argument, the Commissioner affirms or reverses or modifies the action of the examiner as his judgment may direct. This decision is final, and can be reviewed or reconsidered only by the Commissioner himself.³

question of substance, see *Ex parte Schulze-Berge* (1888), 42 O. G. 293.

That whether the invention is new is a question of substance, see *Ex parte Nagel* (1880), 17 O. G. 198; *Ex parte Buchanan* (1879), 16 O. G. 1049; *Ex parte Proudfit* (1876), 10 O. G. 585.

That whether a cited reference is pertinent is a question of substance, see *Ex parte Kerr* (1884), 28 O. G. 95; *Ex parte Borden* (1884), 26 O. G. 439.

That whether an invention is useful is a question of substance, see *Ex parte Buchanan* (1879), 16 O. G. 1049.

That whether the invention has been abandoned is a question of substance, see *Jenkins v. Barney* (1873), 3 O. G. 119.

That whether an amendment departs from the original by inserting new matter is a question of substance, see *Ex parte Lanstrom* (1880), 17 O. G. 744.

That where a feature is struck out of one Claim and inserted in another, the question whether the latter Claim now shows a true combination is one of substance, see *Ex parte Wenzel* (1880), 17 O. G. 512.

That the question whether the draw-

ings are sufficient is one of substance, see *Ex parte Kitson* (1881), 20 O. G. 1750.

That whether a Claim distinguishes the new from the old is a question of substance, see *Ex parte Reynolds* (1874), 6 O. G. 641.

That objections to the insertion of distinct Claims for non-separable parts go to the merits and appeal lies to the examiners-in-chief, see *Ex parte Gerard* (1888), 43 O. G. 1235.

That whether a re-issue application covers new matter is a question of substance, see *Ex parte Keith* (1876), 9 O. G. 744.

§ 567. ¹ That under the rule concerning interlocutory appeals, the principal examiner must act twice before review by the Commissioner, see *Ex parte Bennett* (1886), 35 O. G. 1003.

² That where the examiner requires a model and an appeal is taken, the examiner must show in his answer why a model is needed, see *Ex parte Jovè* (1880), 17 O. G. 801.

³ That examiners must abide by the decisions of the Commissioner, see *Ex parte Kitson* (1881), 20 O. G. 1750.

§ 568. Appeal, on Matter of Substance, to Examiners-in-Chief.

An appeal to the examiners-in-chief from an adverse decision of an examiner upon a matter of substance can be taken only after an original or amended Claim in the application has been twice rejected by the examiner, and after all the Claims have been passed upon and all questions of form conclusively settled in the manner before stated.¹ This appeal is instituted by a written petition, signed by the applicant or his authorized attorney, setting forth the points of the decision from which the appeal is taken and reciting the reasons for the appeal. The petition, having been duly filed, is submitted to the examiner, who, if he finds it to be regular in form, must thereupon furnish to the examiners-in-chief a written statement of the grounds of his decision on all the points involved in the appeal, with copies of the rejected Claims and the references applicable thereto. If he finds the petition irregular in form, the appellant may amend it, or may appeal from this finding to the Commissioner as upon any other question of form. The appellant, previous to the day of hearing before the examiners-in-chief, must file a brief of the authorities and arguments on which he will rely to maintain his appeal; and if he wishes to be heard orally, he must indicate it at the time of filing his petition, when a day of hearing will be fixed and proper notice given him; otherwise the case will be considered and decided by the examiners-in-chief upon the brief presented. The examiners-in-chief can affirm or reverse the decision of the examiner only upon the

§ 568. ¹ That appeals on matters of substance must be taken to the examiners-in-chief, see *Ex parte Baker* (1886), 36 O. G. 1149.

That the right of appeal from a second rejection is absolute, whatever be the cause of rejection, see *Ex parte Bennett* (1886), 35 O. G. 1003.

That an applicant having an option of two or more modes of procedure, must elect one and abide by it, as where he can appeal or amend and chooses the latter, see *Ex parte Williams* (1887), 40 O. G. 1337.

That an application must be perfect in form before an appeal can be allowed on its merits, see *Ex parte Mewes* (1872), 2 O. G. 617.

That the jurisdiction of the examiner ceases on appeal, see *Ex parte Brunner* (1872), 1 O. G. 303.

That *ex parte* cases appealed to the examiners-in-chief are within the jurisdiction of the primary examiner as soon as the appeal is decided, see *Ex parte Pearson* (1887), 40 O. G. 244.

points on which the appeal is taken;² but if they discover any apparent grounds, not involved in the appeal, for granting or refusing letters-patent in the form claimed or in any other form, they must annex to their decision a written statement of these grounds, with such recommendations to the examiner in regard to his future action as they may deem proper.³ These new grounds must then be considered by the examiner; and from his adverse decision, upon any question of substance therein presented, another appeal lies to the examiners-in-chief, or on questions of form to the Commissioner, as in other cases.⁴

§ 569. Appeal from Examiners-in-Chief to Commissioner.

From an adverse decision of the examiners-in-chief the applicant may appeal to the Commissioner in person. This

² That in *ex parte* cases the jurisdiction of the examiners-in-chief is limited to adverse decisions of the examiners, — all other objections they may discover must be referred to the Commissioner, — see *Ex parte Smoot* (1877), 11 O. G. 1010.

³ That the examiners-in-chief must suggest anything they deem important either to the Office or the applicant, see *Ex parte Dodge* (1872), 3 O. G. 179.

That the examiners-in-chief can make no recommendation as to points not within their jurisdiction, see *Ex parte Gillette* (1888), 44 O. G. 819.

That if the examiners-in-chief are of opinion that a different form of Claim from that rejected should be allowed they should annex to their decision a statement to that effect, with such recommendation as they think best, but the examiner is not bound by such recommendation, see *Ex parte Dysart* (1886), 34 O. G. 1390.

That the examiners-in-chief are not required to absolutely determine any form of Claim to be passed on by the examiner, see *Ex parte Dysart* (1886), 34 O. G. 1390.

That a mere suggestion of the exam-

iners-in-chief is not a recommendation, see *Ex parte Holt* (1886), 38 O. G. 229.

⁴ That primary examiners may refuse to act on the recommendation of the examiners-in-chief, but an appeal lies from the refusal, see *Ex parte Pearson* (1887), 40 O. G. 244.

That where the examiners-in-chief make a "recommendation," the party may propose the recommended matter to the primary examiner, and if he refuses, the commissioner may order it or the party may, after acceptance of the matter and a new rejection of the application, appeal, see *Ex parte Holt* (1887), 38 O. G. 229.

That if new references are cited by an examiner after appeal to the examiners-in-chief, the applicant may again appeal without a new fee, unless the new references are based on his amendment, see *Ex parte Dysart* (1886), 34 O. G. 1390.

That a mandamus will not lie to compel the Commissioner to allow an appeal from a decision of the examiner to the examiners-in-chief on a question of abandonment, pending an interference, it being a matter of his discretion,

appeal, like the former, is taken by written petition, setting up the judgment complained of and the reasons of appeal. If the Commissioner, in revising the decision of the examiners-in-chief, discovers any apparent grounds for granting or withholding a patent which are not presented by the appeal, he may at any time, either before or after final judgment, when in his opinion substantial justice requires it, give reasonable notice to the applicant, and if any amendment or other action based thereon shall be proposed, he will remand the case to the examiner for his consideration.¹ He may also at any time return the case to the examiner for further inquiry when any amendment is filed, or other action taken, in pursuance of the recommendation of the examiners-in-chief. From the decision of the examiner in remanded cases appeal lies to the examiners-in-chief upon matters of substance and to the Commissioner upon matters of form, according to the usual rule.²

§ 570. Appeal from Commissioner to Supreme Court of the District of Columbia.

From an adverse decision of the Commissioner on an appeal from the examiners-in-chief in *ex parte* cases, a further appeal may be had to the Supreme Court of the District of Columbia.¹ This appeal is taken by a written petition, duly signed and filed with the clerk of the court, accompanied by certified copies from the Patent Office of all the original papers and evidence in the case. On taking this appeal the appellant

see *Ex rel. Bigelow v. Thacher* (1875), 2 MacArthur, 24; 7 O. G. 603.

§ 569. ¹ That the Commissioner must take notice of an objection to patentability, however it may be brought to his notice, see *Ex parte Smoot* (1877), 11 O. G. 1010.

² That the primary examiner may refuse to act on, the recommendation of the Commissioner and an appeal will lie from such refusal, see *Ex parte Pearson* (1887), 40 O. G. 244.

§ 570. ¹ That in *ex parte* cases an appeal lies from the Commissioner to

the Supreme Court of the District, see *Kirk v. Commissioner* (1886), 37 O. G. 451; 5 Mackay, 229.

That the power to hear appeals, formerly vested in the Circuit Court of the District, now resides in the Supreme Court, see Opinion Atty. Gen. (1869), 13 Op. At. Gen. 79.

That an appeal lies from the Commissioner to the Supreme Court of the District of Columbia before suit brought in equity, except in interference cases, see *Butler v. Shaw* (1884), 21 Fed. Rep. 321.

must give immediate notice thereof to the Commissioner in writing, and file in the Patent Office a written statement of his reasons of appeal, which should be full and explicit and constitute a brief of the appellant's argument in support of his claims. The Commissioner must also furnish to the court the grounds of his decision, fully set forth in writing, touching all points embraced in the reasons of appeal. Notice of the time and place of hearing will be given by the court to the Commissioner and by him to the parties in interest, and upon the hearing the Commissioner or the examiner may be called upon to testify concerning the principles of the invention for which a patent is demanded. In reviewing the action of the Commissioner, the court must confine itself to the points set forth in the reasons of appeal,² and after judgment must return to the Commissioner a certificate of its proceedings and decision, which will be entered of record in the Patent Office, and will govern its further conduct of the case.³ This decision does not, however, preclude any person from contesting the validity of the patent thus awarded, in any court wherein it may be called in question.

§ 571. Remedy of Applicant in Equity after Final Rejection of his Application in the Patent Office.

Where the Supreme Court of the District of Columbia decides against the applicant on this appeal, he may pursue his remedy by bill in equity in the Circuit Court of the District.¹ A copy of the bill must be served on the Commis-

² That in other cases than interference cases the Supreme Court of the District is a mere court of appeal, and is confined to the issues raised in the reasons of appeal and to the evidence produced before the Commissioner, see *Butler v. Shaw* (1884), 21 Fed. Rep. 321; *In re Conklin* (1874), 5 O. G. 235; 1 MacArthur, 375.

That an appeal to the Supreme Court of the District from a decision on a Claim for apparatus is not affected by the intermediate issue of a patent for the process in which the apparatus is

used, see *Butler v. Shaw* (1884), 21 Fed. Rep. 321.

³ That the certificate of the decision of the Supreme Court of the District of Columbia on an appeal should be made and certified during the term of the justice, but may be forwarded to the Commissioner after the justice retires from office, see *Opinion Atty. Gen.* (1870), 13 Op. At. Gen. 265.

§ 571. ¹ Remedy by bill in equity to obtain a patent exists in *ex parte* cases after an appeal to the Supreme Court of the District has been adversely

sioner, and the court having cognizance thereof, after due hearing according to the usual course of equity proceedings, may adjudge that the applicant is entitled to a patent for the whole invention claimed, or for some separable part of it, as the facts may appear.² Such an adjudication will authorize

decided. It also exists where, on an appeal to the Commissioner in an interference proceeding, the applicant has been defeated. The doctrine and notes of this paragraph, (§ 571) apply chiefly to the former case. The latter is considered in § 604 and notes, *post*.

That under Sec. 4915 a bill in equity lies upon the refusal of a patent by the Commissioner or the Supreme Court of the District, see *In re Squire* (1877), 3 Bann. & A. 133.

That the remedy in equity to obtain a patent under Sec. 4915, applies only where the Commissioner or Court decides to reject an application on the ground that the applicant is not, on the merits, entitled to it, see *Butterworth v. Hoe* (1884), 112 U. S. 50 ; 29 O. G. 615.

That an applicant in an *ex parte* case is not entitled to a bill in equity until he has exhausted his remedies by appeal, see *Kirk v. Commissioner* (1886), 37 O. G. 451 ; 5 Mackay, 229.

That where the Patent Office rejects an application the remedy is by bill in equity, not mandamus, see *Hull v. Commissioner* (1875), 7 O. G. 559 ; 2 MacArthur, 90.

That where a patent is allowed by the Office, but the Commissioner, without denying the right of the applicant, refuses to issue it, mandamus will lie, see *Butterworth v. Hoe* (1884), 112 U. S. 50 ; 29 O. G. 615 ; and cases cited under § 583, note 3, *post*.

That the power of the Circuit Court to grant a patent upon a petition is independent of the powers of the Patent Office, see *Whipple v. Miner* (1883), 15 Fed. Rep. 117 ; 23 O. G. 2236.

It has been held that a bill in equity to obtain a patent could be brought in any circuit, and that the Commissioner might bind himself and his successors by appearing or accepting service. *Vermont Farm Mach. Co. v. Marble* (1884), 22 Blatch. 128 ; 27 O. G. 622 ; 20 Fed. Rep. 117. But the contrary has been decided by the Supreme Court of the United States in *Butterworth v. Hill* (1884), 114 U. S. 128 ; 31 O. G. 1043 ; where it is declared that the Commissioner's official residence is at Washington, that he can be sued only in the District of Columbia, and that he cannot waive the question of jurisdiction by appearance, consent, or default. Further, that a bill to obtain a patent must be brought in the Circuit Court for the District of Columbia, the courts of other districts having no power to enforce decrees against the Commissioner, see *Prentiss v. Ellsworth* (1846), 27 O. G. 623.

² For the form of a bill to obtain a patent after rejection by the Patent Office, and other proceedings, see *Ex parte Greely* (1873), 6 Fisher, 575.

That the Commissioner is not a necessary party to a bill in equity to obtain a patent, under Sec. 4915, where there is an opposing party, but a patentee who has transferred his interest must be made a party, see *Graham v. Teter* (1885), 25 Fed. Rep. 555.

That in a bill in equity against the Commissioner the Secretary is not a party, see *Kirk v. Commissioner* (1886), 37 O. G. 451 ; 5 Mackay, 229.

That a bill in equity to obtain a patent may be heard on any issues

the Commissioner to issue a patent to the applicant, upon his filing in the Patent Office a copy of the judgment, and otherwise complying with the requirements of the law.³

§ 572. Appeals in the Patent Office: their General Character and Effect.

An appeal in the Patent Office is not like a writ of error, or a motion for a new trial, but resembles an appeal in equity or admiralty, and does not require for its justification that the judgment appealed from should contradict the evidence.¹ Only questions that were properly within the jurisdiction of the inferior tribunal can be presented on appeal, and decisions affecting matters not within the cognizance of the Patent Office, such as matters of title, are not reviewable in any manner, but are simply void.² No appeal lies from a judgment wholly in favor of the appellant, nor from any judgment until it has been duly rendered in the required official form.³ The decisions of all inferior tribunals must be so ex-

and with any evidence, see *Butler v. Shaw* (1884), 21 Fed. Rep. 321.

That equity will not aid the inventor in procuring a patent under Sec. 4915, in violation of his agreement with others, see *Runstetler v. Atkinson* (1883), 23 O. G. 940.

That delay in suing in equity for a patent is delay in prosecuting an application, and the court may inquire into its reasonableness, see *Gandy v. Marble* (1887), 122 U. S. 432; 39 O. G. 1423.

That a petitioner on a bill in equity to obtain a patent, after a delay of more than two years since the last action, must allege and prove that the delay was unavoidable, see *Gandy v. Marble* (1887), 122 U. S. 432; 39 O. G. 1423.

¹ That a judgment in equity in a suit to obtain a patent binds only the parties and those who derive title from them, see *Butler v. Shaw* (1884), 21 Fed. Rep. 321.

That where the Commissioner is the only defendant in a suit under Sec.

4915, the plaintiff pays the costs, but where there are contesting parties costs follow the usual rule, see *Butler v. Shaw* (1884), 21 Fed. Rep. 321.

§ 572. ¹ That an appeal in the Patent Office is not like a writ of error, but like an appeal in equity or admiralty, see *Dickson v. Kinsman* (1880), 18 O. G. 1225; *Packard v. Sandford* (1879), 16 O. G. 1182.

That an appeal in the Patent Office is not like a motion for a new trial, and the judgment below need not contradict the evidence, see *Dickson v. Kinsman* (1880), 18 O. G. 1225.

That the court below did not give due weight to evidence is ground of appeal, see *Slade v. Blair* (1879), 15 O. G. 830.

² That no appeal lies from the refusal of the Commissioner to recognize an assignee as entitled to the patent, or on any other question of title, see *Whitely v. Fisher* (1870), 4 Fisher, 248.

³ That no appeal lies from a judg-

explicit that the subject of the appeal can be clearly distinguished.⁴ The appeal is limited to the issues apparent on the record, and brings up only the particular adjudications of which complaint is made.⁵ An appeal raising no issue will be summarily dismissed.⁶ If evidence is admitted during an appeal to support the claims of the applicant against the references and objections of the examiner, or to vary in any manner the issues of fact concerning the patentability of the invention, the whole case must be remanded to the examiner that he may pass upon it in its new condition. In an appeal from the examiners-in-chief to the Commissioner, he acts only in a judicial capacity and as a court of appellate jurisdiction.⁷ Cases decided by him on appeal will not be re-opened except by himself, and those which have been determined by his predecessors will not be reviewed except in accordance with the rules governing the granting of new trials.⁸ Cases decided by the examiners-in-chief cannot be reheard by them, when no longer pending before them, without the written authority of the Commissioner.⁹

§ 573. Interviews of Applicants with Examiners: Motions: Procedure.

The rules of the Patent Office generally direct that the communications between the Office and applicants or their

ment affirming patentability, see *Barney v. Kellogg* (1880), 17 O. G. 1096.

That a judgment is not effective until put into the proper official form, see *Ex parte Starr* (1879), 15 O. G. 1053.

⁴ That the judgment below must be explicit, see *Jenkins v. Barney* (1873), 3 O. G. 119.

⁵ That an appeal is limited to the issues apparent on the record, see *Ex parte Jones* (1874), 5 O. G. 585; *Jenkins v. Barney* (1873), 3 O. G. 119.

That on an appeal the presumption is in favor of the decision appealed from, see *Pockard v. Sandford* (1879), 16 O. G. 1182.

⁶ That an appeal raising no issue will be dismissed, see *Ex parte Everts* (1874), 5 O. G. 429.

⁷ That on an appeal from the ex-

aminers-in-chief, the Commissioner acts only in a judicial capacity, and as an appellate tribunal, see *Stone v. Greaves* (1880), 17 O. G. 397.

⁸ That one Commissioner cannot rehear a case decided by his predecessor except on new facts, see *Gill v. Scott* (1884), 29 O. G. 949.

⁹ That the Commissioner has power to revise the decisions of the examiners on motions for rehearings, but is less inclined to interfere when a rehearing is granted than when it is denied, see *Loring v. Hall* (1879), 15 O. G. 471.

That on a motion for rehearing the question is whether the former findings are unsupported by, or are in conflict with, the evidence, see *Gardner v. Dudley* (1880), 18 O. G. 683.

attorneys should take place in writing. Interviews with examiners concerning applications and other pending matters may, however, be had at the examiner's rooms, during office hours, or at any other time and place specially authorized by the Commissioner, although no personal discussion of a pending application is allowed until after the first official action thereon. Motions proper to be made at all must be made and determined by the tribunal before which the case is pending at the time;¹ cases being regarded as pending before a given tribunal until an appeal from its decision has been taken, or until the time for an appeal has expired. An appeal from an adverse decision on a motion must be taken to the Commissioner if the motion involves only matters of form, but to the examiners-in-chief if it relates to matters of substance. A motion once made and determined without appeal cannot be renewed on the same facts.² The conduct of each case is governed by the rules in force at its inception, unless new rules are adopted which can be followed without prejudice to the applicant, in which event the latter rules prevail.³ Changes in the nature or jurisdiction of any of the tribunals in the Patent Office do not interrupt the progress of pending applications, though the mode of their procedure may, to some extent, be changed.⁴

§ 574. Abandonment of Application: not Abandonment of the Invention.

The law requires the applicant to prosecute his application with reasonable diligence. After completing the invention he may delay the filing of his application at his pleasure;

§ 573. ¹ That a motion based on a statutory bar to the granting of a patent may be made to the tribunal having charge of the application, when no other mode for taking the objection has been provided, see *Barney v. Kellogg* (1880), 17 O. G. 1096.

² That a motion once decided without appeal cannot be renewed on the same facts, see *Little v. Lillie* (1876), 10 O. G. 543.

That a motion once absolutely denied

cannot be repeated without leave, see *Clemson v. Fowler* (1886), 37 O. G. 671.

³ That where a rule is changed pending an application, the proceedings will be governed by the new rule unless the applicant would be injured thereby, see *Fowler v. Benton* (1880), 17 O. G. 286.

⁴ That a change in the jurisdiction of a tribunal does not necessitate a beginning *de novo*, see *Colt v. Young* (1852), 2 Blatch. 471.

but having filed it he cannot suffer it to lie indefinitely in the Patent Office, unacted on, without abandoning it. This abandonment of the application is not, however, an abandonment of the invention.¹ By an abandonment of the invention the inventor loses all right to apply for and obtain a patent to protect it. By the abandonment of the application the inventor is placed in the same situation as if he had never filed one; and while he may again apply, his later application may be subject to objections which could not have been urged against the former, and in this manner indirectly his right to a patent may be lost. Thus a public use or sale, which would not have defeated the prior application, because not preceding it at least two years, may on account of the greater lapse of time become a bar to the latter; or a claim of want of novelty or of inventive skill, which could not have been sustained by the state of the art when the first application was filed, may be made good by the advanced state of the art at the date of the new application.² The abandonment of an

§ 574. ¹ That an abandonment of the application does not *ipso facto* abandon the invention, see *Lindsay v. Stein* (1882), 20 Blatch. 370; 10 Fed. Rep. 907; 21 O. G. 1613; *Ex parte Livingston* (1881), 20 O. G. 1747; *Clark v. Scott* (1872), 2 O. G. 4; 9 Blatch. 301; 5 Fisher, 245; *Bevin v. East Hampton Bell Co.* (1871), 9 Blatch. 50; 5 Fisher, 23; also § 353 and notes, *ante*.

That Sec. 4894 does not apply to the same cases as Sec. 4897, the former relating only to the abandonment of the application, see *Ex parte Golding* (1875), 8 O. G. 141; *Ex parte McCully* (1874), 6 O. G. 153.

That Congress can authorize the revival of an old application long after it is abandoned and a patent may then be granted thereon, the invention being examined in view of the state of the art when the application was originally filed, see *Graham v. Johnston* (1884), 21 Fed. Rep. 40.

That a delay in prosecuting an application, after it was erroneously re-

jected, was not abandonment of the invention before the act of 1870, see *Ex parte Stewart* (1873), 4 O. G. 665.

² That an application, filed after the abandonment of a prior one, is open to all objections arising since the prior application was filed, see *Ex parte Livingston* (1881), 20 O. G. 1747.

The effect of changes in the state of the art between the filing of the original and the renewed application is, of course, important only while the date of the application is regarded as the date of the applicant's inventive act. If publications, patents, or inventions, which have come into existence since his former application was filed, are cited against him, he may carry the date of his inventive act back of such advances in the art by extraneous proof, and thus maintain the patentability of his invention, so far as its novelty is concerned. The objection of an intermediate public use or sale cannot, however, be thus obviated, and may prove fatal to his claims.

application, therefore, can result in an abandonment of the invention only by the occurrence of circumstances, after it is filed and before the filing of a new one, which would have been fatal to any application had they transpired before it had been made; and the risk incurred by the inventor depends upon the fact that by the abandonment the date of the application on which his patent rests is transferred from the day on which the original application was filed to the day on which the new one was presented to the Patent Office. In the absence of such intervening circumstances, the trouble and expense of making the new application is the sole consequence of abandoning the former.³

§ 575. Application Abandoned by Unreasonable Delay: Delay of Two Years from "Last Action" Unreasonable.

Prior to the act of 1861 this question of the abandonment of the application by delay was determined upon general principles regarding diligence and good faith with the public. By that act, however, it was provided that all applications must be completed and prepared for examination within two years after the filing of the petition, and in default thereof should be considered as abandoned by the applicants, unless the Commissioner were satisfied that the delay was unavoidable. This provision was re-enacted in the act of 1870, and appears in the Revised Statutes, with the addition that a failure to prosecute the application within two years after any action thereon, of which notice has been given to the applicant, shall also work its abandonment.¹ It is thus made the

³ If the doctrine of estoppel is to be applied to a negligent inventor, either in favor of the public or a rival inventor, under the circumstances discussed in §§ 346 note 1, 357 note 3, and 390 note 3, *ante*, any unreasonable delay in prosecuting a pending application, which can affect adverse interests, may properly be brought within the same rule, and forfeit his right to any further consideration of his claims.

§ 575. ¹ In *Goodyear v. Hills* (1866), 3 Fisher, 134, Cartter, J.: (138) "Is

it the law that because an inventor files his application, which is refused by the Office, he may sleep upon his rights indefinitely, and that at any period in his lifetime, or that of his representatives, the application may be revived against the public? I think not. *Prima facie*, I think he would have to show a reason why he should be so permitted. The judgment of condemnation by the Office advertises to the country, at least, that he stands in no better position than before the application was made. The

duty of the applicant to complete his application by the presentation of all its parts to the Patent Office, and to prepare it for examination within two years after he files his petition, and also to take some active steps in prosecuting it within two years after the last action of the Office concerning it of which he has notice, under pain of having his application treated as abandoned, unless he can affirmatively satisfy the Commissioner that the delay could not have been avoided.² But this provision of the statutes does not confer upon the applicant a right to two years of inaction between each action of the Patent Office. Unreasonable delay for any period is still abandonment. These statutes merely declare that a delay of two years is *prima facie* unreasonable, and thus throw

country is advised, by the deliberation of the only tribunal provided by law for the ascertainment, at that stage of the invention, of his right, that he has none. More especially is he himself advised of that fact, for he is a party to the proceedings, and more immediately damaged by the rejection of the application. That rejection would at least be regarded, in the logic of equity, as a notice to him to proceed with diligence to traverse and reverse the judgment of the Office."

That under Sec. 4894 a failure to prosecute an application for two years abandons it, see *Ex parte Klenha* (1884), 28 O. G. 1272.

That under the provision in Sec. 35, act of 1870, allowing six months after the date of that act for the renewal of withdrawn or rejected applications, an application filed in 1845, withdrawn in 1847, and not subsequently acted on, became dead, see *Ex parte Cryer* (1880), 17 O. G. 452.

That this saving clause of the act of 1870 could be made available to the rejected applicant only by filing a formal renewal of the old application, see *Ex parte Gordon* (1874), 6 O. G. 543.

That the omission of Sec. 35, act of 1870, from the Revised Statutes did not

revive applications that were abandoned under it, see *Davies v. Hartman* (1876), 9 O. G. 351.

That an assignee is bound to the same diligence as an inventor, see *Fire Extinguisher Mfg. Co. v. Graham* (1883), 24 O. G. 793; 16 Fed. Rep. 543.

² That under Sec. 4894 (Sec. 32, Act 1870), a rejected application is abandoned if not prosecuted within two years, but a new one may be filed which will stand alone, unaided by the other on questions of abandonment, see *Lindsay v. Stein* (1882), 20 Blatch. 370; 21 O. G. 1613; 10 Fed. Rep. 907.

That eight years' delay after the rejection of an application without renewing it, other patents for substantially the same invention being granted meanwhile, operates as an abandonment, see *United States Rifle & Cartridge Co. v. Whitney Arms Co.* (1886), 118 U. S. 22; 35 O. G. 873.

That a rejected application leaves the applicant where he was when the application was made, but notifies him to proceed with due diligence, see *Goodyear v. Hills* (1866), 3 Fisher, 134.

That an abandoned application is not further noticed by the Patent Office, see *Ex parte Casilear* (1875), 8 O. G. 474.

upon the applicant the burden of proving that in his particular case the delay was justified.³ In discussing them it will be sufficient to inquire what is meant by the "last action" of the Patent Office; what degree and duration of inactivity on the part of the applicant will abandon his application; and what reasons are sufficient to excuse delay. Whatever concerns the completion of the application and its preparation for examination has been already considered in its proper place.

§ 576. "Last Action" Defined.

The "last action," from which the period of two years dates, is the last interlocutory action of the Patent Office

³ In *Planing Machine Co. v. Keith* (1879), 101 U. S. 479, Strong, J.: (485) "The Patent Law favors meritorious inventors by conditionally conferring upon them for a limited period exclusive rights to their inventions. But it requires them to be vigilant and active in complying with the statutory conditions. It is not unmindful of possibly intervening rights of the public. The invention must not have been in public use or on sale more than two years before the application for a patent is made, and all applications must be completed and prepared for examination within two years after the petition is filed, unless it be shown to the satisfaction of the Commissioner that the delay was unavoidable. All this shows the intention of Congress to require diligence in prosecuting the claims to an exclusive right. An inventor *cannot without cause* hold his application pending during a long period of years, leaving the public uncertain whether he intends ever to prosecute it, and keeping the field of his invention closed against other inventors. It is not unfair to him, after his application for a patent has been rejected, and after he has for many years taken no steps to re-instate it, to renew it, or to appeal, that it should be

concluded that he has acquiesced in the rejection and abandoned any intention of prosecuting his claim further. Such a conclusion is in accordance with common observation. Especially is this so when, during those years of his inaction he saw his invention go into common use, and neither uttered a word of complaint or remonstrance, nor was stimulated by it to a fresh attempt to obtain a patent. When in reliance upon his supine inaction the public has made use of the result of his ingenuity, and has accommodated its business and its machinery to the improvement, it is not unjust to him to hold that he shall be regarded as having assented to the appropriation, or, in other words, as having abandoned the invention. There may be, it is true, circumstances which will excuse delay in prosecuting an application for a patent after it has been rejected, — such as extreme poverty of the applicant, or protracted sickness." 17 O. G. 1031 (1033).

That no unreasonable delay in prosecuting the application can be permitted, see *Planing Mach. Co. v. Keith* (1879), 101 U. S. 479; 17 O. G. 1031; *Hanscom v. Latham* (1876), 9 O. G. 1157; *Marsh v. Sayles* (1872), 2 O. G. 340; 5 Fisher, 610.

affecting the progress of the application, followed by the mailing of a notice of such action to the applicant.¹ Such mere ministerial acts as sending a letter in reply to a request for information, or for the return of papers or a model, do not constitute the action mentioned in the statute.² Every application pending in the Patent Office is presumed to be awaiting some act, either on the part of the Office or of the applicant, which will advance it to the next stage of the proceedings; and the action performed by the Office in its turn, and rendering it necessary for the applicant to act in order that further progress may be made, is the "last action" from which the period of his delay must be computed. A "suspension of action" by the Office implies further action, and does not constitute the "last action" here described.³

§ 577. "Inaction" of Applicant Defined.

The "inaction" of the applicant is, correspondingly, his failure to perform the act devolving upon him in order to advance his case. Whatever else he may do is of no consequence in reference to this question. Letters of general inquiry, the presentation of unimportant amendments, and other similar acts do not prevent the two years from running against his application.¹ His action must be one which renders it incumbent on the Office to take action in its turn, or

§ 576. ¹ That in a rejected application the "last action" of the Patent Office is the mailing of the last letter of rejection to the applicant, and unless he takes further action, within two years from that date, the application is abandoned, see *Ex parte* Blake (1873), 3 O. G. 2.

² That "last action" is some action affecting the merits of the case, not mere ministerial action, see *Ex parte* Graham (1873), 3 O. G. 211.

That an answer to a request to return a model is not "last action," see *Ex parte* Lee (1874), 5 O. G. 58.

³ That "suspension of action" implies further action, see *Ex parte* Hull (1875), 9 O. G. 1.

§ 577. ¹ That after final rejection, without appeal, unimportant amendments will not keep the application alive in the Patent Office, see *Ex parte* Jenks (1878), 14 O. G. 747.

That irregular and illegal modes of procedure do not keep an application alive and prevent its abandonment, see *Kirk v. Commissioner* (1886), 37 O. G. 451; 5 Mackay, 229.

That the suspension of an application at the request of the applicant, and at his option to proceed with it, is "inaction," and unless taken up within two years it is abandoned, see *Ex parte* Norton (1888), 42 O. G. 296.

the delay is clearly imputable to him and he must bear the loss which it entails.² In computing the two years of his inactivity, the day on which the "last action" of the Patent Office was performed is excluded.³

§ 578. Unavoidable Delay not Unreasonable.

The inaction of the applicant, however protracted, cannot prejudice his application if the delay was unavoidable. Of this the Commissioner is made the final judge, though the question as to an abandonment of the invention itself by an unreasonable delay of the application in the Patent Office may always be raised and adjudicated in the courts.¹ No applicant can justly be regarded as responsible for a delay which he could not avoid. If he is urging his application as rapidly as under all the circumstances he is able to do, he cannot be considered as abandoning it.² Thus poverty or sickness, or

² That a bill in equity to obtain a patent, though not a technical appeal from the Patent Office but a true suit in equity, is still a part of the application for a patent, see *Gandy v. Marble* (1887), 122 U. S. 432; 39 O. G. 1423.

That delay in filing a bill in equity to obtain a patent for more than two years since the last action must be shown to be unavoidable, or it will work an abandonment, see *Gandy v. Marble* (1887), 122 U. S. 432; 39 O. G. 1423.

³ That in computing the two years the day of "last action" is excluded, see *Ex parte Musser* (1879), 16 O. G. 858.

§ 578. ¹ That the decision of the Commissioner, that delay in prosecuting an application was unavoidable, is final, see *U. S. Rifle & Cartridge Co. v. Whitney Arms Co.* (1877), 14 Blatch. 94; 11 O. G. 373; 2 Bann. & A. 493; *McMillin v. Barclay* (1871), 5 Fisher, 189; 4 Brews. (Pa.) 275.

That under Sec. 489½ the Commissioner's discretion is judicial, not a mere whim, and the evidence must show that the delay was unavoidable,

see *Ex parte Chapman* (1884), 29 O. G. 950.

That "unavoidable delay" must be clearly proved, see *Ex parte Klenha* (1884), 28 O. G. 1272.

That under Sec. 4894 the evidence is to be heard by the Commissioner in person, see *Smith v. Dimond* (1881), 20 O. G. 742.

That too great leniency to delaying applicants, to the prejudice of the public, must not be allowed, see *Ex parte Klenha* (1884), 28 O. G. 1272.

That the decision of the Commissioner, that the invention has not been abandoned by delays in the application, is not conclusive on the courts, see *Planing Mach. Co. v. Keith* (1879), 101 U. S. 479; 17 O. G. 1031; *U. S. Rifle & Cartridge Co. v. Whitney Arms Co.* (1877), 14 Blatch. 94; 11 O. G. 373; 2 Bann. & A. 493.

² That if the applicant is prosecuting his case as rapidly as he is able, no delay will abandon it, see *Ex parte Barnitz* (1887), 41 O. G. 575; *Good-year Dental Vulcanite Co. v. Smith* (1874), 5 O. G. 585; *Holmes*, 354;

inevitable absence from the United States, or legal inability to pursue his rights, have been held sufficient to relieve him from the consequence of his delay.³ Where the inaction is not truly his own but is ultimately due to the errors or misconduct of other persons, either without his knowledge or beyond his control, he ought not, and is not compelled, to suffer its results. Hence delays in the Patent Office not attributable to him nor acquiesced in by him,⁴ mistakes in the Patent Office which induce him not to act where a correct decision would have led him to exercise due diligence,⁵ and the neglect of his attorney to obey his orders,⁶ have been accepted as excuses

1 Bann. & A. 201; *Ex parte* Leavitt (1873), 3 O. G. 212.

That "unavoidable" delay in prosecuting an application is such delay as prudent and diligent men, using the ordinary agencies, would not have overcome, for the law does not compel parties to resort to unusual methods, see *Ex parte* Pratt (1887), 39 O. G. 1549.

That "unavoidable delay" means hindrance by circumstances over which the inventor had no control, see *Ex parte* Klenha (1884), 28 O. G. 1272.

That delay unaccompanied by any effort to avoid it is not unavoidable, see *Smith v. Dimond* (1881), 20 O. G. 742.

That "unavoidable" delay in prosecuting an application means unavoidable during the entire two years, see *Ex parte* Root (1887), 40 O. G. 811.

³ That poverty, sickness, and other causes may excuse delay, and save the application, see *Planing Mach. Co. v. Keith* (1879), 101 U. S. 479; 17 O. G. 1031.

That poverty, etc., is an excuse only when it prevents action, see *Ex parte* Klenha (1884), 28 O. G. 1272.

That involuntary absence from the country excuses delay, see *Weston v. White* (1876), 13 Blatch. 447; 2 Bann. & A. 364.

See also § 353 and notes, *ante*.

⁴ That delays in the Patent Office do not abandon the application, unless

acquiesced in by the applicant, see *Colgate v. Western Union Telegraph Co.* (1878), 14 O. G. 943; 4 Bann. & A. 36; 15 Blatch. 365; *Smith v. Goodyear Dental Vulcanite Co.* (1876), 93 U. S. 486; 11 O. G. 246; *Jones v. Sewall* (1873), 6 Fisher, 343; 3 O. G. 630; 3 Clifford, 563; *Johnsen v. Fassman* (1872), 1 Woods, 138; 5 Fisher, 471; 2 O. G. 94; *Singer v. Braunsdorf* (1870), 7 Blatch. 521; *Dental Vulcanite Co. v. Wetherbee* (1866), 2 Clifford, 555; 3 Fisher, 87; *Sayles v. Chicago & Northwestern R. R. Co.* (1865), 1 Bissell, 468; 2 Fisher, 523; *Adams v. Jones* (1859), 1 Fisher, 527; *Bell v. Daniels* (1858), 1 Bond, 212; 1 Fisher, 372; *Rich v. Lippincott* (1853), 2 Fisher, 1.

That if the applicant acquiesces in a delay of the Patent Office, his application may thereby be abandoned, see *Bevin v. East Hampton Bell Co.* (1871), 5 Fisher, 23; 9 Blatch. 50.

That a delay while an interference is pending is not abandonment, see *Taylor v. Shreffler* (1883), 24 O. G. 1175.

⁵ That a mistake in the Patent Office, inducing inaction, does not abandon the application, see *Colgate v. Western Union Telegraph Co.* (1878), 14 O. G. 943; 15 Blatch. 365; 4 Bann. & A. 36; *Weitling v. Cabell* (1872), 2 O. G. 223.

⁶ That delay caused by the attor-

for an inaction which otherwise would have been fatal to his application. But where he has been led to his delay by motives of personal interest, or even by more indifference to the rights of others, he must be held strictly to its penalties.⁷ He cannot be relieved upon the ground that his pecuniary interests would not have been advanced by his compliance with the law, nor that other voluntary occupations, however profitable to himself or others, have engrossed his capital or his time.⁸

§ 579. **Abandonment of Application by Express Declaration of the Applicant.**

An application may be abandoned not only by unreasonable delay in completing or prosecuting it, but by the express act of the applicant.¹ Such an abandonment must be in writing, describing the application by the title of the invention and the date of the filing, signed by the applicant in person, and filed in the Patent Office.² The presentation of a new application for the same invention does not withdraw or abandon the original, but each is accepted and treated by the Office as independent of the others, unless the later be offered as an amendment to, or a substitute for, the former.³ An aban-

ney, and not acquiesced in by the applicant, does not abandon the application, see *Howes v. McNeal* (1878), 15 O. G. 608 ; 15 Blatch. 103 ; 3 Bann. & A. 376 ; *Weston v. White* (1876), 13 Blatch. 447 ; 2 Bann. & A. 364.

That a party may rely on trustworthy employees, and if they fail unexpectedly, it is "unavoidable," see *Ex parte Pratt* (1887), 39 O. G. 1349.

⁷ That the present pecuniary worthlessness of an invention does not excuse delay in prosecuting the application, see *Ex parte Woodbridge* (1879), 15 O. G. 564.

⁸ See § 387 and notes, *ante*.

§ 579. ¹ That the cancellation of all the Claims is abandonment, see *Ex parte Lasscell* (1884), 29 O. G. 861 ; 28 O. G. 1274.

² That the Patent Office may re-

quire an abandonment to be stated in terms, and in default thereof an amendment cancelling all Claims may be rejected by the examiner, see *Ex parte Lasscell* (1884), 29 O. G. 861.

That a power of attorney, giving him full authority to amend, does not authorize him to withdraw all the Claims and so destroy the application, see *Ex parte Lasscell* (1884), 28 O. G. 1274.

³ That a pending application is not affected by a subsequent application for the same invention by the same inventor, nor does the later abandon the earlier application, see *Ex parte Langlois* (1878), 14 O. G. 84.

That the filing of a second application, describing but not claiming the improvement claimed in the former application, does not abandon such improvement to the public nor affect the

doned application has no legal existence or validity for any purpose. It cannot aid a subsequent one by carrying back the date of application, nor is it further noticed by the Patent Office.⁴

§ 580. **Withdrawal and Substitution of Applications.**

At any time before the final rejection or allowance of an application it may be withdrawn by the applicant, and a new application may be filed containing a new specification, oath, and drawing, and accompanied by a new fee.¹ Also, after the final rejection of an application, a new one may be filed in the same manner, though the rejected application cannot be withdrawn. In both these cases, the relation of the new application to the old depends upon the question of abandonment. If the original application were abandoned it can never be revived;² and in that case, or when the filing of the

prior application, see *Suffolk Co. v. Hayden* (1865), 3 Wall. 315.

That after a rejected application has lain unnoticed for several years, and a new and independent application for the invention is filed, the later is regarded as a final abandonment of the former, see *Ex parte Gordon* (1874), 6 O. G. 543.

¹ That an abandoned application is no longer noticed by the Patent Office, see *Ex parte Casilear* (1875), 8 O. G. 474. See also § 559, note 4, *ante*.

§ 580. ¹ That under the act of 1836 a request for the return of the fee was not of itself a withdrawal of the application, see *Colgate v. Western Union Telegraph Co.* (1878), 15 Blatch. 365; 14 O. G. 943; 4 Bann. & A. 36; *Ex parte Sexton* (1876), 9 O. G. 251.

That the filing of a second application is not necessarily a withdrawal of the first, see *Colgate v. Western Union Telegraph Co.* (1878), 15 Blatch. 365; 14 O. G. 943; 4 Bann. & A. 36.

For a review of the cases on the withdrawal of applications, see *Colgate v. Western Union Telegraph Co.* (1878),

15 Blatch. 365; 14 O. G. 943; 4 Bann. & A. 36.

² That an application once abandoned can never be revived, see *Ex parte Mayor* (1878), 13 O. G. 912; *Marsh v. Sayles* (1872), 5 Fisher, 610; 2 O. G. 340.

That an abandonment of the invention by a final withdrawal of the application is an abandonment to the public, not to rival inventors, see *Consolidated Fruit Jar Co. v. Bellaire Stamping Co.* (1886), 27 Fed. Rep. 377; 35 O. G. 627.

That on a question of abandonment of the invention by the withdrawal of the application the lapse of time is of great weight, if not conclusive, see *Consolidated Fruit Jar Co. v. Bellaire Stamping Co.* (1886), 27 Fed. Rep. 377; 35 O. G. 627.

That a delay of fifteen years after the withdrawal of an application is abandonment of the invention, see *Consolidated Fruit Jar Co. v. Bellaire Stamping Co.* (1886), 27 Fed. Rep. 377; 35 O. G. 627.

That where eight years have elapsed

new has been unreasonably delayed or delayed beyond the two years named in the statute without an excuse satisfactory to the Commissioner, the later application must stand wholly upon its own merits on all points, including those of the novelty and the abandonment of the invention.³ If the original applications were not abandoned, and if the new ones have been filed without unreasonable delay and within the two years limited by law, they are regarded as substitutes for and as continuations of the former, and on all questions of novelty and abandonment their dates relate back to the dates of the originals.⁴

since the former application was withdrawn, and others have meanwhile patented the same thing and the applicant has patented other things, the application is abandoned, see *U. S. Rifle & Cartridge Co. v. Whitney Arms Co.* (1877), 14 Blatch. 94; 11 O. G. 373; 2 Bann. & A. 493.

That an application being abandoned, a new one may be filed, see *Ex parte Crompton* (1876), 9 O. G. 5; *Davies v. Hartman* (1876), 9 O. G. 351; *Ex parte Golding* (1875), 8 O. G. 141; *Ex parte Casilear* (1875), 8 O. G. 474.

That after one application has been rejected, a new one cannot be filed except as a renewal of the former, see *Ex parte Sexton* (1873), 3 O. G. 409; *contra, Ex parte Sexton* (1876), 9 O. G. 251.

That after the rejection of an application by the Supreme Court of the District it is not renewable, though a new one may be filed, see *Ex parte Gordon* (1874), 6 O. G. 543.

³ In *Lindsay v. Stein* (1882), 20 Blatch. 370, Blatchford, J. : (376) "The defendant contends that the effect of the act of 1870 is, that when an application is, under § 32, to be regarded as abandoned, no new application for a patent for the same thing can be subsequently made. There is nothing to prevent a subsequent application. When made, it can derive no aid, as to time, from the prior abandoned appli-

cation, and the applicant must stand, as to defences in suits on the patent, as if the new application were the first application." 10 Fed. Rep. 907 (913); 21 O. G. 1613 (1615).

That where a former application has been abandoned, and a new one is substituted for it, the later must be examined on its own merits by the state of the art at its date, see *Ex parte Gordon* (1874), 6 O. G. 543; *Ex parte Lo Van* (1872), 1 O. G. 226.

That the intention of an applicant to sever his applications will be regarded, and notice taken of the last only, see *Ex parte Golding* (1875), 8 O. G. 141.

⁴ In *Godfrey v. Eames* (1863), 1 Wall. 317, Swayne, J. : (325) "In our judgment, if a party choose to withdraw his application for a patent, and pay the forfeit, intending at the time of such withdrawal to file a new petition, and he accordingly do so, the two petitions are to be considered as parts of the same transaction, and both as constituting one continuous application, within the meaning of the law."

That an application filed within a reasonable time after a prior application has been withdrawn or rejected, but not abandoned, is regarded as the successor to and continuation of the original application, see *Ex parte Livingston* (1881), 20 O. G. 1747; *Graham v. McCormick* (1880), 5 Bann. & A.

Whether or not two applications are continuous is a question of fact, to be decided by the circumstances of the case.⁶

244 ; 10 Bissell, 39 ; 21 O. G. 1533 ; 11 Fed. Rep. 859 ; *Ex parte* Sexton (1876), 9 O. G. 251 ; *Weston v. White* (1876), 13 Blatch. 447 ; 2 Bann. & A. 364 ; *Goodyear Dental Vulcanite Co. v. Willis* (1874), 7 O. G. 41 ; 1 Bann. & A. 568 ; 1 Flippin, 388 ; *Goodyear Dental Vulcanite Co. v. Root* (1874), 1 Bann. & A. 384 ; 6 O. G. 154 ; *Smith v. Prior* (1873), 2 Sawyer, 461 ; 6 Fisher, 469 ; 4 O. G. 633 ; *Blandy v. Griffeth* (1869), 3 Fisher, 609 ; *Howe v. Newton* (1865), 2 Fisher, 531 ; *Rich v. Lippincott* (1853), 2 Fisher, 1 ; *Adams v. Edwards* (1848), 1 Fisher, 1.

That though twenty years elapse in making successive applications, and endeavoring to secure a patent, the applications may be continuations of the original, see *Colgate v. Western Union Telegraph Co.* (1878), 15 Blatch. 365 ; 14 O. G. 943 ; 4 Bann. & A. 36.

That where a second application is made for part of an invention disclosed in a former and still pending application, the later is a continuation of the former so far as the question of two years' public use is concerned, see *Graham v. McCormick* (1880), 21 O. G. 1533 ; 10 Bissell, 39 ; 11 Fed. Rep. 859 ; 5 Bann. & A. 244.

That where an application has been withdrawn and the attorney is directed to file a new one but fails to do so within reasonable time, and one is afterwards filed and accepted by the Patent Office, they are regarded as the same, and no intermediate public use will work abandonment of the invention, see *Howes v. McNeal* (1878), 15 Blatch. 103 ; 15 O. G. 608 ; 3 Bann. & A. 376.

That applications are not continuous if the interval of delay was avoidable, see *Smith v. Dimond* (1881), 20 O. G. 742.

That a delay of eighteen years without action, after rejection, is abandonment, see *Marsh v. Commissioner* (1872), 3 Bissell, 321.

That an application filed ten years after the withdrawal of its predecessor, no action being meanwhile taken, is not a continuation of the original, see *Bevin v. East Hampton Bell Co.* (1871), 9 Blatch. 50 ; 5 Fisher, 23.

That the continuity of two applications may be interrupted without a technical withdrawal, see *Bevin v. East Hampton Bell Co.* (1871), 9 Blatch. 50 ; 5 Fisher, 23.

That when applications are continuous they take the date of the original on questions of novelty and abandonment, see *Henry v. Frankestown Soap-Stone Stove Co.* (1876), 2 Bann. & A. 221 ; 9 O. G. 408 ; *Howard v. Christy* (1876), 2 Bann. & A. 457 ; 10 O. G. 981 ; *Ex parte* Gordon (1874), 6 O. G. 543.

That where a substituted specification covers a different invention its date is the date of the application, as compared with that of a foreign patent, see *Globe Nail Co. v. Superior Nail Co.* (1886), 27 Fed. Rep. 450.

That an application, substituted for one already filed at the instance of the Patent Office, dates from the filing of the former as to the question of public use, see *International Tooth Crown Co. v. Richmond* (1887), 30 Fed. Rep. 775 ; 39 O. G. 1550.

⁶ In *Weston v. White* (1876), 13 Blatch. 447, Shipman, J. : (452) "The continuity of the two applications is a question of fact, to be determined, in each case, upon an examination of its own circumstances. In order to ascertain this fact, the trier will find whether the inventor has abandoned his original application, either by his own will, or

§ 581. **Substituted Applications are Continuations of the Original and Bear its Date.**

It is immaterial how many of these substituted applications may be filed, or for how long a period such efforts to obtain a patent may be continued. The patent, when granted, will rest on the original application, as represented in its various successors, unaffected by the intermediate conduct of third parties or the current of events, unless some legislative act, embracing it in its provisions, has been passed.¹ New applications, after rejection or withdrawal, may be made by the original applicant, or if he has meanwhile deceased, by his personal representatives.²

§ 582. **Allowance of Patent: Notice to Applicant.**

Whenever by the decision of the examiner, or on appeal, it appears that the applicant is entitled to a patent, a notice of its allowance is sent to him, calling for the payment of the final fee within the period of six months as required by the statute, and if the fee is paid within this period the patent is prepared for issue. Until such notice to the applicant the patent is not "allowed" within the meaning of the law, nor does the case pass beyond the examiner's control, nor does the six months' period begin.¹ After notice is given of an allow-

by his acts, and whether the new application is substantially for the same invention which was originally claimed. If the two applications are found to be continuous, and it has been therefore proved that the delay in making the new application, after the rejection of the first, has not been unreasonable, under the circumstances of the case, and if the invention has not been abandoned to the public, the public use, in order to invalidate the patent, must be a use prior to the original and continuing application. Public or common use subsequent to the date of the original application, if that has been a continuing one, and the two petitions are 'parts of the same transaction,' will not avoid the patent." 2 Bann. & A. 364 (368).

See also *Bevin v. East Hampton Bell Co.* (1871), 5 Fisher, 23; 9 Blatch. 50.

§ 581. ¹ That in a series of applications the first is the one on which the patent depends, see *Pelton v. Waters* (1874), 7 O. G. 425; 1 Bann. & A. 599.

² That when an inventor dies pending an application, his administrator or executor may file a new one, if such course does not affect the rights of third parties, see *Rice v. Burt* (1879), 16 O. G. 1050.

§ 582. ¹ That a patent is not "passed and allowed" until the applicant or his agent is so notified under Sec. 4885, and up to that date the case is still controlled by the examiner, see *Ex parte Starr* (1879), 15 O. G. 1053.

That the formal judgment of the ex-

ance the case will not be withdrawn from issue except on the approval of the Commissioner, and if withdrawn for further action on the part of the Patent Office, and then allowed, a new notice of allowance must be given. After the final fee has been paid, and the case has received its date and number, it cannot be withdrawn for any purpose except on account of mistake on the part of the Office, or fraud or illegality in the application, or for interference proceedings. For these purposes the application is regarded as pending until the letters-patent are delivered.²

§ 583. Allowance of Patent not Binding on Commissioner until Letters-Patent are Issued: Mandamus.

The allowance of an application by the examiner, or by the examiners-in-chief upon appeal, does not oblige the Commissioner to grant the patent for which it prays. The law empowers him to withhold a patent whenever in his judgment the invention is not patentable, or the issue of the patent is forbidden by the statutes, or the patent if granted would probably be held invalid by the courts.¹ This power is not to be exer-

aminer is expressed by signing the file-wrapper and sending it to the Issue Division, and until this is done the case is under his control, see *Ex parte Buell* (1884), 26 O. G. 437.

That until the file-wrapper is signed and the application forwarded to the Issue Division the case is not decided by the examiner, whatever opinion he may have expressed or whatever advice his predecessor may have given, see *Ex parte Fredericks* (1887), 40 O. G. 691.

² That an application is pending until the patent is actually delivered, see *Ex parte Lawrence* (1879), 16 O. G. 955.

§ 583. ¹ In *Ex parte Hunt* (1878), 13 O. G. 771, Schurz, Sec. : (771) "Until the seal is affixed the patent is not complete, and whether it shall be affixed or not in a given case, or in any case, where the merits of the application are directly brought to your attention, is a question which you must judicially

determine in the discharge of your official duty. After a patent is regularly allowed and signed, however, this right to refuse the attaching of the seal, so as to give the patent validity, should not be exercised except in extreme cases, where to attach it would be manifestly a violation of your duty as a public officer ; but where, as in this case, it appears that the patent, erroneously allowed by one of your subordinates, contains Claims which are neither novel nor meritorious and are manifestly old, although no fraud has been practised, I am of the opinion that it is your duty, although the patent may have been signed, to withhold the seal of your Office."

In *Hull v. Commissioner* (1875), 7 O. G. 559, Wylie, J. : (559) "The first question for the court to determine in the present case is this : Whether, *in an ex parte application* for a patent, the Commissioner possesses any author-

cised unnecessarily, nor to delay the patent in order that some collateral controversy may be judicially determined.² The remedy of the applicant against the Commissioner for an im-

ity, under the law, to withhold a patent in opposition to the report of a primary examiner, or the report of the Board of Examiners-in-Chief in its favor; in other words, whether, in such a case, the decision of the primary examiner, if favorable to the patent, is conclusive upon the Office, and if unfavorable, and the applicant has carried his case by appeal before the Board of Examiners-in-Chief, and there obtained a favorable decision, this latter decision is conclusive, so that nothing is left to the Commissioner except the ministerial act of countersigning and affixing the seal of the Office to the parchment. The petitioner for this writ claims that, according to the organization of the Patent Office, the question of the patentability of an alleged invention is to be referred for examination first to one of the primary or assistant examiners. If his decision be unfavorable, the applicant has the right to appeal to the examiners-in-chief. If their decision should also be unfavorable, he has the right of appeal to the Commissioner; and should the Commissioner's decision be unfavorable, the right of still further appeal to this court. In all this the petitioner's views of the law are correct; but he also claims that because his application is *ex parte*, and no one can take the appeal but himself, and nobody will ever appeal from a decision in his own favor, that the first favorable decision he obtains at any stage of the proceedings must be conclusive on the Office, since the case can go no further except by appeal. This view of the law we think is not correct." 2 MacArthur, 90 (102).

See also Opinion Atty. Gen. (1849), 5 Op. At. Gen. 220.

That under Sec. 4885 the Commissioner alone is to award the patent, and

he should withhold it even when the application has been allowed by the examiners if he considers its issue unlawful, see *Ex parte Neale* (1870), 15 O. G. 511; *Smith v. Perry* (1875), 9 O. G. 688.

That the knowledge of the Commissioner that the patent ought not to issue must be legal knowledge derived from sources recognized as evidence by the courts, see *Smith v. Perry* (1875), 9 O. G. 688.

That after the Commissioner has decided that an applicant is entitled to a patent he may reconsider his decision and withhold the patent for reasons satisfactory to himself, and no mandamus can then compel him to issue it, see *United States v. Butterworth* (1884), 3 Mackay, 229; 27 O. G. 519.

² That the Commissioner should not withhold a patent after the application has been allowed by the examiner, unless he deems it necessary, see *Disston v. Frank* (1872), 1 O. G. 305.

That an allowed application cannot be suspended by the Office unless some reference, publication, public use, or interference is alleged, see *Ex parte Atwood* (1888), 44 O. G. 341.

That the Commissioner should not withhold a patent merely to allow other proceedings in court to be determined, see *Ex parte Sargent* (1877), 12 O. G. 475.

That the relation between a process and its apparatus is not that of genus and species, and an application for the former cannot be suspended after allowance on the ground of an interference between an application for its apparatus and other apparatus, see *Ex parte Atwood* (1888), 44 O. G. 341.

That a patent cannot be withheld on moral grounds, see Opinion Atty. Gen. (1812), 1 Op. At. Gen. 170.

proper exercise of this power is by a writ of mandamus, directing the Commissioner to award the patent. A mandamus will not be granted to compel the Commissioner to perform acts which the law leaves to his discretion.³ When granted it is conclusive only on the Patent Office and the public, not on other claimants of the invention.⁴

§ 584. Application Forfeited by Failure of Applicant to Pay Final Fee: Application after Forfeiture.

The failure of the applicant to pay the final fee within six months after the notice of allowance forfeits the application,

³ That where the Commissioner refuses to issue a patent which he has once properly allowed, the remedy is by mandamus unless his refusal is based on a matter within his judicial discretion, see *Butterworth v. Hoo* (1884), 112 U. S. 50; 29 O. G. 615; *Hull v. Commissioner*, (1875), 7 O. G. 559; 2 *MacArthur*, 90.

That a mandamus will not lie against the Commissioner when the matter is within his discretion, see *United States v. Marble* (1882), 22 O. G. 1365; *Bigelow v. Commissioner* (1875), 7 O. G. 603; 2 *MacArthur*, 24.

That if the Commissioner having decided to issue a patent does not change his decision, and still unreasonably delays to issue the patent, a mandamus will lie, see *United States v. Butterworth* (1884), 3 *Mackay*, 229; 27 O. G. 519.

That the delay of the Commissioner to let the opinion of the Secretary of the Interior be taken is not an act of discretion but of deference, and a mandamus will lie, see *United States v. Butterworth* (1884), 3 *Mackay*, 229; 27 O. G. 519.

That a Commissioner, having made return to a mandamus that he withholds the patent merely to await the action of the Secretary of the Interior, cannot afterwards claim that he desires to rehear the case himself, see *Gill v. Scott* (1884), 29 O. G. 949.

That proceedings will not lie against

the Commissioner unless he refuses to issue the patent after the Secretary of the Interior has signed it, see *Whitely v. Fisher* (1870), 4 *Fisher*, 248.

That a mandamus against the Commissioner pending in the Supreme Court of the District, to which the Commissioner has duly made his return, is not affected by the laches of the petitioner, see *Withington v. Locke* (1878), 15 O. G. 426.

That the resignation of the Commissioner, after a return made on the mandamus, will abate it, see *Withington v. Locke* (1878), 15 O. G. 426.

That the refusal of the Commissioner to award a patent, on grounds within his discretion, may be reviewed by a bill in equity, see *Hull v. Commissioner* (1875), 7 O. G. 559; 2 *MacArthur*, 90.

That on a bill in equity the courts may authorize but cannot compel the Commissioner to issue a patent, see *Vermont Farm Machine Co. v. Marble* (1884), 20 *Fed. Rep.* 117; 22 *Blatch.* 128; 27 O. G. 622.

That a bill in equity to obtain a patent is not a substitute for a mandamus, see *United States v. Butterworth* (1884), 3 *Mackay*, 229; 27 O. G. 519.

⁴ That where the court orders the Commissioner to issue a patent the order is conclusive only against the public, not against other applicants, see *Cruikshank v. Strong* (1880), 17 O. G. 511.

and no patent can be issued thereon. At any time, however, within two years after the notice of allowance has been given, the applicant, or any other person interested in the invention as its inventor or assignee, may file a new application for the same invention, using the original oath, petition, specification, drawing and model, if he pleases, but paying a new fee.¹ This second application is not considered as a continuation of the former, but will bear date from the time of the renewal, and will be examined and passed upon like an original application.² In its examination the novelty of the invention will be determined by the state of the art when the original was filed, not by its present state as in the case of an application wholly new, and the question of abandonment will be investigated and de-

§ 584. ¹ That where a patent has been forfeited for non-payment of the final fee, a renewal application may be filed within two years, but not afterward, see *Ex parte Hardy* (1877), 12 O. G. 1075; *Ex parte McCully* (1874), 6 O. G. 153.

That failure to pay the final fee is an incurable forfeiture, though unavoidable, see *Ex parte Barnitz* (1887), 41 O. G. 575.

That notwithstanding *Ex parte Barnitz* (41 O. G. 575), a new original application may be filed after two years, see *Ex parte Barnitz* (1888), 42 O. G. 1061. See also *Thomson v. Waterhouse* (1884), 30 O. G. 177.

That after two years' delay there can be no renewal application, see *Thomson v. Waterhouse* (1884), 30 O. G. 177.

That a renewal application is like a motion to revive a judgment, see *Thomson v. Waterhouse* (1884), 30 O. G. 177.

That an assignee of the invention before patent has a right to renew an application after a former one by the inventor has been forfeited, see *Ex parte Eveleigh* (1872), 1 O. G. 303.

That an assignee may make and swear to a renewal application, see *Thomson v. Waterhouse* (1884), 30 O. G. 177.

That the renewal of an application by a person not the attorney of record, without the knowledge of the applicant, is void, see *Consolidated Fruit Jar Co. v. Bellaire Stamping Co.* (1886), 27 Fed. Rep. 377; 35 O. G. 627.

That the ratification of an unauthorized act of an attorney in renewing an application cannot affect intervening rights, see *Consolidated Fruit Jar Co. v. Bellaire Stamping Co.* (1886), 27 Fed. Rep. 377; 35 O. G. 627.

That there is no rule or statute which authorizes an applicant to forfeit an allowed application, file a renewal within six months, and pay the application fee, as if a forfeiture had already occurred, see *Ex parte Manny* (1888), 44 O. G. 700.

² That a renewal application within two years in lieu of a forfeited one, under Sec. 4897, is for some purposes a continuation of the other and relates back to it, taking its date, see *Thomson v. Waterhouse* (1884), 30 O. G. 177.

That where an application was allowed Dec. 22, 1877, and forfeited for non-payment, but renewed Feb. 4, 1879, the renewal was regarded as a new application and stood on its own date, as to two years' public use, see *Weir v. Morden* (1884), 29 O. G. 83.

cided as a question of fact³ While an application remains forfeited no notice is given to the applicant of any subsequent applications, and neither forfeited nor abandoned applications are cited as references to defeat a later applicant.⁴ Forfeited applications remain in the secret archives of the Patent Office, open to the inspection only of the applicants or their attorneys, but copies of them may be given to other persons when specifically ordered by the Commissioner.

§ 585. Final Fees: how Paid: Delivery of Patent.

The final fee may, like the entrance fee, be paid to the Commissioner, or to the Treasurer or any of the Assistant Treasurers of the United States, or to any of the depositaries, national banks, or receivers of public money designated by the Secretary of the Treasury for that purpose, whose receipt may be transmitted to the Patent Office. The patent will be delivered or mailed on the day of its date to the patentee, unless there be an attorney of record, in which case it will be delivered to him or to the patentee as the attorney may require, but without a special request to that effect it will not be given to an associate or substitute attorney.

³ That a renewal application will be examined in the light of the state of the art at the time the original was filed, see *Ex parte Livingston* (1881), 20 O. G. 1747; *Ex parte Gordon* (1874), 6 O. G. 543.

That a new application, filed more than two years after forfeiture, is defeated by any matter in bar arising after the forfeiture, see *Ex parte Livingston* (1881), 20 O. G. 1747.

That a delay in renewing an application raises a suspicion of abandonment and the oath should negative it, see *Thomson v. Waterhouse* (1884), 30 O. G. 177.

That delay in renewing an applica-

tion is not conclusive proof of abandonment of the invention, see *U. S. Rifle & Cartridge Co. v. Whitney Arms Co.* (1877), 11 O. G. 373; 14 Blatch. 94; 2 Bann. & A. 493.

⁴ That a forfeited application is dead and is not in the way of other applications, see *Opinion Acting-Com.* (1877), 12 O. G. 979.

That a "withheld application" is one held in abeyance and revivable on paying a new fee, but is abandoned after two years, see *Ex parte Livingston* (1881), 20 O. G. 1747.

That Sec. 35, act 1870, does not refer to applications then pending, see *Ex parte Mygatt* (1877), 12 O. G. 51.

SECTION X.

OF THE APPLICATION : PROCEDURE IN INTERFERENCE CASES.

§ 586. Interference Proceeding Instituted to Determine Priority between Rival Inventors.

The procedure heretofore described is that which is pursued in uncontested or *ex parte* cases. Upon all questions relating to the patentability of an invention and the fact of its discovery by the alleged inventor, the only parties in interest are the public on one side and the inventor on the other; and the examination instituted in the Patent Office upon the filing of the application is regarded as sufficient both to protect the public rights and to secure the lawful privileges of the inventor. But when there are rival claimants for the same invention, to neither of whose applications, if each stood alone, could any effectual objection be urged in the interest of the public, the question as to which of these inventors is entitled to a patent still remains, and in the investigation of this question adverse individual interests appear. The law, which authorizes the grant of but a single patent for the invention, awards it to that one of the claimants who first conceived the idea of the art or instrument described, provided he has used due diligence in reducing it to practice. To determine this fact a judicial proceeding becomes necessary, in which the several rivals are parties adverse to each other, having a right to be heard by evidence and argument in vindication of their own claims and in opposition to the claims of their antagonists, and which results in a judgment in favor of some one of them as the lawful patentee.¹ This judicial

§ 586. ¹ In *Hibbard v. Richmond* (1880), 17 O. G. 1155, Doolittle, Act. Com. : (1156) "The first and original inventor, whose invention has not been in public use or on sale more than two years prior to his application, and who has not abandoned the same to the public, is entitled to a patent for his inven-

tion upon making a proper application, and if on examination of such application it shall appear that the applicant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, it becomes the imperative duty of the Commissioner to grant him letters-patent. The whole

proceeding forms the only contested case now known in the Patent Office, and is called an Interference.²

§ 587. **History of Interference Proceedings.**

An interference is a proceeding instituted for the purpose of determining the priority of the inventive act between two or more parties who claim substantially the same patentable invention.¹ This proceeding first appeared in our law in the act of 1793, which provided that interfering applications should be submitted to the arbitration of three persons, — two chosen by the applicants and the third appointed by the Secretary of State, — whose award should be final.² The act

machinery of the Office under the law is framed for this purpose, and if the Commissioner at any time finds that he has granted a patent to one who is not the first and original inventor, but that the first and original inventor is another person whose application is pending before him, it is his duty to grant a second patent to such applicant. The manner of trying the fact as to whether an applicant in any given case is the first and original inventor when his application conflicts with another pending application or with an unexpired patent is prescribed by section 4904, Revised Statutes, and the proceeding is known as an 'interference.'"

² That an interference is now the only contested case in the Patent Office, see *Little v. Lillie* (1876), 10 O. G. 543.

§ 587. ¹ That in an interference proceeding the sole question is that of the priority of the inventive act, see *Hicks v. Keating* (1887), 40 O. G. 343; *Swift v. Rochow* (1880), 17 O. G. 450; *Laverty v. Flagg* (1879), 16 O. G. 1141; *Ex parte Knox* (1879), 16 O. G. 1048; *Miller v. Miles* (1877), 11 O. G. 197; *Lagowitz v. Topham* (1875), 9 O. G. 742; *Dana v. Greenleaf* (1875), 9 O. G. 198; *Smith v. Perry* (1875), 9 O. G. 688; *Bigelow v. Commissioner* (1875), 7 O. G. 603; 2 *MacArthur*, 24.

That disputes between patentees and their assignees cannot be determined in an interference proceeding, see *Swift v. Rochow* (1880), 17 O. G. 450.

That an interference is declared between applications rather than applicants, and is intended to find out which invention was first produced, not who has the title, and want of title may appear without a statutory bar being proved, see *Hicks v. Keating* (1887), 40 O. G. 343.

² In *Little v. Lillie* (1876), 10 O. G. 543, Duell, Com., gives the following short history of interferences: (544) "The first laws relating to interfering applications were passed in 1793, when, under the system then in practice, patents were grantable as a matter of course, the only examination being to determine whether the invention was sufficiently useful and important and the papers in proper form. Even at that early date it was found necessary to provide a means whereby to determine which of two or more persons was the first and original inventor, and for this purpose it was provided that the matter should be submitted to arbitrators. The act of 1836, establishing the Patent Office, inaugurated a new system, which, with various modifications, has since been adopted. The office of Commissioner of Patents

of 1836 gave to the Commissioner the authority to hear and decide these controversies, subject to an appeal to the board of

was then created, and his powers and duties were defined to be 'under the direction of the Secretary of State to superintend, execute, and perform all such acts and things touching and respecting the granting and issuing of patents for new and useful discoveries, inventions, and improvements, as herein provided for, or shall hereafter, by law, be directed to be done and performed.' Section 6 of said act prescribed the conditions upon which a patent should be granted, and section 7 required the Commissioner to cause an examination of each application to be made, in order to determine whether, under the statute, the party was entitled to a patent, and, if found not, then he was to refuse the grant. As a matter separate and distinct from this examination, provision is made in section 8 for interferences, as follows: 'That whenever an application shall be made for a patent, which, in the opinion of the Commissioner, would interfere with any other patent for which an application may be pending, or with any unexpired patent which shall have been granted, it shall be the duty of the Commissioner to give notice thereof to such applicants or patentees, as the case may be, and if either shall be dissatisfied with the decision of the Commissioner on the question of priority of right or invention on a hearing thereof, he may appeal from such decision on the like terms and conditions as are provided in the preceding section of this act; and the like proceedings shall be had to determine which or whether either of the applicants is entitled to receive a patent as prayed for.' The appeal, like that in cases arising from a second rejection under sections 6 and 7, was to be taken to a Board of Examiners appointed for the purpose. By the act of 1839 this Board

was abolished, and the Chief Justice of the District substituted as the appellate tribunal. The act of 1852 gave to the assistant judges the same authority to hear appeals as the Chief Justice. Section 2 of the act of 1861 created the Board of Examiners-in-Chief, whose duty it was made 'to revise and determine upon the validity of decisions made by examiners when adverse to the grant of letters-patent; and also to revise and determine in like manner upon the validity of the decisions of examiners in interference cases.' From the decision of this Board an appeal would lie to the Commissioner. The condition of the law at this time made it necessary that interferences be declared for determining the question of priority between two or more persons in order that the first and original inventor might be discovered. The primary examiners were intrusted with the decision of these cases, and, like *ex parte* cases, their action could be appealed from to the Board of Examiners-in-Chief, from them to the Commissioner, and thence to any of the justices of the District Court. On the 8th of July, 1870, the laws relating to patents were revised and the Patent Office reorganized, several marked and important changes being made in the practice. The provisions for interferences were contained in section 42 (R. S. 4904), as follows: 'Whenever an application is made for a patent, which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior in-

examiners. In 1839 the right of an appeal to the Chief Justice of the District Court of the United States for the District of Columbia, instead of to the board of examiners, was conferred on the defeated party, and the decision of the Chief Justice was made conclusive as to all further proceedings in the case. The act of 1861 intrusted the determination of this question to the primary examiners, subject to appeal to the examiners-in-chief, whose judgment in its turn could be revised by the Commissioner. The act of 1870 directed that a special examiner of interferences should be appointed in the Patent Office, before whom these contested cases should be heard, and from whose finding an appeal might be taken to the examiners-in-chief and from them to the Commissioner, whose decision should be final. The latter is the present system of procedure.

§ 588. Interference Proceedings Instituted only between Pending Applications or between a Pending Application and an Unexpired Patent.

An interference can be instituted only between two or more pending applications, or between a pending application

ventor, unless the adverse party appeals from the decision of the primary examiner, or of the Board of Examiners-in-Chief, as the case may be, within such time, not less than twenty days, as the Commissioner shall prescribe.' A special examiner was provided to attend to interference cases. Appeal to the Board and the Commissioner was allowed as in *ex parte* cases, but here the former practice and analogy ceased. While *ex parte* cases were appealable to the Supreme Court of the District of Columbia sitting in *banc*, instead of the justices, interferences could not be taken beyond the Commissioner, his decision being final. The work of the Office was then divided into *ex parte* and contested cases, the former to be considered by the primary examiners, from whose action an appeal might ultimately be

taken to the Supreme Court of the District, and the latter to the examiner of interferences, whose action was limited to the decision of the question of priority of invention, of which the Commissioner was the last appellate tribunal. In order to facilitate the practice of the Office, the present rules were adopted. They require that the primary examiner shall settle all questions relating to the patentability of the invention before he declares the preliminary interference, for upon doing this the case is at once transferred to the examiner of interferences. The jurisdiction of the examiner of interferences extends only to the determination of the question of priority of invention and matters incidental thereto, in the manner prescribed by the rules."

and an unexpired patent. Where patents already granted conflict with one another, the Patent Office has no authority over them, and the rival patentees must seek the solution of their difficulties in the courts.¹ Where a patent has expired the patentee has no longer any right requiring protection or which he can be called upon to vindicate as against later applications.² Forfeited and abandoned applications have no standing in the Patent Office as the basis of any claim or the allegation of any right on the part of their applicants, and are not noticed in the examination of other applications.³ The jurisdiction of the Patent Office extends to applications alone, and to those only while actually pending before it.⁴ Its judgment upon an interference can affect only the applicant to whom it refuses or allows a patent, a rival claimant who has previously obtained a patent continuing to hold it until it is declared invalid by the courts although the later applicant has proved his own priority before the interference tribunal and received his patent.⁵

§ 588. ¹ That an interference between two or more patents cannot be adjudicated in the Patent Office, see *Nicholson v. Bennett* (1879), 16 O. G. 631; *Wilson v. Yakel* (1876), 10 O. G. 944.

² That an interference cannot be declared against an expired patent, see *Ex parte Mason* (1876), 9 O. G. 1196.

³ That no interference can be declared with forfeited or abandoned applications, see *Starr v. Farmer* (1883), 23 O. G. 2325; Opinion of Acting-Com. (1877), 12 O. G. 979; *Ex parte Spear* (1874), 5 O. G. 201.

⁴ That an interference is declared whenever the Claims of a pending application conflict with those of another application or an unexpired patent, see *Sawyer v. Edison* (1883), 25 O. G. 597; *Western Electric Light Co. v. Chicago Electric Light Mfg. Co.* (1882), 11 *Bissell*, 427; 14 *Fed. Rep.* 691; *Little v. Lillie* (1876), 10 O. G. 543.

That an applicant is not entitled to

an interference with an unexpired domestic patent till he has been rejected thereon, see *Ex parte Massicks* (1887), 38 O. G. 1489.

That an interference should be declared between an application and an unexpired patent, although the applicant's foreign patents are older than the conflicting patent, see *Ex parte Bland* (1879), 16 O. G. 47.

That in an interference it is no advantage to have a patent unless the patentee is the original inventor, see *Ex parte Russell* (1874), 5 O. G. 149.

That an interference becomes necessary because the dates of conflicting applications are not conclusive on the question of priority, see *Thomas v. Reese* (1880), 17 O. G. 195.

⁵ That a judgment against a patent, in an interference case, does not annul the patent, but simply awards a patent to the rival, see *C. A. Yale Cigar Mfg. Co. v. Yale* (1884), 30 O. G. 1183.

§ 589. Interference Proceedings Instituted only between Conflicting Applications, or between an Application and a Conflicting Patent.

An application does not conflict with another application, or an unexpired patent, unless the invention covered by each specification is substantially the same.¹ Similarity or diversity in name and appearance are of no consequence.² Every invention occupies toward every other the relation either of identity or of equivalence or of specific difference or of generic difference. Applications for identical or equivalent inventions are applications for the same invention. Applications for

§ 589. ¹ That patents or applications conflict only when they claim, in whole or in part, the same invention, see *Ex parte* Lasscell (1884), 28 O. G. 1274; *Sawyer v. Edison* (1883), 25 O. G. 597; *Drawbaugh v. Blake* (1883), 23 O. G. 1221; *Gold & Silver Ore Separating Co. v. U. S. Disintegrating Ore Co.* (1869), 3 Fisher, 489; 6 Blatch. 307; *Marvin v. Lillie* (1867), 27 O. G. 299.

That on an interference the Claims actually made are considered, but the examiner must have regard to the whole specification and to the Claims which might be made, see *Ex parte* Wheeler (1883), 23 O. G. 1031.

That the rules governing interferences should be liberally construed, so that patents may be restricted to such inventions as the patentees can justly claim, see *Drawbaugh v. Blake* (1883), 23 O. G. 1221.

That if an applicant claims anything covered by a prior patent the patentee must be notified, and have a chance to contest it, see *Marvin v. Lillie* (1867), 27 O. G. 299.

Under former rules of the Patent Office, an interference was declared where applications might be amended so as to include conflicting Claims, though the conflicting matter were not claimed in the application at the time the interference was instituted. At present the rules forbid the declaration

of an interference until after the conflict appears specifically in the Claims. The foregoing cases, and also the following, should be read in view of this change in the rule.

² That an interference should be declared when the inventions conflict though the Claims do not, see *Drawbaugh v. Blake* (1885), 30 O. G. 259.

That immaterial differences in the Claims of conflicting applications will be disregarded, and an interference declared, if the matter claimed is substantially the same, see *Drawbaugh v. Blake* (1883), 23 O. G. 1221.

That the subjects of an interference are things not words, see *Ex parte* Upton (1884), 27 O. G. 99; *Greenough v. Drummond* (1879), 16 O. G. 586; *Nicholson v. Bennett* (1879), 16 O. G. 631; *Drummond v. Greenough* (1879), 16 O. G. 959.

That an interference may exist though the inventions have different names, see *Hoe v. Scott* (1878), 14 O. G. 447.

That inventions interfere if they are equivalents for each other, though they differ in appearance, see *Withington v. Locke* (1877), 11 O. G. 417.

That an application for a design may interfere with one for a mechanical invention, if both claim the same subject-matter, see *Collender v. Griffith* (1873), 3 O. G. 91.

inventions generically different are wholly distinct and independent of each other. Applications for inventions specifically different are distinct and independent, unless the inventor of one species also claims the genus to which both belong and the inventor of the other species fails to disclaim it in his application.³ An interference can, therefore, be properly declared only when the inventions, as described and claimed in the applications or the patent, are identical or equivalent, or where being specifically different they do involve, or may involve, a claim to the generic invention in which both are embraced.⁴ It is not, however, necessary that the scope of the Description or the subject-matter of the Claims, as presented in each patent or each application, should be the same. If that which is described in one is contained within the Description of the other, or if the Claims of one could by amendment be lawfully incorporated in the other, the inventions are sufficiently identical to warrant this proceeding.⁵

³ In *Banks v. Snediker* (1880), 17 O. G. 508, Paine, Com. : (510) "The relation of two interfering inventions to each other must, in contemplation of law, always be either that of (1) identity, or (2) equivalence, or (3) specific difference, or (4) generic difference. In the first two classes of cases the earlier is absolutely fatal to the later invention; in the fourth, it presents no obstacle to the patentability of the later invention; in the third, the prior invention is no bar to a specific patent for the later invention, subject to a generic patent covering both species."

⁴ That no interference should be declared unless an applicant claims what has been granted to or applied for by another, see *Ex parte Platts* (1879), 15 O. G. 827.

That where one application claims the genus and another the species, they will interfere unless the latter disclaims the genus, see *Ex parte Gardner* (1880), 17 O. G. 626.

That a patent with a Claim for a species will not be granted while an ap-

plication claiming the genus is pending, unless after an interference hearing, see *Ex parte Upton* (1884), 27 O. G. 99; *Ex parte Holt* (1884), 29 O. G. 171.

That where one Claim includes the other an interference should be declared, see *Ex parte Upton* (1884), 27 O. G. 99.

That if a narrow Claim be included in a broad Claim an interference is the proper method of determining who is entitled to the broad Claim, see *Ex parte Upton* (1884), 27 O. G. 99.

That Claims for inventions which are mere double uses interfere, see *Drawbaugh v. Blake* (1883), 23 O. G. 1221.

That a Claim for carrying an invention into use in a specific way does not interfere with a Claim for the invention itself, see *Drawbaugh v. Blake* (1883), 23 O. G. 1221.

That a single Claim in one application may interfere with several Claims collectively in another, see *Drawbaugh v. Blake* (1883), 23 O. G. 1221.

⁵ That applications conflict with each

§ 590. Interference Proceedings Instituted only when the Later Applicant Claims Priority of Inventive Act.

An interference cannot be instituted between conflicting applications, or between an application and a conflicting patent, unless the later applicant claims that his own inventive act preceded that of the former applicant or patentee.¹ Where a conflicting patent has been issued before the filing of the rival application this claim to priority must be explicitly stated.² The grant of letters-patent raises a presumption of priority in favor of the patentee against all future applicants, and their applications are, therefore, rejected by the Patent Office on a reference to a prior patent, unless the applicant avers upon his oath that his inventive act anticipated the filing of the application upon which the patent was allowed. This presumption extends to every application for re-issue based

other when anything that is shown in one is claimed in the other, see *Bell v. Gray* (1879), 15 O. G. 776.

That an application conflicts with a patent when it claims anything shown by the patent, see *Bell v. Gray* (1879), 15 O. G. 776; *Marvin v. Lillie* (1867), 27 O. G. 299.

That two applications for combinations, one wanting an element of the other but otherwise identical in operation and effect, interfere, since the lesser anticipates the larger, and the interference can be prevented or dissolved only when the applicant for the lesser disclaims the larger, see *Banks v. Snediker* (1880), 17 O. G. 508.

That where a design can be produced only by a certain device, an application for the latter conflicts with a patent for the former and an interference should be declared, see *Collender v. Griffith* (1873), 3 O. G. 91.

That no interference will be declared with an improper divisional application, see *Ex parte Holt* (1884), 29 O. G. 171.

§ 590. ¹ That an interference will not be declared between pending applica-

tions, or an application and an unexpired patent, unless the later applicant claims priority under oath, see *Thomas v. Reese* (1880), 17 O. G. 195; *Ex parte Nagel* (1880), 17 O. G. 198.

That where the record conclusively establishes priority no interference should be declared, see *Ex parte Nagel* (1880), 17 O. G. 198.

That the application-oath has nothing to do with priority, see *Sellon v. Hochhausen* (1885), 33 O. G. 995.

That in order to obtain an interference with a patent, an applicant must make oath that he completed his invention before the patentee's application was filed, and must state the facts which prove it, and not merely aver that he invented before the patent issued, see *Ex parte Graydon* (1883), 25 O. G. 192.

² That in a conflict between an application and a patent, the patent makes a *prima facie* case for the patentee, see *Paul v. Dorland* (1873), 4 O. G. 552.

That an applicant in conflict with a prior patent must show that he was the first to conceive and used reasonable diligence in reducing to practice, see *Hammond v. Laird* (1874), 7 O. G. 170.

upon such prior patent, which must prevail over all other applications, whether original or based on later patents, unless the later applicant alleges and proves his own priority. No such presumption, however, exists in favor of one pending original application against another,³ or of a patent granted after the filing of its rival application,⁴ or of a re-issue application based upon a patent issued after the antagonistic application had been filed. Each of such conflicting applications is regarded as hostile to the others, and so asserting a priority in favor of its own individual applicant against all the rest.

§ 591. Interference Proceedings Instituted in Nine Special Cases.

In accordance with these principles an interference can be instituted in the following cases: (1) Between two or more original conflicting applications; (2) Between an original application and an unexpired patent granted during the pendency of such original application; (3) Between an original application and an application for the re-issue of a patent granted during the pendency of such original application; (4) Between two or more applications for the re-issue of patents granted on applications pending at the same time; (5) Between an original application and an unexpired patent, granted before such application had been filed, provided the applicant, after the rejection of his application upon reference to the patent, avers on oath that he made the invention before the original application of the patentee was filed; (6) Between an original application and an application for the re-issue of a patent granted before such original application was filed, provided the applicant avers on oath that he made the invention

³ That an interference is declared whenever the oath and application of one claimant is neutralized by the oath and application of another, see *Little v. Lillie* (1876), 10 O. G. 543.

⁴ That where one of two contesting applicants has obtained a patent an interference may be declared *nunc pro tunc*, see *Ex parte Marston* (1882), 21 O. G. 633.

That an "unexpired patent" means one granted before the conflicting application was filed, see *Ex parte Marston* (1882), 21 O. G. 633.

That conflicting applications are hostile, whenever filed, and the premature issue of a patent to one does not affect the rights of the other, see *Ex parte Marston*, (1882), 21 O. G. 633.

before the original application for the patent sought to be re-issued had been filed; (7) Between two or more applications for the re-issue of patents whose original applications were not pending at the same time, provided the applicant for a re-issue of the later patent avers on oath that he made the invention before the original application on which the earlier patent issued had been filed; (8) Between an application for re-issue and an unexpired patent, provided the original applications for each patent were pending at the same time, and the re-issue applicant avers on oath that he made the invention before the original application of the other patentee was filed; (9) Between an application for the re-issue of a later unexpired patent and an earlier unexpired patent which was granted before the original application for the later patent had been filed, provided the re-issue applicant avers on oath that he made the invention before the filing of the original application for the earlier patent. In the first four cases it will be perceived that no such presumption of priority exists in favor of either party as requires an express averment on the part of the other to authorize an interference, while in the last five cases such a presumption does arise from the previous action of the Patent Office in favor of the earlier patentee, which can be rebutted only by a distinct claim under oath to a priority over the opposing applicant or patentee.¹

§ 591. ¹ In *Ex parte Nagel* (1880), 17 O. G. 198, Paine, Com. : (199) "An original application will be placed in interference with an unexpired patent if the applicant shall, by affidavit, show his ability to controvert the *prima facie* proof furnished by the date of the unexpired patent by showing that he made the invention before the patentee filed his application. So an original application may be placed in interference with a re-issue application, notwithstanding the *prima facie* evidence of priority afforded by the date of the patent of which a re-issue is sought, if the original application shall be fortified by an affidavit of the applicant showing that he made the invention before the

patentee's original application was filed. Again, an interference will be declared between applications for the re-issue of patents granted on applications not pending at the same time, if the applicant for re-issue of the later patent shall support his application with an affidavit showing that he made the invention before the application on which the earlier patent issued was filed. The same principle obtains in all other cases provided for by the rules. . . . (200) It is provided in section 4904 of the Revised Statutes that, 'whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall

§ 592. Interference Proceedings: Notice of Interference to the Rival Claimants.

The first step in an interference is to secure from the adverse parties an exact statement of their conflicting claims

give notice thereof to the applicants or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention.' This obviously does not mean that the Commissioner is to declare an interference whenever an application is filed in which is claimed an invention which is also claimed in an unexpired patent. On the contrary, as a rule, an application is to be rejected if it contains a Claim embraced in an unexpired patent. It is only when the applicant makes oath that he made the invention before the filing of the patentee's application that an interference is declared between an original application and an unexpired patent. If, instead of the *prima facie* proof furnished by the date of the patentee's application and of his patent, on the one hand, and the contradictory proof furnished by the affidavit of the applicant, the record presented conclusive proof in favor of either party, an interference would be a frivolous proceeding, for which the Commissioner would be able to find no excuse."

That no *prima facie* showing of priority on the record can prevent a later applicant from claiming an interference, upon making the proper averments under oath, see *Ex parte Nagel* (1880), 17 O. G. 198.

That an interference should be declared between an application and an unexpired patent showing the same invention, although the applicant's foreign patents are older than the patent in question, see *Ex parte Bland* (1879), 16 O. G. 47.

That an applicant for re-issue is not allowed to establish his priority against

an expired patent, see *Ex parte Mason* (1876), 9 O. G. 1196.

That an interference may be declared between a re-issue application and applications filed or patents granted since the date of the original patent, see *Sargent v. Burgo* (1876), 10 O. G. 285; *Mayall v. Murphy* (1874), 5 O. G. 339; *contra*, *Carroll v. Morse* (1876), 9 O. G. 453; *Becker v. Throop* (1875), 8 O. G. 1; *Paris v. Bussey* (1875), 8 O. G. 859.

That one of two joint patentees may subsequently file a sole application and have an interference declared between it and the joint patent, whereupon if he be found to have been the sole inventor a patent will be granted to him notwithstanding his former oath as joint inventor, see *Kohler v. Kohler* (1888), 43 O. G. 247.

That when, between two successive applications by the same applicant, another application is filed by a different inventor, an interference will be declared, see *Ex parte Golding* (1875), 8 O. G. 141.

That where a patent issues on one of two pending applications without an interference, the patentee will have no advantage on that account over his rival, but an interference will be declared as if no patent had been granted, see *Gordon v. Withrington* (1876), 9 O. G. 1009; *Smith v. Barter* (1874), 7 O. G. 1; *Brookfield v. Brooke* (1873), 4 O. G. 81; *Goodman v. Scribner* (1872), 2 O. G. 673.

That when one application conflicts with two or more patents only one interference should be declared and all be made parties, see *Wilson v. Yaker* (1876), 10 O. G. 944.

That whether an interference shall

in such a form that the Patent Office can judicially act upon them. For this purpose, whenever the examiner in charge of any application discovers that its Claims conflict with those of any other application, or of any unexpired patent, or with any pending caveat, it is his duty to notify such applicants or patentees or caveators and, if necessary, to require them to state their Claims in such a manner that the nature and extent of their antagonism will become distinct and unmistakable.¹ Upon the receipt of this notice and within the time therein specified, all parties must put their Claims in such condition that no further change in them will be required to precisely cover their respective rights. By this method the jurisdiction of the Patent Office over all the parties and the subject-matter in controversy is rendered as complete as possible, and the issues between them are clearly and specifically defined. Any want of exactness in the statement of his Claim, on the part of either of the contestants, is a sufficient reason for requiring him to further amend it, no alteration being permitted after final judgment in the interference unless the testimony adduced upon the trial necessitates or justifies the change. Parties who fail to comply with the requirements of this notice will be excluded from the interference, but without prejudice to any other right than that of being heard therein.

§ 593. Interference Proceedings: Examination of Conflicting Applications on their Merits.

The next step in the interference is to ascertain the right of each claimant to a patent for the invention as against the

be declared is a matter for the Commissioner to decide and from his decision there is no appeal, see *Ex parte Gower* (1879), 15 O. G. 828.

§ 592. ¹ Under former rules of the Office an interference could be instituted between claimants where patents or applications might be amended to claim the same patentable matter, see Rules prior to 1881, and *Ex parte Bland* (1879), 16 O. G. 47. Under present rules no interference is declared unless

the rival application or patent claims the same subject-matter.

That the primary examiner must decide whether Claims interfere, see *Faure v. Bradley* (1888), 44 O. G. 945; *Ex parte Saunders* (1883), 23 O. G. 1224.

That adverse parties in interference will be allowed to see copies of interfering Claims and specifications, but no other persons can have access to the interference files, see *Ex parte Fischer* (1887), 38 O. G. 1237.

public and irrespective of the question of priority. No applicant is entitled to become a party to an interference unless his right against the public is complete. He must have performed an entire inventive act, not only conceiving an idea of means but also reducing it to successful practice, and must have produced an art or instrument belonging to one of the protected classes, possessing novelty and utility, and not abandoned to the public.¹ In this inquiry each applicant stands alone, neither aided nor obstructed by the acts or achievements of any other applicant; and if it becomes apparent that on his individual merits he could not lawfully receive a patent, he cannot be permitted to engage in any contest for priority with those whose applications might be properly allowed.² Upon all the questions thus arising the examiner must pass as in ordinary *ex parte* applications, with the same rights of appeal as heretofore described.³

§ 594. Interference Proceedings: Definition of Issues.

The third step in the interference is to define the issues upon which the judgment of the Patent Office is desired.

§ 593. ¹ That all questions as to the patentability of the subject-matter must be disposed of before the interference is formally declared, and questions not then raised will be waived, see *Ex parte Bland* (1879), 16 O. G. 47; *Anson v. Woodbury* (1876), 11 O. G. 243.

That questions as to novelty must be settled before the interference is declared, see *Bennage v. Phillippi* (1876), 9 O. G. 1159; *Wood v. Morris* (1873), 3 O. G. 239.

That before an interference is declared it should appear that both inventions have been reduced to successful practice, see *Sargent v. Burge* (1877), 11 O. G. 1055.

That a declaration of interference rests upon the assumption that the applications or patents cover operative devices, but such presumption is not conclusive and the question of operativeness may be raised and determined at any

time in settling that of priority, see *Voelker v. Gray* (1885), 30 O. G. 1091.

² That the reduction to practice of one of the conflicting inventions cannot be inferred from that of the other, see *Sargent v. Burge* (1877), 11 O. G. 1055.

That the existence of a patent is *prima facie* evidence of reduction to practice, though no practical use is shown, see *Busha v. Phelps* (1876), 9 O. G. 1010.

That abandonment by one inventor does not affect the other, see *Harnet v. Reese* (1882), 21 O. G. 1875.

³ That the examiner of interferences has no jurisdiction over the question of patentability as such, though he may dispose of the question when collaterally raised in the trial of the interference, see *Faure v. Bradley* (1888), 44 O. G. 945.

This is also the duty of the examiner.¹ These issues must be based upon the applications and patents of those who have been found by him to be entitled to become parties to the interference, and must represent what they actually claim, not what they might claim.² They must contain a summary of the contested matter, and point out the conflicting Claims.³ Hypothetical issues cannot be permitted.⁴ They must have the same meaning as to all the claimants; and if susceptible of various meanings that one will be adopted which sustains the interference as declared, and best agrees with the specifications of the parties.⁵ The construction placed upon an issue by the Patent Office is conclusive.⁶ The issues must embrace only those applications and patents which conflict with all the others, and the various cross-interferences between these should be consolidated by presenting them in different counts in the same issue.⁷ Notices of the interference are then prepared by the examiner for all the parties, disclosing the name and residence of each contestant and those of his attorney, the date of the filing of his application,

§ 594. ¹ That there are no formal pleadings in interference proceedings, see *Faure v. Bradley* (1888), 44 O. G. 945.

That it is the duty of the examiner to see that the subject-matter put in issue by the interference is properly defined, see *Dod v. Cobb* (1876), 10 O. G. 826.

That the primary examiner must decide whether Claims interfere, see *Ex parte Saunders* (1883), 23 O. G. 1224.

² That in declaring an interference the examiner must look to the language of the application alone, see *Faure v. Bradley* (1888), 44 O. G. 945.

That the issue in an interference must set forth what the parties do claim, not what they might claim, see *Nicholson v. Bennett* (1879), 16 O. G. 631.

³ That the issue must point out the conflicting Claims and contain a summary of the contested matter, see *Stephen v. Bailey* (1877), 13 O. G. 45.

⁴ That hypothetical issues cannot be allowed, see *Farnsworth v. Andrews* (1875), 9 O. G. 195.

⁵ That the issue must have the same meaning as to all the parties, see *Nicholson v. Bennett* (1879), 16 O. G. 631; *Drummond v. Greenough* (1879), 16 O. G. 959.

That when the issue is open to several constructions the one which sustains the interference as declared and best agrees with the specifications of the claimants will be adopted, see *Locke v. Levalley* (1881), 20 O. G. 671.

⁶ That the construction placed by the Patent Office on the issue is conclusive, see *Locke v. Levalley* (1881), 20 O. G. 671.

⁷ That a single interference can embrace only such applications and patents as conflict with all the others, and these may be consolidated into one by presenting them in different counts, see *Bell v. Gray* (1879), 15 O. G. 776.

or if he is a patentee the date and number of his patent and the date of his application therefor, the ordinals of conflicting Claims, and the invention claimed, — clearly and concisely defining them in as many counts as are necessary to exhibit all interfering Claims included in the issue. These notices are transmitted with the files to the examiner of interferences, whose duty it is to ascertain whether the issues are clearly stated and the notices sufficient, and if he finds them defective in any material point to return them with his objections to the examiner for amendment. Upon the refusal of the latter to amend them the matter is referred to the Commissioner. These notices being perfected, the interference is formally declared, and the notices are sent to the parties in interest, accompanied by an order to each to file a preliminary statement of the facts, on which his claim to priority is based, within a time mentioned in the notice. The interference then becomes a contested case, and passes under the exclusive jurisdiction of the examiner of interferences, unless some questions other than those relating to priority arise, and thus compel its temporary return to the consideration of the primary examiner.⁸

§ 595. **Interference Proceedings : Preliminary Statements.**

The preliminary statement ordered in the notices of interference is a concise written recital, under oath, of the date of the contestant's original conception of the invention, of his construction of a drawing or model, of the disclosure of his invention to others, of its reduction to practice, and of the extent of its use.¹ If the invention was made abroad, the statement must declare when and where, if ever, it was patented or described in a printed publication, and when it, or the knowledge of it, was introduced into this country.²

⁸ That the examiner of interferences has exclusive jurisdiction of the issues when declared, see *Faure v. Bradley* (1888), 44 O. G. 945.

§ 595. ¹ That the preliminary statement must declare the character and extent of the use of the invention from the time of its perfection until the ap-

plication was filed, see *Dermody v. Pennock* (1878), 14 O. G. 202.

That the extent of the use of the invention need not be given if it is evident that it was completed within two years before the application, see *Ex parte Wheat* (1878), 14 O. G. 787.

² That an applicant for an invention

As the principal object of these statements is to fix the relative times of the inventive acts of the several contestants, the dates given therein are considered as conclusive, and the evidence afterwards offered must confirm, not contradict, them.³ This statement must also embrace, in general, all the facts which the applicant intends to rely on to support his claim, whether they are to be proved by the records of the Patent Office or by extrinsic testimony.⁴ It must be sealed up before filing, and cannot be opened for examination by the opposing parties until all are filed or the time for filing has expired, and until the examiner of interferences has inspected it and found it satisfactory. Either of the contestants may be required by the examiner to correct defects in his statement within a specified period, but neither the original nor the amended statement can be returned to him after it has once been filed. The time for filing or amending the statements may be extended upon motion made before the expiration of the interval first limited for that purpose, and after proper notice to the adverse parties. Claimants refus-

conceived abroad may claim the date of the arrival of the inventor or his agent in the United States as that of his discovery, see *Thomas v. Reese* (1880), 17 O. G. 195.

³ That the preliminary statement need not fix the exact date of the invention, nor must the proof necessarily correspond with the exact date fixed, see *Connor v. Williams* (1878), 15 O. G. 387.

That "on or about" such a date means that exact date, not an earlier one, see *Bering v. Haworth* (1878), 14 O. G. 117.

That the earliest dates given to the inventive act in the preliminary statement are conclusive on the claimant, as against his future claim for an earlier date, see *Connor v. Williams* (1878), 15 O. G. 386; *Walpuski v. Jacobsen* (1876), 9 O. G. 964.

That a statement fixing dates by belief only may be corrected by evidence, see *White v. Farmer* (1874), 5 O. G. 338.

That a claimant fraudulently misled is not bound by his statement, see *Allen v. Gilman* (1872), 2 O. G. 293.

That if the claimant were insane when he made his statement he may amend or disavow it, see *Ex parte Brooks* (1874), 6 O. G. 296.

That a preliminary statement works no estoppel in the courts, see *Union Paper Bag Mach. Co. v. Crane* (1874), 6 O. G. 801; *Holmes*, 429; 1 *Bann. & A.* 494.

⁴ That where the later applicant had filed an application before the earliest of the contesting applicants, his later application must so refer to it as to connect the two, or it will not be noticed, see *Huntley v. Smith* (1880), 18 O. G. 795.

That a disclaimer of the invention in conflict is not a preliminary statement, see *Laverty v. Flagg* (1879), 16 O. G. 1141.

ing to amend their statements when required to do so, will be restricted to their record dates during the further proceedings in the case.

§ 596. **Interference Proceedings: Effect of Failure to File Preliminary Statement.**

The failure of any party to file his preliminary statement within the time prescribed forfeits his right to be further heard, by evidence or argument, in favor of an earlier date for his inventive act than that *prima facie* date fixed by the filing of his application.¹ Hence, if he is the later of two conflicting applicants, judgment goes against him at once upon the record. If he is the later of three or more conflicting applicants, he is no longer recognized as a party to the interference, which proceeds in its regular course as to the others.² If his antagonist is a patentee whose patent was granted on an application prior to his own, judgment is rendered forthwith for the patentee.³ In applications for re-issue, as well as in patents put in interference, the date of the original application on which the first patent issued is the *prima facie* date of the inventive act of the patentee or re-issue applicant; and in the absence of his preliminary statement this date is taken as the true date of his conception of the idea of the invention, and his claim to priority is determined by its relation to the dates fixed by the adverse parties in their applications or by their preliminary statements and the proof that may be afterward adduced in their support. Thus if an applicant, by his preliminary statement, fixes the date of his inventive act at a time previous to the filing of the original application for a conflicting patent, and the patentee

§ 596. ¹ That failure to file a preliminary statement leaves the party to the date of his application, see *Booth v. Lyman* (1880), 17 O. G. 393.

That the rule requiring a preliminary statement and prescribing its form and contents, is reasonable and must be obeyed, see *Smith v. Cowles* (1885), 30 O. G. 343.

² That if the later of three or more

conflicting applicants fails to file his statement he is no longer a party to the interference, see *Ex parte Evans* (1873), 3 O. G. 180.

³ That a prior patentee in interference is entitled to a judgment unless the contesting applicant files his statement and offers evidence, see *Loring v. Hall* (1879), 15 O. G. 471.

presents no preliminary statement, the applicant is entitled to a decision in his favor upon showing that he made the invention before the date on which such original application was filed. Or if an applicant for the re-issue of a later patent, based upon a later original application, by his preliminary statement carries the date of his invention beyond the date of the original application for the prior patent, and the prior patentee fails to file his statement as required, the former will be found to be the prior inventor if his inventive act is proved to have preceded the filing of the application for the earlier patent. Where no preliminary statement is filed by any of the parties, priority is awarded to the senior applicant.⁴

§ 597. Interference Proceedings: Amendment of Preliminary Statement.

The allegations of a preliminary statement are presumed to be correct, and are conclusive upon the party filing it, unless he has been fraudulently misled.¹ Evidence offered to support them must conform to these allegations in all material points or it will be disregarded.² Corrections in the preliminary statement, especially in regard to dates, thus become of vital importance, and if as first filed it contains substantial errors arising from inadvertence or mistake, amendments may be made on motion showing to the satisfaction of the Commissioner that they are essential to the ends of justice.³

¹ That the senior applicant will receive the patent in the absence of any preliminary statement from either party, even though the junior applicant's oath discloses that he received a British patent before the senior application was filed, see *Sellon v. Hochhausen* (1885), 33 O. G. 995.

That where no statement is filed, the junior applicant cannot have a patent even though the senior applicant for the present disclaims the invention, if his application covers it, see *Sellon v. Hochhausen* (1885), 33 O. G. 995.

§ 597. ¹ That a preliminary statement procured by fraud is not binding,

see *Allen v. Gilman* (1872), 2 O. G. 293.

That insanity of the maker avoids a preliminary statement, see *Ex parte Brooks* (1874), 6 O. G. 296.

² That the claimant cannot introduce evidence contradicting his statement, see *Connor v. Williams* (1878), 15 O. G. 387.

³ That a preliminary statement may be amended by permission of the Commissioner in proper cases, see *Clemson v. Fowler* (1886), 37 O. G. 671; *Moore v. Brown* (1882), 22 O. G. 1882.

That an error in a preliminary statement in reference to a date may be

Clerical errors may be corrected at any time, but a motion to amend in material particulars must be made, if possible, before the taking of any testimony and as soon as practicable after the discovery of the error.⁴ Upon this motion all parties are entitled to be heard, and reasonable notice of its pendency must be served upon them. No amendment can

amended on satisfactory proof that it was made in good faith and that the applicant was misled or acted without negligence, see *Clemson v. Fowler* (1886), 37 O. G. 671; *Robinson v. Seymour* (1885), 33 O. G. 113.

That an earlier date, if inconsistent with the proof, cannot be inserted by amendment, see *Cutting v. Kaylor* (1872), 2 O. G. 704.

That an amendment of the statement will not be allowed if the error arose through negligence, see *Clemson v. Fowler* (1886), 37 O. G. 671; *Smith v. Cowles* (1885), 30 O. G. 343.

That if a defect in a preliminary statement occurs through failure to obey orders, or neglect in finding out what the applicant ought to know, no amendment will be allowed, see *Smith v. Cowles* (1885), 30 O. G. 343.

That a party who protests against the adverse statement and obtains its amendment, and after the evidence in chief is taken moves to amend his own statement in order to carry his dates back of those of the adversary, cannot be allowed to do so, being guilty of laches, see *Donnelan v. Berry* (1887), 41 O. G. 1499.

That a party filing a preliminary statement, which he knows to be defective, cannot amend it after he has become familiar with his adversary's case, see *Donnelan v. Berry* (1887), 41 O. G. 1499.

That a preliminary statement may be amended before evidence is taken if the amendment is made as soon as possible after the error is discovered, see *Smith v. Cowles* (1885), 30 O. G. 343.

⁴ In *Hopkins v. Le Roy* (1880), 18 O. G. 859; *Marble, Com.* (859): "When a party makes and files his preliminary statement it is to be presumed that he has fully canvassed all the facts in his case, and that the statement as filed, as far as is necessary, is a correct statement of such facts. Unless the party having made such statement asks to amend the same before any testimony is taken in the case, all parties have a right to proceed on the issue as made in the respective statements. It may be that a statement made contains an erroneous date as is claimed in this case; if so, the party making the statement should correct that date before his opponent has been put to the expense of taking testimony to sustain his own case. A party has no right to wait until his opponent has fully developed all the facts in his case and then for the first time make known the error that he has committed in his preliminary statement. Proper diligence on his part would have placed him in possession of the facts upon which he could have corrected his statement before such testimony was taken. If through carelessness or negligence he has failed to have such correction made, other parties should not be injured by such negligence."

That clerical errors may be corrected at any time, if no injustice will result, see *Allen v. Gilman* (1872), 2 O. G. 293.

That a preliminary statement ought not to be amended after the evidence is taken or published, see *Hopkins v. Le Roy* (1880), 18 O. G. 859; *Oliver v. Zeller* (1876), 10 O. G. 416.

be permitted after the reception of evidence on the ground of ignorance of law or of the neglect of an attorney, and when permitted on any ground, at this stage of the proceedings, ample time is allowed to the adverse parties to contradict the amended allegations by additional proof.⁵ No defective preliminary statement ought to be received by the examiner; but if received, and not objected to by the other contestants, the right to insist on its exclusion will be waived.⁶

§ 598. **Interference Proceedings: Examination of Preliminary Statements.**

When the time for filing the preliminary statements has elapsed, such as have been filed are subjected to examination and are compared with the original applications on which the claims of the contestants rest. If it appears from this examination that the date of the filing of the earliest application is not anticipated by the dates fixed by the other parties for their own conception of the invention, priority is awarded to the earliest applicant.¹ Where the preliminary statement of a later applicant fails to carry the date of his inventive act behind the date when earlier applications were filed, judgment is entered against him.² Only in cases where the date claimed for his inventive act in the preliminary statement of one party anticipates the filing of an earlier application by some other party does the interference proceed further, since in these cases alone is the *prima facie* presumption of priority arising from the dates of filing the respective appli-

⁵ That ignorance of the rules of the Patent Office or the carelessness of an attorney are no reasons for allowing an amendment after the evidence is in, see *Guest v. Finch* (1876), 10 O. G. 165.

That when the statement is amended after evidence taken the adverse party may be allowed, on motion, to take further evidence, see *Moore v. Brown* (1882), 22 O. G. 1882.

⁶ That a defective statement ought not to be received, but if it is the defect is waived unless objected to, see *White v. Farmer* (1874), 5 O. G. 338.

§ 598. ¹ That where an examination of the statements shows that no one is earlier than the first applicant judgment will be rendered in his favor on notice to the other parties; otherwise a hearing will be held, see *Booth v. Lyman* (1880), 17 O. G. 393.

² That unless the statement of a later applicant carries his date of conception beyond the date when the first application was filed, judgment will go against him, see *Huntley v. Smith* (1880), 18 O. G. 795.

cations rebutted, and additional evidence rendered necessary in order to determine between the antagonistic claimants.

§ 599. Interference Proceedings : Taking Testimony.

If the interference proceeds, the time is then fixed by the examiner for the taking of the testimony by the several parties.¹ A period is limited within which the latest applicant must complete his evidence in chief, followed by a period for the adverse party to finish his testimony in reply, and this by a third period for the rebutting evidence of the later applicant. Where there are more than two contestants their periods for taking testimony are so arranged that each shall have an opportunity to prove his own case against prior applicants, and to rebut their evidence when offered in reply, and also to answer that of later applicants. The time for taking evidence may be extended in favor of either party upon a motion disclosing under oath the reasons for his inability to obtain his evidence within the period prescribed, the names of the witnesses whose testimony he desires, the facts which he expects to prove by them, and the efforts he has made already to secure their earlier attendance.² A failure to complete his testimony within the period assigned to any party is not permitted to delay the final hearing. The hearing may be postponed for sufficient reasons by the examiner in charge, but unless thus postponed a later applicant, whose evidence has been completed within the time prescribed, may insist upon a hearing and judgment, after that time has elapsed, upon the evidence as it then appears.

§ 600. Interference Proceedings : Burden of Proof : Evidence Admissible.

The general rules of evidence apply in interference cases to the same extent and in the same manner as on similar issues

§ 599. ¹ That in an interference with a patent the time for taking evidence will not be made coincident with the later dates fixed in another interference with the same patent, unless there is some reason for it other than

that the facts are the same, see *Keith v. Faure* (1883), 25 O. G. 289.

² That the courts are liberal in extending the time for taking testimony if the party has been diligent, see *Osgood v. Badger* (1888), 44 O. G. 1065.

in the courts.¹ Priority of inventive act consists in the prior conception of the idea of means and the prior embodiment of this idea in some practically operative art or instrument, or reasonable diligence in perfecting such embodiment; and the successful claimant must establish this priority by a clear preponderance of evidence, though not necessarily beyond reasonable doubt.² In order to do this he must not only overcome the presumptions against him arising out of earlier applications and patents on behalf of other parties, but must affirmatively establish his right to priority as against such parties themselves, by proofs sufficient to defeat their patents in the courts.³ Thus he must show that his conception of the in-

§ 600. ¹ That the same rules of evidence apply in interference cases as in the courts, see *Millward v. Barnes* (1877), 11 O. G. 1060; *Palm v. Behel* (1876), 10 O. G. 701; *Berry v. Stockwell* (1876), 9 O. G. 404.

That the examiner of interferences has the exclusive right to decide as to the competency, construction, scope, and legal meaning of all foreign patents or other evidence, and to determine whether they cover the same invention as the one in interference, see *Faure v. Bradley* (1888), 44 O. G. 945.

² That on an interference the party having the burden of proof must show that he first completed the invention, see *McKnight v. Wagenen* (1876), 9 O. G. 1161.

That a claimant against a patent has the burden of proof, see *Donoughe v. Hubbard* (1886), 27 Fed. Rep. 742; 35 O. G. 1561; *Cushman v. Parham* (1876), 9 O. G. 1108.

That where the *prima facie* proof arising from the patent is outbalanced by evidence of prior invention, the burden of proof shifts to the patentee, see *Hazelip v. Richardson* (1876), 10 O. G. 747.

That on interference the averment that an applicant is not an original inventor must be conclusively proved by

the party who alleges it, see *Hockhausen v. Weston* (1880), 18 O. G. 857.

That an applicant in interference with a patent need not prove priority beyond reasonable doubt, see *Fulgham v. Westcott* (1879), 16 O. G. 1005.

That the assertion of an applicant that he "invented" at a certain date is of little weight against facts showing the contrary, see *Slade v. Blair* (1880), 17 O. G. 261.

That where one of two joint patentees applies for a sole patent he must overcome by evidence the presumption arising from his oath as joint-inventor, as well as the *prima facie* case presented by the prior patent, or judgment on the interference will be against him, see *Lovrien v. Banister* (1880), 18 O. G. 299.

³ That in an interference between an application and a patent, the applicant must offer such evidence of priority as would defeat the patent in the courts, see *Gill v. Scott* (1883), 23 O. G. 2511; *Withington v. Locke* (1877), 11 O. G. 417; *Palm v. Behel* (1876), 10 O. G. 701; *Stoddard v. Perry* (1874), 6 O. G. 33.

That if a junior inventor, using due diligence in reduction and application, obtains a patent and a senior inventor afterward applies, the latter must show entire freedom from laches or a patent

vention antedated that of every other claimant, and that at the date of their conceptions he had either reduced, or was using reasonable diligence in reducing, his own conception to successful practice.⁴ In proving his conception of the invention the claimant may present any evidence which tends to show that the idea of means was fully developed in his own mind at the date alleged. Verbal descriptions, drawings or sketches, models, other devices equivalent in principle or embracing all the features on which conflict now arises, and any other manifestation or embodiment of his idea sufficient for its complete expression may be offered to support his claim.⁵

will be denied him and all doubts resolved in favor of the patentee, see *Voelker v. Gray* (1885), 30 O. G. 1091.

That the first applicant is regarded as the first inventor till the contrary appears, see *Starr v. Farmer* (1883), 23 O. G. 2325, 2327.

That where an application is complete and duly filed the subsequent applicant must show that he invented, or conceived the idea and was diligently reducing to practice, before the prior application was filed, see *Starr v. Farmer* (1883), 23 O. G. 2325, 2327.

That if one of the applications in interference is a division of one previously filed, the date of the original will be regarded in determining on whom is the burden of proof, see *Henderson v. Reese* (1883), 25 O. G. 191.

⁴ That the successful claimant must show that he was the first to conceive and used reasonable diligence in reducing to practice, see *Hammond v. Laird* (1874), 7 O. G. 170.

That where two persons separately make the same invention the question is which is the first inventor, see *Hall v. Johnson* (1883), 23 O. G. 2411.

That where each one of two persons who united in reducing the invention to practice claims to be the inventor, the question is which conceived it, see *Hall v. Johnson* (1883), 23 O. G. 2411.

See also § 370-391 and notes, *ante*.

⁵ That on an interference the *prima facie* date of a patented invention is the date of filing the application on which the patent issues, though other records of the Patent Office may be consulted, see *Booth v. Lyman* (1880), 18 O. G. 132.

That the uncontradicted oath of the applicant that he made drawings of the invention at a certain time, if supported by one other credible witness, is sufficient though the drawings have been destroyed, see *Smith v. Edson* (1875), 7 O. G. 827.

That the production of sketches prepared for the occasion profits little except as illustrating other evidence, see *McCullough v. Watkins* (1875), 8 O. G. 1074.

That mere descriptions and destroyed drawings are not of much weight to show priority, see *Ware v. Bullock* (1874), 7 O. G. 39.

That a machine embracing all the features over which the interference contest has arisen may serve to show the date of the invention, though it lacks certain improvements found in pending applications, see *Hockhausen v. Weston* (1880), 18 O. G. 857.

That devices produced by the applicant which are equivalent in principle may fix the date of the invention, see *Bird v. Walsh* (1878), 14 O. G. 234.

That an abandoned application is not

In proving reduction to practice he must establish the existence of an operative art or instrument, capable of practical employment.⁶ Upon this point models, drawings, and descriptions have but little weight. Diligence in reducing to practice may be shown by any testimony applicable to the peculiar circumstances of the case. No claimant is allowed by evidence to carry the date of his conception of the invention behind the date assigned to it in the preliminary statement; and any substantial variation between such statement and the evidence on any point renders the evidence suspicious.⁷ Where the statement fixes its dates by belief and information the testimony may render them more certain

considered in fixing the burden of proof, see *Henderson v. Reese* (1883), 25 O. G. 191.

That an abandoned experiment cannot be revived so as to secure priority on an interference, see *Sheridan v. Latus* (1883), 25 O. G. 501.

See also §§ 380, 381 and notes, *ante*.

⁶ In *Stover v. Clark* (1877), 12 O. G. 188, Spear, Com.: (188) "The question in controversy is one capable of easy solution if the bearing of the Office in relation to interference proceedings, in which one of the parties is a patentee, is kept clearly in mind. In this class of cases the adverse applicant must show conclusively that prior to the time of the invention by the patentee he (the applicant) had fully reduced it to a form or condition capable of standing the test of actual practical use. An experimental reduction, the illustration of a theory by a model, will not suffice of itself to establish that completion which is alone regarded by the law as sufficient to impeach the title of the patentee. As was said in *Coffin v. Ogden*, 18 Wall. 124, 'If the thing were embryotic or inchoate; if it rested in speculation or experiment; if the process pursued for its development had failed to reach the point of consummation, — it cannot avail to defeat a patent founded upon a discovery or invention which

was completed, while in the other case there was only progress, however near that progress may have approximated to the end in view."

See also *Gardner v. Dudley* (1880), 17 O. G. 801; *Halladie v. Paino* (1877), 12 O. G. 1077; *Sargent v. Burge* (1877), 11 O. G. 1055.

That a patent is *prima facie* proof that the patentee had completed his invention, though its practical use is not shown, see *Busby v. Phelps* (1876), 9 O. G. 1010.

That the assertion of a party that he conceived the invention at a certain time amounts to very little unless he then completed it, see *McCullough v. Watkins* (1875), 8 O. G. 1074.

⁷ That the evidence must conform to the statement or it will be rejected, see *Hovey v. Hufeland* (1872), 2 O. G. 493.

That any substantial variance between the statement and the evidence renders the evidence suspicious, see *McCullough v. Watkins* (1875), 8 O. G. 1074.

That the evidence as to the date of the invention need not agree with the statement, but must not show it to be earlier than the one therein alleged, see *Connor v. Williams* (1878), 15 O. G. 386; *Walpuski v. Jacobsen* (1876), 9 O. G. 964.

and correct.⁸ A foreign patentee cannot prove an earlier date for his invention than the date of his foreign patent, and a foreign inventor who has not patented his invention abroad cannot anticipate by his evidence the date on which the knowledge of his invention was first brought to the United States, either by himself or by his confidential agent.⁹ A preliminary statement is not admissible in evidence in favor of the party making it, although it may be used against him as rebutting or limiting the other evidence which he presents.¹⁰

§ 601. Interference Proceedings: Rules of Evidence.

The statute authorizes the Commissioner to make rules for taking testimony in cases pending in the Patent Office, and provides for the issue of *subpœnas* from the Federal courts in the districts where the witnesses reside, and for compelling the attendance of those witnesses who disregard the ordinary

⁸ That a statement fixing dates by belief only may be corrected by the evidence, see *White v. Farmer* (1874), 5 O. G. 338.

⁹ That an applicant for an invention conceived abroad may carry the date of his invention back to the arrival of the inventor or his agent in the United States, see *Thomas v. Reese* (1880), 17 O. G. 195.

That a foreign inventor cannot carry the date of his invention back by showing acts done in a foreign country, see *Boulton v. Illingworth* (1888), 43 O. G. 508.

That whether a foreign patentee can carry his date back to that of his foreign patent is doubtful, see *Thomas v. Reese* (1880), 17 O. G. 195.

That a foreign patentee cannot go behind the date of his patent to show the time of his invention, see *Rumpff v. Köhler* (1882), 23 O. G. 1831, 1832; *Chambers v. Duncan* (1876), 10 O. G. 787.

That evidence that one applicant published his invention abroad before the other made it here defeats the ap-

plication of the other, and also possibly his own, see *Thomas v. Reese* (1880), 17 O. G. 195.

That Sec. 4887, limiting the term of the domestic by that of a foreign patent, cannot be invoked to carry the date of invention back to the date of a previously issued British patent, where the two patents are not alike, see *Gandy v. Main Belting Co.* (1886), 37 O. G. 1357.

For a discussion of the value of an English specification as evidence, see *Lauder v. Crowell* (1879), 16 O. G. 405.

On the whole matter of priority in reference to foreign inventors and patentees, see § 382 and notes, *ante*.

¹⁰ That a preliminary statement is not affirmative evidence in favor of the party making it, see *Lauder v. Crowell* (1879), 16 O. G. 405.

That the original statement and the fact of its amendment will be considered on the merits as affecting the evidence concerning the actual date, see *Robinson v. Seymour* (1885), 33 O. G. 113.

summons.¹ In the exercise of the authority thus conferred upon him the Commissioner has established certain regulations, prescribing that all evidence offered in contested cases must be presented in depositions, taken upon due notice to the adverse parties in the form of interrogatories and replies, and sealed up, addressed, and forwarded to the Commissioner by the officer before whom they were given.² Where witnesses reside abroad, such depositions may be taken before an American consul, or other proper officer, by order of the Commissioner, based upon the motion of the claimant and his sworn averment that the motion is not made for purposes of delay or vexation to the adverse party and that the evidence cannot be otherwise conveniently obtained.³ After these depositions are returned to the Commissioner and duly opened, they are subject to inspection by the parties, but cannot be withdrawn. Unless for satisfactory reasons to the contrary they must be printed by some person appointed by the Office for that purpose, and copies must be furnished to the Office and to each of the contestants. Caveats and other official records, and any special matter contained in printed publications, may be filed and used as evidence upon due notice to the adverse parties, when competent and pertinent to the issue. No evidence touching the matters in dispute can be considered at

§ 601. ¹ That the rules of evidence in interference proceedings are those of the law in force in the District of Columbia, see *Marsh v. Rein* (1888), 43 O. G. 1453; *Koen v. Quint* (1883), 23 O. G. 1329.

That witnesses are under the control of the courts, not of the Commissioner, see *Osgood v. Badger* (1888), 44 O. G. 1065.

That husband and wife are not competent witnesses for or against each other in interference proceedings, see *Marsh v. Rein* (1888), 43 O. G. 1453; *contra*, *Koen v. Quint* (1883), 23 O. G. 1329.

That where one party to an interference attacks the patentability of the invention he must offer all his evidence

on this point as well as that of priority before his opponent can be obliged to put in his proof, see *Clark v. La Dow* (1888), 43 O. G. 248.

² That a notice to take testimony after so short an interval that the party must travel night and day to get there is not reasonable notice, see *Hoag v. Abbott* (1879), 15 O. G. 471.

That a failure to appear to take a deposition after reasonable notice is a waiver of all technical irregularities, see *Hoosier Drill Co. v. Ingels* (1879), 15 O. G. 1013.

³ That the Commissioner may order depositions to be taken abroad before consuls, see *Lauder v. Crowell* (1879), 16 O. G. 405.

the hearing unless obtained in accordance with these rules. But merely technical objections, not working any substantial injury to the party raising them, will not be regarded, and where such injury is inflicted the injured party must make his objection as soon as he becomes aware of its existence, and notify the Office and the adverse party that unless the objection is removed it will be urged against him at the hearing.⁴

§ 602. Interference Proceedings: Arguments of Contestants.

The rules advise that arguments and briefs in all contested cases should also be printed and filed before the hearing, and parties neglecting to avail themselves of this advantage in due season have no right to an extension of time for that purpose. Upon the day named for the hearing, any party appearing will be heard, but no case will be taken up for oral argument after the day appointed, except by the consent of all parties. After the arguments have been completed, no further hearing will be accorded to either party unless at the request of the tribunal having jurisdiction of the case.

§ 603. Interference Proceedings: Judgment of Priority.

An interference having been once declared, it cannot be determined without a formal dissolution, or a judgment on the issue of priority.¹ This judgment may be rendered either

* That objections to the evidence must be urged at the hearing, under the rules, see *Hoag v. Abbott* (1879), 15 O. G. 471.

That a deposition improperly taken may be objected to at the interference hearing, though ordinary objections which may be cured by a new commission to take testimony, or formal objections merely, should be taken by motion to suppress, see *Milligan v. Niedringhaus* (1886), 38 O. G. 103.

That it is always better to move to suppress in advance of the hearing, see *Milligan v. Niedringhaus* (1886), 38 O. G. 103.

That a motion to suppress will be

denied, except in extreme cases, if the party moving has neglected to take proper steps for his protection, see *Osgood v. Badger* (1888), 44 O. G. 1065.

That a motion to suppress must be made without unreasonable delay, see *Milligan v. Niedringhaus* (1886), 38 O. G. 103.

That if a witness in an interference refuses to answer a proper question on cross-examination his entire testimony will be excluded, see *Milligan v. Niedringhaus* (1886), 38 O. G. 103.

§ 603. ¹ That where an interference exists the proceedings cannot terminate without a judgment on account of the

upon the testimony, or upon the written concession of the adverse parties, signed by the parties themselves and not merely by their attorneys, or upon the written declaration of either of the parties that he has abandoned his application.² Such written concession must be consistent with the facts, — no false or fraudulent admission of priority authorizing a judgment contrary to the truth.³ In rendering a judgment on the testimony the examiner of interferences must follow the same rules concerning the performance and completeness of the inventive act which are recognized as binding in the courts. The several parties are presumed to have made the invention in the chronological order in which they filed their original applications, and the burden of proof rests on those who endeavor to establish any different order of invention.⁴ Where all the parties are American inventors judgment must be awarded to the claimant who establishes the real priority of his inventive act. Where one of the parties is a foreign inventor and the others are American, the latter is entitled to priority unless the invention of the former was known or used in the United States, or patented or published, before the conception of the invention by the latter. If one of two foreign inventors has obtained a for-

abandonment of his application by one party, if the other party claims it, see *Adler v. Van Wagener* (1875), 8 O. G. 728.

That a judgment must be rendered except in cases where the rules otherwise provide, see *Hicks v. Keating* (1887), 40 O. G. 343.

² That an agreement conceding priority is not good unless signed by the adverse party himself, the attorney having no authority to sign it, see *Tucker v. Kahler* (1879), 15 O. G. 966.

That a concession of priority is not available except between the parties and in reference to pending proceedings, see *Hammond v. Pratt* (1879), 16 O. G. 1235.

³ That a concession of priority contrary to the truth is void, see *Hammond v. Pratt* (1879), 16 O. G. 1235 ; *Packard*

v. Sandford (1879), 16 O. G. 1182 ; *Allen v. Gilman* (1872), 2 O. G. 293.

See also § 363 and notes, *ante*.

⁴ That unless a contrary right appears priority will be awarded to the party who first filed a complete application, including petition, specification, drawings, model, and fee, see *Lapham v. Bettendorf* (1879), 16 O. G. 137.

That priority cannot be awarded to the earliest applicant, who has merely conceived the idea and filed an application, against one who, before the filing of such application, had reduced the idea to practice, see *Gardner v. Dudley* (1880), 17 O. G. 801.

That priority will be awarded to the first perfecter of the invention though the other party were the first to practically use it, see *Martin v. Bogle* (1877), 12 O. G. 625.

foreign patent, he must prevail over his adversary, although the other was in fact the first inventor; if both have obtained foreign patents the earliest patentee has the superior right; if neither has a foreign patent the earliest introducer into the United States prevails.⁵ Where the decision in favor of one applicant against another is not appealed from, or is sustained upon appeal, it is equivalent to a rejection of the defeated applications, and a patent is awarded to the victorious applicant alone.⁶ But when an applicant establishes his own priority against a patent, the patent cannot be affected by the judgment, and the sole result is the issue of another patent to the applicant. Where neither party proves priority judgment is rendered against both, in order that both may be enabled to appeal.⁷ The wrongful issue of a patent to one applicant, pending an interference, does not warrant the issue of another to his rival where the priority of the latter is not proved.⁸

⁵ That an invention made in the United States has priority over a foreign invention unless the foreign invention were used in the United States, or were published or patented, before the domestic invention was made, see *Lauder v. Crowell* (1879), 16 O. G. 405.

That as between two foreign inventions the first applicant in the United States has priority, if he is an original inventor, see *Lauder v. Crowell* (1879), 16 O. G. 405.

That as between two foreign inventors who are applicants in the United States, if one of them has a foreign patent he is entitled to priority, though the other was the first inventor, see *Lauder v. Crowell* (1879), 16 O. G. 405.

That when two foreign applicants are both foreign patentees, the earliest patentee is entitled to priority, see *Lauder v. Crowell* (1879), 16 O. G. 405.

That a foreign patentee stands like any other applicant until a contest begins, and must then prove his priority, see *Lauder v. Crowell* (1879), 16 O. G. 405.

⁶ That the applicant for a specific invention, having been defeated in an interference with the applicant for the generic invention, cannot have a patent for the species subject to that for the genus unless he disclaims the genus or takes some other further action, see *Ex parte Gardner* (1880), 17 O. G. 626.

⁷ That if neither party seems to be the original and first inventor judgment should run against both, see *Wood v. Eames* (1880), 17 O. G. 512.

⁸ In *Ex parte Frick* (1872), 1 O. G. 574, Leggett, Com.: (574) "It is claimed by the applicant in this case that during the pendency of his application a patent has been issued to other parties for substantially the same thing, and he now asks that a patent be allowed him without being called upon to prove priority of invention in an interference with the existing patent. If it be true (which I now neither admit nor deny) that a patent has issued during the pending of this application with which this application at the time interfered, then the Office has committed

§ 604. **Interference Proceedings: Appeal from Judgment of Priority.**

Unless appealed from, the decision of the examiner of interferences is conclusive upon all the parties to the interference.¹ Such an appeal will lie only on some question involved in the issue of priority, and is taken in the first instance to the examiners-in-chief and from their adverse judgment to the Commissioner in person.² An appeal in

a grave error; but this error would not be corrected by granting the motion now made by the applicant. Two wrongs would not make one right. If the Office has committed a blunder by illegally issuing one patent, it cannot now correct that blunder by illegally issuing another. The action now must have reference to the present condition of the two cases. The existing patent, though prematurely issued, is beyond the control of the Office, and cannot be recalled. Another patent cannot be legally issued for the same invention, except upon interference trial it be shown that the applicant is the prior inventor. The motion of the applicant must, therefore, be refused."

§ 604. ¹ That an interference must first be heard before the examiner of interferences, see *Farnsworth v. Andrews* (1875), 9 O. G. 195.

That the decision of the examiner of interferences is conclusive unless appealed from, see *Whitely v. McCormick* (1876), 10 O. G. 826; *Jenkins v. Barney* (1873), 3 O. G. 119.

² That the relation of the examiner of interferences and of the examiners-in-chief to the Commissioner is the same as that of one court to another, see *Berry v. Stockwell* (1876), 9 O. G. 404.

That the jurisdiction of an examiner terminates upon an appeal, see *Ex parte Brunner* (1872), 1 O. G. 303.

That no appeal lies from the refusal of an examiner to dissolve the inter-

ference on the ground that the adverse applicant had no right to make the Claims, no party having any other rights against his adversary than the whole public has, and it being presumed that the Patent Office will protect these, see *Faure v. Bradley* (1887), 40 O. G. 243.

That in an interference case a notice to the defeated party of the adverse decision, limiting the time for appeal to ten days, means ten days from the receipt of the notice, and is, therefore, uncertain, see *Pearson v. Lister* (1883), 24 O. G. 1175.

That on an appeal to the Commissioner in an interference the applicant is entitled to have his case considered on the law and the evidence, see *Sellers v. Walter* (1886), 37 O. G. 1001.

That if, pending an appeal to the Commissioner in an interference, he is notified that the applications should be rejected on the ground of public use, he should refer that question to the examiner, see *Finch v. Bailey* (1883), 25 O. G. 191.

That where the Commissioner is ordered by mandamus to hear an interference in person the patent cannot issue until the mandamus has been obeyed, see *Withington v. Locke* (1878), 15 O. G. 426.

That on an appeal the concurrent opinions of the examiner of interferences and the examiners-in-chief on a question of fact are of great weight, see *Berry v. Stockwell* (1876), 9 O. G. 404.

an interference case must be accompanied by a brief statement of the reasons therefor, and is governed by the same general rules that are applied to appeals in *ex parte* cases. From the decision of the Commissioner there is no appeal, and patents issue to successful applicants without further opposition on the part of rival claimants.³ But a defeated claimant still has a remedy for the assertion of his own rights by a bill in equity upon which all adverse parties, whether applicants or claimants, may be heard; and if he then obtains a judgment another patent will be issued in his favor.⁴

§ 605. **Interference Proceedings: Dissolution of the Interference.**

If it becomes apparent during the course of an interference that its further prosecution would be useless, a motion to dissolve it may be made before the examiner of interferences, by whom the motion, with the files and papers, must be transmitted to the primary examiner for his decision on the points involved.¹ This motion may be offered whenever the testi-

³ That no appeal will lie to the Supreme Court of the District of Columbia from a decision of the Commissioner in an interference case, the only remedy being by bill in equity under Sec. 4915, see *Kirk v. Commissioner* (1886), 37 O. G. 451; 5 *Mackay*, 229; *Butler v. Shaw* (1884), 21 *Fed. Rep.* 321.

That the Secretary of the Interior has no power to revise the decision of the Commissioner on the subject of priority, see *Butterworth v. Hoe* (1884), 112 U. S. 50; 29 O. G. 615; *United States v. Butterworth* (1884), 3 *Mackay*, 229; 27 O. G. 519.

⁴ That a decision in interference is not final except in the Patent Office, and a bill in equity to annul the adverse patent will lie in favor of the defeated party, see *Union Paper Bag Mach. Co. v. Crane* (1874), 1 *Bann. & A.* 494; *Holmes*, 429; 6 O. G. 801.

That the remedy in equity provided by Sec. 4915 applies to decisions in interference cases as well as all other

decisions on the merits of an application, see *Butterworth v. Hoe* (1884), 112 U. S. 50; 29 O. G. 615.

That the successful applicant cannot be enjoined from accepting his patent on the ground that the Commissioner was mistaken as to priority, see *Whipple v. Miner* (1883), 23 O. G. 2236; 15 *Fed. Rep.* 117.

That the power of the Circuit Court to grant a patent is independent of the Patent Office, but the defeated party cannot decide when the court shall act by injunction, see *Whipple v. Miner* (1883), 23 O. G. 2236; 15 *Fed. Rep.* 117.

That the filing of a bill in equity to obtain a patent by the defeated party to an interference does not stay proceedings in the Patent Office nor justify the Commissioner in withholding a patent from the successful party, see *Wells v. Boyle* (1888), 43 O. G. 753.

§ 605. ¹ That an examiner of interferences cannot dissolve an interference

mony introduced or the arguments urged or the concession of either of the parties renders it evident that the interference cannot lawfully proceed.² The grounds on which it may be based are the non-patentability of the invention,³ the absence

on *ex parte* affidavits alleging non-patentability, etc., though he may suspend and remand to the primary examiner, see *Hedges v. Daniels* (1880), 17 O. G. 152.

That if a motion to dissolve an interference is based on want of patentability, etc., it must be sent to the primary examiner, see *Green v. Hall* (1886), 37 O. G. 1475.

That when an interference is remanded to the primary examiner for want of patentability, etc., the interference is dissolved *pro hac vice*, the applications become *ex parte*, the original jurisdiction of the examiner attaches, and the right of appeal exists as in other *ex parte* cases, see *Faure v. Bradley* (1887), 40 O. G. 243.

² That a motion to dissolve may be made at any time, see *Banks v. Snediker* (1879), 16 O. G. 1096.

That if a motion to dissolve the interference is not filed within twenty days after the statement is approved the delay must be explained, or the examiner of interferences will not send the case to the primary examiner, though from his refusal to do so appeal lies to the Commissioner, see *Green v. Hall* (1886), 37 O. G. 1475.

That a motion to dissolve an interference must state the reasons, and recite the grounds, and show all the facts on which the motion is based, see *Green v. Hall* (1886), 37 O. G. 1475.

That adverse parties must be served with a notice of a motion to dissolve an interference and with the reasons therefor, and have an opportunity to be heard, see *Green v. Hall* (1886), 37 O. G. 1475.

That an irregular motion to dissolve an interference will be dismissed on mo-

tion of the adverse party, see *Green v. Hall* (1886), 37 O. G. 1475.

That if the later applicant disclaims the invention the interference will be dissolved, see *Laverty v. Flagg* (1879), 16 O. G. 1141.

³ That a motion to dissolve an interference must be based on the application alone, not on the preliminary statement or other outside matter, see *Faure v. Bradley* (1888), 44 O. G. 945.

That an interference may be dissolved on the ground that the invention is not patentable, see *Stone v. Greaves* (1880), 17 O. G. 397; *Hockhausen v. Weston* (1880), 18 O. G. 857.

That on proof of facts showing a bar to the patent, as distinguished from a mere want of title, the interference may be dissolved, see *Hicks v. Keating* (1887), 40 O. G. 343.

That want of novelty is a ground for dissolution, see *Ex parte Knox* (1879), 16 O. G. 1048.

That if only one of the inventions is useful and operative a dissolution will be ordered, see *Fuller v. Brush* (1879), 16 O. G. 1188.

That where abandonment by public use is suspected the examiner of interferences may be ordered to investigate it, or the case may be remanded to the primary examiner, from whom an appeal lies, see *Ex parte Finch* (1887), 40 O. G. 1027.

That a motion to dissolve on the ground of non-patentability should be made at the outset, see *Blinn v. Gale* (1879), 16 O. G. 459.

For the practice in cases where a statutory bar appears, see *Hicks v. Keating* (1887), 40 O. G. 343.

of any real conflict between the Claims of the several contestants,⁴ the failure of either party to show that he is a true inventor of the invention claimed,⁵ or such irregularity in the institution of the interference as must render any judgment therein void.⁶ From the decision of the primary examiner upon this motion an appeal lies in the usual manner to the examiners-in-chief;⁷ but if no appeal is taken within the

⁴ That unless both devices are embraced in the interference it should be dissolved, see *Smith v. Winchell* (1878), 18 O. G. 1127.

That if both parties do not claim the same subject-matter the interference will be dissolved, see *Sawyer v. Edison* (1883), 25 O. G. 597; *Dod v. Cobb* (1876), 10 O. G. 826.

That where two machines in interference are different, and only one is operative, the difference will be treated as essential, see *Bradford v. Imlay* (1879), 16 O. G. 314.

⁵ That if the contestants appear to be joint inventors dissolution will be ordered, see *Taylor v. Martin* (1879), 16 O. G. 138.

That if a motion to dissolve is made on the ground that the adverse party is not an original inventor, the allegation must be conclusively proved, see *Hockhausen v. Weston* (1880), 18 O. G. 857.

That if it appears that the patentees in a joint conflicting patent were not joint inventors, the interference will be dissolved, see *Walton v. Dennis* (1879), 16 O. G. 959.

⁶ That a motion to dissolve on account of non-interference or irregularity in the proceedings will be heard by the tribunal before which the case is pending, see *Barney v. Kellogg* (1880), 17 O. G. 1096.

That no motion to dissolve an interference should be sent to the primary examiner unless it alleges either that there is no interference in fact, or that the interference has been so irregularly declared that no judgment can be ren-

dered, or that the invention is not patentable, or that the applicant has no right to claim it, see *Edison v. Phelps* (1887), 38 O. G. 539.

That on hearing a motion to dissolve an interference nothing will be considered but what appears on the face of the motion, and the papers filed, see *Green v. Hall* (1886), 37 O. G. 1475.

That on a motion to dissolve an interference counter affidavits may be filed at the time named for the hearing and without notice, and if the adverse party be taken by surprise, a continuance may be granted, see *Green v. Hall* (1886), 37 O. G. 1475.

That on a motion to dissolve an interference affidavits of the adverse party, filed without leave, will not be noticed, see *Green v. Hall* (1886), 37 O. G. 1475.

⁷ That where a primary examiner overrules a motion to dissolve, and affirms his previous finding of patentability, the mover may make protest to the Commissioner against the issue of the patent, see *Fowler v. Benton* (1880), 17 O. G. 266.

That no appeal lies from a decision affirming "the right of the applicant to make the Claims," and so overruling a motion to dissolve, see *Faure v. Bradley* (1888), 44 O. G. 945.

That an appeal from the order to dissolve for want of patentability lies to the examiners-in-chief, see *Fuller v. Brush* (1879), 16 O. G. 1188.

That if an interference is dissolved, and both applications are rejected, and one party appeals to the Supreme Court of the District, the other by two years

time limited for that purpose, or if the right to an appeal is expressly waived by the party entitled to it, the examiner returns the files and papers, with his own judgment upon the matters embraced in the motion, to the examiner of interferences, who dissolves or continues the interference in accordance with the facts found by the primary examiner. Two motions to dissolve on the same ground are not permitted, the remedy of the party claiming it being exhausted by one motion with the privilege of an appeal.⁸

§ 606. **Interference Proceedings: Suspension of the Interference.**

Whenever the examiner of interferences or the examiners-in-chief upon appeal discover any fact not bearing on the question of priority, but showing that no conflict actually exists between the inventions of the several claimants, or that the invention is not patentable to either party, or that the interference was irregularly declared, it is their duty to suggest it to the Commissioner, in order that he may suspend the interference and remand the case to the primary examiner for his consideration of the matters thus discovered.¹

failure to prosecute his application may abandon it, see *Cruikshank v. Strong* (1880), 17 O. G. 511.

⁸ That two motions to dissolve cannot be entertained on the same ground; one motion only with an appeal or rehearing being allowed, see *Banks v. Snediker* (1880), 17 O. G. 508.

§ 606. ¹ That the examiner of interferences has no jurisdiction over questions of patentability, see *Little v. Lillie* (1876), 10 O. G. 543.

That when, on an interference, the patentability of the invention seems doubtful, the interference should be suspended and the question referred to the examiner for decision, see *Lynch v. Dryden* (1873), 3 O. G. 407; *Wood v. Morris* (1873), 4 O. G. 131; *Ex parte Neuboecker* (1873), 4 O. G. 319.

That if the invention is claimed to have been abandoned by public use, a suspension will be ordered and the case

sent to the examiner, see *Hedges v. Daniels* (1880), 17 O. G. 152.

That an interference will not be arrested by the Commissioner before an appeal and referred to the examiner on a question of public use, unless the proof is clear, see *Finch v. Bailey* (1883), 25 O. G. 191.

That an examiner of interferences cannot consider affidavits as to public use, and on that ground reject an application and dissolve the interference, see *Hedges v. Daniels* (1880), 17 O. G. 152.

That an examiner of interferences may be directed to investigate a question of public use, see *Ex parte Finch* (1887), 40 O. G. 1027.

That the examiner of interferences, by order of the Commissioner, may fix times for taking evidence on the question of public use, see *In re Alteneck* (1883), 23 O. G. 2233.

An interference may also be suspended by the Commissioner, upon the request of the primary examiner, for the purpose of adding new parties or when the examiner has found new references which seem to him to cast a doubt upon the patentability of the invention.² After the decision of the primary examiner upon these matters, or that of the examiners-in-chief on an appeal, the interference will be dissolved or re-instated as the character of such decision may require.³ Judgment in an interference case which is otherwise ready for decision will not be suspended in order that different questions, not affecting the defeated party may be first determined.⁴ Hearings before the primary examiners upon these suspensions, as well as upon motions to dissolve, and appeals from their judgments to the examiners-in-chief or the Commissioner, are governed by the rules heretofore discussed in reference to *ex parte* cases.

§ 607. Interference Proceedings : Motions : Practice.

During the proceedings in an interference any other proper motions may be made by either party after reasonable notice

² That where the evidence on interference shows any other defects, suspension may be ordered and the case sent back to the examiner, see *Bigelow v. Commissioner* (1875), 7 O. G. 603 ; 2 *MacArthur*, 24.

That suspension may be ordered to add new parties, see *Maloney v. Kidwell* (1879), 16 O. G. 1139.

That if, pending an interference, an application is filed, which the examiner thinks should be included therein, he must report it to the examiner of interferences, who must ascertain whether any evidence has been taken ; if not, he may suspend the interference and admit the new party, otherwise report to the Commissioner, see *Reed v. Jordan* (1887), 38 O. G. 661.

That an interference opened by the primary examiner to let in new parties stands as if it had just been originally declared, and neither party has a right, at this stage, to interfere in the framing

of the issues or inspect the papers now admitted, see *White v. Demarest* (1887), 41 O. G. 1161.

³ That if the decision of the examiner denies the patentability of the invention, the interference will be dissolved, unless appeal is taken, see *Stone v. Greaves* (1879), 17 O. G. 260.

⁴ That the Commissioner will not suspend his judgment on an interference to await the decision of other questions not affecting the defeated party, see *Smith v. Dimond* (1881), 20 O. G. 742.

That an interference with a patent will not be suspended to await the decision of a suit as to its ownership, unless the interfering applicant is connected with the suit, or the parties to the suit are likely to be injured by the action of the Patent Office and are trying to protect their rights, see *Keith v. Faure* (1883), 25 O. G. 289.

to the adverse claimants.¹ Such motions are addressed to the tribunal having immediate jurisdiction of the interference, but an appeal from the decision thereby rendered may be taken to the examiners-in-chief on questions relating to the merits of the case and on other questions directly to the Commissioner, as provided in the general rules which govern all appeals. A motion does not necessarily operate as a stay of the proceedings. To effect this a special application must be made to the same tribunal, which may upon sufficient grounds order a suspension of the interference until the motion is decided.² The practice upon all motions in contested cases, where not particularly indicated by the rules of the Patent Office, follows the ordinary course of equity practice in the courts of the United States.

§ 608. Interference Proceedings: Amendment of Application by Disclaiming Contested Matter.

Amendments to an application while in interference can be made only for the purpose of delivering its subject-matter, wholly or in part, from the conflict in which it is apparently involved. An applicant who prefers to abandon any claim to the contested matter rather than incur the expense, delay, and risks of an interference, may file in the Patent Office, before the date fixed for the presentation of his preliminary statement, a disclaimer in writing over his own signature and attested by two witnesses, averring that he does not claim to be the inventor of the particular matter in issue. This disclaimer must be accompanied by such an amendment to his specification as removes the contested matter from his Claims as therein stated. Judgment will then be rendered³ against him in the interference, and his disclaimer and amendment will be embodied in his remaining application, which will

§ 607. ¹ That an interference is a contested case, even in its preliminary stages, and motions cannot be made without notice to the other party, see *Bell v. Gray* (1879), 15 O. G. 776; *Gray v. Bell* (1878), 15 O. G. 385.

That notice must be given to all other parties, since every application or

patent involved in the interference is hostile to all the rest, see *Bell v. Gray* (1879), 15 O. G. 776.

² That a motion does not stay proceedings in interference unless a petition to that effect is also offered and granted, see *Dubois v. McCloskey* (1880), 17 O. G. 1158.

thereafter be examined and determined as an *ex parte* case.¹ This disclaimer has no relation to the disclaimer of a patentee, filed for the purpose of amending an already granted patent.² Where there has been an assignment of the invention before or pending the application, such disclaimer must be accompanied by the written consent of the assignee.

§ 609. Interference Proceedings: Amendment of Application by Withdrawing Uncontested Matter for New Application.

Where an application covers several complete inventions, and an interference has been declared between it and another application or a patent embracing less than all the inventions therein claimed, the applicant may file an amendment withdrawing from his application the uncontested matters, in order to make these the subject of a new application, while the interference proceeds to judgment in reference to the matters in dispute.¹ In such new application no Claim can be inserted whose language includes anything still claimed in the original application, though the devices shown in the original may be described in the new, so far as may be necessary to render the subject-matter of the new intelligible to

§ 608. ¹ That where the later applicant disclaims the conflicting invention the interference will be dissolved, see *Laverty v. Flagg* (1879), 16 O. G. 1141.

That the decision of the Commissioner, on appeal, that an amendment does not warrant a dissolution of an interference, is binding until duly reversed, *Ex parte Gardner* (1880), 17 O. G. 626.

² That an interference is not dissolved on account of a disclaimer made *pendente lite*, see *Waring v. Wilkerson* (1878), 15 O. G. 246.

That where a defeated party to an interference cancels the interfering Claims he cannot be required to disclaim such matter though his Claims may be made so specific as not to impose on the public, see *Ex parte Firm* (1887), 39 O. G. 1199.

§ 609. ¹ That a party to an interference may remove from his application all his own peculiar separable inventions and not await the decision in the contest, see *Ex parte Wheeler* (1883), 23 O. G. 1031.

That a party to an interference cannot make in a separate application any Claim which the adverse party might also make, see *Ex parte Wheeler* (1883), 23 O. G. 1031.

That where in an interference the undisputed matter is withdrawn, and made the basis of a separate application, and a patent disclaiming all not claimed therein and reserving the right to apply for the disclaimed matter issues, and then a third application is filed claiming all in both the others, the latter is treated as a division of the first, see *Ex parte Clarke* (1884), 26 O. G. 824.

persons skilled in the art. The new application will be then examined and proceeded with as an *ex parte* case, unless some other interference is discovered.

§ 610. Interference Proceedings: Discovery of Non-Patentability of the Invention pending the Interference.

In rendering their decision on the question of priority, it is the duty of the examiner of interferences, or of the examiners-in-chief upon appeal, to call the attention of the Commissioner to any points they may discover relating to the general merits of the applications.¹ The Commissioner may then remand the case to the primary examiner for his consideration, the parties having the same rights of appeal from his determination of these questions as in other cases.² On an appeal from the examiners-in-chief to the Commissioner, upon the issue of priority, if he perceives that any matter relating to the patentability of the invention, or to the rights of either of the claimants as against the public, still remains undetermined, he may in the same manner provide for its examination and decision.³

§ 611. Interference Proceedings: Effect of Judgment.

A judgment in an interference, if not appealed from, is conclusive on the parties to the interference as far as the action of the Patent Office is concerned, and a second interference will not be declared between the same parties in reference to the same invention, either upon the same or upon

§ 610. ¹ That all questions as to the patentability of the invention ought to be settled before the interference is declared, but if afterwards arising they must be considered, see *Wood v. Morris* (1873), 3 O. G. 239.

That if questions as to patentability first appear on the interference hearing they may be noted, and afterward passed upon by the primary examiner, see *Anson v. Woodbury* (1876), 11 O. G. 243.

That on an appeal to the examiners-in-chief in an interference, if the devices

are found not to interfere, this question is not in issue but may be noted in a postscript for further action, see *Brown v. La Dow* (1880), 18 O. G. 1049.

² That a hearing on an interference will be opened to let in newly discovered evidence as to the novelty of the invention, see *Wood v. Morris* (1873), 3 O. G. 239.

³ That the Commissioner must take notice of an objection to patentability, however it may be brought to his attention, see *Ex parte Smoot* (1877), 11 O. G. 1010.

amended or new applications.¹ The former decision, if erroneous either in fact or in law, can, however, be reviewed, when substantial justice requires it, on a new trial granted according to the principles governing such proceedings in ordinary cases.

§ 612. Interference Proceedings : Number Unlimited : Consolidation of Interferences.

Any number of interferences may be instituted between a given application and conflicting patents or applications ; and these may be concurrent or successive, as the circumstances may require.¹ When several applications interfere with one another upon the same subject-matter, presenting but a single issue, the various reciprocal interferences may be consolidated and disposed of upon one proceeding.² When a new application is filed pending an interference between others, every one of which conflicts with it on different points relating to the invention therein described, each of the former parties may so amend his application as to include all the points claimed in the later, and a new interference embracing all the applications will be then declared.³ But if an application is in

§ 611. ¹ That a second interference will not be declared between the successful party and his opponents, on other applications, although they show features described but not claimed in the successful application, unless the Commissioner so order, see *Hovey v. Muller* (1873), 3 O. G. 149.

§ 612. ¹ In *Potter v. Dixon* (1863), 5 Blatch. 160, Nelson, J. : (163) "It is supposed by the learned Chief Justice that there can be but one interference declared by the Commissioner on an application for a patent, and that the decision of the Chief Justice is conclusive upon the Commissioner, though in the meantime, and before the patent issues, another case of interference should appear or be presented. There is certainly nothing in the statute limiting the power of the Commissioner in this respect, and the reason for the hearing in

the second case is as strong as for that in the first. The object of the provision is one that pervades the whole of the statute, namely, to secure to the real inventor the exclusive privileges therein provided for. Besides, a hearing and decision between the applicant for a patent and A, whether in favor of the one or the other, forms no rule for a decision between the applicant and B, in case of an interference declared between them. The proceedings are independent and *inter alios*." 2 Fisher, 381 (384).

That evidence as to priority must be received by the Patent Office if offered at any time before the patent issues, see *Eccard v. Drawbaugh* (1883), 24 O. G. 301.

² That interferences may be consolidated, see *Bell v. Gray* (1879), 15 O. G. 776.

³ That when a new application is

conflict with another only upon one divisible member of the invention, and with still another only on a different member of the invention, the issues presented are entirely distinct, and the interference proceedings must be separate and independent of each other. A judgment in one interference does not prevent the successful contestant from being made a party to another interference with different opponents, and for this purpose his patent may be withheld from issue even after the allowance of his application and the payment of the final fee.⁴

§ 613. **Interference Proceedings: Judgment how far Conclusive.**

The doctrine of *res adjudicata* is recognized and applied in the Patent Office as well as in the courts.¹ But a judgment in one interference furnishes no guide in others, and is binding only on the parties to the record, and on them only in reference to further proceedings on the same questions in the Patent Office.² Before the courts the adverse parties still stand

filed, interfering with two or more applications already in interference, a new interference will be declared and the former parties may amend their Claims so as to meet the last application, see *Ex parte Smith* (1880), 17 O. G. 447.

⁴ That an application is pending until the patent has been recorded, and up to that time it may be put in interference, whatever orders or payments may have been made, see *Ex parte Osgood* (1885), 33 O. G. 1265.

That the patent will not be withheld, after payment of the final fee, for the purpose of declaring an interference with a new conflicting application filed after a judgment for the patentee in a former interference, see *Wright v. Reese* (1877), 11 O. G. 329.

That no delay in interference proceedings against the consent of the applicant can abandon the application, see *Taylor v. Shreffler* (1883), 24 O. G. 1175; *Weston v. White* (1876), 13 Blatch. 447; 2 Bann. & A. 364.

§ 613. ¹ That the doctrine of *res adjudicata* applies to proceedings in the Patent Office, see *Ex parte Burge* (1877), 13 O. G. 498; *Whitely v. McCormick* (1876), 10 O. G. 826.

That an interference-judgment is binding in interference cases in the Patent Office, though it may not be in the courts, see *Nicholson v. Bennett* (1879), 16 O. G. 631.

That an interference-judgment is conclusive in the Office upon all points which might by due diligence have been presented at the hearing, except in special cases, see *Whitely v. McCormick* (1876), 10 O. G. 826; *Harlow v. Guernsey* (1875), 7 O. G. 513.

² That a judgment in one interference can only indirectly affect others, see *Ex parte Hedderwick* (1879), 15 O. G. 472.

That the decision of the Chief Justice of the District of Columbia on an appeal under the act of 1839 did not prevent the declaration of an interference between the prevailing party and

upon equal ground, and the defeated claimants may be heard, like any other persons, in denial of the claims of the successful party, or in affirmation of their own.³ The judgment of the Patent Office in an interference is, however, noticed by the courts as an indication that priority is justly claimed by the prevailing party till the contrary appears, and has been held to be a sufficient reason for granting him an injunction forbidding the infringement of his patent by the others until the controversy can be legally determined.⁴

other applications, see *Potter v. Dixon* (1863), 2 Fisher, 381; 5 Blatch. 160.

That a patent does not issue as of course upon a decision in interference for one party, see *Potter v. Dixon* (1863), 2 Fisher, 381; 5 Blatch. 160.

³ In *Union Paper Bag Machine Co. v. Crane* (1874), 1 Bann. & A. 494, Lowell, J.: (495) "The decision of the Patent Office is never final upon the question of the novelty or priority of an invention. The rule may have been adopted at first from a consideration of the *ex parte* character of the proceedings at Washington, but it has never been confined, as is now maintained by the complainant, to cases in which no contest was had; and it is obvious that it cannot be so limited, because, if one party to an interference is concluded as against the other party, the result may be that a patent is valid as against him, which is void as against all the rest of the world." 6 O. G. 801 (801), Holmes, 429 (430).

See also *Minneapolis Harvester Works v. McCormick Harvester Mach. Co.* (1886), 37 O. G. 566; 28 Fed. Rep. 565; *Celluloid Mfg. Co. v. Chrolithion Collar & Cuff Co.* (1885), 24 Fed. Rep. 275; 32 O. G. 383; *Whipple v. Miner* (1883), 15 Fed. Rep. 117; 23 O. G. 2236; *Perry v. Starrett* (1878), 14 O. G. 599; 3 Bann. & A. 485.

That an interference-judgment between a patent and a later application is never conclusive on the patentee, see

Perry v. Starrett (1878), 3 Bann. & A. 485; 14 O. G. 599.

That a decision in an interference against a patentee does not bar him from suing to have the other's patent annulled, see *Hubel v. Tucker* (1885), 23 Blatch. 297; 22 Fed. Rep. 701.

That an interference-judgment is not conclusive except as to priority between the same parties, and on them only when they accept and act upon it, see *Peck, Stow, & Wilcox Co. v. Lindsay* (1879), 18 O. G. 68; 2 Fed. Rep. 688; 5 Bann. & A. 390.

That an interference-judgment is *res adjudicata* between the parties, see *Shuter v. Davis* (1883), 16 Fed. Rep. 564; 24 O. G. 303.

⁴ That the decision of the Commissioner on priority, though not conclusive, is of great weight, see *Gloucester Isinglass & Glue Co. v. Brooks* (1884), 19 Fed. Rep. 426.

That an interference decision not appealed from is not conclusive on the parties but raises a strong presumption against the defeated party, see *Kirk v. Du Bois* (1887), 42 O. G. 297.

That an interference-judgment raises no presumption against any one but the defeated party and his privies, see *Edward Barr Co. v. N. Y. & N. H. Automatic Sprinkler Co.* (1887), 32 Fed. Rep. 79.

That an interference-judgment is ground for an injunction in favor of the successful against the defeated party,

§ 614. Interference Proceedings : Estoppel.

The doctrine of estoppel is also enforced in the Patent Office.¹ A party may be estopped either by his acts or admissions in relation to the matter in dispute, as against all other parties whose conduct in regard to the same matter has been based in good faith on his own.² A concession of priority binds him who makes it as to the pending proceedings and in favor of the other parties to the interference, and after such concession he cannot claim a new interference either upon the same grounds or on any other grounds which might have been taken advantage of in such proceedings.³ A device once contended for in an interference as material and patentable in the form in which it is presented in the application cannot afterwards be claimed by the same party to have been insufficiently or erroneously described.⁴ But the doctrine is confined within the narrow limits here specified, and is not applied in favor of third parties nor in reference to other controversies than the one to which the act or the admission specially relates.⁵

see *Celluloid Mfg. Co. v. Chrolithion Collar and Cuff Co.* (1885), 24 Fed. Rep. 275 ; 32 O. G. 383 ; *Smith v. Halkyard* (1883), 16 Fed. Rep. 414 ; 23 O. G. 1833. See also § 1183 and notes, *post*.

That the concurrent judgment of the examiner of interferences and the board of examiners is of great weight, but not conclusive, see *Sellers v. Walter* (1886), 37 O. G. 1001.

That the defeated party in an interference has the burden of proof in any future controversy as to priority, see *Wire Book Sewing Mach. Co. v. Stevenson* (1882), 15 Phila. 481 ; 11 Fed. Rep. 155.

§ 614. ¹ That the doctrine of estoppel applies in interference cases, see *Berry v. Stockwell* (1876), 9 O. G. 404 ; *Ex parte Roe* (1874), 5 O. G. 397.

² That a party to an interference is not estopped by his conduct or admissions, unless the other party has been induced to act on them in relation to

the invention in controversy, see *Taylor v. Bourguignon* (1879), 16 O. G. 958.

³ That a concession of priority binds the parties to the interference, see *Burgess v. Wetmore* (1879), 16 O. G. 765.

That a party, having conceded priority to his rival, and the patent having issued on such concession, cannot claim a new interference on the same grounds or on any which might have been advanced at the former hearing, see *Harlow v. Guernsey* (1875), 7 O. G. 513.

⁴ That a device, once contended for in an interference, cannot afterwards be declared by the contestants to have been erroneously or insufficiently described in the application, see *Ex parte Kirby* (1879), 16 O. G. 1095.

⁵ That the defeated party in an interference is not estopped from objecting to the patent of his rival on the ground of want of novelty, see *Smith v. Halkyard* (1883), 16 Fed. Rep. 414 ; 23 O. G. 1833.

§ 615. Interference Proceedings: New Trials.

Now trials are granted in the Patent Office for the same reasons and with the same restrictions as in other judicial tribunals.¹ The principal grounds for a new trial are the discovery of new evidence, fraud, or mistake of the tribunal on the former trial as to the real points at issue.² A new trial will be granted on the ground of newly discovered evidence only when the evidence is important, was not previously procurable by the use of due diligence, is not cumulative, proves a new and independent fact, and has become known to the party since the former trial.³ If the petitioner failed to employ reasonable diligence in ascertaining the necessity for such evidence and in procuring it before the former trial, or if he were put on inquiry by evidence already given and failed to make the proper application for a continuance in order to secure it if he found it necessary to his case, or if the evidence in itself would manifestly not change the result, his prayer must be denied.⁴ No new trial can be permitted

§ 615 ¹ That new trials in the Patent Office are governed by the same rules as in the courts, see *Stevens v. Putnam* (1880), 18 O. G. 519; *Wicks v. McAvoy* (1880), 18 O. G. 859; *contra*, *Eccard v. Drawbaugh* (1883), 24 O. G. 301.

That the Commissioner cannot rehear matters adjudged by his predecessors, except on new facts or by way of new trial, see *Lee v. Walsh* (1879), 15 O. G. 563.

² That no rehearing in an interference will be allowed, except on such grounds as give the right to a new trial, see *Ex parte Pattee* (1872), 2 O. G. 618.

That a new trial may be granted on the ground of fraud or newly discovered evidence, though a patent has already been awarded to the former successful party, see *Hibbard v. Richmond* (1880), 17 O. G. 1155; *Richmond v. Hibbard* (1879), 16 O. G. 908.

³ That a new trial for newly dis-

covered evidence will be granted only when the evidence is (1) important; (2) not previously procurable by due diligence; (3) not cumulative; (4) proves a new and independent fact; and (5) became known to the party since the former trial, see *Stevens v. Putnam* (1880), 18 O. G. 519.

⁴ That no new trial will be granted for new evidence unless due diligence had been used, see *Rogers v. Bear* (1879), 16 O. G. 908.

That no rehearing will be granted unless the new evidence will fix the date conclusively, see *Eccard v. Drawbaugh* (1883), 24 O. G. 301.

That where the new evidence will not change the result, or where the party was put on inquiry by the evidence already given, and might have procured that now offered as new evidence, a new trial will be denied, see *Josselyn v. Swezey* (1879), 15 O. G. 702.

That where the new evidence is really important its recent discovery

on the ground of ignorance, inadvertence, or mistake of the party or his counsel, or of surprise in matters of law, or of misstatements of attorneys, or of the omission of the former tribunal to give due weight to the evidence admitted or to conform its decision to evidence excluded as inadmissible.⁵ A new trial for a judgment against evidence will not be allowed unless the judgment is either wholly unsupported by, or is in direct conflict with, the evidence received.⁶ The right to a new trial may be forfeited by an unreasonable delay.⁷ The decision of the examiner on an application for a new trial may be revised by the Commissioner; and where sufficient ground appears for granting it a new interference may be declared, and the question of priority again investigated, although the prevailing party on the former hearing has already received his patent.⁸

and former diligence of the applicant are not necessary, see *Eccard v. Drawbaugh* (1883), 24 O. G. 301.

That a new trial will not be granted on the ground that the former evidence was taken pending a motion to dissolve the interference, see *Dubois v. McCloskey* (1880), 17 O. G. 1158.

That on a motion for a rehearing evidence which might have been produced on the original hearing will not be regarded unless satisfactory reasons for not then producing it are given, see *Burdsall v. Curran* (1887), 42 O. G. 1167.

⁵ That ignorance, inadvertence, or mistake of a party or his counsel, or surprise in matters of law, are not grounds for new trial, see *Dod v. Cobb* (1876), 10 O. G. 462.

That a misstatement by counsel in argument is not ground for new trial, see *Wicks v. McAvoy* (1880), 18 O. G. 859.

That the court below mistook the issue, and did not give due weight to certain evidence, is ground for appeal, not new trial, see *Slade v. Blair* (1879), 15 O. G. 830.

That a case decided in spite of evidence offered and excluded as inadmis-

sible will not be re-opened to let in other evidence to establish the same fact, see *Farcot v. Rice* (1879), 15 O. G. 563.

⁶ That a rehearing will be granted where there has been a manifest error as to the real question at issue, see *Hull v. Lowden* (1881), 20 O. G. 741.

That the concurrent decisions of lower tribunals on questions of fact will be set aside only for evident error, see *Hazelip v. Richardson* (1876), 10 O. G. 747.

That on a motion for new trial the question is whether the former findings are either wholly unsupported by, or clearly in conflict with, the evidence, see *Gardner v. Dudley* (1880), 18 O. G. 683.

⁷ That the right to new trial may be lost by laches, see *Jones v. Greenleaf* (1879), 15 O. G. 560.

That the right to a rehearing or new trial is waived by an appeal, though the appellate court has no jurisdiction, see *Gill v. Scott* (1884), 29 O. G. 949.

⁸ That the declaration of a new interference is governed by the same rules as a new trial, see *Marsh v. Dodge* (1872), 2 O. G. 643.

§ 616. **Interference Proceedings: Parties to: Assignees.**

The parties to an interference are usually the rival inventors themselves, and from the nature of the case and the required proceedings no interference can be properly conducted without their participation. But when an inventor is unable or refuses to prosecute or defend his own claims to priority, or whenever the ends of justice would be otherwise defeated, an assignee may be permitted to protect his rights in the invention as a party to the interference, upon motion duly made to the Commissioner and satisfactory evidence that the necessity for such permission actually exists.

SECTION XI.

OF THE FORM AND EFFECT OF LETTERS-PATENT.

§ 617. **Issue of Patent is a Judgment that all Prerequisites are Fulfilled.**

The issue of letters-patent is a judgment that all prerequisites have been performed, and that all the conditions necessary to the granting of a patent privilege have been fulfilled.¹ Upon mere formal matters this judgment is final.² Upon questions relating to the merits of the invention and the title of the patentee it is *prima facie* correct, and casts the burden of proof upon any one who controverts the presumption raised by the patent.³ Upon material points concerning the regu-

§ 617. ¹ That the issue of a patent is a judgment that all the facts entitling the patentee to the patent do exist, see *Konold v. Klein* (1878), 3 Bann. & A. 226.

² That the decision of the Commissioner is final as to the sufficiency of all formal acts and proofs prerequisite to a patent, see *Mahn v. Harwood* (1884), 112 U. S. 354; 30 O. G. 657; U. S. Rifle & Cartridge Co. v. Whitney Arms Co. (1877), 14 Blatch. 94; 11 O. G. 378; 2 Bann. & A. 493.

That after the patent issues the Patent Office cannot inquire whether the

patentee made a false oath, see *Ex parte Gillen* (1877), 11 O. G. 419.

³ That the issue of the patent constitutes *prima facie* evidence of all facts entitling the patentee to the grant, see *Eagleton Mfg. Co. v. West, Bradley, & Cary Mfg. Co.* (1880), 17 O. G. 1504; 18 Blatch. 218; 2 Fed. Rep. 774; *Konold v. Klein* (1878), 3 Bann. & A. 226; *Sands v. Wardwell* (1869), 3 Clifford, 277; *Philadelphia & Trenton R. R. Co. v. Stimpson* (1840), 14 Peters, 448; 2 Robb, 46.

That the decision of the Commissioner is never conclusive on a question

larity of the proceedings in the Patent Office it is so far conclusive that the patent cannot be collaterally attacked upon such grounds, although they may present reasons for its repeal on a bill in equity, or an information.⁴

§ 618. Protest against the Issue of Letters-Patent.

A protest against the issue of a patent may be filed by any person, though not a party to the application nor otherwise connected with the proceedings, for the purpose of calling the attention of the Patent Office to objections urged against the application, or of asserting or saving his own rights as a claimant of the invention. In reference to the objections stated in such protest the Commissioner may take whatever action he deems necessary. As a notice to the Office of the claims of the protestant, it may furnish evidence in some future controversy to rebut presumptions of abandonment or acquiescence in the issue of the patent to another claimant. The protest must show that an application has been or will be filed, and that the protestant's knowledge of the existence of such application has been lawfully obtained through its voluntary communication to him by the applicant.¹

§ 619. Letters-Patent, to whom Issued.

The grantee of a patent is usually the applicant himself. But when an inventor dies pending his application, the patent

of law, see *Gardner v. Herz* (1886), 118 U. S. 180; 35 O. G. 999; *Mahn v. Harwood* (1884), 112 U. S. 354; 30 O. G. 657.

That the decision of the Commissioner is not conclusive upon questions of abandonment or other matters relating to the merits, see *Planing Mach. Co. v. Keith* (1879), 101 U. S. 479; 17 O. G. 1031; *Wilson v. Barnum* (1849), 2 Fisher, 635; 1 Wall. Jr. 347; 2 Robb, 749. See also § 578 and notes, *ante*.

That the decision of the Commissioner is not conclusive on any question on which a defence in the courts may be based under the statutes, see *Mahn v. Harwood* (1884), 112 U. S. 354; 30 O. G. 657.

⁴ That the regularity of a patent cannot be collaterally attacked, see *Hoe v. Cottrell* (1880), 18 O. G. 59; 17 Blatch. 546; 1 Fed. Rep. 597; 5 Bann. & A. 256; *Doughty v. West* (1869), 6 Blatch. 429; 3 Fisher, 580.

See also, as to all the matter of this paragraph, §§ 423, 451, and notes, *ante*, and §§ 967, 1016, 1032, and notes, *post*. As to whether and when a patent can be repealed, see §§ 716-730 and notes, *post*.

§ 618. ¹ That a protest against the issue of a patent can be made only under the rules of the Patent Office, and must show that an application has been, or is about to be, filed and that the protestant's knowledge of it has been lawfully acquired, see *Ex parte Neale* (1879), 15 O. G. 511.

issues to his executor or administrator, in trust for his heirs at law or devisees. When an applicant assigns the whole interest in the expected patent or the entire invention, the patent will be granted to the assignee upon the request of the applicant; and when the assignment transfers only an undivided interest, the patent will, upon a similar request, be awarded jointly to the original applicant and the assignee. To secure the issue of the letters-patent to an assignee, either as the sole or part owner of the invention, however, the assignment must contain an express petition to that effect, and must be received at the Patent Office for record at a date not later than the day on which the final fee is paid.¹

§ 620. Form and Contents of Letters-Patent.

The patent itself is exceedingly brief and simple. It consists of a short title or description of the invention, correctly indicating its nature and purpose, and a grant to the patentee, his heirs or assigns, of the exclusive right to make, use, and vend the invention described in the title and the annexed specification throughout the United States and its territories during the period prescribed by law. No recital of proceedings in the Patent Office is required, all presumptions being in favor of their correctness;¹ but a copy of the specification and drawings is appended to and is by law made part of the grant.² All patents issue in the name of the United States, under the seal of the Patent Office, and must be signed by the Secretary of the Interior and countersigned by the Commissioner. This signature of the Secretary is essential to the validity of the patent, and a patent accidentally issued without it cannot be amended after his term of office has expired.³

§ 619. ¹ For the matter of this paragraph see also §§ 367, 368, 403-414, and notes, *ante*, and §§ 769-772, 800-802, 836, 844, and notes, *post*.

§ 620. ¹ That a patent need not recite that the prerequisites have been fulfilled, see *Gear v. Grosvenor* (1873), *Holmes*, 215; 6 *Fisher*, 314; 3 *O. G.* 380; *Philadelphia & Trenton R. R. Co. v. Stimpson* (1840), 14 *Peters*, 448; 2 *Robb*, 46.

² That the specification might have been made part of the patent before 1836, at the request of the patentee, see *Hogg v. Emerson* (1850), 11 *How.* 587.

That under the act of 1790 the allegations of the petition were recited in the patent, see *Evans v. Chambers* (1807), 2 *Wash.* 125; 1 *Robb*, 7.

³ That a patent is not valid unless signed by the Secretary, and if accidentally issued without his signature it

The patent is not complete until duly sealed; but when allowed and signed it is the duty of the Commissioner to affix the seal, unless it is evident to him that the issue of the patent would be contrary to law.

§ 621. Date and Delivery of Letters-Patent.

Every patent must bear date as of a day not later than six months from the allowance of the application and the mailing of the notice and request for the final fee. On payment of the fee the patent is prepared for issue, and receives its date and number, and is delivered to the patentee or his attorney, as the attorney may direct. In no case can a patent be antedated.¹ It takes effect as the grant of an exclusive privilege from the date of issue, although as evidence of an inventive act, and for many other purposes, it relates back to the date of the application upon which it is based.²

cannot be amended by his successor, see *Marsh v. Nichols* (1883), 15 Fed. Rep. 914; 24 O. G. 901.

That it is doubtful whether a patent issued without the signature of the Secretary becomes good from the date of his subsequently signing it, see *Marsh v. Nichols* (1883), 24 O. G. 901; 15 Fed. Rep. 914.

That the omission of the Secretary's signature cannot be aided by showing the perfect patent on the record (an imperfect grant not being saved by a perfect record), nor be amended by his successor though he were the Acting Secretary when the omission occurred, nor be cured by affixing the true signature after the Secretary's official term has expired, see *Marsh v. Nichols* (1883), 24 O. G. 901; 15 Fed. Rep. 914. See also *McGarrahan v. Mining Co.* (1877), 96 U. S. 316; *Goodman v. Randall* (1877), 44 Conn. 321.

§ 621. ¹ That under the present law a patent cannot be antedated, see *Gramme Electrical Co. v. Arnoux & Hochhausen Electric Co.* (1883), 17 Fed. Rep. 838; 21 Blatch. 450; 25 O. G. 193.

That prior to 1836 a patent could not be antedated, see *Opinion Atty. Gen.* (1820), 5 Op. At. Gen. 722.

That under the acts of 1861 and 1836, a patent could be dated from the filing of the specification, if not preceding its issue more than six months, see *Burdett v. Estey* (1880), 3 Fed. Rep. 566; 19 Blatch. 1.

² That a patent takes effect from the date of the grant, see *Gramme Electrical Co. v. Arnoux & Hochhausen Electric Co.* (1883), 17 Fed. Rep. 838; 25 O. G. 193; 21 Blatch. 450.

That a patent may not always take its date from the day when it begins to run, as when it begins from the date of a foreign patent, see *De Florez v. Reynolds* (1880), 17 O. G. 503; 17 Blatch. 436; 8 Fed. Rep. 434; 5 Bann. & A. 140.

That a patent relates back to the date of the application, see *Johnsen v. Fassman* (1872), 5 Fisher, 471; 2 O. G. 94; 1 Woods, 138.

That in the absence of all other proof the date of the patent will be assumed to be the date of the application and of

§ 622. **Term of Patent Privilege Limited by Express Statute or by Foreign Patents.**

The term of a patent is measured by the statute, not by the language of the grant.¹ Where the invention has not been previously patented in a foreign country, the term is uniformly fixed at seventeen years from the date of the grant.² But where a foreign patent has already been obtained, a different rule has been adopted. It is the policy of our government not to impose upon our own public a greater restriction than has been or may be placed upon a foreign people in the use of the invention; and where the invention has been disclosed abroad by a patent, and will become the property of the foreign public after a given period of time, it is the purpose of our statutes to permit no more extended monopoly to the inventor in the United States. Various rules have been from time to time established to secure this result. Under the act of 1836 a foreign patent was a bar to a domestic application unless it had been granted and published within six months preceding the filing of the latter, thus making the terms of both substantially the same.³ The act of

an assignment before patent, see *Worley v. Loker Tobacco Co.* (1882), 104 U. S. 340; 21 O. G. 559.

That a patent on a renewal application is to be dated six months after the renewal application is allowed, see *Thomson v. Waterhouse* (1884), 30 O. G. 177.

§ 622. ¹ That the statute, not the language of the patent, limits its term, see *De Florez v. Reynolds* (1880), 17 O. G. 503; 8 Fed. Rep. 434; 17 Blatch. 436; 5 Bann. & A. 140.

That the patent ought to express its actual duration, see *Opinion Sec. Int.* (1882), 21 O. G. 1197.

That Sec. 4887 does not require that the term of a patent shall be correctly stated in the patent itself, but only limits the term, and the grant of a patent for seventeen years, therefore, does not prevent it from expiring with a prior foreign patent, see *Canan v.*

Pound Mfg. Co. (1885), 31 O. G. 119; 23 Blatch. 173; 23 Fed. Rep. 185.

That a domestic patent is valid, though its term is not expressly limited to that of a foreign patent, see *American Paper Barrel Co. v. Laraway* (1886), 28 Fed. Rep. 141; 37 O. G. 674.

That in the absence of fraud the date of a patent may be altered to correspond with that of a foreign patent, see *Opinion Atty. Gen.* (1844), 4 Op. At. Gen. 335.

² That under the act of 1861 patents "remain in force" seventeen years, not run seventeen years from the date of the patent, see *De Florez v. Reynolds* (1880), 17 O. G. 503; 8 Fed. Rep. 434; 17 Blatch. 436; 5 Bann. & A. 140.

³ That under the act of 1836 a foreign patentee applying for a domestic patent, within the time prescribed, could enjoy the full statutory term, see *American Diamond Rock Boring Mach. Co. v. Sheldon* (1879), 17 Blatch. 303.

1839 provided that the term of the American patent should be limited to fourteen years from the date of publication of the foreign patent, thereby delivering the invention from the protection of the patent at the time when it would have come into the possession of the public if the American and foreign patents had been simultaneously issued.⁴ Under the act of 1861 the period of seventeen years was substituted for that of fourteen years in this as well as in those cases where no previous foreign patent had been granted.⁵ In 1870 the present law was enacted, requiring the term of the American patent to be so limited as to expire at the same time with the foreign patent; or, if there be more than one, with that having the shortest term, but in no case to be more than seventeen years.⁶

⁴ That under the act of 1839 the inventor might have a patent for the full term, though a prior foreign patent had been granted within six months, see *Kendrick v. Emmons* (1875), 2 Bann. & A. 208; 9 O. G. 201.

That before the act of 1861 patents were not limited by the term of a foreign patent, see *Goff v. Stafford* (1878), 14 O. G. 748; 3 Bann. & A. 610.

That the act of 1839 did not apply to cases where the foreign specification was filed less than six months before the application in the United States, see *American Diamond Rock Boring Mach. Co. v. Sheldon* (1879), 17 Blatch. 303.

⁵ That the act of 1861 does not repeal the provisions of the act of 1839 on this subject, but modifies them to make the term seventeen instead of fourteen years, see *Ex parte Siemens* (1877), 11 O. G. 1107.

That under the act of 1861 the American patent was limited to seventeen years from the date of the previous foreign patent, see *Guarantee Insurance, Trust, & Safe Deposit Co. v. Sellers* (1887), 41 O. G. 1165; *Siemens v. Sellers* (1883), 16 Fed. Rep. 856; 23 O. G. 2234; 16 Phila. 554; *De Florez v. Reynolds* (1880), 17 O. G. 503; 8 Fed.

Rep. 434; 17 Blatch. 436; 5 Bann. & A. 140; *Nathan v. N. Y. Elevated R. R. Co.* (1880), 2 Fed. Rep. 225; 5 Bann. & A. 280.

That the act of 1861 caused the domestic patent to expire seventeen years from the date when the prior foreign patent took effect in favor of the patentee, see *De Florez v. Reynolds* (1880), 17 O. G. 503; 8 Fed. Rep. 434; 17 Blatch. 436; 5 Bann. & A. 140.

That the act of 1861 changes the date when the term ends, not the date of its beginning, see *Guarantee Insurance, Trust, & Safe Deposit Co. v. Sellers* (1887), 41 O. G. 1165.

⁶ That the act of 1870 causes an American patent to expire at the same date with the shortest foreign patent that was granted before the grant of the American patent, see *Gramme Electrical Co. v. Arnoux & Hochhausen Electric Co.* (1883), 21 Blatch. 450; 17 Fed. Rep. 838; 25 O. G. 193; *Koechlin v. Marble* (1882), 2 Mackay, 12; 22 O. G. 1365; *Henry v. Providence Tool Co.* (1878), 14 O. G. 855; 3 Bann. & A. 501.

That the foreign patent limits the domestic, though the applicant here is the foreign patentee or some one to

§ 623. Term of Patent Privilege: When Limited by Foreign Patents.

In order that the term of the foreign patent may thus limit that of the domestic patent, it is essential that the inventions covered by the two patents should be identical,¹ and that the foreign patent should take effect before the issue of the domestic patent. The foreign patent takes effect when it is so issued as to create a monopoly in favor of the inventor, whether the patent is then disclosed to the general public or

whom the inventor caused the foreign patent to be granted, or is an American citizen, see *Edison Electric Light Co. v. U. S. Electric Lighting Co.* (1888), 43 O. G. 1456.

That the act of 1870 was not retroactive and did not apply to previous American patents or their re-issues, see *Anilin v. Hamilton Mfg. Co.* (1878), 3 Bann. & A. 235; 13 O. G. 273; *Goff v. Stafford* (1878), 3 Bann. & A. 610; 14 O. G. 748.

That an American patent cannot run over seventeen years, and will expire with any shorter prior foreign patent, see *Weston v. White* (1876), 9 O. G. 1196; 13 Blatch. 364; 2 Bann. & A. 321.

That to limit the term of a domestic by that of a foreign patent is to make both expire at the same time, see *Ex parte Siemens* (1877), 11 O. G. 969.

That the same rule applies when a single American patent covers several inventions separately patented abroad, see *Ex parte Unsworth* (1879), 15 O. G. 882.

§ 623. ¹ That an American patent is not limited by the term of a foreign patent unless the inventions are identical, see *Siemens v. Sellers* (1883), 16 Phila. 554; 23 O. G. 2234; 16 Fed. Rep. 856; *Ex parte Siemens* (1877), 11 O. G. 969.

That the invention covered by a domestic patent will be the same as that covered by a foreign patent when the principle is the same though it may be

improved, and in this case the term of the whole patent is that of the foreign patent, see *Guarantee Insurance, Trust, & Safe Deposit Co. v. Sellers* (1887), 41 O. G. 1165.

That a domestic patent is not limited by a foreign patent unless the latter claims as well as describes the same invention, see *Holmes Electric Protective Co. v. Metropolitan Burglar Alarm Co.* (1884), 22 Fed. Rep. 341; 32 O. G. 384.

That a patent which is a mere adaptation of a foreign patent expires at the same time, though some slight improvement be embraced in it, see *Clark v. Wilson* (1886), 28 Fed. Rep. 95; 36 O. G. 456.

That if the foreign invention would be enjoined as an infringement of the domestic patent it is the same, see *Commercial Mfg. Co. v. Fairbank Canning Co.* (1886), 27 Fed. Rep. 78; 36 O. G. 1473.

That if a representation in an application that the invention is identical with that covered by a foreign patent is made in good faith it does not estop the applicant from subsequently denying it, see *Commercial Mfg. Co. v. Fairbank Canning Co.* (1886), 27 Fed. Rep. 78; 36 O. G. 1473.

That the validity of a domestic patent cannot depend on that of a foreign patent, though its duration may, see *Cornely v. Marekwald* (1883), 21 Blatch. 367; 24 O. G. 498; 17 Fed. Rep. 83.

is by law confined to the knowledge of a certain class of persons.² It has been held in several cases that the foreign patent must have issued before the filing of the application in the United States;³ but this doctrine was not consistent with the purpose of the rule, and later cases have therefore decided that it is sufficient if the foreign patent take effect before the actual grant of the domestic.⁴ Where both are

² That the date of a foreign patent, when controlling the term of an American patent, is the date of its issue or publication as a patent, see *Do Florez v. Reynolds* (1880), 17 O. G. 503; 17 Blatch. 436; 8 Fed. Rep. 434; 5 Bann. & A. 140; *Weston v. White* (1876), 13 Blatch. 364; 9 O. G. 1196; 2 Bann. & A. 321.

That an English "complete specification" gives the same protection as if the patent were already issued, see *Emerson v. Lippert* (1887), 31 Fed. Rep. 911; 42 O. G. 964.

That the foreign patent limits the domestic whether it be open or secret, see *Gramme Electrical Co. v. Arnoux & Hochhausen Electric Co.* (1883), 17 Fed. Rep. 838; 21 Blatch. 450; 25 O. G. 193.

That no English patent is complete until the final specification is enrolled, see *Coburn v. Schroeder* (1882), 22 O. G. 419; 20 Blatch. 392; 11 Fed. Rep. 425; *Lorillard v. Dohan* (1881), 20 O. G. 1587; 20 Blatch. 63; 9 Fed. Rep. 509; *Bell v. Brooks* (1881), 19 O. G. 290; *Ex parte Mann* (1880), 17 O. G. 330; *American Diamond Rock Boring Mach. Co. v. Sheldon* (1879), 17 Blatch. 303; *Chambers v. Duncan* (1876), 10 O. G. 787; *Chambers v. Duncan* (1876), 9 O. G. 741.

That an English provisional specification is not a patent, see *Emerson v. Lippert* (1887), 42 O. G. 964; 31 Fed. Rep. 911.

That a domestic patent is not limited by an English patent unless the latter is sealed before the former is issued, whatever date the latter may bear, or unless

a complete specification, having the effect of a patent, is filed, see *Emerson v. Lippert* (1887), 42 O. G. 964; 31 Fed. Rep. 911.

That under the act of 1861 when the domestic patent was applied for before the English provisional specification was filed, and was dated before the English patent was sealed (though the latter was dated earlier than the American patent), the term of the American patent was not limited by the English, see *Gold & Stock Telegraph Co. v. Commercial Telegram Co.* (1885), 23 Blatch. 199; 23 Fed. Rep. 340; 31 O. G. 1558.

That a Canadian patent takes effect when signed, sealed, and registered, not from its delivery, see *Bate Refrigerating Co. v. Gillett* (1882), 22 O. G. 1205; 13 Fed. Rep. 553.

That a Canadian patent takes effect from its date, though withheld from delivery on account of non-fulfilment of conditions, see *Bate Refrigerating Co. v. Gillett* (1887), 31 Fed. Rep. 809; 40 O. G. 1029.

³ That the rule limiting the term of an American patent by that of a foreign patent does not apply to cases where the American patent was applied for before the issue of the foreign patent, see *Ex parte Mann* (1880), 17 O. G. 330; *French v. Rogers* (1851), 1 Fisher, 133.

That when a foreign patent is granted on the day the application is filed in the United States, it does not limit the American patent, see *Ex parte Mann* (1880), 17 O. G. 330.

⁴ In *Gramme Electrical Co. v. Arnoux & Hochhausen Electric Co.* (1883), 17

granted on the same day, the domestic patent is regarded as the older, and its term is unaffected by that of the foreign patent.⁵

§ 624. **Term of Patent Privilege: How Limited by Foreign Patents.**

The term to which the American patent is thus restricted is the term of the original foreign patent.¹ Where the laws

Fed. Rep. 838, Blatchford, J.: (840)

“The meaning of section 25 of the act of 1870 is that the United States patent shall expire at the same time with the foreign patent having the shortest time to run, which was granted before the United States patent was granted, and not that it shall expire at the same time with the foreign patent having the shortest time to run, which was granted before the time when the application for the United States patent was made.” 21 Blatch. 450 (452); 25 O. G. 193 (194).

See also *Bate Refrigerating Co. v. Gillett* (1882), 13 Fed. Rep. 553; 22 O. G. 1205.

That the term of a domestic patent will be limited by that of a foreign patent granted pending the application for the domestic patent, see *Bate Refrigerating Co. v. Gillett* (1887), 31 Fed. Rep. 809; 40 O. G. 1029.

That where a foreign patent is applied for after the application for a domestic patent, but is granted before the issue of the domestic, it will still limit the duration of the latter, see *Gramme Electrical Co. v. Arnoux & Hochhausen Electric Co.* (1883), 21 Blatch. 450; 25 O. G. 193; 17 Fed. Rep. 838.

That the term of an American patent will be limited by that of a prior foreign patent, though the American application had been filed and the invention put in use in the United States before the foreign application was made, see *Edison Electric Light Co. v. U. S. Electric Lighting Co.* (1888), 43 O. G. 1456.

That where an application in the United States antedates an application in England, and the American patent issues before the English patent is sealed, or a complete specification is filed, the latter has no effect on the term of the former, see *Emerson v. Lippert* (1887), 42 O. G. 964; 31 Fed. Rep. 911.

⁵ That where domestic and foreign patents are granted, or applications are filed, on the same day, the foreign are not prior to the domestic, see *Ex parte Mann* (1880), 17 O. G. 330.

§ 624. ¹ That the term of the American patent should be fixed by ascertaining how long the foreign patent, as originally granted, was to run after the issue of the domestic, see *Paillard v. Bruno* (1886), 38 O. G. 900; 29 Fed. Rep. 864; *Ex parte Siemens* (1877), 11 O. G. 969.

That the term of a foreign patent, so far as it affects that of a domestic patent, is the term for which it is originally granted, whether it be extended or not, or forfeited for non-payment of periodical fees or not, or increased in statutory duration by subsequent legislative action, see *Bate Refrigerating Co. v. Gillett* (1887), 31 Fed. Rep. 809; 40 O. G. 1029.

That if a foreign patent, limiting the term of a domestic patent, is vacated *ab initio*, the domestic patent is not limited thereby, see *Bate Refrigerating Co. v. Gillett* (1887), 31 Fed. Rep. 809; 40 O. G. 1029.

of the country in which it was issued permit of its extension, this capability of extension forms no part of the grant. Its actual term as specified in the original letters-patent measures the life of the domestic patent, and its extension, if it be extended, does not prolong the monopoly in the United States.² The same rule prevails where an original patent may be enlarged by new grants as the inventor makes improvements to the original invention, thereby extending indirectly the term of the original. Each of these new grants or additions is considered as a different patent, having its own date of issue and its own term, and thus does not remove the limitation placed by the original patent on the term of the American.³ Nor on the other hand does the premature expiration of the foreign patent, on account of the failure of the patentee to comply with the conditions essential to the completion of its granted term, extinguish the American patent, nor curtail the term fixed for it by the foreign patent at the date when it was issued.⁴

§ 625. Term of Patent Privilege: How Calculated when not Limited by Foreign Patents.

In calculating the term of a patent whose duration is not affected by that of a prior foreign patent, the day of its date

² That the capacity of extension is not part of a grant, and a foreign patent measures the domestic by its granted term, not by its possibilities of extension, see *Gramme Electrical Co. v. Arnoux & Hochhausen Electric Co.* (1883), 17 Fed. Rep. 838; 21 Blatch. 450; 25 O. G. 193.

That the extension of a foreign patent does not affect the American, see *Paillard v. Bruno* (1886), 38 O. G. 900; 29 Fed. Rep. 864; *Bate Refrigerating Co. v. Gillett* (1882), 13 Fed. Rep. 553; 22 O. G. 1205; *Reissner v. Sharp* (1879), 16 O. G. 356; 16 Blatch. 383; 4 Bann. & A. 366; *Henry v. Providence Tool Co.* (1878), 14 O. G. 855; 3 Bann. & A. 501.

³ That under the French law each "addition" stands by itself like a new patent, and by its own date fixes the term

of a subsequent American patent, see *De Florez v. Reynolds* (1880), 17 Blatch. 436; 17 O. G. 503; 8 Fed. Rep. 434; 5 Bann. & A. 140.

⁴ That the forfeiture of the foreign patent by the non-fulfilment of conditions does not affect the duration of the American patent, see *Paillard v. Bruno* (1886), 38 O. G. 900; 29 Fed. Rep. 864.

That under Sec. 4887 the term of a domestic patent is to be equal to the remainder of the term for which the foreign patent was granted, although the latter has been forfeited by not paying a tax or by other subsequent events, see *Holmes Electric Protective Co. v. Metropolitan Burglar Alarm Co.* (1884), 21 Fed. Rep. 458; 22 Blatch. 471; 28 O. G. 1189.

is excluded, and it will expire on the last hour of the same day and month, seventeen years after its issue.¹ Its term is unrestricted by that of any other patents, although the invention described in one patent may be so far dependent on those protected by others as to be incapable of use without them, and thus the public may be debarred from the free employment of any until all the patents have expired.² The term of a design patent has a different limitation, such patents being granted for three and a half, seven, or fourteen years, as the inventor may elect.

§ 626. Effect of Clerical Errors in Letters-Patent.

Mere clerical errors in the language of a patent do not affect its validity nor imperil the rights of the patentee. A mistake in his Christian name, or of a single letter in his surname, is of no consequence if he is otherwise sufficiently described; and the same liberal construction prevails in reference to other immaterial defects.¹ Where such mistakes occur through the fault of the Patent Office, they are corrected on the record at the request of the patentee. Errors upon material points must be cured by an amendment of the patent by a re-issue or disclaimer.

§ 625. ¹ That a patent expires on the last hour of the same month and day, seventeen years after its issue, see *Johnson v. McCullough* (1870), 4 Fisher, 170.

² That separate patents for different inventions, having separate dates, will each expire at the end of its own term, though neither invention is capable of use without the others, see *McKay v. Dibert* (1881), 19 O. G. 1351; 5 Fed. Rep. 587.

But see *McKay v. Jackman* (1882), 20 Blatch. 466; 22 O. G. 85; 12 Fed. Rep. 615.

That where a patent having been issued with its term limited by that of a foreign patent is not accepted by the patentee, and a new patent is then

granted for seventeen years, the new patent will run from the date of its issue, not from that of the former patent, see *Railway Register Mfg. Co. v. North Hudson C. R. Co.* (1885), 23 Fed. Rep. 593; 32 O. G. 519.

§ 626. ¹ That a mistake in the Christian name of the patentee does not affect the patent, if he is otherwise sufficiently pointed out, see *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.* (1874), 1 Bann. & A. 177; 6 O. G. 34; 10 Phila. 227.

That one erroneous letter in the name of the patentee may be of no consequence, see *Bignall v. Harvey* (1880), 18 O. G. 1275; 4 Fed. Rep. 334; 18 Blatch. 353.

§ 627. Recording of Letters-Patent: Copies of the Records.

All letters-patent are recorded, with their specifications, in books kept for that purpose in the Patent Office.¹ The record of a patent, like that of every other instrument which the law requires to be recorded, is constructive notice of its contents to all parties subsequently becoming interested in the invention, and is binding throughout the world.² After the patent is recorded, its record, with its specifications, drawings, model, and all other documents relating to the case, are open to general inspection in the Patent Office. No private individual is permitted to make copies or tracings from the files and records of the Office; but certified copies may be obtained by any one who civilly requests them, upon payment of the lawful fees.³ These copies have the same weight, as evidence in any controversy in the courts or Patent Office, as would be given to the originals themselves.⁴

§ 628. Patented Articles to be Stamped.

The law requires that every patentee and his assigns and legal representatives, and all other persons making or vend-

§ 627. ¹ That the grant of a patent is not complete, nor does any title pass, until it is recorded, see *Ex parte Osgood* (1885), 33 O. G. 1265.

That a title by the grant of letters-patent is a title of record, and no delivery is necessary to make it good, see *Ex parte Osgood* (1885), 33 O. G. 1265.

² That the record of a patent and its title is notice to all the world, see *National Car Brake Shoe Co. v. Terre Haute Car & Mfg. Co.* (1884), 19 Fed. Rep. 514; 28 O. G. 1007.

That the record of an instrument, which the law does not require to be recorded, is no notice of anything to any person, see *Hamilton v. Kingsbury* (1879), 17 Blatch. 264; 17 O. G. 147.

That where some papers not required to be recorded are recorded and others are not, a person who acts upon those recorded in ignorance of the others is bound by the latter as if they were

known, see *Hamilton v. Kingsbury* (1879), 17 Blatch. 264; 17 O. G. 147.

See also § 785 and notes, *post*.

³ In *Boyden v. Burke* (1352), 14 How. 575, Grier, J.: (583) "These records being in the care and custody of the Commissioner of Patents, it is his duty to give authenticated copies to any person who shall demand the same, as soon as he conveniently can, on payment of the legal fees. Where there is a right on the one side, and a corresponding duty imposed on the other, a refusal to perform such duty, on the reasonable request of the party entitled to demand it, will subject the officer to an action."

⁴ That copies of the records in the Patent Office are evidence, see *Brooks v. Jenkins* (1844), 3 McLean, 432. See also §§ 1015-1017, and notes, *post*.

That an incorrect transcript from the Patent Office may be corrected by a new transcript, see *Brooks v. Jenkins* (1844), 3 McLean, 432.

ing any patented article for or under them, shall give sufficient notice to the public that such article is patented.¹ This notice may be given by marking the article itself with the word "patented," together with the date of the patent, or where this is impracticable by affixing to the article, or to the package in which it is enclosed for the market, a label containing the same word and date.² A failure to comply with this requirement prevents the owner of the patent, in any suit for its infringement, from recovering other than nominal damages against the defendant,³ unless he can affirmatively prove that in some manner practically equivalent to this the defendant has received notice that his acts were an infringement of the patent, and after such notice has continued in his violation of the plaintiff's rights.⁴

§ 628. ¹ That the duty of marking patented articles as "patented" devolves upon the manufacturer, see *Wilson v. Singer Mfg. Co.* (1879), 9 Bissell, 173 ; 4 Bann. & A. 637 ; 16 O. G. 1091.

That the object of the statute requiring patented articles to be stamped is to secure the public right to use unpatented articles, and prevent imposition under the claim that the articles have been patented, see *Nichols v. Newell* (1853), 1 Fisher, 647.

That this statute is to be strictly construed, see *Wilson v. Singer Mfg. Co.* (1879), 9 Bissell, 173 ; 4 Bann. & A. 637 ; 16 O. G. 1091 ; *United States v. Morris* (1866), 2 Bond, 23 ; 3 Fisher, 72.

² That where the mark cannot be put on the article itself it may be placed on the package, see *Sessions v. Romadka* (1884), 28 O. G. 721 ; 21 Fed. Rep. 124.

³ That unless the evidence shows that the statute has been complied with only nominal damages can be recovered for infringements, see *McComb v. Brodie* (1871), 1 Woods, 153 ; 5 Fisher, 384 ; 2 O. G. 117.

That this statute applies to suits in equity as well as at law, see *New York*

Pharmical Association v. Tilden (1882), 21 Blatch. 190 ; 23 O. G. 272 ; 14 Fed. Rep. 740.

That the failure to stamp prevents recovery of damages, but is no bar to an injunction either preliminary or perpetual, see *Goodyear v. Allyn* (1868), 3 Fisher, 374 ; 6 Blatch. 38.

That Sec. 13, act March 2, 1861, does not require that the plaintiff's bill in equity aver that his articles were stamped, see *Goodyear v. Allyn* (1868), 3 Fisher, 374 ; 6 Blatch. 33.

That to prevent a recovery of actual damages by reason of Sec. 13, act March 2, 1861, it must appear either from the bill or the proofs that the patentee has made or sold articles under the patent, see *Goodyear v. Allyn* (1868), 3 Fisher, 374 ; 6 Blatch. 33.

⁴ In *New York Pharmal Association v. Tilden* (1882), 14 Fed. Rep. 740, Wallace, J. : (741) "Patentees are therefore required to give 'sufficient notice to the public' that the article is patented, . . . 'together with the day and year the patent was granted,' by stamping or labelling the article. It is a fair interpretation to hold that when any equivalent notice has been given, the defendant has been 'duly notified.' As

§ 629. Stamping Patented Articles by Infringers Prohibited.

As the complement of the foregoing rule, the law forbids any person, other than the patentee and those who claim or practise the invention under the protection of the patent, to mark on any article made, used, or sold by him the name or imitation of the name of its true patentee, without obtaining his consent or that of his assigns or legal representatives. It also prohibits every one, except with the consent of the true patentee or his assigns or legal representatives, from marking any patented article with the words "patented," "patentee," or "letters-patent," or any word of similar import, with intent to imitate or counterfeit the mark of the real owner of the patent.¹ The object of the first provision

the sufficient notice prescribed includes a specification of the time when the patent was granted, it is reasonable to conclude that any notice, verbal or written, that includes this information, will suffice." 23 O. G. 272 (272); 21 Blatch. 190 (191).

That notice otherwise given is equivalent to a mark on the articles themselves, in its effect on the right to substantial damages, see *McComb v. Brodie* (1871), 1 Woods, 153; 5 Fisher, 384; 2 O. G. 117.

That under Sec. 4900 no recovery of substantial damages can be had while articles were unstamped unless notice is given or knowledge is possessed by the infringer, and even then he is liable to pay substantial damages only for infringements committed with knowledge or after notice, see *Allen v. Deacon* (1884), 21 Fed. Rep. 122; 10 Sawyer, 210.

§ 629. ¹ In *Washburn & Moen Mfg. Co. v. Haish* (1879), 9 Bissell, 141, Blodgett, J. : (142) "I am very clear that the defendant has no right, upon the admitted facts in the case, to mark his goods with any words or terms indicating that they are manufactured under complainant's patent. He has the right, and it is his duty, to mark

his goods with his own patent-mark; but this does not give him the right to put upon the goods any *indicia* showing that they are made under another man's patent or a patent which he does not own and has no right to use. Several reasons occur to me why he should not be allowed to do this. In the first place, the owner of a patent has the right to regulate the quality of goods bearing the patent-mark. The value of a patent to its owner may largely depend upon the quality of goods manufactured under it. By manufacturing and selling a poor article purporting to be made under complainant's patent the value of the patent itself may be seriously impaired and the complainant damaged. In the second place, the public would be imposed upon and led to believe that they were purchasing a genuine article made by the patentee or under his patent. This reason applies the more forcibly because the law makes it the duty of a patentee, or those manufacturing goods under a patent, to mark his goods with the word 'patented,' with the date of the patent; and persons purchasing such goods with the belief that they were made and vended by the patentee, or those acting under his license, might be liable for an

of the statute is to protect the patentee and his assignees or licensees against the fraudulent and tortious imitation of his name upon an article apparently made under the monopoly created by his patent. The object of the second is to protect them against the intentional proximate representation of their patent-mark by an infringer. These wrongful acts tend to depreciate the value of the patent by casting doubts upon the scope of the invention, or by enabling the infringer to throw on the market inferior articles under the patent-mark, and thereby destroy the confidence of the public in the utility of the invention. The law cannot permit its own requirement of the patentee to be thus turned into a weapon against him, and hence attaches to these acts a penalty distinct from that which the wrong-doer would incur by a mere infringement.

§ 630. Stamping Unpatented Articles Prohibited.

A third provision of the statute forbids the marking or affixing to any unpatented article the word "patent," or any word importing that the same is patented, for the purpose of deceiving the public. The object of this provision is to prevent fraudulent impositions upon the community at large.¹ The fact that an article is patented is an indication to the public of its merit, and tends to promote its sale and use; and the unauthorized mark is thus a false pretence by which the purchaser is liable to be deceived. The marking of an article is also a notice to the public that its manufacture, use, and sale are under the protection of a patent, and cannot be engaged in without the license of the patentee; and if this notice be untrue, the public are fraudulently restricted in the enjoyment of their natural rights. Fraud being thus the gist of the offence forbidden, the penalty is not incurred unless the marking is performed with the intention to deceive.² To

action of infringement by the owner of the patent; and, thirdly, such an act is a direct violation of the property interest which the law vests in the owner of a patent." 4 Bann. & A. 571 (572); 18 O. G. 465 (465).

§ 630. ¹ That the law forbidding the marking of unpatented articles as "pat-

ented" was intended to prevent fraud, see *Wilson v. Singer Mfg. Co.* (1879), 9 Bissell, 173; 4 Bann. & A. 637; 16 O. G. 1091.

² In *Walker v. Hawxhurst* (1867), 5 Blatch. 494, Nelson, J.: (495) "The counsel for the plaintiff requested the Court to charge that if the jury be-

mark in joke, or in evident derision, or in the belief that the article comes within the scope of a patent, does not constitute the crime. But where the intent to deceive exists, it is immaterial whether the article is patentable or not, or whether a patent has been applied for and is expected to issue, or how the mark is made and attached to the article, or whether the article is ever sold or offered for sale in the market.³ Where

lied that the defendant intended the public to understand, by the words and figures he caused to be put on the article, that he had got a patent for it, he was liable for the penalty. The Court refused so to charge, but charged that if the defendant used the marks, knowing he had no right to, and with the intention of deceiving the public, then he was liable; but if he used them, supposing he had a right to, and with no intention to deceive the public, then he was not liable. I am of opinion that the Court did not err in refusing to charge as requested by the counsel. The request leaves out altogether the element of fraud and deceit, which is clearly, and even in terms, made essential to bring a party within the penalties of the statute. According to the interpretation of the counsel, the simple act of marking the article, indicating that it was patented when it was not, would be sufficient, because of necessity the party must mean and intend that the public should understand what he has thus explicitly expressed. But this is not the statute. The marking must not only give the public to understand the fact of a patent, but the act must be done *malo animo*, with an intent to deceive; and this ingredient of the offence, which is essential to make it complete, must be left to and be found by the jury. The Court, therefore, was right in submitting it to them."

See also *Nichols v. Newell* (1853), 1 Fisher, 647.

That an "intent to deceive" is an intent to make the public believe that

the article is covered by a patent, and this intent exists where the party stamps an article without knowing or caring whether or not it is patented, and without an affirmative belief that it is patented, see *Tompkins v. Butterfield* (1885), 25 Fed. Rep. 556; 33 O. G. 758.

That a corporation may violate this act through its officers, see *Tompkins v. Butterfield* (1885), 25 Fed. Rep. 556; 33 O. G. 758.

That where a defendant is proved to have falsely stamped articles with intent to deceive the public, he is guilty of the offence, and no other matter is pertinent, see *Kass v. Hawlowitz* (1885), 33 O. G. 1135.

³ In *Oliphant v. Salem Flouring Mills Co.* (1878), 5 Sawyer, 128, Deady, J. : (129) "The first two clauses of this section are evidently intended to protect the patentee of a patented article against the fraudulent use of his name or device upon a spurious article, and it is equally manifest that the third clause is intended to protect the public against the fraudulent use of the word 'patent.' What art, machine, composition, process, or result may be patented, is largely a question of fact, which in most cases lies beyond the knowledge or observation of the mass of mankind, the public. To say whether an article is both novel and useful, has 'a sufficiency of invention' to entitle it to be patented, is often a difficult question, and one which in most cases requires the skill and research of experts to determine. It may be useful but not new, or the re-

this intent is wanting, an article manufactured under an ex-

verse, and in neither case is it patentable. But the word 'patent' upon an article is *prima facie* an assertion that it has some peculiar value or merit sufficient to induce the government, upon a thorough examination of the subject, to give the inventor the exclusive right to make and vend the same. The impression which the fact ordinarily makes upon the mind is that the article marked 'patent' is in some respects more useful or desirable than articles of the same general kind or use which are not so marked. If, then, a person marks an unpatented article with the word 'patent,' the public are thereby liable to be deceived as to the character and value of the article. The act is a species of counterfeiting. This being so, the presumption is, until the contrary appears, that the mark was placed on the article with the intention to deceive. The falsehood is a badge of fraud. To my mind it is clear, both upon the reason of the thing and the plain words of the statute, that the penalty is incurred by marking an unpatented article with the word 'patent,' whether the same is patentable or not. The statute is made for the protection of the public, and is intended to prevent unscrupulous persons from imposing upon the community by the unauthorized and false use of the word 'patent.' But it must also appear that the article was so falsely marked with intent to deceive the public. Cases may arise in which it is apparent that the marking was done on unpatented articles in jest or ridicule, or as a mere fancy or caprice under such circumstances that it is not possible that any one could be misled or deceived by it. A person might mark his dog or horse with the word 'patent,' but hardly with the intention to make the public believe that either was of any more use or value than any other

like animal. And in such an extreme case the Court might be able to say, on demurrer to the complaint, that there could not by any possibility have been any intention to deceive. But in all ordinary cases, or cases in which there can be any doubt about it, the question of fraudulent intent or purpose to deceive is one for the jury. In passing upon it, the probability or improbability of the public being deceived by the alleged false marking will be taken into consideration by them." 8 Bann. & A. 256 (257).

In *Nichols v. Newell* (1853), 1 Fisher, 647, Sprague, J. : (659) "If there was a purpose, at the time these words were affixed, to deceive the public, although the party may have expected a patent shortly, or within any time (if in the mean time they intended to put forth the articles and thereby deceive the public), then the offence would be committed. If they intended to deceive the public for a short time, and believed that they should then have their patent, still the offence is committed, because the statute forbids deceiving the public at any time."

That to mark "patented" on articles evidently not patentable and which cannot deceive the public is not an offence, see *U. S. v. Morris* (1866), 2 Bond, 23 ; 3 Fisher, 72.

That the marking is an offence, though no sales result, see *Nichols v. Newell* (1853), 1 Fisher, 647.

That the offence is committed by marking falsely, not by carrying the marked articles into another district with intent to sell, see *Pentlarge v. Kirby* (1884), 19 Fed. Rep. 501.

That the offence is committed however the mark may be put on, see *Nichols v. Newell* (1853), 1 Fisher, 647.

pected patent, or one formerly protected by a patent which has now expired, may lawfully bear this inscription.⁴

§ 631. Procedure and Penalty for Falsely Stamping Infringing or Unpatented Articles.

The statute embracing these provisions is penal in its nature, and must be strictly construed.¹ The punishment for its violation is a fine of one hundred dollars and costs,² to be recovered by any person in a *qui tam* action brought to the District Court of the United States within whose jurisdiction the offence may have been committed.³ The person falsely

⁴ That articles may be marked "patented" when a patent is expected, if there is no intent to deceive, see *Nichols v. Newell* (1853), 1 Fisher, 647.

That articles are patented and may be so marked, although the patent has expired, if the date of the patent is included in the mark, see *Wilson v. Singer Mfg. Co.* (1882), 11 Bissell, 298; 12 Fed. Rep. 57; *Wilson v. Singer Mfg. Co.* (1879), 9 Bissell, 173; 4 Bann. & A. 637; 16 O. G. 1091.

That a patentee has no right to mark his articles "patented," after the patent expires, under Sec. 4900, Rev. Stat., the act of marking showing an intent to deceive, see *N. Y. Consolidated Card Co. v. Union Playing Card Co.* (1886), 39 Hun, 611.

§ 631. ¹ That the statute against false marking must be strictly construed, see *Pentlarge v. Kirby* (1884), 19 Fed. Rep. 501; *United States v. Morris* (1866), 2 Bond, 23; 3 Fisher, 72.

² That the penalty must be exactly one hundred dollars, see *Stimpson v. Pond* (1855), 2 Curtis, 502.

That the full penalty may be imposed for each article falsely stamped and sold, see *Tompkins v. Butterfield* (1885), 25 Fed. Rep. 556; 33 O. G. 758.

³ That any person may maintain a *qui tam* action on this statute, see *Kass*

v. Hawlowetz (1885), 33 O. G. 1135; *Winne v. Snow* (1884), 19 Fed. Rep. 507.

That the suit must be brought in the name of the informer, not of the United States, see *United States v. Morris* (1866), 3 Fisher, 72; 2 Bond, 23.

That a suit for false stamping under Sec. 4901 can be maintained only in the district where the stamping was done, and not where the stamped goods were sold, see *Pentlarge v. Kirby* (1884), 19 Fed. Rep. 501; *Winne v. Snow* (1884), 19 Fed. Rep. 507.

That a corporation is liable for the act of its superintendent in wrongfully stamping if he knew or should have known that the article was not patented, but not if he was ignorant and acted in good faith, see *Tompkins v. Butterfield* (1885), 25 Fed. Rep. 556; 33 O. G. 758.

That acts of employees in false stamping are acts of the principal, see *Kass v. Hawlowetz* (1885), 33 O. G. 1135.

That in a suit for false stamping in New York the plaintiff need not allege the tort as committed on a certain day, but "on or about the month of" is sufficient, see *Fish v. Manning* (1887), 31 Fed. Rep. 340.

That in a suit for falsely stamping

marking articles as protected by a given patent may be thereby estopped to deny its validity.⁴

§ 632. Failure of Alien Inventor to put his Invention into Market in the United States.

Under the act of 1836 it was the duty of an alien inventor and patentee to put his patented invention into the market in this country within eighteen months after the issue of the patent. To put his invention into the market consisted in offering it for sale at a reasonable price; and his failure to do

an article with the name or patent-mark of the true patentee in New York the declaration must point out the section of the statute sued on, and must allege that the defendant had no patent, that his device contained the patented improvement, and that it was stamped without consent of the patentee or his assigns or representatives, see *Fish v. Manning* (1887), 31 Fed. Rep. 340.

That in a suit for false stamping by a foreign corporation in New York, service upon the person who has general control of the business in which the stamping is done, is on the "managing agent" and is sufficient, see *Hat-Sweat Mfg. Co. v. Davis Sewing Mach. Co.* (1887), 31 Fed. Rep. 294.

That in a suit for false stamping the question of the identity of the stamped device with the patented invention is a question of law, where the want of identity is evident from the patent itself, see *Tompkins v. Butterfield* (1885), 33 O. G. 758; 25 Fed. Rep. 556; *Hawlowetz v. Kass* (1885), 33 O. G. 1499; 23 Blatch. 395; 25 Fed. Rep. 765.

That whether a stamped article, which is not covered by any patent before the court, is patented or not is a question for the jury, see *Kass v. Hawlowetz* (1885), 33 O. G. 1135.

That in a suit for a penalty for false stamping, under Sec. 4901, if the defendant has a patent which he claims covers the articles, the court should de-

termine the scope and effect of the patent, see *Hawlowetz v. Kass* (1885), 23 Blatch. 395; 33 O. G. 1499; 25 Fed. Rep. 765.

That the charge of false stamping must be proved beyond reasonable doubt, see *Tompkins v. Butterfield* (1885), 25 Fed. Rep. 556; 33 O. G. 758.

That in a suit for false stamping the plaintiff is not bound to prove his case as fully as under an indictment, see *Hawlowetz v. Kass* (1885), 23 Blatch. 395; 33 O. G. 1499; 25 Fed. Rep. 765.

That in a suit for stamping with intent to deceive the plaintiff need not prove that the stamped articles are patentable, it being for the defence to show that they are not patentable and that the public could not be deceived, see *Winne v. Snow* (1884), 19 Fed. Rep. 507.

That in a suit for infringement the defendant cannot show that he has not stamped the infringing device as patented, especially if he does not set it up in his answer, see *Herring v. Gage* (1878), 15 Blatch. 124.

⁴ That a person marking articles "patented," under a patent to which he has no right, cannot dispute the validity of such patent, on a motion to enjoin him from falsely stamping, see *Washburn & Moen Mfg. Co. v. Haish* (1879), 9 Bissell, 141; 4 Bann. & A. 571; 18 O. G. 465.

this within the time prescribed forfeited his right to recover for an infringement of the patent.¹ This requirement did not extend to the native assignees of an alien patentee, and was removed even from the latter by the act of 1870.² At present no obligation rests upon any patentee to develop his invention or to bring it into practical use.³

§ 632. ¹ That "to put into market," under this statute, is to be willing to sell at reasonable prices, see *Tatham v. Lowber* (1847), 2 Blatch. 49.

² That this provision did not apply to native assignees of alien inventors, see *Tatham v. Lowber* (1847), 2 Blatch. 49.

³ See § 31 and note, *ante*.

CHAPTER II.

OF THE AMENDMENT OF LETTERS-PATENT.

§ 633. Patentee Bound by the Language of his Patent as Construed by the Courts, whether or not his Actual Invention is thereby Adequately Protected.

AN inventor who has complied with all the provisions of the law on his part is entitled to the complete protection of his invention. The protection actually afforded by his patent, however, is limited and defined by the language it employs for describing and claiming the invention, as such language is interpreted by the courts. From many causes it may happen that the patent, thus construed, fails to cover the invention really made and intended to be patented; and the inventor, being concluded by his patent, is in this manner, therefore, liable to be defeated in the endeavor to secure his rights. In the early history of Patent Law no method existed by which this evil could be remedied. Whatever might be the character or merit of the invention, the patentee must take his letters-patent as they were granted to him; and if they were inaccurate or incomplete the consequences of these defects were inevitable and must be endured. He was regarded as responsible for all discrepancies between the language of the patent and the invention it pretended to describe. If it attempted, in the opinion of the courts, to cover more than the true invention, it was considered as a fraud upon the public, inasmuch as it deprived them of the right to use what was already known. If it departed from the essential characteristics of the invention, it was condemned as a fraudulent concealment from the public of such information as the patentee was bound to disclose. Thus, whether it described and claimed too much, or described and claimed too little, or

incorrectly stated what it did describe and claim, it was alike void and the patentee was left without redress.¹

§ 634. Power to Amend the Defective Language of a Patent Necessary to the Protection of the Patentee.

With the amelioration of public sentiment toward inventors these burdens have been substantially removed. The custom of correcting defective patents by their surrender and the issue of amended patents was early established in this country, and received the sanction and approbation of the courts.¹ This practice has been formally adopted by the acts of Congress and made a permanent feature of our Patent Law.² Other statutes have provided simpler methods by which a mere redundancy of description or an excess of claim may be eliminated from the patent, while errors and mistakes which do not qualify the rights conferred by the patent are either wholly disregarded by the courts or may be amended by the Patent Office at the request of the inventor.

§ 635. The Power to Amend the Defective Language of a Patent does not Include the Power to Change the Nature of the Patented Invention or the Person of the Patentee.

The concession to the inventor of this power to amend his patent has not, however, in any degree obliterated the distinction between a new patent and an amended patent. By no process of emendation can the grant of an exclusive privilege to one person for one invention be transformed into the grant of an exclusive privilege to a different person or for a different invention. A patent is the bestowal of the right to a specific art or instrument upon a specific patentee, and through all the variations which its language may assume its identity as a patent must remain unchanged.¹ The scope of the

§ 633. ¹ See §§ 14, 15, and notes, *ante*.

§ 634. ¹ See *Grant v. Raymond* (1832), 6 Pet. 218; 1 Robb, 604.

² Act of 1832, § 3.

§ 635. ¹ Nearly all the difficulties which have attended the subject of Re-issue might have been avoided by a

proper recognition of the principle here stated. A patent is the grant of a monopoly in an invention. This monopoly cannot be conferred except in an invention completely existing at the time of the grant, and upon an application for a patent for that invention by the inventor or his representatives; and

amending power is limited to such alterations of description and assertion as do not affect the essential character of the invention or the person of the patentee. For a mistake in these the only remedy is by the issue of a new original patent upon an independent application.

§ 636. **Defects and Modes of Amendment, each of Three Classes.**

Defects which fall within the scope of the amending power may be divided into three classes, as indicated by the methods now provided for their removal: (1) Clerical errors; (2) Errors consisting in an excess of claim; and (3) Errors of any kind, whether by excess or deficiency or misstatement, in any matter relating to the substance of the grant. The third

when conferred it is limited in scope to the invention for which the patent has been sought. Here are three inexorable rules which cannot be affected by the concession of the amending power: (1) That the invention must have existed at the issue of the original patent, clearly perceived as well as conceived by the inventor, and fully reduced to practice; (2) That in his application for the original patent the inventor must have attempted to describe and claim every attribute of the invention which he desired to bring within the monopoly created by that patent; (3) That the monopoly created by that patent must thenceforth be regarded as commensurate with the invention which the inventor then endeavored to protect, and if the language of the patent, either through deficiency or excess of statement, fails to correspond with the monopoly as thus created, amendments for the purpose of curing this defect must be permitted until the language of the patent and the scope of the monopoly exactly correspond. The first rule precludes the introduction into the amended patent of any patentable matter which was not clearly in the mind of the inventor or had not been reduced to practice at the date of the

original patent. The second rule forbids the insertion of any matter which the patentee did not endeavor to incorporate into the claims of his patent as originally granted, whether his purpose was to abandon the unclaimed matter to the public, or to reserve it for a future application. The third rule at once compels him and entitles him to change the terms in which his original patent describes and claims the invention it attempted to protect, whenever he discovers that its present language is inadequate. These rules are recognized in many cases, especially in *Parker & Whipple Co. v. Yale Clock Co.* (1887), 123 U. S. 87; 41 O. G. 811; *Powder Co. v. Powder Works* (1878), 98 U. S. 126; 15 O. G. 289; etc., where it is held that a re-issue is valid whenever it is confined to the invention which the inventor intended to describe and claim in the original patent, unless meanwhile he has abandoned it to the public. The application of these rules in the Patent Office and in the courts in a few of the earlier cases would have simplified the whole matter, and probably have saved numerous and expensive contests in which the subject of amending patents seems only to become more difficult and obscure.

class includes the second, so far as the nature of the defects are concerned; but the second has a peculiar remedy in addition to that by which the other errors of the third class are corrected. Defects of the first class are amended by the action of the Patent Office at the suggestion of the patentee. Defects of the second class may be cured by Disclaimer. Defects of the third class are removed by a Re-issue. Each of these remedies, with the method of applying them, will now be examined.

SECTION I.

OF THE AMENDMENT OF LETTERS-PATENT: CLERICAL ERRORS.

§ 637. Clerical Errors Defined: How Corrected.

Under the head of clerical errors may be embraced all the mistakes in the patent which do not affect the substance of the grant, and which occur through the fault of the employees of the Patent Office.¹ Upon his discovery of any such mistake after the delivery of the patent, the patentee or his assignee may make an application to the Commissioner for its correction, and if the error is clearly disclosed by the files or records of the Office, a certificate showing the fact and nature of the mistake will be signed by the Secretary of the Interior, countersigned by the Commissioner, sealed with the seal of the Patent Office, endorsed upon the patent, and duly recorded in the records of original patents as a part of that on which it is endorsed.² A printed copy of this certificate will also be

§ 637. ¹ That an error in the number of a patent is a clerical error, see *Reed v. Street* (1884), 34 O. G. 339.

That a mistake in the Christian name of a patentee does not invalidate the patent, if he is otherwise so described as to be identified, see *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.* (1874), 6 O. G. 34; 1 Bann. & A. 177; 10 Phila. 227.

That an error in one letter of the surname of a patentee may be of no consequence, see *Bignall v. Harvey* (1880),

18 O. G. 1275; 4 Fed. Rep. 334; 18 Blatch. 353.

That a mistake of the Patent Office in engrossing the specification is a clerical error, see *In re Johnson's Patent* (1877), L. R. 5 Ch. D. 503.

² That clerical errors may be corrected, without surrender and re-issue, by the action of the Patent Office, see *Reed v. Street* (1884), 34 O. G. 339.

That a clerical error in a patent could be corrected, under the act of 1836, only by the Secretary of State,

attached to each printed copy of the specifications and drawings issued from the Office.

§ 638. Errors of Substance not Corrected as Clerical Errors.

Errors affecting the substance of the grant cannot be corrected in this summary manner, although occurring through the fault of the employees of the Patent Office. Mistakes whose ordinary remedy is a re-issue can be removed only by that proceeding, from whatever cause they may arise; but when a re-issue becomes necessary through official negligence no fees are charged for its allowance, unless it operates as an amendment of other defects than those for which the Patent Office is responsible.

§ 639. Correction of Clerical Errors not to affect Intervening Rights.

The correction of a clerical error relates back to the date of the patent, and the amended instrument is thenceforth regarded as the original form of the grant. But such an amendment cannot affect intervening rights. While the patent remains uncorrected the public may safely act upon it as it stands, and the delay of the patentee in procuring its correction is regarded as an acquiescence in whatever rights or privileges others meanwhile may have lawfully acquired.¹

SECTION II.

OF THE AMENDMENT OF LETTERS-PATENT: DISCLAIMER.

§ 640. Disclaimer: Its Twofold Purpose: To Amend Defective Patent: To Save an Otherwise Lost Suit.

Errors consisting in an excess of claim, whereby the protection of the patent is extended to matters not embraced

though his signature was not necessary, see *Woodworth v. Hall* (1846), 1 W. & M. 389; 2 Robb, 517.

§ 639. ¹ That the correction of a clerical error relates back to the date of the error unless intervening rights would be thereby affected, see *Woodworth v. Hall* (1846), 1 W. & M. 389; 2 Robb, 517.

That if the correction be material it can operate only on subsequent cases, see *Woodworth v. Hall* (1846), 1 W. & M. 248; 2 Robb, 495.

That the right to the correction of clerical errors may be lost by delay, see *In re Blamoud's Patent* (1860), 3 L. T. Rep. n. s. 800.

within the actual invention, may be amended by disclaimer. Disclaimer forms the subject of two distinct provisions of the statutes, embraced in different sections and having no direct connection with each other. Section 4917 relates to disclaimer as a method of amending a defective patent. Section 4922 relates to it as a method by which the plaintiff, in a suit for infringement, may avoid the defence that his original patent claimed more than his invention, and in spite of this defect may recover proper damages for the injury he has sustained. Although these two provisions were incorporated into our Patent Law by the same act of Congress, this distinction between their purposes and scope is of great importance, and the failure to observe it has led, in some cases, to serious misunderstanding.¹

§ 641. Origin and Nature of Disclaimer as a Method of Amending a Defective Patent.

A disclaimer, considered as a method of amending a defective patent, is a development of that amending power which formerly could be exercised only by a re-issue. As will hereafter appear, the re-issue of a patent necessitated the surrender of the original patent and the destruction of all rights arising therefrom. It was also a proceeding attended with expense and delay, and required the co-operation of all the owners of the patent in the surrender of the old patent and the application for the new. And yet in the absence of this proceeding, under the acts of 1832 and 1836, the rights of the patentee could not be vindicated against an infringer if his patent claimed more than his actual invention, although the actual invention were sufficiently described, and the portions properly claimed could be clearly distinguished from the excess. It was soon perceived, however, that for the purposes of this species of amendment, no such formidable and cautious procedure was demanded. The restriction of an ex-

§ 640. ¹ That disclaimers under Secs. 4917 and 4922 rest on the same grounds though used for different purposes, see *Hailes v. Albany Stove Co.* (1887), 123 U. S. 582; 42 O. G. 95.

That a disclaimer does not admit that the patent is void, see *Stocker v. Waller* (1845), 9 Jur. 136; 1 C. B. 147.

cessive Claim is the simple abandonment of an apparent right. It prejudices no one except him who relinquishes what he has hitherto asserted, and may be made by any owner of a separate interest in a patent without affecting the privileges of his co-owners or the public. Hence in the act of 1837 it was provided that this particular amendment might be made by any owner of the whole patent, or of a sectional interest therein, by filing in the Patent Office a written disclaimer of the excess, and that, as modified by this disclaimer, the original patent should thereafter be construed in all cases where the rights of the disclaimant were involved. A disclaimer is thus an inexpensive and expeditious method of removing from a patent a defect which could at first be cured only by a re-issue, and which may still be remedied at the option of the owners of the entire patent by that more elaborate proceeding.¹

§ 642. Disclaimer a Method of Amending only an Excessive Claim.

The defect which a disclaimer is intended to remove is one that, in its nature, is fatal to the patent.¹ An inventor has

§ 641. ¹ That a disclaimer is allowed in reference to patents that were issued before the act was passed, see *Hotchkiss v. Oliver* (1848), 5 Denio (N. Y.), 314.

§ 642. ¹ That a disclaimer is necessary when too much has been claimed, see *Seymour v. McCormick* (1856), 19 How. 96.

That superfluous Claims may be disclaimed, but cannot be rejected by the courts, see *Parker v. Sears* (1850), 1 Fisher, 98.

That a void Claim may be disclaimed, see *Tyler v. Galloway* (1882), 12 Fed. Rep. 567 ; 20 Blatch. 445 ; 22 O. G. 2072.

That a Claim, if too broad, may be narrowed by disclaimer, see *Terry Clock Co. v. New Haven Clock Co.* (1879), 17 O. G. 909 ; *Rice v. Garnhart* (1874), 34 Wis. 453.

That where the original patent claims

two methods, the disclaimer may relinquish one, see *Tuck v. Bramhill* (1868), 6 Blatch. 95 ; 3 Fisher, 400.

That a patent covering distinct improvements may be amended by disclaiming all but one, see *Sessions v. Romadka* (1884), 28 O. G. 721 ; 21 Fed. Rep. 124.

That expanded and unlawful Claims inserted by re-issue may be abandoned by disclaimer, see *Schillinger v. Cranford* (1885), 4 Mackay, 450 ; 37 O. G. 1349 ; *Atlantic Giant Powder Co. v. Hulings* (1884), 21 Fed. Rep. 519 ; *Schillinger v. Gunther* (1879), 17 Blatch. 66 ; 16 O. G. 905.

That the original patent cannot be revived merely by disclaiming all changes made by the re-issue, but a new re-issue must be had, see *McMurray v. Mallory* (1884), 111 U. S. 97 ; 27 O. G. 915.

no more right under the modern law than he had under the ancient law to claim what he has not invented, and thus deprive the public of their vested privileges. Knowingly to insert such Claims in his original patent is a fraud which invalidates his grant, and knowingly to persevere in them, after he has discovered that they are without foundation, is a fraud which forfeits all his rights to the protection of any part of the invention covered by the patent. In cases of excessive Claim an amendment by disclaimer or re-issue is thus necessary to save any portion of the privilege conferred by the patent; and at whatever period, during the life of the patent, the patentee becomes aware of this defect he must remove it or the value of his patent is destroyed.

§ 643. **Claim when Excessive: How Excess Ascertained.**

A Claim is excessive when it claims any material and substantial act or thing beyond the scope of the real invention of the patentee, or beyond the scope of what he has described in his specification, drawings, or model, as his invention.¹ Immaterial and unessential features of the art or instrument protected by the patent are never regarded as covered by the Claim, nor does their mention in the Claim in any degree affect the character of the patented invention. Excess in these particulars is, therefore, not a fault which calls for any amendment, unless its presence in the Claims renders them obscure and thus requires their correction by re-issue.² Whether the Claim is broader than the Description may be discovered by comparing them with each other as they appear on the face of the patent. Whether it exceeds the real invention is determined by ascertaining the precise limits of the idea of means embodied in the invention, and inquiring if the

§ 643. ¹ In *O'Reilly v. Morse* (1853), 15 How. 62, Taney, C. J.: (121) "Whether, therefore, the patent is illegal in part because he claims more than he has sufficiently described, or more than he invented, he must in either case disclaim, in order to save the portion to which he is entitled."

² In *Hall v. Wiles* (1851), 2 Blatch. 194, Nelson, J.: (199) "The pro-

vision in question applies only in the case where the part claimed by the patentee, of which he is not the inventor, is a material and substantial part of the thing patented. A disclaimer is necessary, therefore, only where the thing claimed without right is a material and substantial part of the machine invented."

allegations of the Claim cover any substantial instrument or operation not embraced in this idea. The former investigation is governed by the ordinary rules of interpretation. The latter may be pursued in any manner tending to disclose the actual nature of the invention made. Thus if the patentee has received a foreign patent in which his invention is described and claimed within narrower limits than in the domestic patent, or if in actual use certain features which the patent claims as material parts of the invention are discarded as non-essential, or if by any evidence it is established that the Claim includes features already known at the date of the invention, — in these and in all other proper ways the identity of the invention made with the invention claimed may be tested, and the extent and nature of the excess, if any, may be ascertained.³ This excess, if separable from the other portions of the Claim, or if constituting one of several Claims in the patent, may form the subject-matter of a disclaimer. When not separable from the other portions of the Claim, the entire Claim is void and can be cured only by re-issue; and when the patent contains no other Claims than this indivisible, excessive Claim, the patent itself is inoperative and should be surrendered and re-issued.

§ 644. Excessive Claim Amendable by Disclaimer only when the Defect Arose through Mistake and without Fraud.

An excessive Claim can be amended by disclaimer only when the error arose through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention.¹ A

³ That where a foreign patent (English) contains a disclaimer of certain features, the American patent must be limited in the same way, see *Ashcroft v. Boston & Lowell R. R. Co.* (1877), 97 U. S. 189; 13 O. G. 865.

That a device actually discarded in practice ought to be disclaimed, see *Ex parte Marsh* (1872), 2 O. G. 197.

That immaterial parts may be removed by disclaimer, see *Lister v. Leather* (1858), 8 El. & B. 1004; *Reg. v. Mill* (1851), 14 Beav. 312.

That a claimed element of a combi-

nation cannot be disclaimed, see *Vance v. Campbell* (1861), 1 Black, 427; *Foxwell v. Bostock* (1864), 4 De G. J. & S. 298.

That the correction of a mistake as to the effect produced must be made by re-issue, not by disclaimer, see *Schillinger v. Gunther* (1878), 14 O. G. 713; 15 Blatch. 303.

§ 644. ¹ In *Schillinger v. Gunther* (1879), 17 Blatch. 66, Blatchford, J. : (69) "But no disclaimer can be allowed to be operative unless the unlawful claim was made through inadvertence, accident, or mistake, and without

patentee is not allowed to speculate on the chances of an attack upon his patent for its unwarranted assertions, nor on the submission of the public to his improper claims. The law requires of him the utmost good faith, with reasonable diligence and skill in the description of his invention and the statement of his claims, and does not hold him responsible for errors into which, in spite of honesty and caution, he is liable to fall. But to the patentee who wilfully endeavors to mislead the public, it lends no aid either in the correction of his errors or in avoiding their consequences, but leaves him to meet his merited fate in the rejection of his patent by the courts.

§ 645. Excessive Claim Amendable by Disclaimer only when the Amended Claim would cover a Patentable Invention.

An excessive Claim can be amended by disclaimer only when the Claim as amended would cover a patentable invention.¹ The patentee has no right to any patent whatever unless he has invented something which may lawfully become the subject-matter of a patent, and no mistake of his in coupling with his own production such instruments or operations as give to the described invention its entire patentable character can entitle him to retain the patent for what is truly his, after disclaiming that excess in which the attributes

any fraudulent or deceptive intention; nor can a plaintiff recover on a patent which claims anything not *bona fide* the patentee's, unless the claim to the thing not *bona fide* his was made through inadvertence, accident, or mistake, and without any wilful default or intent to defraud or mislead the public." 16 O. G. 905 (906).

That a disclaimer is proper where the mistakes were mistakes of fact, see *Schillinger v. Gunther* (1879), 16 O. G. 905; 17 Blatch. 66.

That the burden of proof rests on those who allege that the excess was originally claimed through fraud, see *Hotchkiss v. Oliver* (1848), 5 Denio (N. Y.), 314.

For a discussion of inadvertence, etc., see §§ 658, *ante*, and 685-692, and notes, *post*.

§ 645. ¹ That a disclaimer is of no avail unless the part rightfully claimed is a material and substantial part of the matter patented, and is distinguishable from the rest, see *Hotchkiss v. Oliver* (1848), 5 Denio (N. Y.), 314.

That an element of a combination is not a distinguishable part, see *Vance v. Campbell* (1861), 1 Black, 427.

That a part may be useful and yet neither material nor substantial nor distinguishable, see *Hotchkiss v. Oliver* (1848), 5 Denio (N. Y.), 314.

of a patentable invention alone reside. No one, therefore, can be permitted to disclaim, unless he or the alleged inventor from whom he derives his title has performed an inventive act, resulting in some material and substantial part of the thing patented which is so far separable from the excess that the patent can be valid for it, and protect it, after the excess has been disclaimed.

§ 646. Excessive Claim not Amendable by Disclaimer after Unreasonable Delay.

An excessive Claim can be amended by disclaimer only when the amendment is attempted without unreasonable delay. The same principle which forbids a patentee to assert a right to more than he has actually invented compels him to disavow the right as soon as he discovers that it has been unjustly claimed. Unreasonable delay in disclaiming is thus tantamount to an original fraudulent Claim, and through it the patentee loses the privilege of making the amendment by which alone his patent could be saved.¹ The question of unreasonable delay is a question for the court, upon the facts as found either by its own investigation or the verdict of a jury.² Delay begins whenever the patentee becomes aware that he has claimed more than he has invented or described. In cases where the excess is not apparent at once upon the inspection of the patent by the patentee, the allowance of his

§ 646. ¹ That "unreasonable delay" avoids the good effect of a disclaimer, see *Tuck v. Bramhill* (1868), 6 Blatch. 95; 3 *Fisher*, 400; *Singer v. Walmsley* (1860), 1 *Fisher*, 558; *Seymour v. McCormick* (1856), 19 *How.* 96; *Brooks v. Jenkins* (1844), 3 *McLean*, 432.

That a delay in filing a disclaimer does not prejudice the patentee unless it is unreasonable, see *Hotchkiss v. Oliver* (1848), 5 *Denio* (N. Y.), 314.

That no disclaimer can be filed after the patent has expired, see *Yale Lock Mfg. Co. v. Sargent* (1886), 117 *U. S.* 536; 35 *O. G.* 497; *Vacuum Oil Co. v. Buffalo Lubricating Oil Co.* (1885), 23 *Fed. Rep.* 891.

² In *Singer v. Walmsley* (1860), 1 *Fisher*, 558, *Giles, J.*: (575) "What is 'unreasonable delay' is a question to be settled by the court and not for the jury. . . . The court will find that the time, in reference to the question of delay, commences when the knowledge was brought home to the party that he was not the first inventor, or when it is declared by a court, of competent jurisdiction to settle the question, that he was not the first inventor; then it is that the time commences to run, and not until then."

See also *Seymour v. McCormick* (1856), 19 *How.* 96; *Brooks v. Jenkins* (1844), 3 *McLean*, 432.

Claim by the Patent Office raises such a presumption in its favor that he may rely on its validity until a court of competent jurisdiction decides that it is broader than his real invention.⁸

§ 647. Disclaimer, by Whom Made.

Where an excessive Claim can be cured by disclaimer, the disclaimer must be filed by a party owning an interest in the patent and whose interest is distinct from that of his co-owners.¹ The original patentee cannot disclaim after he has parted with his entire title to the patent.² An owner of an undivided interest cannot disclaim, and thus change the form of the patent, without the co-operation of the other owners of the same interest in the patent. But an owner either of the entire patent, or of the entire interest within a specified territory, may file a disclaimer; and when the disclaimant is a territorial owner its effect upon the patent will be commen-

⁸ In *O'Reilly v. Morse* (1853), 15 How. 62, Taney, C. J. : (121) "It appears that no disclaimer has yet been entered at the Patent Office. But the delay in entering it is not unreasonable. For the objectionable Claim was sanctioned by the head of the Office; it has been held to be valid by a circuit court, and differences of opinion in relation to it are found to exist among the justices of this court. Under such circumstances the patentee had a right to insist upon it, and not disclaim it until the highest court to which it could be carried had pronounced its judgment."

See also *Seymour v. McCormick* (1856), 19 How. 96.

That the allowance of Claims by the Patent Office is such evidence of their validity that the patentee may rely upon it until the courts have decided to the contrary, see *Yale Lock Mfg. Co. v. Sargent* (1886), 117 U. S. 536; 35 O. G. 497; *Stutz v. Armstrong* (1884), 28 O. G. 367; 20 Fed. Rep. 843; *Burdett v. Estey* (1878), 15 Blatch. 349; 15 O. G. 877.

That delay in disclaiming cannot exist until the need of a disclaimer is made known, see *Kittle v. Hall* (1887), 30 Fed. Rep. 239.

That a disclaimer may be filed after a patent has been adjudged invalid, see *Morgan v. Seaward* (1838), 2 Carp. P. C. 104; *In re Derosne's Patent* (1835), 1 Carp. P. C. 698.

§ 647. ¹ That a disclaimer must be made by one who owns an entire right within a given territory, see *Myers v. Frame* (1871), 4 Fisher, 493; 8 Blatch. 446.

² That a disclaimer by a patentee is not valid unless he is still the owner of the patent, see *Myers v. Frame* (1871), 4 Fisher, 493; 8 Blatch. 446.

That under the English statute a disclaimer may be filed by a patentee who has parted with his interest, see *Spilsbury v. Clough* (1842), 1 Web. P. C. 255.

That a disclaimer by an attorney does not necessarily bind a patentee, see *Mann v. Bayliss* (1876), 10 O. G. 789.

surate only with his interest; and the patent as amended will thereafter limit and define his rights, while other parties hold under the patent in its original form.³ Thus the same patent may be operative, in terms at least, to different extents in different sections of the United States, and may be valid as to diligent disclaimants, though void as to other owners who have unreasonably neglected to disclaim.

§ 648. Disclaimer, how Made.

A disclaimer must be made in writing, must be signed by the disclaimant and attested by one or more witnesses, and must be recorded in the Patent Office. It must state the exact interest of the disclaimant in the patent, and distinctly set out the excess which is to be disclaimed, averring that it was included in the patent through inadvertence, accident, or mistake.¹ Upon the receipt and recording of this disclaimer, it is considered as part of the original specification, to the extent of the interest possessed by the disclaimant and by those deriving title from him after the disclaimer is recorded.²

³ In *Potter v. Holland* (1858), 1 Fisher, 327, *Ingersoll, J.* : (339) "The owner of a sectional interest, however, can make a disclaimer for his sectional interest, which is to be taken as a part of the original specification, for the section owned by him, and no greater extent. After such disclaimer a different claim of right is secured to the disclaimant, the owner of a sectional interest, from what is purported to be secured to the patentee, the owner of the remaining interest; different claims of right in the same invention are secured to different sectional owners; there are two specifications for the same invention, one making one claim of right to an invention for one section of country, and the other making another and different claim of right to the same invention, for another section of country. In effect it makes two patents out of one, one securing a claim of right to one person, and the other securing a

different claim of right to another person. This is expressly authorized by the Patent Law." 4 Blatch. 206 (217).

That the word "claimant" in Sec. 4917 Rev. Stat. means disclaimant, see *Union Metallic Cartridge Co. v. United States Cartridge Co.* (1884), 112 U. S. 624; 30 O. G. 771.

§ 648. ¹ That a disclaimer, under Sec. 7, act of 1837, must state the interest of the disclaimant, or it will be invalid, see *Foote v. Silsby* (1849), 1 Blatch. 445; *Brooks v. Jenkins* (1844), 3 McLean, 432.

² That a disclaimer becomes part of the specification and is considered in construing the patent, see *Dunbar v. Myers* (1877), 94 U. S. 187; 11 O. G. 35.

That a disclaimer may relate to one figure only in a drawing, see *Brush v. Condit* (1884), 28 O. G. 451; 22 Blatch. 246; 20 Fed. Rep. 826.

§ 649. Disclaimer not a Method of Amending a Defective Description.

From the nature of a disclaimer, and of the defect it is intended to remedy, it is evident that it cannot be employed for the alteration or reformation of the Description, but only for the elimination of superfluous matter from the Claims.¹ If the Description requires amendment in order to give effect to a Claim, or if the Claim itself demands restatement to avoid obscurity, or if new Claims are necessary to protect the actual invention, these objects must be sought by a re-issue, not by

§ 649. ¹ In *Hailes v. Albany Stove Co.* (1887), 123 U. S. 582, Bradley, J. : (587) "A disclaimer is usually and properly employed for the surrender of a separate Claim in a patent, or some other distinct and separable matter, which can be excised without mutilating or changing what is left standing. Perhaps it may be used to limit a Claim to a particular class of objects, or even to change the form of a Claim which is too broad in its terms; but certainly it cannot be used to change the character of the invention. And if it requires an amended specification or supplemental Description to make an altered Claim intelligible or relevant, while it may possibly present a case for a surrender and re-issue, it is clearly not adapted to a disclaimer. A man cannot by merely filing a paper drawn up by his solicitor make to himself a new patent, or one for a different invention from that which he has described in his specification." 42 O. G. 95 (97).

In *Union Metallic Cartridge Co. v. United States Cartridge Co.* (1884), 112 U. S. 624, Blatchford, J. : (642) "It is a patentee who 'has claimed more than that of which he was the original or first inventor or discoverer,' and only 'such patentee,' or his assigns, who can make a disclaimer, and the disclaimer can be a disclaimer only 'of such parts of the thing patented as he shall not choose to claim or hold by

virtue of the patent or assignment.' A disclaimer can be made only when something has been claimed of which the patentee was not the original or first inventor, and when it is intended to limit a Claim in respect to the thing so not originally or first invented. It is true that, in so disclaiming or limiting a Claim, descriptive matter on which the disclaimed Claim is based may, as incidental, be erased, in aid of, or as ancillary to, the disclaimer. But the statute expressly limits a disclaimer to a rejection of something before claimed as new or as invented, when it was not new or invented, and which the patentee or his assignee no longer chooses to claim or hold. It is true that this same end may be reached by a re-issue, when the patentee has claimed as his own invention more than he had a right to claim as new; but if a Claim is not to be rejected or limited, but there is merely 'a defective or insufficient specification,' — that is, Description, as distinguished from a Claim, — the only mode of correcting it was and is by a re-issue." 30 O. G. 771 (775).

That a disclaimer cannot be used to make a patent cover what is not described or claimed as part of the invention, see *White v. Gleason Mfg. Co.* (1883), 24 O. G. 205; 21 Blatch. 364; 17 Fed. Rep. 159; *Foxwell v. Bostock* (1864), 4 De G. J. & S. 298.

a disclaimer. But where excessive Claims are to be remedied by a disclaimer, such parts of the Description as serve no other purpose than to support the excess disclaimed may also be withdrawn by the disclaimer, and the distinction between the actual invention and the excess be thus more clearly indicated.² In the same manner objectionable phrases in the

² In *Hailes v. Albany Stove Co.* (1883), 16 Fed. Rep. 240, Wallace, J. : (242) "If it is true that the patentees defectively or insufficiently described the invention, and claimed more than they had a right to claim as new, they were entitled to a re-issue of their patent upon surrender of the original. But it is not the office of a disclaimer to reform or alter the Description of the invention. If a patentee has claimed more than that of which he was the inventor, his patent may be valid for all that part which is justly and truly his own, and he may recover upon his patent if the part which is his own be definitely distinguished from the parts claimed without right; but in such case he cannot recover costs unless a disclaimer has been entered before suit commenced. When there are several Claims, some of which he is entitled to and others of which he is not entitled to, the part of the invention which is his own may be definitely distinguishable from that which is not his own, and a disclaimer before suit brought will put him right, and enable him to recover upon his patent as though it had originally been confined to the proper Claims; and there would seem to be no objection in such a case to eliminating by his disclaimer such parts of the Description as relate to the Claims to which he is not entitled and which he abandons. This, however, is a very different thing from converting a Claim from one thing into a Claim for something else, and amending the Description to effectuate the Claim. This might give the patentee a new patent;

it certainly would enable him to grant himself a re-issue without the concurrence of the Commissioner of Patents. It would enable him, after others had occupied the field of invention, and by their intellect and experiments discovered what he had never pointed out or claimed, except, perhaps, so vaguely that his information was valueless, to deprive them of the fruit of their efforts. When there are distinct Claims in the patent, some of which are valid and others not; or, where there is a single Claim, but a specification by which the public can definitely distinguish what is new and belongs to the patentee, and what does not really belong to him, although he had claimed it, a disclaimer will right the patentee's mistake, and will work no injustice to others." 21 Blatch. 271 (273); 24 O. G. 391 (392).

In *Schillinger v. Gunther* (1879), 17 Blatch. 66, Blatchford, J. : (69) "It is true, that, strictly, Sec. 4917 contemplates only a disclaimer of some Claim, or part of a Claim; but, in connection with a disclaimer of a Claim, or of a part of a Claim, it is not improper to eliminate or withdraw, by the same writing, the parts of the body of the specification on which the disclaimed Claim, or part of a Claim, is founded. The disclaimer is none the less a disclaimer of a Claim or of a part of a Claim because, in addition, it disclaims such parts of the body of the specification. The disclaimer being a proper one, in form and substance, it is, by the statute, to be, after its filing, 'considered as part of the original specification.' The re-issued specification is to be

specification may be removed, and false statements of fact may be expunged, provided that no new construction is thereby given to what remains.⁸ For the sole purpose of a disclaimer is to amend excessive Claims by eliminating from them the separable excess; and whatever else it may accomplish must be wholly subordinate and auxiliary to that end.

§ 650. Disclaimer Affects only the Excess which it Eliminates from the Claim.

The effect of a disclaimer is confined to the excess which it removes from the apparent protection of the patent. Except as to this the patent remains operative to the same extent as before the disclaimer was filed.¹ The disclaimer of a void Claim does not affect such other Claims of the patent as by themselves are valid, nor does the disclaimer of the excessive portion of a Claim impair the force of what is not disclaimed. Thus the disclaimer neither adds to the patent, nor makes it cover more than it formerly embraced.² The disclaimer of a species does not affect a Claim for the genus which includes it, nor does the disclaimer of an apparatus except when used for a particular purpose prevent the patentee from claiming it in connection with the purpose so described.³ The patent stands

thereafter read as if the disclaimer were incorporated in it." 16 O. G. 905 (906).

That a disclaimer may eliminate all of the descriptive matter which relates to the parts disclaimed, see *Tarrant v. Duluth Lumber Co.* (1887), 39 O. G. 1425; 30 Fed. Rep. 830.

That a disclaimer may remove matter first set up in a re-issue, and may relate to the Description as well as to the Claim, see *Schillinger v. Gunther* (1879), 16 O. G. 905; 17 Blatch. 66.

⁸ That objectionable phrases in the specification may be removed by disclaimer, see *American Wood Paper Co. v. Heft* (1867), 3 Fisher, 316.

That an unintelligible specification cannot be cured by disclaimer, see *Ralston v. Smith* (1865), 11 H. L. 223.

§ 650. ¹ That the matter disclaimed

ceases to be part of the invention, see *Dunbar v. Myers* (1877), 94 U. S. 187; 11 O. G. 35.

That a void Claim being disclaimed the rest are good, see *O'Reilly v. Morse* (1853), 15 How. 62.

² That a disclaimer adds nothing to the patent nor can it make the patent cover more than it did before, this being the province of a re-issue, see *White v. Gleason Mfg. Co.* (1883), 17 Fed. Rep. 159; 21 Blatch. 364; 24 O. G. 205; *Foxwell v. Bostock* (1864), 4 De G. J. & S. 298.

³ That the disclaimer of one species does not affect the genus, see *Walsh v. Shinn* (1879), 16 O. G. 1006.

That a disclaimer of apparatus except when used for a special purpose does not admit it to be old, or bar the patentee from claiming it for that purpose, see

after the disclaimer as if it had been originally issued in the amended form, and both its Claims and its Descriptions are interpreted and applied without reference to the matter that has been withdrawn.⁴

§ 651. **Origin and Nature of Disclaimer as a Method of Saving an Otherwise Lost Suit.**

A disclaimer, considered as a method of avoiding a defence based on an excessive Claim, was also introduced into our Patent Law by the act of 1837. Prior to that act the patentee could not recover on a patent in which he claimed more than he had actually invented. It was his duty not only to describe his invention with exactness, neither withholding from the public the knowledge of any material part thereof nor misleading them by asserting the materiality of that which in itself was not essential, but to distinguish the invention to be covered by the patent from all other arts or instruments by a certain and specific Claim. Upon this Claim the fortunes of the patent turned. If it were narrower than the invention the scope of the protection afforded by the patent was nevertheless restricted to its terms. If it were broader than the actual invention it was false, at least in part, and as the court had no means of determining, as matter of law, how far the Claim was true nor of separating the true allegations from the false, the entire Claim was necessarily regarded as invalid. The act of 1836, while it made this defect curable by re-issue, also provided that when a defendant in an action for infringement prevailed over the

Black v. Thorne (1872), 10 Blatch. 66 ;
5 Fisher, 550 ; 2 O. G. 388.

⁴ That an unfounded Claim being disclaimed the patent stands for the residue as if so originally issued, see *McCormick v. Seymour* (1854), 3 Blatch. 209 ; *Clark v. Kenrick* (1843), 12 M. & W. 221.

That after an amendment by disclaimer a patent cannot be so construed as to render the amendment nugatory, see *Atlantic Giant Powder Co. v. Hullings* (1884), 21 Fed. Rep. 519.

That where a disclaimer withdraws a new re-issue Claim, and leaves only what was covered by the original, if any new matter remains in the Description it must be discarded, see *Schillinger v. Cranford* (1885), 4 Mackay, 450 ; 37 O. G. 1349.

That a disclaimer cannot be used to explain that which remains in the patent, see *Tetley v. Easton* (1857), 2 C. B. N. s. 706.

plaintiff on this ground of defence, the court might award costs to either party in its discretion, if the defendant had used any part of the invention which was truly claimed as new. This provision enabled the court to shield the honest but mistaken patentee from some of the consequences of his error, leaving him, under other provisions of the same act, to amend his Claim and thus protect himself from further violations of his rights. The act of 1837 extended, and made more immediately applicable, these benign provisions. While conferring on the owner of the patent the power to amend at once by filing a disclaimer, it enacted that in all those cases where a disclaimer might properly be filed the patent should be good and valid for so much of the invention claimed as was truly and honestly the invention of the patentee, if it were in itself a patentable invention and separable from the matter falsely claimed. It further enacted that the plaintiff claiming under such a patent should be entitled to maintain his suit in spite of this defect, if the right to amend the patent by disclaimer had not been already forfeited by an unreasonable delay, but that he should recover no costs against the defendant unless he had filed such disclaimer in the Patent Office prior to the commencement of the suit.¹

§ 651. ¹ In *Tuck v. Bramhill* (1868), 3 Fisher, 400, Blatchford, J. : (406) "But the defendant contends that the disclaimer in this case, if properly made at all, cannot affect the issues in this suit, because it was not filed till after the commencement of the suit. In other words, the defendant contends that the plaintiff cannot recover in this suit because the Claim, as it stood when the suit was brought, embraced more than that of which the plaintiff was the first inventor. In urging this view, the defendant relies on the general principle of law to that effect, as recognized before the act of March 3, 1837, was passed, and on the provision of section 7 of that act, that 'no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of

unreasonable neglect or delay in filing the same;' and he insists that the Claim of the patent must be construed, for the purposes of this suit, as if no disclaimer had been filed. . . . (408) This is not so. It is true that Judge Story, in *Reed v. Cutter*, 1 Story, 590, 600, says that if a disclaimer is filed during the pendency of a suit, the plaintiff will not be entitled to the benefit thereof in that suit, and that the same judge, in *Wyeth v. Stone*, 1 Story, 273, 294, says that the disclaimer mentioned in section 7 must be interpreted to apply solely to suits pending when the disclaimer is filed in the Patent Office, and the disclaimer mentioned in section 9 to apply solely to suits brought after the disclaimer is so filed, and that the proviso to section 7, as to the disclaimer's affecting a pending suit, prevents its affect-

Under these provisions the patent is no longer open to this defence except where the disclaimer was unreasonably de-

ing in any manner whatsoever a suit pending at the time it is filed. . . . (409) I cannot concur, however, in Judge Story's view of the provision in section 7 as to the disclaimer's affecting a pending suit. I understand that provision to mean that a suit pending when a disclaimer is filed is not to be affected by such filing, so as to prevent the plaintiff from recovering in it, unless it appears that the plaintiff unreasonably neglected or delayed to file the disclaimer. The 'unreasonable neglect or delay' mentioned in section 7 manifestly refers to the unreasonable neglect or delay mentioned in section 9, and the disclaimer mentioned in section 9 is clearly the disclaimer provided for in section 7. Moreover, the provision of section 9, that the plaintiff, where he is entitled to recover under that section, shall not recover costs unless he has entered a disclaimer, prior to the commencement of the suit, of what he claimed without right, is a strong implication that where he does not enter the disclaimer until after the commencement of the suit he may still recover in the suit, if otherwise entitled to do so, but without recovering costs. And such has been the view heretofore held by Mr. Justice Nelson, in this circuit. In *Guyon v. Serrell*, 1 Blatch. 244, he allowed a recovery, without costs, in a case where a disclaimer was filed after suit was brought; and in *Hall v. Wiles*, 2 Blatch. 194, 198, he says: 'If the disclaimer was entered in the Patent Office before the suit was instituted, the plaintiff recovers costs in the usual way, independently of any question of disclaimer. But if, in the progress of the trial, it turns out that the disclaimer ought to have been made as to part of what is claimed, the plaintiff may recover, but will not be entitled to costs.' Of

course, it follows that if a disclaimer is made after suit brought, the plaintiff may still recover, but without costs.' 6 Blatch. 95 (102).

That the plaintiff may recover for the infringement of his actual invention though he has filed no disclaimer, unless he has been guilty of unreasonable delay, see *O'Reilly v. Morse* (1853), 15 How. 62; *Hall v. Wiles* (1851), 2 Blatch. 194.

That an excessive Claim inserted by mistake may be disclaimed pending suit and the suit saved, though without costs, see *Matthews v. Spangenberg* (1882), 23 O. G. 92; 20 Blatch. 482; 19 Fed. Rep. 823.

That where a proper disclaimer has been filed the plaintiff may recover on the Claims not disclaimed, see *Schillinger v. Gunther* (1879), 17 Blatch. 66; 16 O. G. 905.

That a patentee may have his remedy though no disclaimer is filed, it not being a condition precedent, see *Hotchkiss v. Oliver* (1848), 5 Denio (N. Y.), 314.

That the court may increase the damages under Sec. 14, act of 1836, though no disclaimer was filed, see *Guyon v. Serrell* (1847), 1 Blatch. 244.

That under the act of 1837, when the patent claims too much, a suit can be saved only where the thing rightfully claimed can be distinguished from the excess, see *Vance v. Campbell* (1861), 1 Black, 427.

That in order to save the costs a disclaimer must be filed before suit, as well as with reasonable diligence, see *Tuck v. Bramhill* (1868), 6 Blatch. 95; 3 Fisher, 400; *Reed v. Cutter* (1841), 1 Story, 590; 2 Robb, 81.

That the filing of a disclaimer before suit affects only the costs, if there is no question of unreasonable delay, see *Dunbar v. Myers* (1877), 94 U. S. 487; 11

ferred, but the defendant is not liable for costs on any action brought while the patent still remains in its defective state.²

§ 652. Disclaimer a Nullity unless Original Claim Actually Excessive.

A disclaimer filed without sufficient cause is a nullity under this as well as the former section of the act.¹ If there is no real excess of Claim, according to the construction given to its language by the court, the filing of a disclaimer by the plaintiff, pending suit, does not admit his inability to recover costs.² A disclaimer leaving the patent to claim the entire invention, as the courts must have construed it had the disclaimer not been filed, is equally inoperative both as an amendment and upon the costs.³ The same is true of a disclaimer of a part or act not claimed in the patent, and of such

O. G. 35 ; Tuck *v.* Bramhill (1868), 3 Fisher, 400 ; 6 Blatch. 95.

That a disclaimer being filed during suit, the plaintiff can recover no costs, see Hayes *v.* Bickelhaupt (1885), 32 O. G. 133 ; 23 Fed. Rep. 183 ; Burdett *v.* Estey (1878), 15 O. G. 877 ; 15 Blatch. 349.

That under the act of 1837 a disclaimer may be filed after the commencement of a suit, and the court will duly protect the interest of the defendants, see Smith *v.* Nichols (1874), 21 Wall. 112.

² That under Sec. 9, act of March 3, 1837, the plaintiff can recover for the infringement of such part of the device as is truly his, though his specification embraces more than he has a right to claim and no disclaimer is filed, see Tuck *v.* Bramhill (1868), 3 Fisher, 400 ; 6 Blatch. 95.

That Claims not sued on need not have been cured by disclaimer, in order to warrant a preliminary injunction, see Duff *v.* Calkins (1883), 25 O. G. 601.

That where the Claim of a patent is declared invalid too nearly to the expiration of the patent to allow of the

filing of a disclaimer, the patentee can recover on the valid Claims, notwithstanding his failure to disclaim, see Kittle *v.* Hall (1887), 30 Fed. Rep. 239.

That where a disclaimer was made pending suit, and the defendant was not prejudiced thereby, the proceedings need not be recommenced, see Libbey *v.* Mt. Washington Glass Co. (1886), 36 O. G. 572 ; 26 Fed. Rep. 757.

§ 652. ¹ That a disclaimer, filed without necessity, is a nullity, and does not affect the costs of the suit, see Sharp *v.* Tift (1880), 17 O. G. 1282 ; 18 Blatch. 132 ; 2 Fed. Rep. 697 ; 5 Bann. & A. 399.

² That a disclaimer of something not claimed in the patent is a nullity, see Sharp *v.* Tift (1880), 17 O. G. 1282 ; 18 Blatch. 132 ; 2 Fed. Rep. 697 ; 5 Bann. & A. 399.

³ That where a disclaimer leaves the patent to claim the whole thing invented just as it must have been construed before, it has no effect on the costs, see Sharp *v.* Tift (1880), 18 Blatch. 132 ; 17 O. G. 1282 ; 2 Fed. Rep. 697 ; 5 Bann. & A. 399.

features as the court finds merely formal and not essential to the idea of means embodied in the invention as originally claimed.

SECTION III.

OF THE AMENDMENT OF LETTERS-PATENT: RE-ISSUE.

§ 653. Origin of Re-issue as a Method of Amending a Defective Patent: Re-issues Prior to the Act of 1832.

Amendment by re-issue was introduced into our statute law by the act of 1832. Prior to this act, the right of the inventor to a patent, whose protection was commensurate with the invention he had made and had endeavored to describe in his specification, had been distinctly recognized by the courts as well as by the government itself. The practice of surrendering such patents as failed to afford this protection, and of issuing corrected patents by which the purposes of the law on behalf of the inventor were fulfilled, had been established, and had been repeatedly sanctioned by judicial decisions.¹ Such defective patents were regarded as invalid and inoperative whether the defect consisted in an insufficient or

§ 653. ¹ In *Grant v. Raymond* (1832), 6 Peters, 218, Marshall, C. J. : (243) "It has been said that this permission to issue a new patent on a reformed specification, when the first was defective through the mistake of the patentee, would change the whole character of the act of Congress. We are not convinced of this. The great object and intention of the act is to secure to the public the advantages to be derived from the discoveries of individuals, and the means it employs are the compensation made to those individuals for the time and labor devoted to these discoveries, by the exclusive right to make, use, and sell the things discovered for a limited time. That which gives complete effect to this object and intention, by employing the same means for the correction of inadvertent error which

are directed in the first instance, cannot, we think, be a departure from the spirit and character of the act." 1 Robb, 604 (635). This case was tried in the Circuit Court in 1828. The original patent was granted in 1821, and on account of its defective specification was surrendered and re-issued in 1825. Against an objection, at the trial, that such surrender and re-issue were not authorized by law, the patent was sustained, and the decision on this point was affirmed in the Supreme Court at the January Term, 1832. The act of 1832 was approved in the following July.

See also *Shaw v. Cooper* (1833), 7 Peters, 292; 1 Robb, 643; Opinion Atty. Gen. (1831), 2 Op. At. Gen. 454; *Morris v. Huntington* (1824), 1 Paine, 348; 1 Robb, 448.

obscure description of the invention or in an inaccurate statement of the true line of distinction by which the new matter described was separated from the old. The principle on which this practice rested is easily discernible. The inventor, having a right under the law to a patent for his actual invention, and not having succeeded in obtaining such a patent by his first attempt, was entitled to make another application and receive a more perfect patent. But in doing this he was liable to be met by the objection that his invention had already gone into public use and that his right to any protection had been thereby lost. To avoid this objection the method of securing the same object by amending the original patent was devised, to the mutual advantage both of the inventor and the public, — the inventor escaping the objection before mentioned, and the public becoming completely possessed of the invention at the expiration of the term of the original patent, instead of being compelled to await the passage of a new term dating from the issue of a later patent.² As this practice is the origin and foundation of the entire body of rules relating to re-issues, its purposes, spirit, and methods form the key by which the conflicts and problems arising under the later law are to be resolved.³

§ 654. Re-issues under the Act of 1832.

The act of 1832 recognized this mode of amendment and prescribed definite rules for its performance. It provided

² That a re-issue for the purpose of perfecting the patent is promotive of the public interest, see *French v. Rogers* (1851), 1 Fisher, 133.

That the privilege of a re-issue is invaluable to inventors, see *Blake v. Stafford* (1868), 6 Blatch. 195; 3 Fisher, 294.

³ The first act of Parliament which authorized the amendment of existing patents was passed in 1835. Prior to this date, however, the power had been exercised to a limited extent in cases where the error was merely verbal, was apparent on the face of the patent, and had arisen through accident or mistake.

See *In re Whitehouse's Patent* (1830), 1 Web. 649, note; *In re Redmund's Patent* (1828), 1 Web. 649, note; and § 16 and notes, *ante*. Mr. Ogden's argument in *Grant v. Raymond* (1832), 6 Peters, 218, refers to *Ex parte Beck* (1784), 1 Bro. Ch. Rep. 575, as showing that the surrender of a defective patent and the issue of a new one in its stead was under the English practice "a matter of course." Other cases of amendment of letters-patents (not apparently relating to inventions, however), are cited in a note to 1 Web. 647.

that whenever any patent should be invalid or inoperative, through the non-compliance of the inventor with the terms and conditions mentioned in the third section of the act of 1793, the patent might be surrendered and re-issued if the error had arisen from inadvertence, accident, or mistake, and without any fraudulent or deceptive intention.¹ The invalidity and inoperativeness of the patent were thus made dependent on the failure of the patentee to fulfil the obligations imposed by the third section of the act of 1793, and his right to a re-issue was denied only when such failure had resulted from an intention to deceive, or from some other cause than inadvertence, accident, or mistake. The obligations imposed upon the patentee by the third section of the act of 1793 were threefold: (1) To make oath that he believed himself to be the true inventor of the art or instrument for which he sought a patent; (2) To deliver to the government a written description of his invention in such complete and exact language as would distinguish it from all other things before known and would enable any person skilled in the art to construct and use it; (3) To furnish with this description such drawings, model, or specimens, as the nature of the case might require.² Now it is obvious that a failure to comply with

§ 654. ¹ Act of 1832, § 3: "Wherever any patent . . . granted to any inventor in pursuance of the act of Congress . . . passed . . . in the year of our Lord 1793, . . . shall be invalid or inoperative by reason that any of the terms or conditions prescribed in the third section of the said . . . act, have not, by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, been complied with on the part of said inventor, it shall be lawful for the Secretary of State, upon the surrender to him of such patent, to cause a new patent to be granted," etc.

² Act of 1793, § 3: "That every inventor, before he can receive a patent, shall swear or affirm that he does verily believe that he is the true inventor or discoverer of the art, machine, or improvement, for which he solicits a pat-

ent, which oath or affirmation may be made before any person authorized to administer oaths, and shall deliver a written description of his invention and of the manner of using, or process of compounding the same, in such full, clear, and exact terms, as to distinguish the same from all other things before known, and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same. And in the case of any machine, he shall fully explain the principle, and the several modes in which he has contemplated the application of that principle or character, by which it may be distinguished from other inventions; and he shall accompany the whole with drawings and written references, where the nature of the case

these conditions, through inadvertence, accident, or mistake, can rarely occur, except in reference to the second condition, or to so much of the third as is directly related to the second. A breach of the first condition must consist either in making no oath whatever, — a defect too glaring to escape attention, — or in making a false oath, which would be a wilful fraud. A breach of the third could take place only when no drawings, model, or specimens were furnished, — another open and apparent defect, — or when they failed to correspond with the invention, and thus rendered the description of which they were a part ambiguous and uncertain. Hence, in the vast majority of cases in which the patent was invalid or inoperative, its defects must have resided in the description given of the invention in the specification, drawings, model, or specimens, and it was chiefly to cure these defects that the remedy by re-issue was provided by the statute. The third section of the act of 1793 prescribed two rules concerning the description: (1) That its terms should be so full, clear, and exact as to enable any person skilled in the art to make and use the invention; (2) That its terms should be so full, clear, and exact as to distinguish the invention from all other things before known. Defects in this description, rendering the patent invalid and inoperative were, therefore, of two classes: (1) Defects in the disclosure of the invention to the public; (2) Defects in defining the precise limits of the invention by distinguishing it from things already known. At this early period of our Patent Law, the modern distinction between the Description and the Claim, as parts of the written specification, was unknown. The same statements and recitals served both purposes, — the scope of the protection afforded by the patent, and the explication of the invention for the information of the public, being gathered from the

admits of drawings, or with specimens of the ingredients, and of the composition of matter, sufficient in quantity for the purpose of experiment, where the invention is of a composition of matter; which description, signed by himself and attested by two witnesses, shall be filed in the office of the Secretary of

State, and certified copies thereof shall be competent evidence in all courts, where any matter or thing touching such patent right shall come in question. And such inventor shall, moreover, deliver a model of his machine, provided the Secretary shall deem such model to be necessary."

entire document without attaching particular significance to any special clause therein contained. But the act of 1793 was at least as stringent as any later statute has been in requiring the presence of such language in the written specification as should completely fulfil both these purposes. The right of the inventor to his patent was made contingent upon the fulness, clearness, and exactness with which the terms of his specification defined the invention which he claimed, and communicated to the public a knowledge of its construction and mode of use; and if in either of these respects the specification was deficient, the patent was invalid and inoperative, and became a proper subject for re-issue under the act of 1832. By virtue of this act the patentee might thus amend those portions of the specification which related to his claim for protection as readily as he could those portions which explained the method of making and using the invention. His right to what was actually his own was treated as commensurate with his duty of disclosure to the public, and the privilege of correcting a mistake, when the correction would redound to his advantage, was as fully recognized as was his obligation to correct it whenever the information afforded by his specification to the public was erroneous or incomplete.

§ 655. Re-issues under the Act of 1836.

The act of 1836 introduced into these provisions certain changes of phraseology, but no substantial variation either in the spirit or the meaning of the law. The requirements of the third section of the act of 1793 in reference to the description were preserved almost in the same language, except as to the method of distinguishing the new invention from all other things before known. The words relating to this matter in the act of 1793 were omitted in the act of 1836, and, instead thereof, it was prescribed that the inventor should particularly specify and point out that which he claimed to be his own invention or discovery.¹ This particular statement

§ 655. ¹ Act of 1836, § 6: "But before any inventor shall receive a patent for any such new invention or discovery, he shall deliver a written description of his invention or discovery, and of the manner and process of mak-

of his claim is called throughout this act by the name of the "specification," — a name afterwards in use to denote sometimes the Description as distinguished from the Claim, sometimes the entire instrument embracing both, but in the act of 1836 evidently referring mainly to the clause or clauses in which the inventor attempted to specify and point out the exact limits of the invention which he claimed.² Thus the terms "description" and "specification," when coupled together in this act, indicate, not the same entire instrument or the same portions of the instrument, but two distinct portions, — the former being the detailed delineation of the invention given for the information of the public and as a basis for the Claim; the latter being the specific statement and definition of the invention claimed. Attention to this use of the word in this act is essential to the true interpretation of its provisions in relation to re-issues.

ing, constructing, using, and compounding the same, in such full, clear, and exact terms, avoiding unnecessary prolixity, as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; . . . and shall particularly specify and point out the part, improvement, or combination which he claims as his own invention or discovery."

² Act of 1836, § 5: "Descriptions, specifications, and drawings;" "specifications . . . specifying what the patentee claims as his invention or discovery." Sec. 6: "Written description of his invention or discovery, . . . and specify and point out the part . . . which he claims as his own invention." Sec. 7: "Application, description, and specification;" "altering his specification to embrace only that part of the invention or discovery which is new." Sec. 12: "Description, specifications, drawings, and model;" "specifications of claim." Sec. 13: "Defective or insufficient description or specification;" "claiming in his specification as his

own invention;" "corrected description and specification;" "original description and specification." Sec. 15: "Description and specification;" "specification of claim," etc. An examination of the context in which these phrases occur renders it perfectly apparent that "specification" signifies the Claim as distinguished from the Description.

In *Wilson v. Coon* (1880), 18 Blatch. 532, Blatchford, J.: (536) "The provision of Sec. 13 of the act of 1836 was that a patent might be re-issued when it was "inoperative or invalid by reason of a defective or insufficient description or specification," and the new patent was to be issued with a corrected "description and specification." This language was based on that of Sec. 6 of the act of 1836, which required the inventor to give in writing a description of his invention and of the manner of making and using it, and also to "particularly specify and point out" what he claimed as his invention. Under this language the "specification was the Claim, and the rest was the description." 6 Fed. Rep. 611 (616); 19 O. G. 482 (483).

§ 656. Re-issues under the Act of 1836: Variations from the Act of 1832.

The language of the act of 1836 in reference to re-issues limited their allowance to cases where a patent was "inoperative or invalid, by reason of a defective or insufficient description or specification, or by reason of the patentee claiming in his specification, as his own invention, more than he had, or shall have, a right to claim as new."¹ Of the import of this language two different views have been taken. It has been held, on the one hand, that the words "description" and "specification" are synonymous and are applied to the delineation of the invention given for the information of the public; that any mistake or insufficiency in this delineation is remediable by re-issue; that the only form of defective Claim which is recognized by the statute or is therein made curable by a re-issue is an excessive Claim; and consequently that a too restricted Claim, though it may wholly fail to afford the patentee that protection which the law endeavors to confer upon him, cannot be so corrected and enlarged as to secure to him the actual invention except by virtue of the general provisions of the law or under the doctrines applied to similar cases in courts of equity.² On the other hand, it

§ 656. ¹ Act of 1836, Sec. 13.

² In *Mahn v. Harwood* (1884), 112 U. S. 354, Bradley, J. : (362) "The truth is (as was shown in *Miller v. The Brass Company*) that this class of cases, namely, re-issues for the purpose of enlarging and expanding the Claim of a patent, was not comprised within the literal terms of the law which created the power to re-issue patents." 30 O. G. 657 (659).

In *Miller v. Brass Co.* (1881), 104 U. S. 350, Bradley, J. : (352) "The power given by the law to issue a new patent upon the surrender of the original, for the correction of errors and mistakes, has been greatly misunderstood and abused. It was first contained in the act of July 3, 1832, c. 357; and the law was adopted in view of suggestions made in several judgments of

this court. But it was carefully confined to cases where the patent was invalid or inoperative by reason of a failure to comply with any of the terms and conditions prescribed by the law for giving a clear and exact description of the invention, and where such failure was due to inadvertence, accident, or mistake, without any fraudulent or deceptive intention. This being shown, a new patent, with a correct specification, was authorized to be issued for the same invention. The act of July 4, 1836, c. 45, enlarged the power to grant re-issues by adding an additional ground for re-issue; namely, that the patentee had inadvertently claimed in his specification, as his own invention, more than he had a right to claim as new. And, with that addition, the law has continued substantially the same to the

has been declared that the words "description" and "specification" relate to two distinct portions of an entire instru-

present time. The fifty-third section of the act of 1870, c. 230, which was the law on this subject when the re-issue in the present case was granted, is in the following words: 'Whenever any patent is inoperative or invalid by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the Commissioner shall, on the surrender of such patent, and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued to the patentee.' It will be observed that while the law authorizes a re-issue when the patentee has claimed too much, so as to enable him to contract his Claim, it does not, in terms, authorize a re-issue to enable him to expand his Claim. The great object of the law of re-issues seems to have been to enable a patentee to make the description of his invention more clear, plain, and specific, so as to comply with the requirements of the law in that behalf, which were very comprehensive and exacting. The third section of the act of 1793, c. 11, required an applicant for a patent 'to deliver a written description of his invention, and of the manner of using, or process of compounding the same, in such full, clear, and exact terms as to distinguish the same from all other things before known, and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same. And in the case of any machine, he shall fully explain the principle, and the several modes in which

he has contemplated the application of that principle or character, by which it may be distinguished from other inventions; and he shall accompany the whole with drawings and written references, where the nature of the case admits of drawings.' This careful and elaborate requirement was substantially repeated in the sixth section of the act of 1836, with this addition: 'And shall particularly specify and point out the part, improvement, or combination which he claims as his own invention or discovery.' Although it had been customary to append a Claim to most specifications, this was the first statutory requirement on the subject. It was introduced into the law several years subsequently to the creation of re-issues; and it was in the thirteenth section of this act of 1836 that provision was made for a re-issue to correct a Claim which was too broad in the original. Now, in view of the fact that a re-issue was authorized for the correction of mistakes in the specification before a formal Claim was required to be made, and of the further fact that when such formal Claim was required express power was given to grant a re-issue for the purpose of making a Claim more narrow than it was in the original, without any mention of a re-issue for the purpose of making a Claim broader than it was in the original, it is natural to conclude that the re-issue of a patent for the latter purpose was not in the mind of Congress when it passed the laws in question. It was probably supposed that the patentee would never err in claiming too little. Those who have any experience in business at the Patent Office know the fact that the constant struggle between the Office and applicants for patents has reference to the Claim. The patentee seeks the

ment, — the former being the Description proper, the latter what is now known as “the Claim;” that a patent is in-

broadest Claim he can get. The Office, in behalf of the public, is obliged to resist this constant pressure. At all events, we think it clear that it was not the special purpose of the legislation on this subject to authorize the surrender of patents for the purpose of re-issuing them with broader and more comprehensive Claims, although, under the general terms of the law, such a re-issue may be made where it clearly appears that an actual mistake has inadvertently been made. But by a curious misapplication of the law it has come to be principally resorted to for the purpose of enlarging and expanding patent Claims. And the evils which have grown from the practice have assumed large proportions. Patents have been so expanded and idealized, years after their first issue, that hundreds and thousands of mechanics and manufacturers, who had just reason to suppose that the field of action was open, have been obliged to discontinue their employments, or to pay an enormous tax for continuing them. Now, while, as before stated, we do not deny that a Claim may be enlarged in a re-issued patent, we are of opinion that this can only be done when an actual mistake has occurred, not from a mere error of judgment (for that may be rectified by appeal), but a real *bona fide* mistake, inadvertently committed, such as a court of chancery, in cases within its ordinary jurisdiction, would correct. Re-issues for the enlargement of Claims should be the exception and not the rule; and when, if a Claim is too narrow, — that is, if it does not contain all that the patentee is entitled to, — the defect is apparent on the face of the patent and can be discovered as soon as that document is taken out of its envelope and opened, there can be no valid

excuse for delay in asking to have it corrected. Every independent inventor, every mechanic, every citizen, is affected by such delay, and by the issue of a new patent with a broader and more comprehensive Claim. The granting of a re-issue for such a purpose after an unreasonable delay is clearly an abuse of the power to grant re-issues, and may justly be declared illegal and void. It will not do for the patentee to wait until other inventors have produced new forms of improvement, and then, with the new light thus acquired, under pretence of inadvertence and mistake, apply for such an enlargement of his Claim as to make it embrace these new forms. Such a process of expansion, carried on indefinitely, without regard to lapse of time, would operate most unjustly against the public, and is totally unauthorized by the law. In such a case, even he who has rights and sleeps upon them justly loses them.” 21 O. G. 201 (202).

The statements contained in the foregoing extract are responsible for the widely-spread impression that the case of *Miller v. Brass Co.* introduced radical changes into the law of re-issues. But the case itself, taken as a whole, warrants no such impression. In view of the facts apparent on the record, the judgment of the court was eminently just. The conclusions of the learned judge who delivered the opinion, — that a re-issue is proper only where the defect to be amended was “a *bona fide* mistake inadvertently committed;” that an unreasonable delay in applying for a re-issue indicates that the allegation of original “inadvertence or mistake is a mere pretence;” that when the defect is evident on an inspection of the patent, as is usually the case where it consists in an undue restriction of the

operative or invalid when either the Description or the Claim is defective or insufficient, or when the Claim ex-

Claim, any avoidable delay is unreasonable, — are supported not only by sound reason and the general analogies of the law, but by an almost unbroken current of judicial decisions. In reaching these conclusions, however, the court pursues the novel line of argument set forth in the passage above quoted, and seems to find the ground for its refusal to recognize the re-issued patent in the equitable doctrine that laches may forfeit an existing right, rather than in the rule of Patent Law that laches in re-issuing is inconsistent with the original existence of the right itself. An analysis of this argument results in the following propositions :—

(1) That prior to the act of 1836 the law did not require a formal Claim of the invention to be inserted in the specification.

(2) That prior to this act, therefore, the errors contemplated by the law governing re-issues, and curable by that mode of amendment, were errors in the Description, not the Claim.

(3) That when the Claim was made an essential part of the specification the law of re-issues was enlarged to embrace errors arising in the Claim.

(4) That as this extension of the law of re-issues expressly related only to errors consisting in an excess of Claim, it impliedly excluded from the operation of that law all errors which result from an undue restriction of the Claim.

(5) That, being thus excluded, the correction of an unduly restricted Claim is not within the special purpose of the legislation concerning re-issues; and, though permitted, must find its warrant in the general terms of the law and in the principles of equity.

(6) That the correction of restricted Claims is, therefore, lawful only where

a court of chancery, if the case were within its jurisdiction, would order the amendment; and though otherwise proper, may be refused whenever the patentee has slept upon his rights or when the interests of others would be unjustly prejudiced by the re-issue.

In the case under consideration the final judgment must have been the same whether attained by this mode of reasoning or by that which, treating the correction of restricted Claims as within the ordinary amending powers conferred by the statutes, regards unreasonable delay, etc., as bearing only upon the question of original inadvertence or mistake. The same would probably be true in nearly every case where the lawfulness of a re-issue was to be determined by the Patent Office or the courts. But since the propositions above enumerated in effect transfer this class of re-issues from the statutory jurisdiction of the Patent Office to the chancery jurisdiction of the courts, and render their validity dependent not merely on the conditions named in the statute but on the equities arising after the issue of the patent, thus opening a wide and deep gulf of separation between these re-issues and all others; and since these several propositions, taken as the statement of special doctrines of Patent Law, have led to decisions in many later cases which are evidently erroneous in principle; — it is important that so far as they are incorrect they should be, if possible, refuted. The fundamental error seems to reside in the deduction drawn in the second proposition from the fact stated in the first. It is true that before the act of 1836 the law did not require a *formal* Claim to be inserted in the specification; but it does not follow from this that under the provisions of preceding statutes no claim

ceeds the limits of the actual invention; and consequently that whatever may be the nature of the error, or in whatever

was necessary, or that the modes therein prescribed for avoiding or correcting errors applied solely to the Description as distinguished from the Claim. On the contrary, a claim in some form has always been an essential feature of the specification. Whether couched in words of petition or in words of grant, whether incorporated in the general description or constituting an independent clause, this definition and assertion of the exclusive right of the inventor was never absent from the instrument creating his monopoly. Moreover, this statement of his claim has always been liable to the same defects, both of undue restriction and undue excess, resulting in the partial or entire destruction of his rights, and the amending power was thus as indispensable to him for the correction of imperfect claims as for the removal of obscurities from his description. Hence, as this power was granted professedly for his protection, it might safely be assumed that an amendment by enlarging restricted claims in order that they may include the whole invention, or by restricting claims to exclude what he had at first improperly embraced, should be as lawful and as readily permitted as the substitution of a clearer or a more complete description. Our courts proceeded upon this assumption before the act of 1832 was passed. In *Morris v. Huntington* (1824), 1 Paine, 348, Thompson, J. advances the opinion that where the patentee has claimed too much he may surrender, and take out an amended patent. In *Grant v. Raymond* (1832), 6 Peters, 218, the amendment which the court sustained was an enlargement of the Claim; and in the decision, Marshall, C. J., states that both the statutes which confer the patent, and the amending power which corrects its inadvertent errors, have for

their chief object the protection of the inventor in the enjoyment of his actual invention; replying to the argument that by such amendments public interests are prejudiced by saying: "the communication of the discovery to the public has been made in pursuance of law with the intent to exercise a privilege which is the consideration paid by the public for the future use of the machine. If, by an innocent mistake, the instrument introduced to secure this privilege fails in its object, the public ought not to avail itself of this mistake, and to appropriate the discovery without paying the stipulated consideration. The attempt would be disreputable in an individual, and a court of equity might interpose to restrain him." The act of 1832 was enacted, as Baldwin, J., declares in *McClurg v. Kingsland* (1843), 1 How. 202, in affirmance of the principles laid down in *Grant v. Raymond* and other cases. Among the re-issues while this statute was in force, was that involved in *Stimpson v. Westchester R. R. Co.* (1846), 4 How. 380, in which the claims of the patent had been enlarged by including an element referred to in the original Description but omitted from its Claim. The Supreme Court, through McLean, J., held that this enlargement of the Claim did not, as matter of law, invalidate the re-issue. These cases, as well as the reason of the law itself, sufficiently demonstrate that before the act of 1836, though no "formal Claim" was required by law, the existence of the claim, its susceptibility to error, and the power to amend it by restriction or extension as might be necessary to render the patent valid and operative in the interest of the inventor, were as clearly recognized as by any subsequent statute or decision. Indeed, this entire

part of the instrument it may occur, the statute provides for

portion of the argument appears to rest upon a misconception of the act of 1832 in its relation to the act of 1793, and of the true meaning of the term "specification" as it is employed in the act of 1836. See § 654, *ante*.

With the demolition of this fundamental error, the other portions of the argument also fall. If the Claim in some form had always been a feature of the specification, and if its faults of excess or deficiency were amendable by re-issue under and prior to the act of 1832, evidently no extension of the law of re-issues was intended or effected by the enumeration in the act of 1836 of the excessive Claim among the subjects of amendment. And if no such extension of the law occurred, there is no ground for the inference contained in the fourth proposition that a restricted Claim is not among the faults which a re-issue was expressly designed to cure, or for that in the fifth which bases the privilege of re-issuing in these cases upon general principles, and by the operation of the sixth imposes upon them conditions which are foreign to re-issues for the removal of other unintentional defects.

The extent to which these controverted opinions have been shared or adopted may be seen in the cases cited in the remaining portion of this note. It may fairly be questioned whether in most of them the position taken on this subject represents the deliberate judgment of the court. The ease with which sweeping statements, shorn of all qualifying phrases, are caught up and enunciated, especially in the reasonings as distinguished from the final decision of a judge, may account for what seems a striking departure from the general current of authority as exhibited in the succeeding note. In several of these cases, also,

there are other statements which clearly show that the court had no intention to deny the right to correct an unduly restricted Claim in the same manner and upon the same conditions as any other defect occurring in the specification.

That a re-issue is not allowed except to give a more perfect description of the invention intended to be claimed in the original patent, or to narrow an excessive Claim, see *Giant Powder Co. v. California Vigorit Powder Works* (1880), 6 Sawyer, 508; 18 O. G. 1339; 4 Fed. Rep. 720; *Knight v. Baltimore & Ohio R. R. Co.* (1840), 3 Fisher, 1; Taney, 106.

That a re-issue cannot enlarge or expand the Claims of the original, see *Dunbar v. White* (1883), 15 Fed. Rep. 747; 23 O. G. 1446; *Nye v. Allen* (1883), 15 Fed. Rep. 114; 23 O. G. 2328; *Fay v. Preble* (1882), 14 Fed. Rep. 652; *Moffitt v. Rogers* (1882), 106 U. S. 423; 23 O. G. 270; *New v. Warren* (1882), 22 O. G. 587; *James v. Campbell* (1881), 104 U. S. 356; 21 O. G. 337.

That a re-issue cannot claim what is described but not claimed in the original, see *Reed v. Chase* (1885), 25 Fed. Rep. 94; 33 O. G. 996; *Ex parte Pfaudler* (1882), 22 O. G. 1881.

That it is the office of a re-issue to correct a Claim, not to enlarge it, see *Russell v. Dodge* (1876), 93 U. S. 460; 11 O. G. 151.

That the enlargement of the Claims of the original makes a re-issue void, as against the public as well as against intervening patentees, see *Dunbar v. White* (1883), 15 Fed. Rep. 747; 23 O. G. 1446.

The numerous cases, found in the notes to ensuing paragraphs, which assert that unreasonable delay, or the existence of intervening rights, or the

its amendment by re-issue.⁸ That the latter view is the true one there are several indications in the body of the act itself.

appropriation of the unclaimed matter by the public, etc., work a forfeiture of the patentee's right to a re-issue, generally draw their erroneous doctrine from the same source, regardless of the principle that a privilege conferred by the statutes upon certain conditions cannot be abrogated by the courts if those conditions are fulfilled, whatever power the courts may have to determine by what kind and degree of evidence their fulfillment must be proved.

⁸ In *Odell v. Stout* (1884), 22 Fed. Rep. 159, Sage, J. : (162) "It is to be kept in mind, however, that enlarging the Claim may be an entirely different thing from broadening the invention. He may, under proper circumstances, so enlarge his Claim as to make it extend to the limits of his invention, but he is bound by those limits. He may not enlarge the invention. . . . (164) Upon the authority of these cases it is clear that the Claim of a patent may be enlarged by a re-issue, if the patentee move promptly and no rights of others have intervened ; and we are of opinion that in this case the delay was not unreasonable." 29 O. G. 862 (863).

In *Combined Patents Can Co. v. Lloyd* (1882), 21 O. G. 713, Butler, J. : (714) "That this statute authorizes the insertion of new Claims, founded on the original invention as exhibited by the specifications or drawings, in re-issues when the omission results from 'inadvertence, accident, or mistake,' and where the claimant has not by some act or omission estopped himself from exercising the right to amend, has been uniformly held, not only by the several circuit courts, but by the Supreme Court also. In *Seymour v. Osborne* (11 Wall. 516), the latter court said : 'Power is unquestionably conferred upon the Commissioner to allow the specifications to

be amended if the patent is inoperative or invalid, and in that event to issue the patent in proper form ; and he may under that authority allow the patentee to re-describe his invention and to include in the Description and Claims of the patent not only what was well described before, but whatever else was suggested or substantially indicated in the specifications or drawings which properly belonged to the invention as actually made and perfected.' The re-issue there involved, it is true, antedated the statute now in force, but as respects the question here involved this is unimportant, as before indicated. In the last cases in which this subject is discussed (*Miller & Co. v. The Brass Company*, and *James v. Campbell et al.*) . . . the right to insert new and enlarged Claims is clearly stated. In the first of these cases the court says : 'If a patentee who has no corrections to suggest in his specifications except to make his Claims broader and more comprehensive, uses due diligence in returning to the Patent Office, and says, "I omitted this," or "my solicitor omitted that," his application may be entertained, and on proper showing correction may be made.' And again, 'While, as before stated, we do not deny that a Claim may be enlarged in a re-issued patent, we are of opinion that this can only be done where an actual mistake has occurred, . . . a real *bona fide* mistake, inadvertently committed, such as a court of chancery in cases within its ordinary jurisdiction would correct. Re-issues for the enlargement of Claims should be the exception.' In the last of these cases it is said, 'Of course, if by actual inadvertence, accident, or mistake, innocently committed, the Claim does not fully assert or define the patentee's right in the invention specified in the patent, a speedy appli-

In the first place, this view gives full effect to the language of the act in reference to this subject. It preserves the distinc-

tion for its correction before adverse rights have accrued may be granted, as we have explained in the recent case of *Miller et al. v. The Brass Company.*" 11 Fed. Rep. 149 (150); 15 Phila. 481 (482).

See also *James v. Campbell* (1881), 104 U. S. 356; 21 O. G. 337.

In *Marsh v. Seymour* (1877), 97 U. S. 348, Clifford, J. : (355) "Patents, in a proper case, may be surrendered and re-issued, but the re-issued patent must be for the same invention as the original patent, else the re-issue is invalid; but the patentee may redescribe his invention, and include in the Description and Claims of the specification not only what was well described before, but whatever else was suggested or substantially indicated in the old specification, drawings, or Patent-Office model, which properly belonged to the invention as actually made and perfected. Corrections may be made in the Description, specification, or Claims of the patent where the patentee has claimed as new more than he had a right to claim, or where the Description, specification, or Claim is defective or insufficient; but he cannot, under such an application, make material additions to the invention which were not described, suggested, nor substantially indicated in the original specifications, drawings, or Patent-Office model." 13 O. G. 723 (725).

In *Welling v. Rubber-Coated Harness Trimming Co.* (1875), 2 Bann. & A. 1, Nixon, J. : (4) "It is a well-settled principle that a patentee may so limit his Claim as to deprive himself of the full benefit of his invention or discovery. It was to remedy such a difficulty or omission that the privilege of surrender and re-issue was granted in the Patent Laws. Patentees often fail to realize any substantial advantage

from some of the most useful inventions owing to their too narrow Claims, until such surrender, amendment, and re-issue have been made." 7 O. G. 608 (609).

In *Calkins v. Bertraud* (1875), 2 Bann. & A. 215, Blodgett, J. : (217) "This re-issue was made on the 26th of April, 1870, and while the Patent Office was acting under the law of 1836, as amended. . . . This law has been construed to authorize a patentee to claim on a re-issue whatever shall clearly appear to have been a part of his original invention as described or shown in his original specifications, drawings, or models. There are ample authorities upon that point construing the act of 1836 with amendments up to 1861, in that regard, and giving the inventor the right to a re-issue where the new Claim is clearly justified by his drawings, or specifications, or models, or either, and allowing him to amend his specifications, if necessary, so as to cover more fully what, upon experience, has proven to be a meritorious part of his invention. *Battin v. Taggart*, 17 How. 74; *Gallahue v. Butterfield*, 10 Blatchf. C. C. R. 232; *Wheeler v. Clipper Co.*, 6 Fisher, 1; *Seymour v. Osborne*, 11 Wall. 544." 6 Bissell, 494 (496); 9 O. G. 795 (796).

In *Wells v. Jacques* (1874), 1 Bann. & A. 60, Nixon, J. : (68) "With regard to the first objection, it is undoubtedly true that it is not the province or the design of a re-issue to enlarge the original right of the inventor, but to cure some defect arising from inadvertency or mistake, and not from fraud, in drawing the specifications or Claims of the first patent. Every inventor is entitled to the benefit of all that he invents; and if he fails, for the reason above assigned, to acquire a right to his whole invention in his letters-patent,

tion which the act evidently makes between the Description and the specification, and recognizes a defect or insufficiency

he may surrender them and have a re-issue from time to time, until his specifications and Claims cover the whole ground." 5 O. G. 364 (366).

In *Blake v. Stafford* (1868), 6 Blatch. 195, Shipman, J. : (198) "Inventors are not usually sufficiently skilled in the art of nice composition to enable them to accurately draft their own specifications. They must, therefore, resort to others; and it not unfrequently happens that the draftsman employed to describe a particular invention, either through want of skill or from haste or ignorance of the state of the art, gives, in the specification, a very imperfect description of the thing invented. He sometimes narrows the scope of the inventor's ideas and combinations, and at other times expands them over instruments and devices which are not the product of his original thoughts. He may fail to set forth some feature of the invention which at the time is deemed unimportant, and which subsequently may be proved to be vital, or at least of great value. If the invention is of considerable pecuniary consideration, the public examine it with scrutinizing eyes, and if an inch of ground within the true scope of the discovery is unoccupied by the specification, it is at once seized upon by parties to whose business the new improvement has a near relation. If a fatal or damaging error has crept into the description, that fact is soon ascertained by those who desire to avail themselves of whatever improvement has been discovered. The privilege of surrender and re-issue is, therefore, invaluable to inventors, for without it they would often lose that protection for the offspring of their skill and labor which it is the immediate object of all patent laws to afford. It is, indeed, to be regretted that so great a

proportion of the industry and intellectual acumen expended upon patents should be devoted to assailing, circumventing, or defeating them, rather than to their original construction. But the greatest skill and most untiring patience would not always be able to guard against all error. The privilege of surrender and re-issue is, therefore, necessary for the protection of inventors, and the act of Congress has explicitly stated the cases to which it shall extend, and conferred upon the Commissioner the power of determining when a patentee has brought himself within its provisions." 3 Fisher, 294 (299).

In *Swift v. Whisen* (1867), 3 Fisher, 343, Leavitt, J. : (352) "On this subject I may remark in deciding what a party may claim under a re-issued patent, there has been a tendency to great liberality in the action of the courts, and it has been held that whatever was the invention of the original patentee, whether expressly claimed in the original patent or not, when incorporated in the re-issued patent, will be held to be within the Claim of the original patent, and that it is the right of the assignee or holder of the patent to claim everything that was claimed, or everything which belonged rightfully, by fair construction, to the original patentee. I may not be understood. If there is evidence that the original patentee claimed, as a part of his invention, a certain feature, or that a certain feature was a part of his invention which he omitted to claim in his specification and Claim, upon the surrender of that patent by himself, or by an assignee, he has a right to incorporate in the re-issued patent that element, though not claimed specially in the first patent. And in determining this question, that

in either as a proper matter for amendment. It treats the adjectives "defective" and "insufficient" as covering two different classes of errors, the former consisting in want of exactness, the latter in want of completeness, instead of regarding the second as a substantial repetition of the first. It makes the field of amendment commensurate with the field of error, — all possible errors being comprised in inexactness and incompleteness of the Description, and in inexactness, incompleteness, and excessiveness of the Claim. In the second

is, the substantial identity of the invention covered by the original patent with that covered and described in the re-issued patent, it is competent for the jury to look into the drawings of the original patent to determine whether the inventions are the same. The drawings, as well as the specifications, are to be looked to in giving a construction to the Claims of a patent, in determining what was the invention of the original patentee. If, for instance, the drawings show an element of the invention which the patentee has not included specially in his Claim, it is evidence nevertheless that it was a part of his invention, and he or his assignee has a right to incorporate that element in the re-issued patent." 2 Bond, 115 (127).

Further, that the re-issue may so enlarge or otherwise modify the Claims of the original as to secure the actual invention, see *Jenkins v. Stetson* (1887), 32 Fed. Rep. 398; *Becker v. Hastings* (1884), 28 O. G. 98; 22 Fed. Rep. 827; *Ex parte Long* (1883), 25 O. G. 1189; *Crandall v. Watters* (1881), 9 Fed. Rep. 659; 20 Blatch. 97; 21 O. G. 945; *Smith v. Merriam* (1881), 6 Fed. Rep. 713; 19 O. G. 601; *Waring v. Johnson* (1881), 19 O. G. 1068; 19 Blatch. 38; 6 Fed. Rep. 500; *Miller v. Brass Co.* (1881), 104 U. S. 350; 21 O. G. 201; *Anilin v. Higgin* (1878), 15 Blatch. 290; 14 O. G. 414; 3 Bann. & A. 462; *Lorillard v. McDowell* (1877), 2 Bann. & A. 531; 11 O. G. 640; 13

Phila. 461; *Westinghouse v. The Gardner & Ranson Air Brake Co.* (1875), 9 O. G. 538; 2 Bann. & A. 55; *Seymour v. Marsh* (1872), 2 O. G. 675; 6 Fisher, 115; 9 *Phila.* 380.

That a Claim is part of the specification and therefore amendable, see *Smith v. Merriam* (1881), 19 O. G. 601; 6 Fed. Rep. 713.

That an enlarged Claim is allowable in a re-issue, if there are no adverse rights to be affected by it, see *Stutz v. Armstrong* (1884), 20 Fed. Rep. 843; 28 O. G. 367; *McArthur v. Brooklyn Railway Supply Co.* (1884), 19 Fed. Rep. 263; 21 Blatch. 558.

That a re-issue is the proper mode of securing what was described but not claimed in the original patent, see *Asmus v. Alden* (1886), 27 Fed. Rep. 684; 36 O. G. 231; *Hill v. Commissioner* (1885), 33 O. G. 757; 4 Mackay, 266; *Ex parte Cottrell*, (1876), 9 O. G. 495; *Richardson v. Lockwood* (1870), 4 Clifford, 128.

That a re-issue is the only mode of securing what was accidentally omitted from the original, see *Keystone Bridge Co. v. Phoenix Iron Co.* (1877), 95 U. S. 274; 12 O. G. 980.

That an element shown but not claimed in a prior patent, yet patentable thereby if it had been claimed, can be secured by re-issue or by a separate patent, see *Loring v. Hall* (1879), 15 O. G. 471.

place, this view is in harmony with the entire tenor of the act. The act is characterized by a spirit of great liberality toward inventors. The benefits which it confers upon them are incalculable. Even in the very section which provides for a re-issue the privilege of incorporating subsequent improvements and additions into an existing patent, with the same effect in law as if embraced in the patent as originally issued, was accorded, — a privilege far beyond the scope of any conceivable amendment in the Description or Claim of the original invention; and it can scarcely be supposed that the same legislature which conferred this privilege intended to deprive inventors of that remedy for insufficient Claims which had already been found necessary by the courts and had been granted by the act of 1832. In the third place, this view is the only one under which the remedy by re-issue is of any practical advantage to inventors. The value of a patent to the patentee depends upon the completeness with which it protects his actual invention, and as the limits of the protection are fixed by the Claim, a mistake by which the Claim is unduly restricted is, more than any other error, injurious to the inventor, and in his interest more imperatively demands correction. To permit him to amend by giving more specific information to the public, or by narrowing the Claims of his original patent, or by stating in more precise language the Claim that he has already made to the invention, affords him no adequate relief against the evils that inevitably arise out of the inherent difficulty which attends the endeavor to put into words a complete delineation of those essential characteristics in which the identity and individuality of the invention reside. If in any portion of the instrument error is likely to occur it is here; and if any error seriously prejudices his interests it is the one by which his patent is made narrower than his invention. And hence, if any error ought to be corrected, when occurring without wilful fault on his part, it is the one whereby he is deprived of that right to which he is entitled both by the spirit and the letter of the law. For these three reasons, and others which a careful study of the act itself suggests, it seems that of the two views of the rule above described the latter is correct; and that this act con-

fers the privilege of a re-issue whenever the Description or the Claim is inexact or incomplete, or when the Claim is broader than the actual invention, provided the error has arisen from inadvertence, accident, or mistake, and without any fraudulent or deceptive intention.⁴

§ 657. **Re-issues under the Act of 1870 and the Revised Statutes of 1874.**

Under the act of 1870 and the Revised Statutes, the law governing re-issues is the same as under the act of 1836. The phrasology of these later acts differs from that of the earlier in some unimportant respects, but it is evident that no intent to change the rules existed at the passage of these statutes, and that the language used was regarded as substantially identical with that of the former act.¹ This being the case, the law may now be considered as providing for

⁴ That both the Description and the Claims may be corrected by re-issue, see *Sewing Mach. Co. v. Frame* (1884), 24 Fed. Rep. 596 ; 28 O. G. 96 ; *Hailes v. Albany Stove Co.* (1883), 16 Fed. Rep. 240 ; 24 O. G. 391 ; 21 Blatch. 271 ; *Wilson v. Coon* (1880), 6 Fed. Rep. 611 ; 19 O. G. 482 ; 18 Blatch. 532 ; *Anilin v. Higgin* (1878), 14 O. G. 414 ; 15 Blatch. 290 ; 3 Bann. & A. 462 ; *Tucker v. Tucker Mfg. Co.* (1876), 10 O. G. 464 ; 4 Clifford, 397 ; 2 Bann. & A. 401 ; *Carew v. Boston Elastic Fabric Co.* (1871), 3 Clifford, 356 ; 5 Fisher, 90 ; 1 O. G. 91 ; *Batten v. Taggart* (1854), 17 How. 74.

§ 657. ¹ Act of 1870, Sec. 53: "That whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new," etc. Act of 1836, Sec. 13: "That whenever any patent . . . shall be inoperative or invalid, by reason of a defective or insufficient [description or] specification, or by reason of the patentee claiming [in his specification] as his own invention

more than he had or shall have a right to claim as new," etc. The difference between these two provisions consists simply in the omission from the act of 1870 of the words here included in brackets in the act of 1836. The change is evidently verbal, not substantial. The word specification is used in its modern sense as covering the Description as well as the Claim, and the patent is treated as a proper subject for re-issue when either is defective or insufficient. That this alteration in language was not intended to limit re-issues to cases where the Description as distinguished from the Claim is defective or insufficient appears from the final clause of Sec. 53, which permits the introduction into the re-issue specification of matter wholly omitted from the original, upon proof that it constituted part of the original invention, and was omitted by inadvertence, accident, or mistake. The Revised Statutes, Sec. 4916, follow the act of 1870, Sec. 53, so far as this point is involved. See *Wilson v. Coon* (1880), 6 Fed. Rep. 611; 19 O. G. 482; 18 Blatch. 532.

the re-issue of a patent whenever it becomes necessary to amend either the Description or the Claim in order to make the actual invention accessible to the public, or to afford it that complete and exact protection to which its inventor is entitled.²

§ 658. **Conditions of Re-issue the Same under all the Foregoing Statutes.**

The conditions upon which an amendment by re-issue might be made have remained the same under all these statutes. These are that the defect or insufficiency should have arisen through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention. A defective or insufficient statement, purposely inserted with intent to deceive the public, is regarded as a fraud which vitiates the entire patent and justly forfeits all right of the inventor to any consideration from the government. Such a statement cannot be amended in any form. A defective or insufficient statement, occurring otherwise than through inadvertence, accident, or mistake, is also not amendable. "Inadvertence" signifies want of attention; "mistake," want of knowledge; "accident," circumstances against which the inventor cannot guard. A statement, made without inadvertence, accident, or mistake, is a statement made voluntarily and with sufficient knowledge and attention. If a statement thus made in the Description is defective or insufficient, the inventor is guilty of wanton negligence, if not of fraud, and certainly ought not to be permitted to amend. If a statement thus made in the Claim is incomplete, the inventor is precluded from correcting it on the ground that he has either abandoned the unclaimed matter to the public, or has excluded it from the present monopoly and reserved it for the protection of an independent patent. If the Claim is wilfully and with knowledge and attention made obscure or broader than his actual invention, it is evidently fraudulent and void. Of these questions of inadvertence, accident, mistake, and fraud, the Patent Office is to judge upon an application for re-issue; though where an

² See Sec. 656, note 3, *ante*, for cases on this subject decided since the passage of the act of 1870.

alleged incompleteness in the Claim is so apparent upon a comparison of the Description with the Claim that it could not have occurred involuntarily or through any want of knowledge or attention, or where unreasonable delay in obtaining a re-issue, or other circumstances in the history of the application or the patent, show that no inadvertence, accident, or mistake could have originally existed, the courts regard it as conclusive evidence that the inventor intended to exclude from his original patent all that was not duly claimed, and treat a re-issue which endeavors to reclaim it as to that extent invalid.

§ 659. The Fundamental Principles Governing Amendment by Re-issue Reducible to Four Propositions.

This review of the historical development of the subject of re-issues suggests the following propositions as representing the present doctrines of the law in reference thereto:¹ (1) That the sole object of a re-issue is to so amend an imperfect existing patent that it may disclose and protect the patentable subject-matter which it was the purpose of that patent to secure to its inventor; (2) That being the amendment of an existing patent, and not the grant of a new patent, it must be confined to the invention which the patentee attempted

§ 659. ¹ The first three of these propositions express the fundamental conditions of amendment by re-issue, the absence of any one of which is a perfect bar to its allowance. The original patent must be an existing patent, otherwise there is nothing to amend; and it must be an imperfect patent, otherwise there can be no defect requiring an amendment. The subject-matter of the amendment must be the invention which the patentee endeavored to describe and claim in the original patent, otherwise the re-issue would be a new patent for a different invention, and not a mere amendment of the old. The defect must have occurred through inadvertence, accident, or mistake, and without fraud, or the pretended amendment would, in the first case, be a recla-

mation of matter already voluntarily excluded from the patent; or in the second, the original patent, and therefore the re-issue, would be wholly void. The absence of either one of these conditions is thus fatal to the re-issue. If two or all of them are wanting, the effect on the re-issue is the same. Hence it makes no stronger case against a re-issued patent to combine objections based upon the failure of these requisites than if one alone were proved. Caution to this effect would be unnecessary were not many decisions to be found in which the concurrence of these faults is given as the reason for rejecting the re-issue, — as if a partial one could be supported by the existence of the others, or as if one alone were not sufficient to render it invalid.

to describe and claim in his original patent; (3) That this amendment cannot be allowed unless the imperfections in the original patent arose without fraud, and from inadvertence, accident, or mistake; (4) That when the amendment is allowable it can be made in any form and to any extent that may be necessary to render the patent effective for the protection of the original invention. The discussion of these propositions, and of the proceedings in obtaining a re-issue, will occupy the remainder of this section.

§ 660. First Proposition: Sole Purpose of a Re-issue is to so Amend an Imperfect Patent that it may Protect the Patentable Subject-Matter which the Original Patent Attempted to Secure to its Inventor.

The truth of the first proposition, — that the sole purpose of a re-issue is to amend an imperfect patent in order that it may disclose and protect the proper subject-matter of the original patent — is self-evident. Being the method of amending a patent it pre-supposes a patent to amend. A patent void *ab initio* from any cause, as where it issues on a false oath of citizenship, or to alleged joint-inventors for a sole invention, is not an existing patent nor capable of becoming one by any process of amendment.¹ Whatever remedy there may be in such a case must be sought by an application for new letters-patent, not by a re-issue of the old. A perfect patent requires no re-issue. Changes in its language cannot

§ 660. ¹ That a void patent cannot be re-issued, see *Marsh v. Nichols* (1883), 15 Fed. Rep. 914; 24 O. G. 901; *Ex parte Benton* (1882), 23 O. G. 341; *Child v. Adams* (1854), 1 Fisher, 189; 3 Wall. Jr. 20.

That where the defect in the original consists in a false oath of citizenship, it is void and cannot be re-issued to cure the defect, see *Child v. Adams* (1854), 1 Fisher, 189; 3 Wall. Jr. 20.

That a patent issued on an application signed and sworn to in blank, and afterwards filled out by the attorney, is void, and cannot be re-issued, see *Ex parte Benton* (1882), 23 O. G. 341.

That a joint patent for a sole invention being invalid no re-issue of it can be granted, see *Ex parte Benton* (1882), 23 O. G. 341; *Ex parte Boursaloux* (1878), 14 O. G. 233.

That if it appears on the face of the re-issue application that the original patent was void, the application will be dismissed, see *Ex parte Benton* (1882), 23 O. G. 341.

That an expired patent cannot be re-issued, see *Ex parte Siemens* (1877), 11 O. G. 1107; *Ex parte Pulvermacher* (1876), 10 O. G. 2.

be amendments unless the language were before defective, and though the former patent may have been surrendered and a new one has been granted by the Patent Office, yet if the former needed no amendment, the two are in all respects substantially the same, and the last is a mere duplication of the other.² An existing imperfect patent is thus the sole subject for a re-issue. The defects by which an existing patent can be rendered imperfect are specified by the statutes as any invalidity or inoperativeness arising from inexactness or incompleteness in the Description, or from inexactness, or

² By a "perfect patent," as the phrase is here employed, is meant a patent which completely covers and protects the invention which the patentee endeavored to secure. As appears hereafter in this paragraph, a patent may be perfect *in itself*; *i. e.*, it may cover patentable subject-matter and be free from all ambiguity, and thus be valid and operative when judged by the standard of such patentable subject-matter, and yet be wholly invalid and inoperative when measured by the actual invention which it was intended to include. That in this case the patentee is entitled to a re-issue cannot now be doubted. See notes 5 and 6, *post*. Certain decisions, however, are reported in which the power of the Commissioner to re-issue a patent that is valid and operative in itself seems to be denied, and in some of these the courts are said to have authority to review the judgment of the Commissioner on this point, and, on finding the original patent perfect *per se*, to declare the re-issue void. See § 714 and note, *post*.

Thus that no re-issue is proper unless the original is inoperative or invalid for a defective specification, or claims too much, and if the original shows on its face that this is not so, the re-issue will be void, see *James v. Campbell* (1881), 104 U. S. 356; 21 O. G. 337; *Flower v. Rayner* (1881), 19 O. G. 425; 5 Fed. Rep. 793; *Giant Powder*

Co. v. California Powder Works (1875), 3 Sawyer, 448; 2 Bann. & A. 131; *Burr v. Duryee* (1863), 1 Wall. 531.

That where the original is valid and operative to the extent of its Claim, there is no reason for the re-issue and the re-issue is void, see *Giant Powder Co. v. California Vigorit Powder Co.* (1880), 18 O. G. 1339; 4 Fed. Rep. 720; 6 Sawyer, 508.

That where the only difference between the original and the re-issue is that the re-issue specification has the broader scope, the original would be valid if the re-issue is, and hence there was no reason for the re-issue and the re-issue will be void, see *Giant Powder Co. v. California Vigorit Powder Co.* (1880), 18 O. G. 1339; 4 Fed. Rep. 720; 6 Sawyer, 508.

As shown in § 714 and note, these positions are not correct. A re-issue cannot be held void even on the ground that it apparently reproduces the original patent, the decision of the Commissioner on the necessity for a re-issue being final. And that the validity and operativeness of the original patent, with reference to one invention, constitute no bar to its re-issue whenever the monopoly which it defines is not co-extensive with that which the patentee intended and attempted to secure, is evidenced by numerous decisions hereafter cited. See also *Smith v. Merriam* (1881), 6 Fed. Rep. 713; 19 O. G. 601.

incompleteness, or excess in the Claim. By enumerating these the statutes exclude all others, and confine the remedy to these alone.³ "Invalidity" is any defect on account of which a patent might be declared invalid by the courts. It occurs whenever the Description is not sufficiently precise and complete to enable persons skilled in the art to practise the invention, or where the Claim is broader than the actual invention.⁴ "Inoperativeness" is any defect, by reason of which the patent fails to give to the invention the protection which it was intended to afford. This occurs whenever the Claim is so obscure or so restricted that the exact limits of the invention entitled to protection are not clearly and correctly defined. In judging as to the existence of these defects, the nature of the invention which the patent was intended to protect must be kept constantly in view. A patent may be valid and operative as to one invention and not as to another. Thus where an invention is reached by several steps, or is composed of several parts, each of which is a separate invention, either of these may be sufficiently described and claimed, and yet the patent be invalid and inoperative as to the principal invention which it was chiefly intended to secure. That a patent is valid and operative to the extent that it discloses and protects some patentable invention does not, therefore, render it a perfect patent.⁵ The object of the in-

³ In *Giant Powder Co. v. California Vigorit Powder Co.* (1880), 6 Sawyer, 508, Field, J. : (520) "As thus seen, a re-issue can only be had when the original patent is inoperative or invalid from one of two causes,—either by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new. And even then the patentee can only obtain a re-issue where the error has arisen from inadvertence, accident, or mistake, and without any fraudulent or deceptive intention." 4 Fed. Rep. 720 (723); 18 O. G. 1339 (1340).

That the provisions of the statute

defining the conditions under which a patent may re-issue impliedly forbid it under any other conditions, see *Ex parte Whitely* (1886), 36 O. G. 1243; *Child v. Adams* (1854), 1 Fisher, 189; 3 Wall. Jr. 20.

⁴ That where the Description is not full and clear a re-issue is needed, see *Sewing Mach. Co. v. Frame* (1884), 28 O. G. 96; 24 Fed. Rep. 596.

⁵ In *Giant Powder Co. v. Safety Nitro Powder Co.* (1884), 10 Sawyer, 23, Sawyer, J. : (24) "A patent may be inoperative in my judgment, when it is inoperative in part. I do not think it must be absolutely inoperative in its entirety. If it is inoperative so far as not to cover all that the party is entitled

ventor in procuring it, and of the government in granting it, was to render accessible to the public, and for the time being to secure to the inventor, a specific invention or group of inventions, and if the patent, as it stands, does not accomplish this object it is invalid and inoperative within the meaning of the law, and may be amended by re-issue.⁶

§ 661. Failure to Describe or Claim Matter outside the Invention not a Defect in the Patent.

It is obvious that no patent can be invalid and inoperative by reason of its failure to describe and claim matter lying outside the limits of that invention which, having been conceived by the inventor and reduced to practice, the govern-

to claim, and what he is entitled to claim appears in the specifications, it being inoperative to that extent, I think it would be inoperative within the meaning of the provisions of the statute, and entitle the party to a re-issue covering his entire invention." 19 Fed. Rep. 509 (510); 27 O. G. 99 (100).

In *Wilson v. Coon* (1880), 18 Blatch. 532, Blatchford, J. : (536) "A patent may be inoperative from a defective or insufficient description, because it fails to claim as much as was really invented, and yet the Claim may be a valid Claim, sustainable in law, and there may be a description valid and sufficient to support such Claim. In one sense such patent is operative and is not inoperative; yet it is inoperative to extend to or claim the real invention, and the description may be defective or insufficient to support a Claim to the real invention, although the drawings and model show the things in respect to which the defect or insufficiency of description exists, and show enough to warrant a new Claim to the real invention. It can never be held, as it never has been held in a case where the point arose for decision, that a patent cannot be re-issued where a suit could be sustained on the specifica-

tion and Claim as they were." 6 Fed. Rep. 611 (615); 19 O. G. 482 (483).

See also *Hartshorn v. Eagle Shade Roller Co.* (1883), 18 Fed. Rep. 90; 25 O. G. 1191.

That "not fully operative" is "inoperative," see *Hartshorn v. Eagle Shade Roller Co.* (1883), 25 O. G. 1191; 18 Fed. Rep. 90.

That a specification may be inoperative as to some parts of the invention and not as to others, and its inoperativeness as to the others may not have been discovered until long after its issue, see *Thomson v. Wooster* (1885), 114 U. S. 104; 31 O. G. 913.

That where the original patent is ambiguous and on that account inoperative, it may be explained by a re-issue if the Commissioner is satisfied that the inventions are the same, see *Ex parte Gottstein* (1877), 11 O. G. 1061.

⁶ That where the Claims of the original patent were unnecessarily restricted, the re-issue may correct them and cover the whole invention, see *Schuessler v. Davis* (1878), 13 O. G. 1011.

That a re-issue is proper when the specification is imperfect, though the drawings and model are perfect, see *Wilson v. Coon* (1880), 6 Fed. Rep. 611; 18 Blatch. 532; 19 O. G. 482.

ment, by issuing that patent, originally endeavored to protect. If the idea of means had possibilities of further development or application, which the inventor did not then perceive, these did not enter into his actual invention. If his idea, as already conceived and apprehended, was divisible into other ideas of means, only a part of which had been reduced to practice, the latter alone could have constituted his invention. If his idea presented different aspects, capable of embodiment in essentially distinct inventions, each of which would have formed matter for an independent patent, the one selected by him as the subject of the patent whose amendment is in question is the sole invention which that patent could, if perfect, have secured. The limits of this invention thus exclude all new developments of the idea of means which have taken place since the original patent issued, all ideas which were not reduced to practice before the application for the original patent, and all distinct and independent parts or forms of the invention which were not embraced within the subject-matter of the patent already issued; and therefore no defect or insufficiency of statement concerning these can render the original patent inoperative or invalid, or furnish an occasion for its amendment. All that it can be made to cover, by any degree or species of correction is that completely *conceived*, *perceived*, and practically operative means for which the inventor then sought and the government then bestowed protection.¹ Intervening inventions, whether wholly distinct

§ 661. ¹ In *Manufacturing Co. v. Ladd* (1880), 102 U. S. 408, Bradley, J.: (413) "A re-issue can only be granted for the same invention which was originally patented. If it were otherwise, a door would be opened to the admission of the greatest frauds. Claims and pretensions shown to be unfounded at the time might, after the lapse of a few years, a change of officers in the Patent Office, the death of witnesses, and the dispersion of documents, be set up anew, and a reversal of the first decision obtained without an appeal, and without any knowledge of the previous investigations on the subject. New

light breaking in upon the patentee as the progress of improvement goes on, and as other inventors enter the field, and his monopoly becomes less and less necessary to the public, might easily generate in his mind an idea that his invention was really more broad and comprehensive than had been set forth in the specification of his patent. It is easy to see how such new light would naturally be reflected in a re-issue of the patent, and how unjust it might be to third parties who had kept pace with the march of improvement. Hence there is no safe or just rule but that which confines a re-issued patent to the

or consisting in substantial variations in or improvements on the old, subsequently discovered attributes of the invention

same invention which was described or indicated in the original." 19 O. G. 62 (64).

That a re-issue cannot cover more than the original invention as determined by the state of the art at the date of the first patent, see *Carlton v. Bokee* (1873), 17 Wall. 463; 6 Fisher, 40; 2 O. G. 520.

That a re-issue cannot embrace any invention other than that which the patentee had fully invented and the government had endeavored to protect by the original patent, see *Cornell v. Weidner* (1888), 127 U. S. 261; 43 O. G. 985; *Haines v. Peck* (1886), 26 Fed. Rep. 625; 35 O. G. 1227; *Hubel v. Dick* (1886), 24 Blatch. 139; 28 Fed. Rep. 656; 37 O. G. 1480; *Schilling v. Cranford* (1885), 4 Mackay, 450; 37 O. G. 1349; *Farmers' Friend Mfg. Co. v. Challenge Corn Planter Co.* (1885), 23 Fed. Rep. 42; 30 O. G. 661; *Reed v. Chase* (1885), 25 Fed. Rep. 94; 33 O. G. 996; *Flower v. Detroit* (1884), 22 Fed. Rep. 292; *Dryfoos v. Wiese* (1884), 19 Fed. Rep. 315; 26 O. G. 639; 22 Blatch. 19; *Parker & Whipple Co. v. Yale Clock Co.* (1883), 18 Fed. Rep. 43; 25 O. G. 290; 21 Blatch. 485; *McKay v. Stowe* (1883), 17 Fed. Rep. 516; *Hoffheins v. Russell* (1883), 107 U. S. 132; 23 O. G. 2030; *Andrews v. Hovey* (1883), 26 O. G. 1011; 5 McCrary, 181; 16 Fed. Rep. 387; *Lorillard v. McAlpin* (1882), 14 Fed. Rep. 112; *Newton v. Furst & Bradley Mfg. Co.* (1882), 14 Fed. Rep. 465; 11 Bissell, 405; *Neacy v. Allis* (1882), 13 Fed. Rep. 874; 22 O. G. 1621; *Hayes v. Seton* (1882), 20 Blatch. 484; 12 Fed. Rep. 120; *Streit v. Lauter* (1882), 11 Fed. Rep. 309; *Hart v. Thayer* (1882), 10 Fed. Rep. 746; 20 Blatch. 315; 21 O. G. 791; 22 O. G. 1787; *Meyer v. Maxheimer* (1881), 9 Fed.

Rep. 99; 20 Blatch. 15; 20 O. G. 1162; *Averill Chemical Paint Co. v. National Mixed Paint Co.* (1881), 9 Fed. Rep. 462; 20 Blatch. 42; 22 O. G. 585; *Putnam v. Tinkham* (1880), 4 Fed. Rep. 411; *Giant Powder Co. v. California Vigorit Powder Co.* (1880), 4 Fed. Rep. 720; 6 Sawyer, 508; 18 O. G. 1339; *American Middlings Purifier Co. v. Atlantic Milling Co.* (1879), 5 Dillon, 127; 4 Bann. & A. 148; 15 O. G. 467; *Curtis v. Branch* (1879), 4 Bann. & A. 189; 15 O. G. 919; *Kerosene Lamp Heater Co. v. Littell* (1878), 3 Bann. & A. 312; 13 O. G. 1009; *Powder Co. v. Powder Works* (1878), 98 U. S. 126; 15 O. G. 289; *Vogler v. Semple* (1877), 11 O. G. 923; 2 Bann. & A. 556; 7 Bissell, 382; *Manufacturing Co. v. Ladd* (1877), 2 Bann. & A. 488; 11 O. G. 153; *Russell v. Dodge* (1876), 93 U. S. 460; 11 O. G. 151; *Ex parte Aldrich* (1876), 9 O. G. 407; *Ex parte Baldwin* (1876), 9 O. G. 639; *Putnam v. Yerrington* (1876), 9 O. G. 689; 2 Bann. & A. 237; *Tucker v. Tucker Mfg. Co.* (1876), 10 O. G. 464; 2 Bann. & A. 401; 4 Clifford, 397; *Stevens v. Pritchard* (1876), 10 O. G. 505; 4 Clifford, 417; 2 Bann. & A. 390; *Giant Powder Co. v. California Powder Works* (1875), 3 Sawyer, 448; 2 Bann. & A. 131; *La Baw v. Hawkins* (1874), 1 Bann. & A. 428; 6 O. G. 724; *Ball v. Withington* (1874), 1 Bann. & A. 549; 6 O. G. 933; *Ex parte Wheeler* (1873), 4 O. G. 5; *Dorsey Harvester Rake Co. v. Marsh* (1873), 6 Fisher, 387; *Aultman v. Holley* (1873), 6 Fisher, 534; 11 Blatch. 317; 5 O. G. 3; *Wells v. Gill* (1873), 6 Fisher, 574; 4 O. G. 669; *Carew v. Boston Elastic Fabric Co.* (1871), 1 O. G. 91; 5 Fisher, 90; 3 Clifford, 356; *Brown v. Selby* (1871), 4 Fisher, 363; 2 Bissell, 457; *Parham v. American But-*

or of any of its parts, independent arts or instruments though tracing their origin to the same fundamental idea, and new matters of any kind, are equally beyond the scope of the original patent and of any correction or enlargement of its terms by a re-issue.²

tonhole, Overseaming, & Sewing Machine Co. (1871), 4 Fisher, 468; *Hoffheins v. Brandt* (1867), 3 Fisher, 218; *Cahart v. Austin* (1865), 2 Clifford, 528; 2 Fisher, 543; *Whitely v. Swayne* (1865), 4 Fisher, 117; *Sickles v. Evans* (1863), 2 Fisher, 417; 2 Clifford, 203; *Poppenhusen v. Falke* (1862), 5 Blatch. 46; 2 Fisher, 213; *Poppenhusen v. Falke* (1861), 2 Fisher, 181; 4 Blatch. 493; *French v. Rogers* (1851), 1 Fisher, 133; *Batten v. Taggart* (1851), 2 Wall. Jr. 101; *Knight v. Baltimore & Ohio R. R. Co.* (1840), Taney, 106; 3 Fisher, 1.

That the re-issue cannot introduce a different principle though it were known to the patentee when he obtained the original patent, see *Dyson v. Danforth* (1865), 4 Fisher, 133.

That a re-issue cannot claim devices used with, but not part of, the original invention, see *Ex parte Barker* (1873), 4 O. G. 155.

That where the original patent accurately defines the invention, a re-issue cannot embrace antecedent improvements not within the limits of the original patent, see *Funck v. Doty* (1877), 13 O. G. 322.

That where the original patent covers but one form of an invention, it cannot re-issue to cover other forms, see *Steam Gauge & Lantern Co. v. Miller* (1882), 11 Fed. Rep. 718; *N. Y. Bung & Bushing Co. v. Hoffman* (1881), 9 Fed. Rep. 199; 20 Blatch. 3; 20 O. G. 1451; *Washburn & Moen Mfg. Co. v. Haish* (1880), 10 Bissell, 83; 7 Fed. Rep. 906; *Manufacturing Co. v. Ladd* (1877), 2 Bann. & A. 488; 11 O. G. 153; *Wicks v. Stevens* (1876), 2 Bann. & A. 318; 2 Woods, 310.

That a patentee is not entitled to a re-issue covering any matter which, according to the records of the Patent Office, he was not the first to disclose, see *Ex parte Platts* (1879), 15 O. G. 827.

That a re-issue will be sustained if the court can see that the patentee only seeks to cover his real invention, see *Crandall v. Parker Carriage Goods Co.* (1884), 28 O. G. 369; 20 Fed. Rep. 851.

² In *Ex parte Seibert* (1879), 16 O. G. 262, Paine, Com. : (265) "Where, however, he makes no discovery of the art of lubricating by hydrostatic pressure at all, but devises and patents a particular mechanism for lubricating by steam pressure, never suspecting the operativeness of that particular mechanism by hydrostatic pressure until after his patent has been granted, he is not entitled on a re-issue to a broad Claim for an art or method of hydrostatic lubrication, for he had not invented or discovered any such art or method when he took out his patent. But he is entitled, on a re-issue, to a Claim for just what he invented, — that is to say, for a machine in a particular form, involving the use of hydrostatic pressure. His monopoly of the method is limited to the method used in the precise construction invented."

In *U. S. & Foreign Salamander Felt-ing Co. v. Haven* (1875), 9 O. G. 253, Treat, J. : (254) "The repeated decisions by the courts, and especially by the United States Supreme Court in the 1st, 17th, and 19th Wallace, indicate with sufficient distinctness that not only no new matter shall be introduced,

§ 662. Defects Amendable by Re-issue are Defects of Statement only, not of Subject-Matter.

It thus appears that the sole office of a re-issue is to correct faults of statement in the description and claim of the origi-

but that an enlargement of the original Claim growing out of the subsequent advance of the art is not to be tolerated. The reason of the rule is obvious. Every patent as to novelty or utility depends on the state of the art at the time of the claim made or patent issued; and, therefore, if a party, after learning from a subsequent advance of the art the worthlessness of his original invention, is to be permitted to claim a re-issue incorporating what was not originally in his mind, and what had been afterward suggested to him only by advances in the art made by others, then he could, it may be, even without any new invention, override all the elements which would serve to test the validity of the new application. In other words, having procured a worthless patent, and having subsequently learned from the advancing art how, by changing the terms of his patent, it could be made of value, he would, if a re-issue including the new matter were permitted, have the re-issue not only relate back to the date of the original patent, but absorb within its privileges all subsequent matters wholly unknown to and unthought of by him originally." 3 Dillon, 131 (134); 2 Bann. & A. 164 (166).

That a re-issue must be for the same invention as the original patent, and cannot be expanded to cover intervening inventions, see Meyer v. Maxheimer (1881), 20 Blatch. 15; 20 O. G. 1162; 9 Fed. Rep. 99.

That matter discovered by using the original invention cannot be embraced in the re-issue, see Andrews v. Hovey (1883), 5 McCrary, 181; 16 Fed. Rep. 387; 26 O. G. 1011.

That where the utility of an invention depends upon some property of matter which is not discovered until after the date of the original patent, no re-issue can claim and appropriate the property of matter as a feature in the invention, see Andrews v. Hovey (1883), 5 McCrary, 181; 16 Fed. Rep. 387; 26 O. G. 1011.

That a re-issue cannot embrace later inventions, no matter how meritorious the original may be, see Manufacturing Co. v. Ladd (1877), 2 Bann. & A. 488; 11 O. G. 153.

That to cover a new invention by suppressing certain features of the old is not allowable, see Matthews v. Iron Clad Mfg. Co. (1888), 124 U. S. 349; 42 O. G. 827; Matthews v. Boston Mach. Co. (1882), 105 U. S. 54; 21 O. G. 1349.

That a patentee cannot expand his Claims in a re-issue so as to cover the patentable invention of another, and if he does so he is liable to lose his own, see Adjustable Window Screen Co. v. Boughton (1874), 10 Phila. 251; 1 Bann. & A. 327.

That a re-issue cannot contain new matter, see Ives v. Sargent (1886), 119 U. S. 652; 38 O. G. 781; Hayes v. Seton (1882), 20 Blatch. 484; 12 Fed. Rep. 120; Kerosene Lamp Heater Co. v. Littell (1878), 3 Bann. & A. 312; 13 O. G. 1009; Gong Bell Mfg. Co. v. Clark (1878), 3 Bann. & A. 211; 13 O. G. 274; Thomas v. Shoe Mach. Mfg. Co. (1878), 3 Bann. & A. 557; 16 O. G. 541; Vogler v. Semple (1877), 11 O. G. 923; 2 Bann. & A. 556; 7 Bissell, 382; Union Paper Collar Co. v. Van Deusen (1874), 23 Wall. 530; 7 O. G. 919; La Baw v. Hawkins (1874), 1 Bann. & A.

nal patent.¹ It is a mere method of relieving the inventor from the disastrous consequences arising out of his want of skill in drawing his specification, and of preventing the public from taking an undue advantage of his errors. Mistakes in his choice or judgment as to what he shall attempt to cover by his patent, it does not undertake to remedy.² His present rights are adequately secured by the power conferred upon him to repeat his statements in varied forms by as many successive re-issues as he desires, until his language corresponds exactly with the actual invention which his patent was intended to protect. If he has other rights beyond the limits of this invention, he must ensure their preservation by an independent application and a separate patent.

428 ; 6 O. G. 724 ; *Whitely v. Swayne* (1865), 4 Fisher, 117.

See also § 668, note 10, *post*.

§ 662. ¹ That a re-issue is intended to cure the inevitable defects of statement, see *Blake v. Stafford* (1868), 6 Blatch. 195 ; 3 Fisher, 294 ; *Burr v. Duryee* (1862), 2 Fisher, 275.

That it is the purpose of a re-issue to make the patent better, see *Jordan v. Dobson* (1870), 4 Fisher, 232 ; 2 Abbott, U. S. 398 ; 7 Phila. 533 ; *Blake v. Stafford* (1868), 6 Blatch. 195 ; 3 Fisher, 294.

That a re-issue may correct, but cannot alter, see *Doane & Wellington Mfg. Co. v. Smith* (1882), 24 O. G. 302 ; 15 Fed. Rep. 459.

² That an error in judgment as to what the patent shall cover, or in conclusions of fact, is no ground for a re-issue, see *Ex parte Mahnken* (1887), 40 O. G. 915 ; *Yale Lock Mfg. Co. v. James* (1884), 28 O. G. 917 ; 20 Fed. Rep. 903 ; 22 Blatch. 294.

That an error in judgment as to the nature of the invention cannot be corrected by re-issue, see *Hubel v. Dick* (1886), 28 Fed. Rep. 656 ; 37 O. G. 1480 ; 24 Blatch. 139.

That if the invention is really broader than the patentee supposes, but he describes and claims it in the original as he understands it, there is no inadvertence, accident, or mistake, and no room for a re-issue, see *American Diamond Drill Co. v. Sullivan Mach. Co.* (1884), 22 Blatch. 298 ; 21 Fed. Rep. 74 ; 28 O. G. 811.

That an error in fixing the term of a patent, so that it fails to conform to that of a foreign patent previously granted, may be corrected by re-issue, see *Buerk v. Valentine* (1872), 9 Blatch. 479 ; 2 O. G. 295 ; 5 Fisher, 366.

That where an American patent claimed several devices covered by separate foreign patents, of which some were expired, the devices covered by the expired patents can be excluded from the American patent by re-issue, and the patent be valid for the rest, see *Ex parte Pulvermacher* (1876), 10 O. G. 2.

That a re-issue cannot claim matters for which the original has expired by reason of its limitation by a foreign patent, see *Ex parte Siemens* (1877), 11 O. G. 1197.

§ 663. Second Proposition: Re-issued Patent must be Confined to the Invention which the Patentee Attempted to Describe and Claim in his Original Patent.

The second proposition, — that a re-issue, being the amendment of an existing patent as distinguished from the grant of a new patent for an amendment in the invention, must be confined to the invention which the patentee attempted to describe and claim in the original patent, — is equally indisputable. The fundamental theory of Patent Law that the complete and exact disclosure of the invention to the public is the consideration paid by the inventor for the monopoly created by the patent, as well as the express provisions of the statutes, require that the invention to be covered by the patent should be entirely and precisely described and claimed by the inventor in his specification; and as the patent could not lawfully have been issued, so it cannot be amended by re-issue, to embrace any subject-matter which the patentee did not endeavor at the outset to describe and claim.¹ Hence, before any amendment of the patent can be

§ 663. ¹ As the principal difficulties which have arisen under the law of re-issues relate to this second proposition, it seems necessary, at the risk of some repetition, to examine more fully the foundation on which it rests, and the exact truth which it expresses. In order to obtain the grant of a monopoly the inventor must, in the first place, have conceived an idea of means and reduced it to practice in some operative art or instrument. In the second place, he must have perceived the essential character of his invention with such clearness and completeness as to be able to reproduce it, and to confer it on the public, in such a form as to make it available for practical use without the further exercise of inventive skill. In the third place, he must determine to patent either the entire invention or some separable part thereof, and must apply for a patent for that which he has thus concluded to secure. In the fourth place, he must incorporate in

his application a specification in which he makes an honest effort to describe and to claim the invention, or separable part, which his expected patent is intended to protect. Until an inventor has taken these four steps he is not entitled to any patent whatever; and if they have been taken he is entitled to a patent only for the subject-matter which he has endeavored to describe and claim. Now if, in the first step, the idea of means which he has conceived has possibilities of development beyond the point to which he has carried it, these lie wholly outside of his invention, whether they are ever thereafter realized or not, and whether, if realized, their realization is due to his own or to another's inventive act. Obviously, therefore, none of these can enter into the subject-matter of his patent, although when the inventive act as to them becomes complete they may be covered by a subsequent and independent patent. Again

properly allowed, it must be made apparent to the Patent Office that every portion of the subject-matter of the pro-

if, in the second step, he apprehends but partially the attributes of his invention, perceiving only its narrower where it has a broader aspect, or seeing in it only a fraction of what it would present to more intelligent or experienced observers, that which he thus perceives and consequently can reproduce or communicate to others alone can be considered as entering into his invention or included in the subject-matter of his patent. If, in the third step, his invention is of such a nature as offers him the opportunity to choose whether he will obtain a monopoly for it as a whole, or for one or more of its separable parts, or for it in one aspect rather than another, he must assume the responsibility of this selection, and having made it, and acted on it in his application for a patent, he cannot reconsider his determination and substitute a different subject-matter in the same application. Finally, in the fourth step, if he does not in good faith endeavor to describe the invention for which he has determined to procure the patent, he is guilty of a fraudulent concealment which renders his patent, if he obtains one, wholly void; and if he does not attempt to claim it, he waives the right to its protection by that patent. These are principles which are not open to dispute and form an invariable guide to the Patent Office in granting patents, and to the courts in construing them and ascertaining their validity.

But if a re-issue is the amendment of an existing patent, as distinguished from the grant of a new patent, it is evident that, in its exercise of the amending power, the Patent Office can bestow on the inventor no other or greater privilege than it could have conferred upon him in the original pat-

ent; in other words, that only that invention which he had fully invented, which he clearly comprehended, which he selected as the subject-matter of the patent, and attempted to describe and to claim in his original application, can be embraced in the re-issue. And it is also evident that this exercise of the amending power cannot extend to any steps in the foregoing series anterior to the one in which the amendable defect may have arisen, to wit; the fourth and last. If the inventor has more fully developed his original idea of means, or if he has more deeply fathomed the character of that which he had then conceived, or if maturer judgment has led him to a different conclusion as to what he should have made the subject of his patent; these are matters entirely antecedent in the order of events to that in which alone, under our Patent Law, any amendable defect can have occurred. Whatever advantage can accrue to him from these later achievements, or more perfect knowledge, must be sought in new and original proceedings, not in a reformation of the old. For neither the language of the statutes, nor the general provisions of the law, permit the surrender and re-issue of a patent for any other purpose than that of curing some defect or insufficiency in the description of the patented invention or in the statement of the inventor's claims.

These considerations are so simple and so elementary that an apology for their frequent repetition would be necessary were not numerous expressions to be found in text-books and reported cases, modern as well as ancient, which misrepresent, or at least do not correctly state, this rule of law. Thus it is not true that an inventor may embrace in his re-issue his entire actual invention; or that it may include whatever the

posed re-issued patent was not only included in the original invention, but that the inventor attempted both to describe it

original patent suggested or described as belonging to the invention ; or that it may cover anything which might have been claimed in the original, etc. It is true that whatever he had actually invented, had comprehended, had selected as the subject-matter of his patent, had attempted to describe and claim in his original specification, and through inadvertence, accident, or mistake, had there failed to properly describe and claim, he may now protect in his re-issue, — so much, and no more.

Of the multitude of cases which bear upon this point, a very few state it in its proper form and in intelligible language. Among these are the following : In *Flower v. City of Detroit* (1888), 127 U. S. 563, Blatchford, J. : (571) "It is sought to sustain the validity of the re-issue by attempting to show that the model filed in the Patent Office with the original application exhibited the invention covered by the first claim of the re-issue. It is doubtful whether that fact is satisfactorily established. But, irrespective of this, the case falls directly within the recent decision of this court in *Parker & Whipple Co. v. Yale Clock Co.* (123 U. S. 87 ; 25 O. G. 290). It was held in that case that what was suggested in the original specifications, drawings, or Patent Office model is not to be considered as a part of the invention intended to have been covered by the original patent, unless it can be seen from a comparison of the two patents that the invention which the original patent was intended to cover embraced the things suggested or indicated in the original specification, drawings, or Patent Office model, and unless the original specification indicated that those things were embraced in the invention intended to have been secured by the original patent. (See

also *Hoskin v. Fisher*, 125 U. S. 217.) In the present case it cannot be seen from a comparison of the two patents that the original specification indicated that what is covered by the first claim of the re-issue was intended to have been secured by the original." 43 O. G. 1348 (1349).

In *Parker & Whipple Co. v. Yale Clock Co.* (1887), 123 U. S. 87, Blatchford, J. : (95) "The appellants contend that the first eight Claims of the re-issue do not specify any invention which is not contained in the clock described in the original patent and embodied in the model originally deposited in the Patent Office, and that the drawings of the original and of the re-issued patent are substantially the same. On these premises, it is argued for the appellants that it is lawful to include in the Claims of a re-issue whatever is suggested or substantially indicated in the specification, model, or drawings of the original patent, if the applicant was the original and first inventor thereof, and that such a re-issue will therefore be for the same invention as that of the original patent. Expressions in some opinions of this court, wrested from their context and interpreted in a different sense from that in which they were used, are cited to support these views ; but the language of the court on the subject has steadily been to the contrary ; and as the question arises so distinctly in this case and some misapprehension exists in regard to it, it seems proper to discuss it with some fulness." Here the court reviews the statutes, and several decisions, concluding with that of *Seymour v. Osborne* (1870), 11 Wall. 516, from which it quotes Judge Clifford's familiar statement, that a re-issue may contain whatever was "suggested or substantially indicated in the specifications or

and to claim it in the specification annexed to his original patent. And the courts, in construing the re-issued patent

drawings which properly belonged to the invention as actually made and perfected," and then continues: — (98) "In these extracts from the opinion it is seen that the court adheres strictly to the view that under the statute the Commissioner has no jurisdiction to grant a re-issued patent for an invention substantially different from that embodied in the original patent, and that a re-issue granted not in accordance with that rule is void. In what is there said about re-describing the invention, and about including in the new Description and new Claims what was suggested or indicated in the original specification, drawings, or Patent Office model, it is clearly to be understood, from the entire language, that the things so to be included are only the things which properly belonged to the invention as embodied in the original patent; that what that invention was is to be ascertained by consulting the original patent; and that while the new Description may properly contain things which are indicated in the original specification, drawings, or Patent Office model (though not sufficiently described in the original specification), it does not follow that what was indicated in the original specification, drawings, or Patent Office model is to be considered as a part of the invention, unless the court can see from a comparison of the two patents that the original patent embodied as the invention intended to be secured by it what the Claims of the re-issue are intended to cover. In what was thus said in *Seymour v. Osborne* there is no warrant for the view that, *ex vi termini*, what was suggested or indicated in the original specification, drawings, or Patent Office model is to be considered as a part of the invention intended to have been covered by the original patent, un-

less the court can see from a comparison of the two patents that the invention which the original patent was intended to cover fairly embraced the things thus suggested or indicated in the original specification, drawings, or Patent Office model, and unless the original specification indicated that those things were embraced in the invention intended to have been secured by the original patent. . . . (102) There is no evidence of any attempt to secure by the original patent the inventions covered by the first eight Claims of the re-issue, and those inventions must be regarded as having been abandoned or waived, so far as the re-issue in question is concerned, subject however to the right to have made a new application for a patent to cover them; in other words, those eight Claims are not for the same invention which was originally patented." 41 O. G. 811 (812).

In *Yale Lock Mfg. Co. v. Seovill Mfg. Co.* (1880), 18 Blatch. 248, Shipman, J. : (256) "I understand that the Supreme Court, in the case cited and in other cases, intend to declare that in a re-issue the same, and only the same, invention which was attempted to be secured in the original patent, but which was there imperfectly stated, and was not fully secured, through inadvertence, accident, or mistake, can be re-stated, so that the principles or details of the invention may be presented clearly and accurately, but that other inventions of the patentee, or modifications of the patented invention, which had not been attempted to be secured, or had not been applied for, cannot be embraced in a re-issue, but must be the subject of a new application, and that 'courts should regard with jealousy and disfavor any attempt to enlarge the scope of an application

are logically and legally compelled to presume that the Patent Office has performed this duty, and that the monopoly

once filed, or of a patent once granted, the effect of which would be to enable the patentee to appropriate other inventions made prior to such alteration.' (Railway Co. v. Sayles, 97 U. S. 554.) But if the patentee has made a palpable mistake, and has limited his real invention by a misstatement of its principles, so that he is about to lose the fruit of his labor, he should be permitted to restate, and, if need be, enlarge his specification, so as to include the same invention which was plainly the subject of, but was not fully secured by, the original patent, although, literally, the enlarged invention is one which he did not apply for in his original specification, because that specification, by a misstatement of his actual invention, applied for a narrower patent than he was entitled to have." 3 Fed. Rep. 288 (296); 5 Bann. & A. 519 (526).

In *Powder Co. v. Powder Works* (1878), 98 U. S. 126, Bradley, J. : (138) "The specification may be amended so as to make it more clear and distinct ; the Claim may be modified so as to make it more conformable to the exact rights of the patentee ; but the invention must be the same. So particular is the law on this subject that it is declared that 'no new matter shall be introduced into the specification.' This prohibition is general, relating to all patents ; and by 'new matter' we suppose to be meant new substantive matter, such as would have the effect of changing the invention, or of introducing what might be the subject of another application for a patent. The danger to be provided against was the temptation to amend a patent so as to cover improvements which might have come into use, or might have been invented by others, after its issue. The legislature was willing to concede to the pat-

entee the right to amend his specification so as fully to describe and claim the very invention attempted to be secured by his original patent, and which was not fully secured thereby in consequence of inadvertence, accident, or mistake, but was not willing to give him the right to patch up his patent by the addition of other inventions, which, though they might be his, had not been applied for by him, or, if applied for, had been abandoned or waived. For such inventions he is required to make a new application, subject to such rights as the public and other inventors may have acquired in the meantime. This, we think, is what the present statute means, and what, indeed, was the law before its enactment, under the previous act of 1836. If decisions can be found which present it in any different aspect, we cannot admit them to be correct expositions of the law." 15 O. G. 289 (292).

In *Brown v. Selby* (1871), 4 Fisher, 363, Drummond, J. : (368) "A re-issue can only be for the invention originally made and intended to be described or claimed, and included in the original patent." 2 Bissell, 457 (462).

In *Knight v. Baltimore & Ohio R. R. Co.* (1840), 3 Fisher, 1, Taney, C. J. : (3) "The plaintiff was not entitled to the patent of 1834, except for the purpose of giving a more perfect description of the invention intended to be claimed by him in the patent of 1829. . . . The patent of 1829 having been cancelled when that of 1834 was granted, the subsequent patent of 1836, upon which this suit is brought, is not valid, unless the improvement described in it is, in its principles and mode of operation, the same with that intended to be described in the patent of 1834, and differing from it only in giving a more perfect description of the improvement intended to be

defined in the re-issued patent was not intended to extend beyond the invention which the patentee endeavored to dis-

secured by that patent. . . . The plaintiff was not entitled in the patent of 1836 to enlarge, change, or modify the improvement intended to be protected by the patent of 1834. . . . The plaintiff is not entitled to recover unless he is the original inventor of the improvement described in the patent of 1836, and unless that improvement is the same in principle and in its mode of operation with the one intended to be described in the patents of 1834 and 1829." Taney, 106 (107). It is worthy of remark that in this case, — the first in which the courts seem to have been called upon to decide what a re-issue might contain — the true rule is stated by Chief Justice Taney, viz. : that the patentee is entitled to claim in his re-issue only what he "intended to" describe and claim in his original patent.

That a re-issue is intended to cover the invention which the inventor actually made and attempted to protect by the original, see *Eames v. Andrews* (1887), 122 U. S. 40 ; 39 O. G. 1319 ; *Parker & Whipple Co. v. Yale Clock Co.* (1883), 21 Blatch. 485 ; 25 O. G. 290 ; 18 Fed. Rep. 43 ; *Yale Lock Co. v. Scoville Mfg. Co.* (1880), 18 Blatch. 248 ; 3 Fed. Rep. 288 ; 5 Bann. & A. 519 ; *Powder Co. v. Powder Works* (1878), 98 U. S. 126 ; 15 O. G. 289.

That if no attempt was made to secure the invention by the original patent, it cannot be embraced in a re-issue, see *Hoskin v. Fisher* (1888), 125 U. S. 217 ; 43 O. G. 509.

That a re-issue cannot claim either another invention or a broader invention than the one attempted to be described and claimed in the original patent, see *Worden v. Searls* (1887), 121 U. S. 14 ; 39 O. G. 359 ; *Ex parte Herr* (1887), 41 O. G. 463 ; *Archer v. Arnd* (1887), 31 Fed. Rep. 475 ; 40 O. G. 1032 ;

Coon v. Wilson (1885), 113 U. S. 268 ; 30 O. G. 889 ; *Dryfoos v. Wiese* (1884), 22 Blatch. 19 ; 26 O. G. 639 ; 19 Fed. Rep. 315 ; *Hart v. Thayer* (1882), 20 Blatch. 315 ; 10 Fed. Rep. 746 ; 21 O. G. 791 ; 22 O. G. 1787 ; *Combined Patents Can Co. v. Lloyd* (1882), 21 O. G. 713 ; 11 Fed. Rep. 149 ; 15 Phila. 481 ; *Miller v. Brass Co.* (1882), 104 U. S. 350 ; 21 O. G. 201 ; *Moffitt v. Rogers* (1882), 106 U. S. 423 ; 23 O. G. 270 ; *Wing v. Anthony* (1882), 106 U. S. 142 ; *Gosling v. Roberts* (1882), 106 U. S. 39 ; 22 O. G. 1785 ; *James v. Campbell* (1881), 104 U. S. 356 ; 21 O. G. 337 ; *Heald v. Rice* (1881), 104 U. S. 737 ; 21 O. G. 1443 ; *Smith v. Merriam* (1881), 19 O. G. 601 ; 6 Fed. Rep. 713 ; *Waring v. Johnson* (1881), 19 O. G. 1068 ; 6 Fed. Rep. 500 ; 19 Blatch. 38 ; *Kells v. McKenzie* (1881), 20 O. G. 1663 ; 9 Fed. Rep. 284 ; *Meyer v. Maxheimer* (1881), 20 Blatch. 15 ; 20 O. G. 1162 ; 9 Fed. Rep. 99 ; *Washburn & Moen Mfg. Co. v. Haish* (1880), 10 Bissell, 65 ; 19 O. G. 173 ; 4 Fed. Rep. 900 ; *Covell v. Pratt* (1880), 18 Blatch. 126 ; 18 O. G. 301 ; 2 Fed. Rep. 359 ; 5 Bann. & A. 380 ; *Manufacturing Co. v. Corbin* (1880), 103 U. S. 786 ; 20 O. G. 297 ; *Ball v. Langles* (1880), 102 U. S. 128 ; 18 O. G. 1405 ; *Garneau v. Dozier* (1880), 102 U. S. 230 ; 19 O. G. 61 ; *Manufacturing Co. v. Ladd* (1880), 102 U. S. 408 ; 19 O. G. 62 ; *American Middlings Purifier Co. v. Atlantic Milling Co.* (1879), 15 O. G. 467 ; 5 Dillon, 127 ; 4 Bann. & A. 148 ; *Cammeyer v. Newton* (1879), 16 O. G. 720 ; 4 Bann. & A. 159 ; *Campbell v. James* (1879), 18 O. G. 979 ; 17 Blatch. 42 ; 4 Bann. & A. 456 ; *Powder Co. v. Powder Works* (1878), 98 U. S. 126 ; 15 O. G. 289 ; *Jones v. McMurray* (1877), 13 O. G. 6 ; 2 Hughes, 527 ; 3 Bann. & A. 130 ;

close and to appropriate in his original patent. Where the re-issued patent will bear no construction which confines its subject-matter to this invention, its Claims are necessarily invalid.

§ 664. **Nature and Scope of the Invention which the Inventor Attempted to Describe and Claim in his Original Patent, how Determined.**

By what method the Patent Office or the courts shall ascertain the limits of the invention which the patentee originally endeavored to describe and claim, the statutes do not particularly prescribe. The act of 1832 simply required that the re-issue should be for the same invention. The act of 1836 followed in this respect the act of 1832. The act of 1870 further provided that "no new matter shall be introduced into the specification, nor in case of a machine-patent shall the model or drawings be amended except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the Commissioner that such new matter or amendment was part of the original invention and was omitted from the specification by inadvertence, accident, or mistake." The Revised Statutes reproduce these provisions of the act of 1870. Under these, it will be noticed that no limitation is placed to the amendment of the original specification except the prohibition of new matter, and no test is given by which the Office or the courts are to determine what it attempted to describe and

Marsh *v.* Seymour (1877), 97 U. S. 437; 5 Fisher, 415; Seymour *v.* Osborne (1870), 11 Wall. 516; Morey *v.* Lockwood (1868), 8 Wall. 230; Hoffheins *v.* Brandt (1867), 3 Fisher, 218; Cahart *v.* Austin (1865), 2 Clifford, 528; 2 Fisher, 543; Burr *v.* Duryee (1863), 1 Wall. 531.

That where the re-issue does not cover an invention distinct from that described and attempted to be claimed in the original, the re-issue is valid, unless the failure to claim amounted to abandonment, see Eames *v.* Andrews (1887), 122 U. S. 40; 39 O. G. 1319.

Marsh *v.* Seymour (1877), 97 U. S. 348; 13 O. G. 723; Vogler *v.* Semple (1877), 7 Bissell, 382; 11 O. G. 923; 2 Bann. & A. 556; Russell *v.* Dodge (1876), 93 U. S. 460; 11 O. G. 151; Tucker *v.* Tucker Mfg. Co. (1876), 4 Clifford, 397; 10 O. G. 464; 2 Bann. & A. 401; Collar Co. *v.* Van Deusen (1874), 23 Wall. 530; 7 O. G. 919; Gill *v.* Wells (1874), 22 Wall. 1; 6 O. G. 881; Carlton *v.* Bokes (1873), 17 Wall. 463; 6 Fisher, 40; 2 O. G. 520; Tarr *v.* Webb (1872), 10 Blatch. 96; 5 Fisher, 593; 2 O. G. 568; Sarven *v.* Hall (1872), 9 Blatch. 524; 1 O. G.

claim. In the case of a machine-patent it is assumed that every feature of the invention which the inventor intended to protect will be exhibited either in his drawing or his model, and by prescribing that these can be amended only by each other the statute fairly implies that no part of the actual invention which he made can be regarded as embraced in what he intended to describe and claim unless in one or both of these it is disclosed. Where no model or drawing exists, the Office and the courts are left to the guidance of such regulations concerning the kind and degree of evidence required for the solution of this question as they may, in general, or in reference to particular cases, see fit to establish.¹ The necessity for some permanent and definite rule upon the subject, however, and the manifest danger of fraud and imposition if the fact that by the original patent the inventor intended and attempted to cover the matter now claimed in the re-issue were to be determined in any case upon his mere assertions or other parol testimony alone, early led the courts to declare that the original specification, as illustrated by the model or drawings if any, and as interpreted by a proper explanation of its terms of art and by the examination in connection with it of the invention actually made, must bear upon its face sufficient evidence of the alleged endeavor to describe and claim.² This rule, as usually stated,

§ 664. ¹ That the courts and the Patent Office obey the same rules in ascertaining the character of the invention which the patentee originally attempted to protect, see *Ex parte Aldrich* (1876), 9 O. G. 407.

² The cases in which this rule has been accepted and followed are almost without number, and yet in scarcely any of them has it been completely and accurately stated. The adoption of the incorrect forms mentioned in the text is largely responsible for this, but such has been the history of the rule itself that freedom from obscurity could scarcely be expected. The earliest case in which the courts seem to have established a test for determining the char-

acter of the invention which the original patent was intended to protect, and for ascertaining the identity with this of the invention claimed in the re-issue, was *Knight v. Baltimore & Ohio R. R. Co.* (1840), Taney, 106 ; 3 Fisher, 1. In this case Chief Justice Taney charged the jury that the plaintiff could not recover on his re-issued patent unless the invention which it described and claimed was "the same in principle and in its mode of operation with the one intended to be described in" the original patent, and then left this question of identity (which of course includes the question of the actual character of the invention intended to be covered by the original patent) to be decided by the jury, as a

appears in one of the two following forms: negatively, that a re-issue cannot include any subject-matter which the orig-

matter of fact. In the cases which immediately followed this, the same position was taken by the courts, and the jury were required to pass upon the identity of the inventions on any relevant evidence that might have been presented. See *Carver v. Braintree Mfg. Co.* (1843), 2 Story, 441; *Stimpson v. Westchester R. R. Co.* (1845), 4 How. 404; *Allen v. Blunt* (1846), 2 W. & M. 139; *Batten v. Taggart* (1854), 17 How. 83; *Heilner v. Battin* (1856), 27 Penn. 521; *Poppenhuson v. Falke* (1861), 4 Blatch. 496, etc. While the courts were pursuing this method of investigation a practice appears to have arisen in the Patent Office of confining the applicant for a re-issue to such evidence concerning the invention which he first endeavored to protect, and its identity with that claimed in the re-issue, as was furnished by the original patent and its specification, drawings, and model, when interpreted by the invention itself, — a practice more than once repudiated in the courts, but gradually making its impression upon their decisions. Concurrently with these events, the doctrines that the nature and scope of any patented invention is to be determined by the court as a matter of law upon an inspection of the patent; that consequently the identity of two patented inventions must be ascertained by a comparison of their respective patents with each other by the court; and that the action of the Commissioner in issuing or re-issuing a patent is *prima facie* lawful and valid; — were becoming firmly grounded and universally applied, culminating, at length, in the proposition announced by Clifford, J., in *Sickles v. Evans* (1863), 2 Clifford, 203, and affirmed by him in *Stevens v. Pritchard*, (1876), 4 Clifford, 417, that the action of the Commissioner in granting a re-

issue is "final and conclusive, unless the court is of the opinion, upon comparing the two instruments, that the re-issued patent, as matter of legal construction, is not for the same invention as the original."

In the transition to this doctrine from that of Chief Justice Taney in 1840 decisions of various degrees of incorrectness and inconsistency were rendered, some affirming the right of the patentee to a re-issue in the broadest terms which his original invention would permit, others restricting him in the re-issue to what he had claimed in the original patent; some asserting that the identity of the inventions covered by the original and re-issued patents must be apparent to the court upon a mere inspection of the instruments themselves, others adopting the extreme position of Judge Clifford that this identity must be conclusively presumed unless the patents, when compared with one another, disclosed substantial differences between them; yet all finally agreeing in the rule primarily adopted by the Patent Office, that the original specifications, drawings, and model must afford the ultimate test by which the Office or the courts are to determine what portions and aspects of his actual invention the inventor had intended and attempted to describe and claim.

Having reached this point in the explication of the rule, most of the decisions treat it as sufficiently stated, and proceed to apply it in their own peculiar modes. But it is evident that this explication is not a finality. For though it be established that the subject-matter of a re-issue must be confined to the invention which the patentee originally attempted to secure, and that this attempt must be discoverable in the original specification, drawings, or model,

inal patent, as construed by the court, does not apparently endeavor to protect; affirmatively, that a re-issue may em-

the mode to be pursued in making that discovery is still to be determined. In reference to this mode of inquiry it must be remembered that the specification, in which the discovery is to be made, is confessedly defective, — so defective, indeed, that in consequence of its defects the patent is inoperative or invalid. Manifestly, then, no mere process of interpretation can avoid or cure its imperfections and ascertain what patentable matter it has undertaken to describe and claim, since where interpretation can have this effect the patent cannot be invalid or inoperative. Hence recourse must be had to some exterior source for information as to the true nature of the invention, that in the light afforded by its actual character, as the inventor conceived it and reduced it to practice before his original application for a patent, his defective claims and description may be read. This is evidently the only method in which the fact that the specification is defective can be ascertained, or the nature and degree of the defect can be measured, or the scope of the invention which the defective delineation or assertion attempted to embrace can be explored; and not until the Patent Office or the court is thus informed of what the inventor might have made the subject-matter of his patent, if he had so desired, can it be in any situation to scrutinize the original specification, drawings, or model in order to discover what he did intend and endeavor to describe and claim.

Three sources of information concerning the actual character of the original invention may be accessible for the purpose of this inquiry: (1) The assertions of the inventor or other parol testimony; (2) The specification of the re-issued patent; (3) The inven-

tion itself as originally made and perfected. The first is excluded because unreliable and unnecessary, as well as on grounds of public policy, and demands no further consideration. The specification of the re-issued patent, on the contrary, is in the highest degree authoritative and available. It purports to give, and must be accepted as giving, a complete and exact description of the invention, and as stating fully and clearly the claims of the inventor. It is assumed to be sufficient to acquaint those skilled in the art with the mode of making and using the invention, and to inform the public of the precise line which separates the arts and instruments at their command from that which is embraced in the monopoly. The patentee cannot be permitted to deny that the court or Patent Office, by legally interpreting his re-issue specification, with its drawings and model, will obtain a perfect knowledge of his true invention, as he himself has made it and contemplated its introduction into public use. And hence the Patent Office and the courts have here a ready, permanent, and invariable standard with which to compare the original specification, and thus discover how much of the invention as it now appears in the perfected patent the inventor then attempted to describe and claim. Where no re-issue has as yet been granted, and no re-issue specification on which the patentee insists as the accurate presentation of his invention has been filed, this source of information is, of course, absent, and a resort to the actual invention becomes necessary.

This review of the subject makes it evident that the mode of discovery to be pursued in ascertaining what the original specification attempted to embrace must vary with the different

brace whatever was suggested or substantially indicated in the original specification or drawings as belonging to the invention

stages in the history of the re-issue. When the inventor or his attorney are endeavoring to decide what can be claimed in the proposed re-issue, or when the Patent Office is assisting the inventor to secure all that a re-issue may lawfully include, the actual invention itself must be examined, and by comparing this with the original specification, drawings, and model, they must determine how much of that invention the patentee then intended and attempted to describe and claim, and confine within those limits the invention claimed in the re-issue. This is evidently the proceeding contemplated by that clause of the statutes which authorizes the Commissioner, in certain cases, to consider any proper proof as to the real nature of the actual invention, and the extent to which the inventor failed in his original attempt to disclose and protect it; while in the case of a machine, the original model and drawings, in connection with the specification and the machine itself, are presumed to offer all the information upon these points that, for the purpose of preparing and allowing a re-issue, the inventor or the Office can require.

When the re-issue application is perfected in the Patent Office, according to the intention of the applicant, and he insists upon its correspondence with the actual invention as he originally attempted to secure it, the specification, drawings, and model embraced in this re-issue application become the test by which the intended scope of the original patent is to be judged; and it must therefore be assumed by the Office that whatever parts or features of the invention, as set forth in these amended and presumably correct delineations, are wholly absent from the original specifications were not included in the

invention which the inventor there attempted to describe and claim. At this stage there is, therefore, no occasion for exterior evidence, or for an examination of the actual invention itself, except so far as may be necessary to understand the description and claims of the re-issue application.

When the courts are called upon to enter into this investigation (except in proceedings on appeal, or in equity, supplemental to the re-issue application, and which are consequently governed by the foregoing rules), the re-issued patent has been granted and its specification stands before the public, as well as the court itself, as the complete and accurate exposition of the invention originally made and intended to be patented by the inventor. When construed by the court, with such explanation of technical terms and such reference to the actual invention as may be deemed essential to its true interpretation, it furnishes all needed information concerning the character of the invention as originally made and perfected, and constitutes a standard with which the original specification, drawings, and model may be compared, and from which the court may satisfactorily and sufficiently discover what portions of the invention the patentee endeavored to communicate to the public and to bring within the monopoly created by his original patent. From this as well as the preceding stage of the investigation extrinsic testimony is thus excluded, save for the purpose of aiding the court in its interpretation of the original and re-issued patents with their respective specifications, drawings, and models.

As this inquiry in the courts is instituted after the re-issued patent has been granted, a further question arises which is not encountered in the previous

actually made and embodied in the original patent. These statements are not literally correct, since the rule itself relates

stages in the Patent Office. It has become a settled principle of law that the issue of a patent raises a presumption of its validity and of the existence of all the conditions which the statutes have imposed upon the patentee. Applied to the proceeding now under discussion, this principle would seem to justify the extreme doctrine heretofore referred to, and compel the courts to recognize the judgment of the Patent Office in allowing the re-issue, and thereby deciding that its subject-matter was attempted to be covered by the original patent, as final and conclusive unless the contrary is clearly evident on a comparison of the original and re-issue specification. This doctrine has been held in many cases, among which are *Herring v. Nelson* (1877), 14 Blatch. 293; 3 Bann. & A. 55; 12 O. G. 753; *Tucker v. Tucker Mfg. Co* (1876), 10 O. G. 464; 4 Clifford, 397; 2 Bann. & A. 401; *Stevens v. Pritchard* (1876), 10 O. G. 505; 4 Clifford, 417; 2 Bann. & A. 390; *Chicago Fruit House Co. v. Busch* (1871), 2 Bissell, 472; 4 Fisher, 395; *Carew v. Boston Elastic Fabric Co.* (1871), 3 Clifford, 365; 5 Fisher, 90; 1 O. G. 91. Later cases manifest a disposition to repudiate this position, and to assert that the presumption arising from the action of the Patent Office in allowing a re-issue does not prevent the courts from re-examining this question of correspondence between the original and re-issue specifications, and affirming the validity or invalidity of the re-issued patent according as this correspondence may or may not appear. In these cases, therefore, it is held that a comparison of the re-issue and original specifications must affirmatively show that the subject-matter of the former was attempted to be stated in the latter, and that the Claims of the re-issue can

embrace no invention unless the court can see that the inventor intended to secure it under the original patent. See *Flower v. Detroit* (1888), 127 U. S. 563; 43 O. G. 1348; *Fisher v. Hoskin* (1888), 125 U. S. 217; 43 O. G. 509; *Parker & Whipple Co. v. Yale Clock Co.* (1887), 123 U. S. 87; 41 O. G. 811, etc. These cases probably represent the law as it will ultimately be established, though at present it is scarcely safe to prophesy whether their doctrine will prove as just and practically beneficial to inventors and the public as the former.

The rule, as stated and explained in the preceding portions of this note, is applicable whenever the descriptive matter of the original specification is imperfect, whether or not the Claims, as measured by such description, are defective or sufficient. But where the description is complete and accurate, and the fault resides in an obscure or too restricted or excessive Claim, the modes of inquiry above delineated are unnecessary. Here the description of the original patent becomes the standard by which the imperfections in its Claims, and the extent to which they can be corrected, must be judged, and neither in the Patent Office nor the courts can the Claims of the re-issue be permitted to embrace any subject-matter which was not adequately portrayed in the original description.

In concluding this prolix discussion the proposition announced in the previous paragraph may be reiterated, — that the object of discovery in the methods before mentioned is the attempt of the inventor not merely to describe the invention now embraced in the re-issue, but also to claim it, and thus bring it within the original monopoly. It is not indeed necessary that it appear expressly in his original Claims.

only to the mode by which the intended scope of the original patent is to be determined, while these forms of expressing it prescribe what a re-issue may or may not contain,—a matter already definitely fixed by the language of the statute, and which the courts have no power to extend or to curtail. From these erroneous forms of statement have arisen serious misapprehensions as to the nature and practical application of the rule itself. Certain decisions may be found which proceed on the assumption that it governs the allowance of re-issues, and which, adopting its affirmative form, therefore declare that anything which might have been claimed in the original patent, under the description therein given of the invention, may be claimed in the re-issue.³ This position, as thus broadly stated, is not correct. That a Claim might have been made in the original does not, *ipso facto*, entitle the inventor to insert it in his re-issue.⁴ Additional circumstances, such as abandonment, estoppel, and the like, are to be regarded; and in view of these, as well as its relation to the original description, is the validity of the amended Claim to be determined. Other decisions are reported which, assuming the rule to be of the same character and following its negative form, have held that nothing can be claimed in a re-issue which was not included in the Claim of the origi-

It may have been so connected with claimed matter in the Description that a Claim for either would impliedly cover both, as where Claims for a process embrace its inseparable product, or Claims for a combination incidentally include its indispensable elements and sub-combinations. But in this or some other manner the attempt to claim must have been so made in the original specification that the Patent Office and the courts, pursuing the appropriate method of inquiry just considered, may satisfy themselves that what the inventor clearly claims in his re-issue, he did endeavor to protect by his original patent.

³ That whatever could have been claimed in the original patent may be claimed in the re-issue, see *Washburn & Moen Mfg. Co. v. Haish* (1880), 10

Bissell, 65; 19 O. G. 173; 4 Fed. Rep. 900; *Draper v. Wattles* (1878), 3 Bann. & A. 618; 16 O. G. 629; *Union Paper Collar Co. v. Van Deusen* (1872), 10 Blatch. 109; 5 Fisher, 597; 2 O. G. 361.

⁴ That the mere fact that matter might have been claimed in the original is not alone enough to warrant its claim in the re-issue, see *Electric Gas Lighting Co. v. Smith & Rhodes Electric Co.* (1885), 31 O. G. 792; 23 Fed. Rep. 195; *Yale Lock Mfg. Co. v. James* (1884), 20 Fed. Rep. 903; 28 O. G. 917; 22 Blatch. 294; *Newton v. Furst & Bradley Mfg. Co.* (1882), 11 Bissell, 405; 14 Fed. Rep. 465; *Kells v. McKenzie* (1881), 9 Fed. Rep. 284; 20 O. G. 1663.

nal patent;⁵ a rule which unwarrantably restricts the rights of the inventor, and is contrary alike to the uniform practice of the Patent Office and the general current of judicial opinion.⁶ Both these errors might have been avoided had the true reason and purpose of this rule been clearly apprehended. It does not pretend to state when a re-issue may be granted or withheld, or what the re-issued patent may or may not contain. The acts of Congress have determined when it shall be granted, and that when granted it may contain whatever may be necessary to render it effectual to protect the invention which the inventor originally attempted to secure. In ascertaining what that invention was, the Patent Office and the courts have properly refused to look beyond the specification, drawings, and model of the original patent, interpreted when necessary by an examination of the invention itself, but have not held, nor had they any authority to hold, that everything which could have been claimed under the original patent, whether a part of the actual invention or not, and whether or not abandoned, might be claimed under the re-issue; nor, on the other hand, that nothing could be covered by the latter patent, although belonging to the actual invention, which was not embraced within the Claims of the former. Considered in its true intent, as a simple rule of evidence, it presents no special difficulty, but is reasonable, intelligible, and in most instances easy of application.

§ 665. The Attempt of the Inventor to Describe and Claim the Invention Embraced in the Re-issue must Appear in the Specification, Drawings, or Model of the Original Patent.

In order to determine what invention the inventor intended and endeavored to secure by the original patent, the specifi-

⁵ That a re-issue cannot be expanded so as to claim matters which the patentee did not see fit to claim in the original, see *Fay v. Fraser* (1882), 11 Bissell, 422; 14 Fed. Rep. 652.

That a re-issue, whose only Claims are not in the original, is void, see *Singer*

Mfg. Co. v. Goodrich (1883), 15 Fed. Rep. 455.

That Claims in a re-issue which expressly enlarge the invention claimed in the original are void, see *Curtis v. Branch* (1879), 15 O. G. 919; 4 Bann. & A. 189.

⁶ See § 656 and note 3, *ante*.

cation, drawings, and model connected with that patent, explained when necessary by comparison with the actual invention or its correct description in the re-issue specifications, must, therefore, be adopted as the final guide.¹ These,

§ 665. ¹ In *Hould v. Rice* (1882), 104 U. S. 737, Matthews, J.: (740) "The principles for determining the validity of re-issued patents have been discussed and formulated so repeatedly and so recently in this court that it is necessary at present only to refer to *James v. Campbell*, *supra*, 356; *Miller v. Brass Company*, *supra*, 350; *Burr v. Duryce*, 1 Wall. 531; and *Powder Company v. Powder Works*, 98 U. S. 126. In the present case the question of the identity of the invention in the original and re-issued patents is to be determined from their face by mere comparison, notwithstanding what was said in *Battin v. Taggert* (17 How. 74), and consistently with *Bischoff v. Wethered* (9 Wall. 812), according to the rule laid down in *Seymour v. Osborne* (11 Wall. 516), and *Powder Company v. Powder Works*, *supra*. That is, if it appears from the face of the instruments that extrinsic evidence is not needed to explain terms of art, or to apply the descriptions to the subject-matter, so that the court is able from mere comparison to say what is the invention described in each, and to affirm from such mere comparison that the inventions are not the same, but different, then the question of identity is one of pure construction, and not of evidence, and consequently is matter of law for the court, without any auxiliary matter of fact to be passed upon by a jury, if the action be at law." 21 O. G. 1443 (1446).

In *Glue Co. v. Upton* (1874), 6 O. G. 837, Clifford, J.: (838) "Power to surrender patents for the purposes suggested in the act of Congress implies that the specification may be corrected to cure the defect and to supply the de-

ficiency, but interpolations in a re-issued patent of new features or ingredients or devices, which were neither described, suggested, nor substantially indicated in the original specification, drawings, or Patent Office model, are not allowed. (*Battin v. Taggert*, 17 How. 86; *O'Reilly v. Morse*, 15 How. 112; *Sickles v. Evans*, 2 Cliff. 222; *Cahart v. Austin*, 2 Cliff. 536.) Nor is parol testimony admissible in an application for a re-issue to enlarge the scope and nature of the invention beyond what was described, suggested, or substantially indicated in the original specification, drawings, or Patent Office model, as the purpose of a surrender and re-issue is not to introduce new features, ingredients, or devices into the patent, but to render effectual the actual invention for which the original patent should have been granted. Whether a re-issued patent is or is not for the same invention as the surrendered original cannot be satisfactorily determined without a comparison of the two, as the decision must necessarily depend very largely upon the question whether the specification and drawings of the re-issued patent are or are not substantially the same as those of the original, and if not, whether the changes or alterations are or are not greater than the act of Congress granting the power of surrender and re-issue allows." 4 Clifford, 237 (239); 1 Bann. & A. 497 (500).

That a re-issue cannot claim matters inconsistent with the specification, drawings, and model of the original, even though the same matters were claimed in the original patent, see *Ex parte Warren* (1876), 10 O. G. 1.

That where the original patent does

taken together and construed as mutually interpreting each other,² constitute the attempt of the inventor to disclose to others the idea of means which he has himself conceived and reduced to practice, and which he has selected as the subject-matter of his patent; and in the very nature of things this attempt must be so far successful as to afford some substantial indication or suggestion of the actual invention which is to be embraced in the proposed monopoly. An idea which the inventor is unable to express in words, or by pictorial representation, or in tangible materials, must either be so far abstract and indefinite as to lie outside the domain of the concrete industrial arts, or the inventor himself must have failed to apprehend it with that clearness and exactness which alone entitles him to claim the complete performance of an inventive act.³ Cases in which an inventor, having conceived the idea of means, having perceived it, and having reduced it to practice in a new art or instrument, honestly attempts to describe and claim it, and yet succeeds in giving no substantial indication of its character and scope, must be so rare, if in-

not describe the real invention, the remedy is by a new application and patent, not by re-issue, see *James v. Campbell* (1881), 104 U. S. 356; 21 O. G. 337; *Sarven v. Hall* (1872), 1 O. G. 437; 9 Blatch. 524; 5 Fisher, 415.

The fact that a device is not mentioned in the original is evidence that a re-issue which claims it is for a different invention, see *Campbell v. James* (1879), 18 O. G. 979; 17 Blatch. 42; 4 Bann. & A. 456.

That the question is never how the original might have described the invention but how it did describe it, see *Hammond v. Franklin* (1885), 23 Blatch. 77; 22 Fed. Rep. 833; 30 O. G. 1324.

That the article, as made by the inventor before his application, was the same as that claimed in the re-issue is of no consequence, unless it was so described in the original patent, see *Hammond v. Franklin* (1885), 23 Blatch.

77; 22 Fed. Rep. 833; 30 O. G. 1324.

That a re-issue may claim whatever clearly appears, either by the specification, drawings, or model of the original patent, to have been part of the invention it intended to protect, see *Calkins v. Bertraud* (1875), 6 Bissell, 494; 9 O. G. 795; 2 Bann. & A. 215; *Chicago Fruit House Co. v. Busch* (1871), 2 Bissell, 472; 4 Fisher, 395.

² That a re-issue can cover nothing which is not found either in the specification, drawings, or model of the original, though either of these may be aided by the others, see *Sarven v. Hall* (1872), 9 Blatch. 524; 1 O. G. 437; 5 Fisher, 415.

³ That what an alleged inventor cannot describe he cannot have invented, see *Smith v. Downing* (1850), 1 Fisher, 64; *Boulton v. Bull* (1795), 2 H. Bl. 463; 1 Abb. P. C. 59.

See also § 79 and notes, *ante*.

deed such a case is possible, that the rule is liberal enough toward any careful and diligent patentee, and no indulgence beyond this can be accorded to him without endangering the public interests and unjustly limiting the rights of subsequent inventors.⁴

§ 666. The Attempt of the Inventor to Describe and Claim the Invention may Appear either in the Original Specification, the Drawings, or the Model.

The attempt of the inventor to cover the invention by his original patent may appear either in the specification, the model, or the drawings.¹ If it were contained only in the

⁴ Rev. Stat. Sec. 4916.

That an invention cannot be added to for re-issue purposes by proof that it really included matters not shown, see *Averill Chemical Paint Co. v. National Mixed Paint Co.* (1881), 20 Blatch. 42; 22 O. G. 585; 9 Fed. Rep. 462; *Tarr v. Webb* (1872), 10 Blatch. 96; 5 Fisher, 593; 2 O. G. 568.

That a re-issue cannot be granted on proof where there are no drawings, model, or specifications to show the invention, see *Averill Chemical Paint Co. v. National Mixed Paint Co.* (1881), 22 O. G. 585; 20 Blatch. 42; 9 Fed. Rep. 462.

That a re-issue cannot contain Claims which either the patent or contemporary records show could not have been embraced in the original, see *Combined Patents Can Co. v. Lloyd* (1882), 21 O. G. 713; 11 Fed. Rep. 149; 15 Phila. 481.

That no parol proof is admissible to show that the inventor intended to describe or claim matter not indicated to some extent in his original patent, see *Tarr v. Webb* (1872), 10 Blatch. 96; 5 Fisher, 593; 2 O. G. 568; *Sarven v. Hall* (1872), 9 Blatch. 524; 1 O. G. 437; 5 Fisher, 415; *Cahart v. Austin*, (1865), 2 Clifford, 528; 2 Fisher, 543.

§ 666. ¹ That it is enough if the attempt of the inventor appears in the

drawings, though it is not shown in the specification, see *Smith v. Merriam* (1881), 19 O. G. 601; 6 Fed. Rep. 713; *Washburn & Moen Mfg. Co. v. Haish* (1880), 10 Bissell, 83; 7 Fed. Rep. 906; *Kerosene Lamp Heater Co. v. Littell* (1878), 13 O. G. 1009; 3 Bann. & A. 312; *Bantz v. Elsas* (1874), 6 O. G. 117; 1 Bann. & A. 351; *Booth v. Parks* (1874), 1 Bann. & A. 225; 1 Flippin, 381; *Swift v. Whisen* (1867), 3 Fisher, 343; 2 Bond, 115.

That the attempt may be shown only in the model of the original patent, see *Hendy v. Golden State & Miners' Iron Works* (1883), 17 Fed. Rep. 515; 8 Sawyer, 468; *Meyer v. Goodyear India Rubber Glove Mfg. Co.* (1881), 11 Fed. Rep. 891; 22 O. G. 681; 20 Blatch. 91; *Smith v. Merriam* (1881), 19 O. G. 601; 6 Fed. Rep. 713; *Ex parte Hunt* (1879), 15 O. G. 831; *Reissner v. Anness* (1877), 13 O. G. 870; 3 Bann. & A. 176; *Ex parte Baldwin* (1876), 9 O. G. 639.

That the original patent may be amended by the model in the Patent Office or by the drawings, and the model may be inspected by the court, see *Hendy v. Golden State & Miners' Iron Works* (1883), 8 Sawyer, 468; 17 Fed. Rep. 515; *Reissner v. Anness* (1877), 3 Bann. & A. 176; 13 O. G. 870.

model, and the model has since been destroyed or lost, proper proof of its existence in the model may be offered, if consistent with the original drawings and Description.² And in examining the latter for this purpose, the application for the original patent, with its various amendments and substitutions, may be consulted, as throwing light upon the actual subject-matter which the inventor did endeavor to describe.³

§ 667. How the Attempt of the Inventor to Describe and Claim the Invention Embraced in the Re-issued Patent must Appear in the Original Specification, Drawings, or Model.

The attempt of the inventor to secure by his original patent the invention claimed in the re-issue is sufficiently indicated in his original specification, drawings, or model, whenever the Patent Office or the courts, by examining them in the light of the actual invention or the perfect re-issue specification, can perceive that if the original claims and descriptions had been free from substantive defects of statement the inventions covered by the original and re-issued patents would have been identical. The Patent Office, in endeavoring to afford the inventor the widest protection to which he is entitled, may,

² That it is sufficient if the attempt to cover alleged new matter were shown only in the model of the original, though the model is now lost, see *Meyer v. Goodyear's India Rubber Glove Mfg. Co.* (1881), 20 Blatch. 91 ; 22 O. G. 681 ; 11 Fed. Rep. 891.

That a re-issue cannot include an element not found either in the drawings or specifications, simply on the ground that the model is imperfect and that this may be the missing element, see *Stockwell v. Haines* (1877), 12 O. G. 137 ; *Ex parte Seibert* (1877), 12 O. G. 268.

That a re-issue cannot wholly change the character of the original invention, from what it appears in the specification and drawings, on the strength of a feature shown in the model, see *Parker & Whipple Co. v. Yale Clock Co.* (1883),

21 Blatch. 485 ; 25 O. G. 290 ; 18 Fed. Rep. 43.

That a re-issue will not be granted for what is shown in the model, if it contradicts the drawings and specifications, see *Ex parte Hunt* (1879), 15 O. G. 831.

That the Office model alone is not sufficient basis for a new Claim in the re-issue, unless it also appears that the inventor originally intended to claim the feature in question, see *Flower v. Detroit* (1888), 127 U. S. 563 ; 43 O. G. 1348.

³ That where there have been successive applications for the original patent, these may be examined in order to ascertain what the inventor attempted to claim, see *Ex parte Sexton* (1876), 9 O. G. 251.

in certain cases, explore the history of the art to ascertain what the inventor might have claimed, and give effect to any phrases in the original description which can fairly be construed to cover it.¹ But in the courts the original specification, model, and drawings must speak for themselves, — not, of course, with perfect clearness and completeness, for then no amendment would be needed, but yet so as to render it apparent to the judicial mind, when comparing the original with the re-issue, that the inventions intended to be set forth in each patent are the same.² Thus matter mentioned in the Claims of the original but not consistent with the Description nor found either in the model or in the drawings, and matter merely alluded to as possible and useful but not suggested as a part of the invention to be patented, are alike outside the rule and cannot be embraced in the re-issue.³ But matter stated to belong to the claimed invention, or appearing

§ 667. ¹ See § 664, note 2, *ante*.

² In *Thomas v. Shoe Mach. Mfg. Co.* (1878), 16 O. G. 541, Clifford, J. : (542) "Inquiries in such a case are restricted to a comparison of the terms and import of the two patents in view of the drawings and Patent Office model. If from these it results that the invention claimed in the re-issue is not substantially different from the one described, suggested, or indicated in the specification or drawings of the original patent or Patent Office model, the re-issued patent must be held valid, as all other alterations and amendments plainly fall within the intent and purpose of the provision in the act of Congress which allows a surrender and re-issue; or, in other words, if the re-issued patent does not, upon the face of the instrument, embrace anything not substantially described, suggested, or indicated in the specifications, drawings, or model of the original, the defence that the re-issued patent is not for the same invention as the original must be overruled." 3 Bann. & A. 557 (561). See also *Heald v. Rice* (1882), 104 U. S. 737; 21 O. G. 1443; *Glue*

Co. v. Upton (1874), 6 O. G. 837; 4 Clifford, 237; 1 Bann. & A. 497; and § 664, note 2, *ante*.

That the courts will not explore the history of the art to ascertain what the inventor might have claimed and may have attempted to patent, see *James v. Campbell* (1881), 104 U. S. 356; 21 O. G. 337; *Keystone Bridge Co. v. Phoenix Iron Works* (1877), 95 U. S. 274; 12 O. G. 980.

That the original and re-issued patents are construed according to the state of the art at the date of the application for the original, see *Eachus v. Broomall* (1885), 115 U. S. 429; 33 O. G. 1265; *Garneau v. Dozier* (1880), 102 U. S. 230; 19 O. G. 61.

³ That matter appearing only in the Claim of the original patent, and not consistent with the description, cannot be regarded as belonging to the invention, see *Ex parte Warren* (1876), 10 O. G. 1.

That a re-issue cannot claim what is merely alluded to in the original as a possibility, but is not described therein as part of the invention, see *Ex parte Evans* (1873), 3 O. G. 180.

as a part thereof in the model or the drawings, although as thus described the invention is impracticable, and matter necessarily implied by what is actually described though not itself expressed in any form, are so contained in the original that an amendment by re-issue may include them.⁴ When the original patent has already been before the courts, and it has been judicially determined that its description relates to but a single form of the invention, its model, drawings, and specification must be thenceforth regarded as attempting to describe only that form of the invention, and the re-issue must be limited in a corresponding manner.⁵

§ 668. Variations between the Descriptions and Claims of the Original and Re-issued Patents not Inconsistent with Identity of Subject-Matter.

The restriction of a re-issue to the subject-matter attempted to be covered by the original patent does not require an exact correspondence between the specifications, drawings, and models of the original and re-issued patents, except in machine-patents where the model and drawings can be amended only by each other.¹ The specification of the re-issue may

⁴ That matter which as described is impracticable, may be redescribed and claimed in a practically operative form, see *Wheeler v. McCormick* (1873), 6 Fisher, 551; 11 Blatch. 334; 4 O. G. 692; *Wheeler v. Clipper Mower & Reaper Co.* (1872), 10 Blatch. 181; 6 Fisher, 1; 2 O. G. 442.

That a re-issue may include matters not described or claimed in the original patent if they were really parts of the original invention, and are necessarily implied by what was described, see *Eames v. Andrews* (1887), 122 U. S. 40; 39 O. G. 1319; *Ex parte Siemens* (1877), 12 O. G. 626.

⁵ That a re-issue, after the specification of the patent has been construed by the courts, cannot claim a different form of the invention from that held to have been described in the original, see *Cammerer v. Newton* (1879), 4 Bann. & A. 159; 16 O. G. 720.

That a re-issue may extend the patent beyond the judicial interpretation of the original Claims, see *Poppenhusen v. Falke* (1862), 5 Blatch. 46; 2 Fisher, 213.

§ 668. ¹ In *Stevens v. Pritchard* (1876), 4 Clifford, 417, Clifford, J. : (422) "Corrections may be made in such cases by the specifications, drawings, or Patent Office model, and if the alterations do not exceed what was well described before, and what is substantially suggested or indicated in the surrendered specifications, drawings, and Patent Office model, the re-issued patent cannot be held invalid upon the ground that it embodies and secures a different invention from the original." 10 O. G. 505 (507); 2 Bann. & A. 390 (395).

In *French v. Rogers* (1851), 1 Fisher, 133, Kane, J. : (138) "It is not the meaning of the law that the patent-

vary from that of the original in its language,² in its general

tee who applies for a re-issue must, at his peril, describe and claim in his new specification, either in words or idea, just what was described and claimed in his old one. His new specification must be of the same invention, and his Claim cannot embrace a different subject-matter from that which he sought to patent originally. But, unless we narrow down the correction which the statute contemplates till it becomes a mere disclaimer, it is not possible in any case to frame a correct specification which shall not be broader than the one originally filed. To supply a defect, to repair an insufficiency, is to add, — either directly, or by modifying or striking out a limitation; in either form, the effect is to amplify the proposition; in the case of a specification under the Patent Laws, it is to amplify the Description and enlarge the Claim."

That immaterial differences between the original and the re-issue, not affecting the construction or the mode of operation of the invention are permissible, see *Crandall v. Watters* (1881), 20 Blatch. 97; 21 O. G. 945; 9 Fed. Rep. 659; *McCrary v. Penna. Canal Co.* (1880), 5 Fed. Rep. 367; 14 Phila. 441; *Herring v. Nelson* (1877), 14 Blatch. 293; 12 O. G. 753; 3 Bann. & A. 55; *Glue Co. v. Upton* (1874), 4 Clifford, 237; 1 Bann. & A. 497; 6 O. G. 837; *Parham v. American Buttonhole, Overseaming, & Sewing Mach. Co.* (1871), 4 Fisher, 468.

That a re-issue may make definite what was before reached only by inference, see *Hicks v. Otto* (1884), 22 Blatch. 94; 29 O. G. 365; 19 Fed. Rep. 749.

That in the re-issue of other than machine-patents the specification may be made more certain or the Claim made to correspond with the specification, but nothing more, see *Giant Powder Co. v.*

California Powder Works (1875), 3 Sawyer, 448; 2 Bann. & A. 131.

That models and drawings in machine-patents can be amended only by each other, see *Stockwell v. Haines* (1877), 12 O. G. 137.

² In *Kerosene Lamp Heater Co. v. Littell* (1878), 3 Bann. & A. 312, Nixon, J. : (316) "It must be for the same invention; but, subject to this limitation, such changes may be introduced in the Description, specifications, or Claims, as may be deemed necessary to give validity to the invention, and protect it against infringement. Whatever is fairly indicated, either in the schedules, drawing, or model of the original, may be comprehended in the specifications and Claims of a re-issue without subjecting the patentee to the imputation of claiming more than he is entitled to." 13 O. G. 1009 (1010).

In *Herring v. Nelson* (1877), 12 O. G. 753, Johnson, J. : (755) "That in re-describing his invention the patentee is not rigidly confined to what was described before, but that he may include in the new description whatever else was suggested or substantially indicated in the old, provided it was embraced in the invention as actually made and perfected. Differences in the Description and Claims of the old and new specifications are not the tests of substantial diversity, but the Description may be varied and the Claim restricted or enlarged, provided the identity of the subject-matter of the original patent is preserved. Within this range whatever change is required to protect and effectuate the invention is allowable." 14 Blatch. 293 (300); 3 Bann. & A. 55 (62).

In *La Baw v. Hawkins* (1874), 1 Bann. & A. 428, Nixon, J. : (430) "The patentee has a right to change his modes of expressing his specifications

description of the invention,³ in its statement of the best mode

or Claims, — restricting or enlarging them, so as more fully to effectuate his intention. Variations in this respect do not make the two patents different. The precise object of the statute is to authorize such amendments. What he is not allowed to do is to interpolate into the re-issue new features and devices, which were not suggested or substantially indicated in the original specifications, drawings, models, or Claims." 6 O. G. 724 (725).

In *Aultman v. Holley* (1873), 11 Blatch. 317, Woodruff, J. : (319) "It is always to be borne in mind, in considering the validity of a re-issued patent, in the face of the objection before us, that the object of a re-issue, and the purpose of the law in permitting the surrender of a patent and a re-issue thereof, are to correct, or rather perfect, a defective or insufficient description or specification, including the Claim which the patentee makes to the devices described and which he alleges are his invention. The re-issue is, therefore, not to be tested by the mere language of the original specification, for the fact of re-issue proceeds upon the ground that such language is defective or insufficient." 6 Fisher, 534 (538) ; 5 O. G. 3 (5).

That the language of the re-issue specification may differ from that of the original, see *Dunbar v. White* (1883), 23 O. G. 1446 ; 15 Fed. Rep. 747 ; *National Pump Cylinder Co. v. Gunnison* (1883), 17 Fed. Rep. 812 ; *Davis v. Brown* (1881), 20 O. G. 1021 ; 9 Fed. Rep. 647 ; 19 Blatch. 263 ; *Pearl v. Ocean Mills* (1877), 2 Bann. & A. 469 ; 11 O. G. 2 ; *Sprague v. Adriance* (1877), 3 Bann. & A. 124 ; 14 O. G. 308 ; *Putnam v. Yerrington* (1876), 9 O. G. 689 ; 2 Bann. & A. 237 ; *Tucker v. Tucker Mfg. Co.* (1876), 2 Bann. &

A. 401 ; 4 Clifford, 397 ; 10 O. G. 464 ; *Carew v. Boston Elastic Fabric Co.* (1871), 3 Clifford, 356 ; 5 Fisher, 90 ; 1 O. G. 91.

That variances in the title, Descriptions, and Claims of the original and re-issue will not affect the latter, if the inventions are the same, see *Penna. Salt Mfg. Co. v. Thomas* (1871), 5 Fisher, 148 ; 8 Phila. 144.

That general descriptions in the original may be made definite in the re-issue if the invention is unchanged, see *St. Louis Stamping Co. v. Quinby* (1879), 16 O. G. 135 ; 4 Bann. & A. 192.

That the omission in the re-issue of ambiguous words of the original does not enlarge the invention, see *Atlantic Giant Powder Co. v. Goodyear* (1877), 13 O. G. 45 ; 3 Bann. & A. 161.

That the re-issue may contain new words or phrases more accurately descriptive of the invention, see *Draper v. Potomska Mills Co.* (1878), 13 O. G. 276 ; 3 Bann. & A. 214.

That a re-issue may omit words used in the original, see *Allen v. Blunt* (1846), 2 W. & M. 121 ; 2 Robb, 530.

That a re-issue changing one letter in name of patentee, viz., *Denchfield* to *Deuchfield*, is good, see *Bignall v. Harvey* (1880), 18 Blatch. 353 ; 18 O. G. 1275 ; 4 Fed. Rep. 334.

³ In *Potter v. Stewart* (1881), 18 Blatch. 561, Blatchford, J. : (562) "It is of no consequence that the re-issue states that certain combinations are found in the machine, which will act in a certain way and effect certain results, when the original did not state that such combinations were found there, or failed to state that said modes of operation and said results would follow, provided the said combinations in fact existed in a machine made according to the drawings and description in the original patent, or provided the

of using or constructing the invention,⁴ or in the number and

said modes of operation and the said results in fact followed in a machine so made. To supply such defects is the very object and office of a re-issue." 19 O. G. 997 (997) ; 7 Fed. Rep. 215 (216).

That identity and diversity between the original and re-issue depends on the things described, not on the mere descriptions, see *Herring v. Nelson* (1877), 3 Bann. & A. 55 ; 12 O. G. 753 ; 14 Blatch. 293.

That the description of the re-issue may be more full and accurate than the original, see *Washburn & Moen Mfg. Co. v. Haish* (1880), 19 O. G. 173 ; 10 Bissell, 65 ; 4 Fed. Rep. 900 ; *Robertson v. Secombe Mfg. Co.* (1873), 6 Fisher, 268 ; 3 O. G. 412 ; 10 Blatch. 481 ; *Crompton v. Belknap Mills* (1869), 3 Fisher, 536 ; *Poppenhusen v. Falke* (1861), 4 Blatch. 493 ; 2 Fisher, 181.

That a re-issue may describe more fully and set forth distinct functions, or those not before stated, see *Doane & Wellington Mfg. Co. v. Smith* (1882), 24 O. G. 302 ; 15 Fed. Rep. 459.

That in a re-issue enlarging the Claims, the Claims alone are involved, and if the Description covers more than the Claims it is of no consequence, see *Turner & Seymour Mfg. Co. v. Dover Stamping Co.* (1884), 111 U. S. 319 ; 27 O. G. 1131.

That a re-issue may contain a fuller description of the state of the art, of the nature of the improvement, and of the advantages secured by its use, see *Robertson v. Secombe Mfg. Co.* (1873), 3 O. G. 412 ; 6 Fisher, 268 ; 10 Blatch. 481.

That a re-issue may describe a well-known thing differently from the original, see *Tarr v. Folsom* (1874), 1 Bann. & A. 24 ; 5 O. G. 92 ; Holmes 312.

That substances directly indicated in the original may be described in the

re-issue, see *Penna. Salt Mfg. Co. v. Thomas* (1871), 5 Fisher, 148 ; 8 Phila. 144.

That the re-issue may more fully describe surrounding parts, remove false impressions, or show how difficulties may be avoided, see *Kearney v. Lehigh Valley R. R. Co.* (1887), 32 Fed. Rep. 320.

That where the original imperfectly describes what the state of the art shows to have been the real invention, the re-issue may cover it, see *Yale Lock Mfg. Co. v. Scoville Mfg. Co.* (1880), 18 Blatch. 248 ; 3 Fed. Rep. 288.

That the re-issue may describe and claim the invention either with or without the adjuncts described in the original, if the invention in both be really the same, see *National Spring Co. v. Union Car Spring Mfg. Co.* (1874), 6 O. G. 224 ; 12 Blatch. 80.

That a re-issue may redescribe the invention by the original model, drawings, or specification, but it is doubtful if it can go beyond these and include matter shown in the original application only, see *Cahart v. Austin* (1865), 2 Fisher, 543 ; 2 Clifford, 528.

⁴ In *Broadnax v. Central Stock-Yard & Transit Co.* (1880), 4 Fed. Rep. 214, Nixon, J. : (216) "Because one mode only is indicated in the original, the patentee is not shut up to the one mode in the re-issue, as long as it is not of the essence of the invention. The law, indeed, requires him to disclose some mode by which it can be rendered practically useful, but it does not follow that he is confined to that, and may use no other." 5 Bann. & A. 609 (611).

That a re-issue may point out new uses or modes of using the original invention, see *Potter v. Stewart* (1881), 19 O. G. 997 ; 7 Fed. Rep. 215 ; 18 Blatch. 561 ; *Ex parte Palmer* (1880),

scope of its Claims.⁵ The Claims, if previously too narrow,

17 O. G. 976 ; *Do Florez v. Raynolds* (1878), 14 Blatch. 505 ; 3 Bann. & A. 292 ; *Ex parte Donaldson* (1873), 4 O. G. 4.

That a mistake in the original patent, as to the effect produced by the use of the invention, may be corrected by re-issue, not by disclaimer, see *Schillinger v. Gunther* (1878), 14 O. G. 713 ; 15 Blatch. 303 ; 3 Bann. & A. 491.

That the re-issue is good though it expresses different views from the original as to which one of two modes of construction is best, see *American Nicholson Pavement Co. v. Elizabeth* (1873), 3 O. G. 522 ; 6 Fisher, 424.

That a re-issue may depart from the original in matters of mechanical adaptation, see *Decker v. Grote* (1873), 10 Blatch. 331 ; 6 Fisher, 143 ; 3 O. G. 65.

⁵ That a re-issue may explain and modify the Claims of the original, see *Smith v. Merriam* (1881), 19 O. G. 601 ; 6 Fed. Rep. 713 ; *Woodward v. Dinsmore* (1870), 4 Fisher, 163.

That the inventions may be the same though the Claims of the re-issue be entirely unlike those of the original, see *Hussey v. Bradley* (1863), 2 Fisher, 362 ; 5 Blatch. 134 ; *Hussey v. McCormick* (1859), 1 Fisher, 509 ; 1 Bissell, 300.

That the invention can be divided into distinct Claims in a re-issue, see *Brown v. Deere* (1881), 19 O. G. 361 ; 2 McCrary, 422 ; 6 Fed. Rep. 484.

That an improper multiplication of Claims in the re-issue does not affect the patent, the superfluous Claims being void, see *Dederick v. Cassell* (1881), 20 O. G. 1233 ; 9 Fed. Rep. 306 ; 14 Phila. 503.

That the re-issue may contain new Claims founded on the original Description, see *Combined Patents Can Co. v. Lloyd* (1882), 11 Fed. Rep. 149 ; 21 O. G. 713 ; 15 Phila. 481.

That a re-issue may claim matters found in the original Description though the inventor made no attempt to insert them in his Claims, see *Eickemeyer Hat Blocking Mach. Co. v. Pearce* (1873), 3 O. G. 150 ; 10 Blatch. 403 ; 6 Fisher, 219.

That a re-issue may restate the invention and claim such essential features as are not clearly stated in the original, see *Woven Wire Mattress Co. v. Wire Web Bed Co.* (1881), 8 Fed. Rep. 87.

That a re-issue may secure a different feature of the invention from the one claimed in the original patent, if it does not go beyond the invention described or suggested in the original, see *Stevens v. Pritchard* (1876), 4 Clifford, 417 ; 10 O. G. 505 ; 2 Bann. & A. 390.

That the patentee may in a re-issue claim a form of the invention described but not claimed in the original, when its importance has become apparent since the original was granted, see *Atwood v. Portland Co.* (1880), 5 Bann. & A. 533 ; 10 Fed. Rep. 283.

That where an original patent describes two forms of the invention and claims but one, the re-issue may claim the other, see *American Nicholson Pavement Co. v. Elizabeth* (1873), 6 Fisher, 424 ; 3 O. G. 522.

That the re-issue may cover the actual invention made, according to the original specification and drawings, though the specification may not have accurately described it, see *Potter v. Stewart* (1881), 7 Fed. Rep. 215 ; 18 Blatch. 561 ; 19 O. G. 997.

That a re-issue may contain new drawings based on the original specification, see *Union Paper Bag Co. v. Nixon* (1873), 6 Fisher, 402 ; 4 O. G. 31.

That the drawings of the re-issue may contain features not shown in the drawings of the original, see *Union Paper*

may be extended to embrace the entire patented invention, unless the additional features have been abandoned;⁶ or, if excessive, may be so reformed as to exclude the matter hitherto improperly embraced within the patent.⁷ But matter once described in the original specification as essential to the invention cannot be omitted;⁸ and matter once disclaimed —

Bag Co. v. Nixon (1873), 4 O. G. 31; 6 Fisher, 402.

That the drawings may be amended in matters outside the model if it does not affect the Claims of the re-issue, see *Pearl v. Appleton Co.* (1880), 3 Fed. Rep. 153.

⁶ That the Claims of a re-issue may be stated in language differing from those of the original, see *Fay v. Fraser* (1882), 11 Bissell, 422; 14 Fed. Rep. 652; *La Baw v. Hawkins* (1874), 6 O. G. 724; 1 Bann. & A. 428; *Poppenhusen v. Falke* (1862), 2 Fisher, 213; 5 Blatch. 46.

That the re-issue may cover the invention though it is broader than the patentee at first supposed, see *Tuttle v. Loomis* (1885), 24 Fed. Rep. 789; 30 O. G. 344.

That in a re-issue the Claims may be either enlarged or restricted as may be necessary to cover the actual invention, see *Dorsey Harvester Rake Co. v. Marsh* (1873), 6 Fisher, 387.

That enlarging Claims is not enlarging the invention, see *Jenkins v. Stetson* (1887), 32 Fed. Rep. 398; *Odell v. Stout* (1884), 22 Fed. Rep. 159; 29 O. G. 862.

That the re-issue may claim more than the original, see *Robertson v. Secombe Mfg. Co.* (1873), 6 Fisher, 268; 3 O. G. 412; 10 Blatch. 481.

That an element described but not claimed in the original patent, may be claimed in the re-issue, see *Loring v. Hall* (1879), 15 O. G. 471.

That a re-issue cannot claim other and distinct things from those attempted to be claimed in the original, see *Kells v. McKenzie* (1881), 9 Fed. Rep. 284; 20

O. G. 1663. See also *Am. Law Rev.* vol. xv. p. 731.

That where the original patent fully and clearly describes and claims a specific invention so as not to be invalid by reason of an insufficient specification, the re-issue cannot expand and generalize the Claims so as to go beyond the original, see *James v. Campbell* (1882), 104 U. S. 356; 21 O. G. 337; *Gill v. Wells* (1874), 22 Wall. 1; 6 O. G. 881; *Burr v. Duryee* (1863), 1 Wall. 531.

That the omission of ambiguous words in the re-issue does not enlarge it, see *Atlantic Giant Powder Co. v. Goodyear* (1877), 3 Bann. & A. 161; 13 O. G. 45.

That the opinion of the inventor, stated in the re-issue, as to the character of his invention is not improper if it does not affect the Claims, see *Reed v. Chase* (1885), 25 Fed. Rep. 94; 33 O. G. 996.

⁷ That the re-issue may be narrower than the original if the invention is unchanged, see *Gould v. Ballard* (1878), 3 Bann. & A. 324; 13 O. G. 1081.

That a re-issue need not claim all matters found in the original, see *Gould v. Ballard* (1878), 3 Bann. & A. 324; 13 O. G. 1081; *Albright v. Celluloid Harness Trimming Co.* (1877), 12 O. G. 227; 2 Bann. & A. 629; *Chicago Fruit House Co. v. Busch* (1871), 4 Fisher, 395; 2 Bissell, 472; *Crompton v. Belknap Mills* (1869), 3 Fisher, 536; *Carver v. Braintree Mfg. Co.* (1843), 2 Story, 432; 2 Robb, 141; *Knight v. Baltimore & Ohio R. R. Co.* (1840), 3 Fisher, 1; Taney, 106.

⁸ That a re-issue cannot treat as non-essential what the original treated as es-

whether during the proceedings in the Patent Office in order to avoid an interference or to overcome the objections of an examiner, or in the body of the original patent, or by a subsequent disclaimer filed to save the patent or secure the costs of suit, — cannot be reclaimed, except in cases where the party applying for and obtaining the re-issue could not, according to the principles of equity, be regarded as estopped by the disclaimer.⁹ The legal effect of such amendments, if allowed, would be an enlargement of the patented invention, and an insertion into the re-issue of features wholly distinct from or in addition to the subject of the original patent. Whatever variations may be made in the description or the Claims of the re-issue, neither directly nor indirectly can new matter be introduced into the patent,¹⁰ by embracing parts of the

essential, see *Russell v. Dodge* (1876), 93 U. S. 460; 11 O. G. 151.

That an immaterial element may be dropped in the re-issue, see *McWilliams Mfg. Co. v. Blundell* (1882), 22 O. G. 177; 11 Fed. Rep. 419; *Union Paper Collar Co. v. Van Deusen* (1872), 5 Fisher, 597; 10 Blatch. 109; 2 O. G. 361; *Woodward v. Dinsmore* (1870), 4 Fisher, 163.

That where a difference in the number or quantity of the parts of an invention does not affect its substantial character or mode of operation, a re-issue for less than the original is good, see *Coburn v. Schroeder* (1881), 20 O. G. 1524; 8 Fed. Rep. 519; 19 Blatch. 377.

That an element apparently material may be omitted in the re-issue if the essence of the invention be unchanged, see *McWilliams Mfg. Co. v. Blundell* (1882), 22 O. G. 177; 11 Fed. Rep. 419.

That the re-issue may restrict the invention by omitting minor features described in the original, see *Gould v. Ballard* (1877), 13 O. G. 1081; 3 Bann. & A. 324.

⁹ See §§ 680, 687–689, and notes, *post*.

That the re-issue is good where equity

would decree the same correction of the mistake, see *Jones v. Barker* (1882), 11 Fed. Rep. 597; 22 O. G. 771; *Miller v. Brass Co.* (1881) 104 U. S. 350; 21 O. G. 201.

¹⁰ In *Thomas v. Shoe Mach. Mfg. Co.* (1878), 16 O. G. 541, Clifford, J. : (542). “ Patents may be surrendered to be corrected, and the power to surrender implies that the specification may be corrected to the extent necessary to cure the defects and to supply the deficiencies to render the patent operative and valid; but the patentee may not interpolate new features not described, suggested, or substantially indicated either in the specification, drawings, or Patent Office model. Interpolations of the kind, if material, show that the Commissioner exceeded his jurisdiction, and where that is done it clearly becomes the duty of the court to declare the patent void.” 3 Bann. & A. 557 (560).

In *Russell v. Dodge* (1876), 93 U. S. 460, Field, J. : (463) “ And as a re-issue could only be granted for the same invention embraced by the original patent, the specification could not be substantially changed, either by the addition of new matter or the omission of important particulars, so as to enlarge

invention which the patentee did not attempt to cover by his former patent, or by reviving claims then made and since

the scope of the invention as originally claimed. A defective specification could be rendered more definite and certain so as to embrace the Claim made, or the Claim could be so modified as to correspond with the specification; but except under special circumstances, such as occurred in the case of *Lockwood v. Morey*, 8 Wall. 230, where the inventor was induced to limit his Claim by the mistake of the Commissioner of Patents, this was the extent to which the operation of the original patent could be changed by the re-issue. The object of the law was to enable patentees to remedy accidental mistakes, and the law was perverted when any other end was secured by the re-issue." 11 O. G. 151 (152).

In *Stevens v. Pritchard* (1876), 4 Clifford, 417, Clifford, J. : (421) "Surrenders are allowed in order that what was imperfect before may be made perfect, and in order that what was before ambiguous may be made clear and certain; and for that purpose the patentee may add whatever was substantially suggested or indicated in the original specifications, drawings, or Patent Office model. New features may not be introduced for the reason that every interpolation of the kind is forbidden by the act of Congress. Errors and defects may, however, be corrected under the conditions specified, and the prohibition that new features shall not be introduced must not be understood as taking away the right to include in the re-issue whatever was substantially suggested or indicated in the surrendered specifications, drawings, or Patent Office model." 10 O. G. 505 (506); 2 Bann. & A. 390 (393).

In *Salamander Felting Co. v. Haven* (1875), 3 Dillon, 131, Treat, J. : (134) "The repeated decisions by the courts,

and especially by the United States Supreme Court, in the 1st, 17th, and 19th Wallace, indicate with sufficient distinctness, that not only no new matter shall be introduced, but that an enlargement of the original Claim, growing out of the subsequent advance of the art, is not to be tolerated. The reason of the rule is obvious. Every patent as to novelty or utility depends on the state of the art at the time of the claim made or patent issued, and, therefore, if a party, after learning from a subsequent advance of the art the worthlessness of his original invention, is to be permitted to claim a re-issue incorporating what was not originally in his mind, and what had been afterwards suggested to him only by advances in the art made by others, then he could, it may be, even without any new invention, override all the elements which would serve to test the validity of the new application. In other words, having procured a worthless patent, and having subsequently learned from the advancing art how, by changing the terms of his patent, it could be made of value, he would, if a re-issue, including the new matter, were permitted, have the re-issue not only relate back to the date of the original patent, but absorb within its privileges all subsequent matters, wholly unknown to, and unthought of by him, originally. This rule controls both the Patent Office and the courts. New matter must not be introduced. By new matter is not meant merely the introduction of a new ingredient in a patented composition, but any change in the original specification and Claim whereby a new and substantially different composition and results are secured." 9 O. G. 253 (254).

Further that "new matter" cannot be embraced in a re-issued patent, see

abandoned, or by extending his description to inventions created after the original patent had been granted.

Andrews v. Hovey (1833), 5 McCrary, 181; 16 Fed. Rep. 387; 26 O. G. 1011; *Washburn & Moen Mfg. Co. v. Haish* (1880), 10 Bissell, 65; 19 O. G. 173; 4 Fed. Rep. 900; *Giant Powder Co. v. California Powder Works* (1875), 3 Sawyer, 448; 2 Bann. & A. 131; *Glue Co. v. Upton* (1874), 1 Bann. & A. 497; 4 Clifford, 237; 6 O. G. 837; *Carew v. Boston Elastic Fabric Co.* (1871), 3 Clifford, 356; 5 Fisher, 90; 1 O. G. 91.

That a re-issue blending old matter and new matter in the same Claim is void, see *Cabart v. Austin* (1865), 2 Fisher, 543; 2 Clifford, 528.

That enlarged Claims are to be carefully scrutinized to see that they contain no new matter, see *Tyler v. Welch* (1880), 17 O. G. 1508; 3 Fed. Rep. 636; 18 Blatch. 209.

That new matter cannot be inserted in the re-issue though invented by the patentee and inadvertently omitted by him from the original, see *Atwater Mfg. Co. v. Beecher Mfg. Co.* (1881), 8 Fed. Rep. 608.

That where the original patent had no model or drawing, no new matter can be inserted in the re-issue on the ground that the inventor had it in his mind when the original application was filed, see *Ex parte Dieckerhoff* (1877), 12 O. G. 429.

That the rule as to the insertion of new matter is more strict in re-issues than in amendments to applications, — the former being governed by law, the latter by the discretion of the Commissioner, — see *Ex parte Bragg* (1875), 8 O. G. 985.

That new matter is anything not embraced in the original specifications, drawings, and model, see *Dederick v. Cassell* (1881), 14 Phila. 503; 20 O. G. 1233; 9 Fed. Rep. 306.

That where the same idea is found in the original specification and drawings, there is no new matter, see *Christman v. Rumsey* (1879), 58 How. Pr. 114; 17 Blatch. 148; 17 O. G. 903; 4 Bann. & A. 506.

That "new matter" in a re-issue is such an enlargement or alteration in the original specification and Claims as to include combinations or results which did not necessarily flow from the invention as originally described, see *Putnam v. Yerrington* (1876), 2 Bann. & A. 237; 9 O. G. 689.

That "new matter" in a re-issue is such as changes the invention or introduces what might be the subject of a new patent, see *Seibert Cylinder Oil Cup Co. v. Harper Steam Lubricator Co.* (1880), 4 Fed. Rep. 328; *Powder Co. v. Powder Works* (1878) 98 U. S. 126; 15 O. G. 289.

That nothing can be regarded as "new matter" unless it affects the substance of the invention, see *Christman v. Rumsey* (1879), 17 O. G. 903; 4 Bann. & A. 506; 58 How. Pr. 114; 17 Blatch. 148; *Ex parte Carlock* (1875), 8 O. G. 191.

That where the re-issue seeks to cover an infringing device it will be closely scrutinized, but will be valid if clearly for the same invention as the original patent, see *Crompton v. Knowles* (1881), 7 Fed. Rep. 199.

That unless it clearly appears that the re-issue contains new matters, substantially different from the original, it will be held valid, see *Thomas v. Shoe Machinery Mfg. Co.* (1878), 16 O. G. 541; 3 Bann. & A. 557.

That where the Claim in the re-issue states what the original Claim must have been construed to mean, there is no new matter, see *Gold & Stock Telegraph Co. v. Commercial Telegram Co.*

§ 669. **The Re-issued Patent may Embrace all Inventions which the Original Patent Defectively or Insufficiently Described and Claimed, subject to the Rules Governing the Joinder of Inventions.**

The application of this second proposition to individual cases of re-issue would be comparatively simple and easy were every patent limited to a single invention. Then having ascertained, in view of the state of the art at the date of the original patent, what were the essential attributes of the actual invention which the patentee endeavored to secure, as indicated in his specification, the amendments necessary to set forth and claim it with completeness and exactness could be readily perceived. But under the doctrines which permit the joinder of several distinct though dependent inventions in one patent, the subject becomes more complicated. The specification of a patent may describe and claim several distinct inventions, or it may describe several and claim only a certain number of those described, or it may describe and claim but one. In determining the scope of an original patent, as a basis for its amendment by re-issue, the question as to what invention the inventor has attempted to protect must then be variously answered. When the original specification describes but one invention, this of course is the only matter that can be embraced in the re-issue. But where it has described and claimed one art or instrument, and with that also has described subordinate parts which are distinct inventions, or has set forth additional inventions dependent on or independent of the one specifically claimed, the scope permissible to the re-issue must be subjected to a different test. It cannot be assumed that the original patent attempted to protect nothing except the one invention which it claimed. Nor, on the other hand, can it be supposed that the inventor intended to embrace therein distinct inventions, whose joinder with the principal invention is

(1885), 23 Blatch. 199 ; 23 Fed. Rep. 340 ; 31 O. G. 1559.

That a re-issue is too broad only where it embraces what was not described in the original as part of the invention or being described was aban-

doned, see *Eames v. Andrews* (1887), 122 U. S. 40 ; 39 O. G. 1319.

See further as to the subject of this paragraph, § 656, note 3, and § 661 and notes, *ante*, and § 693 and notes, *post*.

prohibited by law. In such cases, if the patent does not itself indicate the contrary, there seems to be no other practicable method of construing the original patent than to regard it as an attempt of the inventor to secure not only the invention claimed, but all the new results of his inventive skill whose nature and essential attributes he has substantially indicated in his description, and which were dependent on the invention covered by his original patent; and if these have not been abandoned or disclaimed they may all be included in the re-issue.¹ It is apparently upon this method that the courts and

§ 669. ¹ Although no formal statement of this rule may be found in the reported cases, it has nevertheless been too often acted on by the courts to be disputed. The decisions cited in the subsequent paragraphs show that the test applied is not that of the presence of the subordinate or dependent inventions in the Claims of the original patent, but their capability of being claimed therein under the rules of joinder. It is taken for granted, where there are no indications to the contrary, that the patentee intended to secure by his original patent all those dependent and auxiliary inventions which he then described as resulting from his inventive act, and in the absence of any abandonment or estoppel, he is permitted to insert in his re-issue any such inventions which could lawfully have been claimed in the original. The few cases which depart from this rule are so manifestly unjust in their effect, and involve so wide a divergence from the settled principles of Patent Law, that they cannot be regarded as authority against the current practice of the Patent Office and the general position of the courts.

Within the limits of the doctrine thus declared there are, however, certain variations which deserve attention. Inventions capable of joinder may be either (1) mutually separable, or (2) mutually inseparable, or (3) one may be unable to subsist without the other though the

other, on the contrary, could independently exist. Where the inventions are mutually inseparable a patent for one impliedly covers the other and is a bar to any subsequent patent therefor. The same is true where an invention, with which another is inseparably connected, has been patented. As in both these cases the unclaimed invention must either have been within the intended scope of the original patent, or have been abandoned to the public under circumstances which prevented the public from enjoying it by reason of its connection with the matter expressly patented, it is always a fair presumption that the patentee, by describing it in his original specification, endeavored to bring it within his monopoly and consequently has a right to claim it in his re-issue. But where the inventions are mutually separable or the invention sought to be introduced into the re-issue is not inseparable from the one claimed in the original patent, no such presumption can arise. Here it was optional for the inventor to have embraced the inventions in the same or different patents, and from the fact that he describes them in connection with the invention claimed in the original, no inference can be drawn that he did not intend to abandon them to the public or to procure for them a separate patent. In these cases the validity of the Claims by which they are appropriated in the re-issue must de-

the Patent Office have proceeded in affirming or denying the correspondence of re-issues with original patents in the different classes of cases which we now are to consider.

§ 670. Re-issued Combination-Patent cannot Embrace a Combination Essentially Distinct from that Described and Claimed in the Original Patent.

Where the subject-matter of the original patent is a combination, the re-issue may always cover the same combination; in some cases, it may be extended to protect sub-combinations, and in others to secure even the elements of which the combination is composed. The identity of the combination claimed in the re-issue with that which the inventor endeavored to describe and claim in the original specification depends upon the identity of their respective elements and of the co-operative law under which they are associated.¹ If the combination claimed in the re-issue contains less than all the elements of that described in the original, or if it substitutes for any former element an act or substance which is not its true equivalent,²

pend largely on the rules followed by the Office or the courts in comparing the original and re-issued patents. If the rule stated so often by Judge Clifford is adopted, — that the re-issue is valid unless the court can see that its subject-matter was not included in the attempt of the patentee to describe and claim his invention in the original specification, — such a relation between the inventions would, in the absence of any counter indications, relieve the original and re-issued patents from any appearance of repugnancy, and warrant a decision that the claims were valid. But if the rule is, as announced in more recent decisions, that a comparison of the two patents must affirmatively show that the invention claimed in the re-issue was evidently intended by the patentee to be embraced in his original Claims, a contrary conclusion might be reached, since the relation between the inventions is not incompatible with their intentional exclusion from the original patent. See also §§ 464-466 and notes, *ante*.

That a re-issue for separate parts of the invention where the original did not contemplate them as separate inventions, is void, see *Ex parte Powell* (1878), 13 O. G. 911.

§ 670. ¹ That a combination-patent cannot be re-issued to cover a different combination or a combination embracing new elements, see *Washburn & Moen Mfg. Co. v. Fuchs* (1883), 5 McCrary, 236; 16 Fed. Rep. 661.

That a claim for a combination of parts, made in a peculiar way for a peculiar purpose, cannot be expanded by re-issue to include a combination of the same parts without limitation as to construction or uses, see *McMurray v. Malloy* (1884), 111 U. S. 97; 27 O. G. 915.

² In *Gill v. Wells* (1874), 22 Wall. 1, Clifford, J.: (24) "Very different rules, however, apply in a case where the only invention described in the original patent is the one which includes all the ingredients of the machine, provided there is no suggestion, indication, or intimation that any other invention of

or if it adds to the original elements another element per-

any kind has been made. Such a patentee as the one last mentioned may subsequently discover that he can accomplish a new and useful result by a combination embracing less than the whole number of the ingredients included in the prior patented combination, but he cannot secure the right and privilege of a patentee in the combination of the smaller number of the ingredients by a surrender of his first patent and a re-issue of the same which shall include the second combination as well as the first, because the re-issued patent in that event would not be for the same invention as the surrendered original. . . .

(27) Equivalents are doubtless allowed to a patentee or owner of the patent to shut out infringements, but the Patent Act furnishes no support to the theory that the patentee may surrender a patent for an invention consisting of a combination of old ingredients, and amend the descriptive parts of the specification by striking out the entire description of one of the ingredients of the combination and inserting in lieu thereof a full description of several other devices, without any allegation that they are the equivalents of the one whose description is stricken out, or any explanation whatever, showing the reason why the change was made." 6 O. G. 881 (884, 885).

This portion of the above opinion is sometimes referred to as denying the right to cover sub-combinations in a re-issue. But it has no bearing on that question. A combination may be composed of simple elements united under a co-operative law. Or it may be composed of sub-combinations, i. e., of groups of elements, each group being itself a complete combination and entering into co-operative union with the other groups, not as an aggregation of collective elements, but as an organ-

ism governed by its own co-operative law. A combination composed of simple elements contains no sub-combinations, but each one of its elements co-operates with every other and performs its individual and distinctive function in the combination. In such a combination no patentable subject-matter exists except the combination as an entirety and its severable elements. Any union of the elements less than the whole number constitutes a distinct combination, utterly independent of the former and outside the scope of any patent by which the former may have been protected. It is to this class of combinations and this only that the doctrine of *Gill v. Wells*, here cited, and similar decisions, can apply. A combination composed of sub-combinations, on the other hand, contains three forms of patentable matter, — the principal combination, the sub-combinations, and the elements entering into each sub-combination; and all of these are within the scope of the patent for the principal combination, and under proper circumstances may be claimed in its re-issue. But in these cases the line dividing the sub-combinations from each other must be strictly preserved. A combination of one sub-combination with a portion of another is not a part of the original invention but an entirely separate combination, introducing a new grouping of the elements and a new co-operative law. Where a combination is formed by adding a simple element to a complete sub-combination, the principal combination, the sub-combination, and the added element are the sole subjects-matter to which a patent for the principal combination can extend, and to these only while they retain their individual identity.

That a patent for a combination cannot re-issue to cover a less number of elements unless described in the original

forming a new material function in the combination,³ or if it groups the same elements under a different method of co-

as a sub-combination, see *Jenkins v. Stetson* (1887), 32 Fed. Rep. 398.

That a re-issue is void when the original was for a combination only, if it covers a lesser combination of some of the original elements and is issued within four months of the expiration of the original, see *Gage v. Herring* (1882), 107 U. S. 640 ; 23 O. G. 2119.

That a re-issue of a combination-patent is void if it omits one of the essential elements of the original invention, see *Jenkins v. Stetson* (1887), 32 Fed. Rep. 398 ; *Neacy v. Allis* (1882), 22 O. G. 1621 ; 13 Fed. Rep. 874 ; *Cammerer v. Newton* (1879), 16 O. G. 720 ; 4 Bann. & A. 159 ; *Redmond v. Parham* (1879), 16 O. G. 359.

That the re-issue of a combination-patent cannot omit one of the elements on the ground that experience has shown it to be unnecessary, see *Hale v. Stimpson* (1865), 2 Fisher, 565 ; *Vance v. Campbell* (1861), 1 Black, 427.

That an original, covering a combination of four elements, cannot re-issue as covering three only, or the combination of three with a different fourth element, see *Gill v. Wells* (1874), 22 Wall. 1 ; 6 O. G. 881.

That a re-issue is void when the original was for a combination and the re-issue is for another combination, containing only part of the elements of the former and operating in a different way, see *Johnson v. Railroad Co.* (1882), 105 U. S. 539 ; 22 O. G. 329 ; *Johnson v. Railroad Co.* (1878), 15 Blatch. 192 ; 3 Bann. & A. 428.

That when an element formerly claimed as essential is omitted, the Claim is expanded, see *Phillips v. Risser* (1885), 26 Fed. Rep. 308.

That if an inventor allows his solicitor to describe an element as essential and the patent so to issue, he is bound

by it and cannot re-issue to exclude that element, see *Holt v. Keeler* (1882), 21 Blatch. 68 ; 22 O. G. 1291 ; 13 Fed. Rep. 464.

That a combination-patent cannot be re-issued, after fifteen years, so as to drop elements described as essential in the original, and so cover a different invention, see *Johnson v. Railroad Co.* (1882), 105 U. S. 539 ; 22 O. G. 329.

That the re-issue of a combination-patent cannot substitute another element for one of those contained in the original, unless the substituted element be a mere equivalent, see *Blackman v. Hibbler* (1879), 17 Blatch. 333 ; 4 Bann. & A. 641 ; 17 O. G. 107 ; *Gill v. Wells* (1874), 22 Wall. 1 ; 6 O. G. 881 ; *National Spring Co. v. Union Car Spring Mfg. Co.* (1874), 6 O. G. 224 ; 12 Blatch. 80 ; *Decker v. Grote* (1873), 3 O. G. 65 ; 10 Blatch. 331 ; 6 Fisher, 143 ; *Gallahue v. Butterfield* (1872), 10 Blatch. 232 ; 2 O. G. 645 ; 6 Fisher, 203.

³ In *Washburn & Moen Mfg. Co. v. Fuchs* (1883), 16 Fed. Rep. 661, Treat, J. : (668) "The attempt to justify the re-issued patent of May 12, 1874, by invoking the prior application, October 27, 1873, for the patent of November, 1874, falls within the reasoning of the United States Supreme Court, 11 Wall. 516 ; the statement wherein is the *converse* of that now under review. That court said: 'Where the thing patented is an entirety, consisting of a single device or combination of old elements incapable of division or separate use, the respondent cannot escape the charge of infringement by alleging or proving that a part of the entire thing is found in one prior patent or printed publication, or machine, and another part in another prior exhibit, and still another part in a third one, and from the three or any greater num-

operation, — the re-issue has departed from the original patent and cannot be sustained. But if the actual nature of the combination is unchanged, the re-issue may vary widely from the original in its statement of the invention as well as in its Claims.⁴ Non-essential parts which the original specification erroneously described as entering into the combination may be omitted, or equivalents for any of the elements may be introduced, their equivalence being duly pointed out in the re-issue specification.⁵ Though the original purports to describe the invention as a single article, yet if it be a true combination, as shown upon the face of that description, the re-issue may claim it according to its proper character.⁶ But a suggestion, in a patent for an element or a sub-combination, that it is capable of use when combined with others also named, without substantially indicating the nature and essential fea-

ber of such exhibits draw the conclusion that the patentee is not the original and first inventor of the patented improvement.' If this be true as to the nature of a combination when an infringer seeks to defeat the same, why is it not equally true where a re-issue is sought to be upheld, under an original patent, by importing into the re-issue devices not suggested in the original, making thereby a new combination, distinct from the original? In other words, the re-issue must be confined to the original 'combination,' and cannot be expanded to make a new combination by introduction therein of devices, new or old, not included in or suggested by the original. *Munson v. Gilbert & Barker Manuf'g. Co.*, 3 Bann. & A. 595. It must be borne in mind that the court is dealing with a 'combination' patent, and that under pretence of a re-issue a new combination cannot be upheld." 5 McCrary, 236 (245). See also *Hayes v. Bickelhaupt* (1885), 32 O. G. 133; 23 Fed. Rep. 183.

⁴ That where the original patent describes and claims two elements, either of which is the equivalent of both, the re-issue may claim either alone, see *Gal-*

lahue v. Butterfield (1872), 6 Fisher, 203; 10 Blatch. 232; 2 O. G. 645.

That where an original patent described and claimed a certain element having two specific properties, which properties constituted the value of that element in the combination, the re-issue may claim any other element then known which had the same properties, see *Dunbar v. White* (1881), 4 Woods, 116; 23 O. G. 1446; 15 Fed. Rep. 747.

⁵ That a re-issue of a combination-patent may omit one or more of the non-essential features described in the original, see *Parham v. American Buttonhole, Overseaming, & Sewing Mach. Co.* (1871), 4 Fisher, 468.

That if such non-essential feature were, however, claimed as an essential element the mistake is irremediable, see §§ 278, 282, 527, and notes, *ante*.

That equivalents may be introduced by the re-issue, provided their equivalence is pointed out in the re-issued patent, see *Gill v. Wells* (1874), 22 Wall. 1; 6 O. G. 881.

⁶ That where the original patent covers an "article" the re-issue may claim it as a combination, see *Middletown Tool Co. v. Judd* (1867), 3 Fisher, 141.

ures of the resulting combination, does not warrant a re-issue covering such combination.⁷

§ 671. Re-issued Combination-Patent may Embrace Sub-Combinations.

When the original patent describes and claims only the combination, but at the same time in its model, drawings, or specifications substantially sets forth any or all of the various sub-combinations which enter into the principal invention, these may be claimed in the re-issue, if not before abandoned or disclaimed, provided they originated from the inventive genius of the same inventor.¹ That the entire combination described

⁷ That where the original merely suggests that the invention can be used with certain other devices, the re-issue cannot claim the combination of the invention with such devices, see *Ex parte Wooten* (1873), 3 O. G. 521.

§ 671. ¹ In *Christman v. Rumsey* (1879), 17 Blatch. 148, Blatchford, J. : (155) "Under the decision in *The Corn Planter Patent* (23 Wallace, 181), which was subsequent to that in *Gill v. Wells*, the re-issue in the present case cannot be held to be void. The drawings of the original and the re-issue being the same, and the two specifications describing the same mechanical structure, with the same mode of operation, it must be held to be lawful to re-issue the patent with Claims to combinations of fewer elements than were contained in the combination claimed in the Claim of the original patent. The original claimed a general and larger combination, and the re-issue claims sub-combinations which enter into such general and larger combination. Such a re-issue was sustained in *The Corn Planter Patent*, on the ground that the re-issue was for things contained within the apparatus described in the original patent, and against the effort to control the case by the decision in *Gill v. Wells*." 17 O. G. 903 (905) ; 58 How. Pr. 114 (123) ; 4 Bann. & A. 506 (513).

In *Herring v. Nelson* (1877), 12 O. G. 753, Johnson, J. : (756) "But upon the doctrine of these cases in respect to actions for infringements, it is sought to establish a distinction between patents for combinations of old elements and all other patents in regard to re-issues, and to deny the power to re-issue such a patent for a combination of any fewer elements than were contained in the original combination. Now the Patent Act makes no such distinction. Its terms are general and relate alike to all patents. The position is set up and rests upon this argument, viz., the re-issue must be for the same invention. This consists in the combination, which disappears when one element is omitted. But this argument, true or unsound, does not apply to a case in which among the old elements some are single and some are sub-combinations entering into the general and larger combination." 14 Blatch. 293 (303) ; 3 Bann. & A. 55 (65).

In *Pearl v. Ocean Mills* (1877), 11 O. G. 2, Shepley, J. : (4) "When in the specification of the original patent the inventor describes a new and useful combination of a number of ingredients, performing in combination certain functions less than he has claimed, he may in the re-issue claim such combination of the less number which he has de-

and claimed in the original was impracticable does not prevent such a re-issue for the sub-combinations if, as suggested in the original patent, these are practically operative arts or instruments, and the re-issue indicates how each one may

scribed, suggested, or substantially indicated as his invention, but failed to include in his Claims; and the re-issue need not describe it in the exact language of the original, but may contain a more full and exact description of the same invention, imperfectly described in the original. There is nothing in the decision in *Wells v. Gill* in conflict with this statement of the principle of Patent Law." 2 Bann. & A. 469 (475).

In *Gill v. Wells* (1874), 22 Wall. 1, Clifford, J. : (24) "Cases arise where a patentee, having invented a new and useful combination consisting of several ingredients which in combination compose an organized machine, also claims to have invented new and useful combinations of fewer numbers of the ingredients; and in such cases the law is well settled that if the several combinations are new and useful, and will severally produce new and useful results, the inventor is entitled to a patent for the several combinations, provided that he complies with the requirement of the Patent Act and files in the Patent Office a written description of each of the alleged new and useful combinations, and of the manner of making, constructing, and using the same. He may give the description of the several combinations in one specification, and in that event he can secure the full benefit of the exclusive right to each of the several inventions by separate Claims referring back to the Description in the specification; and if by inadvertence, accident, or mistake, he should fail to claim any one of the described combinations, he may surrender the original patent and have a re-issue not only for the combination or combinations claimed in the original, but for any which were so omitted

in the Claims of the original patent." 6 O. G. 881 (884).

Further, that sub-combinations, if shown in the original patent, and invented by the same inventor, may be claimed in the re-issue, see *Jenkins v. Stetson* (1887), 32 Fed. Rep. 398; *Hubel v. Dick* (1886), 24 Blatch. 59; 28 Fed. Rep. 132; 36 O. G. 939; *Odell v. Stout* (1884), 22 Fed. Rep. 159; 29 O. G. 862; *Dederick v. Cassell* (1881), 14 Phila. 503; 9 Fed. Rep. 306; 20 O. G. 1233; *Kerosene Lamp Heater Co. v. Littell* (1878), 13 O. G. 1009; 3 Bann. & A. 312; *Turrell v. Spaeth* (1878), 14 O. G. 377; *Miller v. Bridgeport Brass Co.* (1877), 12 O. G. 667; 14 Blatch. 282; 3 Bann. & A. 20; *Stevens v. Pritchard* (1876), 4 Clifford, 417; 10 O. G. 505; 2 Bann. & A. 390.

That where the sub-combinations claimed in the re-issue were shown in the original and the re-issue is applied for within six months after the grant of the original, inadvertence or mistake need not be specially proved, the speedy application being sufficient evidence thereof, see *Jenkins v. Stetson* (1887), 32 Fed. Rep. 398.

That where the original patent suggested only the combination it cannot re-issue to embrace sub-combinations, see *Washburn & Moen Mfg. Co. v. Fuchs* (1883), 5 McCrary, 236; 16 Fed. Rep. 661; *Turrell v. Bradford* (1883), 15 Fed. Rep. 808; 23 O. G. 1623; *Miller v. Bridgeport Brass Co.* (1877), 12 O. G. 667; 14 Blatch. 282; 3 Bann. & A. 20; *Gill v. Wells* (1874), 22 Wall. 1; 6 O. G. 881.

As to the joinder of a combination with its sub-combinations, see §§ 472, 528, and notes, *ante*.

be practically used ;² for every sub-combination is a distinct invention which might have been protected under the original patent, and which does not forfeit its protection by having been joined with another invention, whose unpatentability has been demonstrated by experience. In its description of such

² In *Wheeler v. Clipper Mower & Reaper Co.* (1872), 10 Blatch. 181, Woodruff, J. : (186) "The claim that the original patent of 1854 was void because the invention therein described was not susceptible of being reduced to practical operation gains its importance to this controversy from the inference sought to be drawn therefrom, namely, that the several re-issues are therefore void. These suits are not founded on the original patent, but on the re-issues ; and the claim is that, if the original patent was void because the machine therein described was not capable of reduction to practical use, therefore the re-issues are themselves void. If the premise were here conceded, I do not think that the inference necessarily follows. For example, suppose an inventor of several distinct new devices, or of several new combinations, each capable of being usefully employed in and towards a machine or various machines, and that their separate construction and mode of operation is fully apprehended, and the distinct office or function of each is appreciated, such inventor may, undoubtedly, have a patent for each. Suppose, now, he erroneously conceives that he has arranged a combination of all of them, or a combination of all of them with other known devices, so as to produce a new and useful machine, and for such a machine he applied for and obtains a patent, describing and illustrating all the several new devices or separate combinations of devices, their construction, and operation, but claiming only the aggregate machine. Such aggregate machine may be utterly useless ; the patentee is wholly mistaken in regard to the practical operation of

the whole ; it will not produce the result for which it was intended, nor, in its aggregate form, any other useful result. Does the inventor, in such case, lose the benefit of his skill and ingenuity in producing devices, or combinations of devices, which are of practical value, because he first sought his patent in the form of a useless or impracticable combination ? I apprehend not. He may surrender his original patent and have it re-issued in parts, which shall claim the respective new and useful devices or combinations of devices, pointing out, of course, in his specification, some mode or manner in which they may be reduced to practical use and value. He might have done this in his original patent, and claimed each separate new device as his invention. Not having done so, he may do so in his application for re-issues and his specifications therein ; and the fact, if it be true, that his original patent was defective, because he claimed therein the aggregate combination, and that a useless or impracticable one, no more impairs the validity of the re-issues than any other defect or invalidity which makes a surrender and re-issue necessary to protect the device or devices which are useful, and which were in fact invented." 6 Fisher, 1 (18) ; 2 O. G. 442 (444).

See also *Wheeler v. McCormick* (1873), 6 Fisher, 551 ; 11 Blatch. 334 ; 4 O. G. 692.

So far as the decisions in the above cases assume that the re-issue may embrace sub-combinations or elements which the patentee did not intend and attempt to protect by the original, they are, of course, erroneous.

sub-combinations the re-issue may follow or depart from the language used in the original,—the identity of the sub-combination, both as to its elements and its co-operative law, being, however, always preserved.

§ 672. **Re-issued Combination-Patent may Embrace the Elements of the Combination.**

The re-issue of a patent for a combination may embrace such of its essential elements as are substantially indicated in the original specification, drawings, or model, and were the inventions of the same inventor.¹ As every element of a combination is in itself an operative means, and not a mere part of some patentable article or art, it is a distinct invention and could have been protected by a patent issued for itself alone. Its joinder with the combination in the original patent would have been legitimate, since the inventions are dependent; and hence it may be covered by the re-issue, even although the combination may not actually have been entitled to protection.² The re-issue cannot depart from the original as to the essential character therein given to the element, whatever variation in its language may be permitted; and if the original treats one form of the element as necessary to

§ 672. ¹ In *Wheeler v. Clipper Mower & Reaper Co.* (1872), 10 Blatch. 181, Woodruff, J.: (186) "The original patent embraced, as an aggregate combination, several parts of the entire machine described in the specification, and claimed such aggregate as the invention of the complainant. These parts were all shown in the specification, drawings, and models. I know of no rule which forbids the inventor, who has omitted to claim separate new devices, or severable and distinct combinations, in the original patent, making a surrender, and taking re-issues for the distinct combinations or separate devices. From the fact of surrender and re-issue it is to be inferred that the original patent did not secure to the patentee all that he claims in the re-issue; but that alone does not render the re-issue void. If the devices covered by

the re-issues were, in fact, new and useful, and if they are shown in the original specification, drawings, or model, then the patentee is entitled to secure the exclusive use of each separately, by a re-issue embracing each." 6 Fisher, 1 (18); 2 O. G. 442 (443).

That the re-issue of a combination-patent may cover its elements, see *Smith v. Merriam* (1881), 19 O. G. 601; 6 Fed. Rep. 713; *Gallahue v. Butterfield* (1872), 6 Fisher, 203; 10 Blatch. 232; 2 O. G. 645; *Chicago Fruit House Co. v. Busch* (1871), 4 Fisher, 395; 2 Bissell, 472; *Batten v. Taggart* (1854), 17 How. 74.

² That where the patented combination is impracticable, a re-issue for its elements, if described in the original, may be obtained, see *Wheeler v. Clipper Mower & Reaper Co.* (1872), 10 Blatch. 181; 6 Fisher, 1; 2 O. G. 442.

its performance of its elemental functions in the combination, the re-issue must adhere to that form, though other forms adapting it to other uses and positions are more valuable.³ But when form is not made material by the original description, the re-issue may claim all forms of the element; or when the original describes an element as consisting in a class of acts or substances, the re-issue may confine the element to any single member of that class.⁴ The right to thus bring individual elements within the operation of the patent by re-issue does not authorize the inventor to claim in it any grouping of elements which the original did not describe as a sub-combination.⁵ If any individual element has been disclaimed, unless by mere mistake, the combination-patent cannot be re-issued to reclaim it.⁶

³ That where the original patent is for a combination, one part of which is of peculiar shape so as to serve certain purposes, it cannot be re-issued to cover all shapes of this part whether they serve such purposes or not, see *McMurray v. Mallory* (1884), 111 U. S. 97; 27 O. G. 915.

⁴ That where the original patent describes one form of an element in a combination, the re-issue may cover all forms of the element, unless form was material, see *Gong Bell Mfg. Co. v. Clark* (1878), 13 O. G. 274; 3 Bann. & A. 211.

That where the original patent claimed the use of an entire class of substances as a step in the process, the re-issue may confine the Claim to the use of any particular substance of that class, see *St. Louis Stamping Co. v. Quinby* (1879), 4 Bann. & A. 192; 16 O. G. 135.

⁵ In *Matthews v. Machine Co.* (1882), 105 U. S. 54, Bradley, J. : (57) "But the complainants, in their re-issued patent, have split up and divided the elements of their invention, and claimed them separately, and not as a combination. Of course, this enlarges the scope of their patent. The separate Claims embrace fewer elements in combination

than were embraced in the Claim of the original patent. No one could infringe the original patent unless he used all the elements of the combination. Any one will infringe the re-issue who uses any of those elements which are now separately claimed." 21 O. G. 1349 (1350). See also *Bantz v. Frantz* (1882), 105 U. S. 160; 21 O. G. 2037; *Gill v. Wells* (1874), 22 Wall. 1; 6 O. G. 881.

That a combination-patent cannot re-issue to cover the separate elements after unreasonable delay, see *Archer v. Arnd* (1887), 31 Fed. Rep. 475; 40 O. G. 1032; *Bantz v. Frantz* (1882), 105 U. S. 160; 21 O. G. 2037.

That elements shown in the original drawings only as a connected portion of the mechanism, and so described, cannot be claimed on the re-issue as an invention, see *Ives v. Sargent* (1887), 119 U. S. 652; 38 O. G. 781.

That a re-issue covering additional elements in a combination is improper, see *Hubel v. Dick* (1886), 28 Fed. Rep. 132; 36 O. G. 939; 24 Blatch. 59.

⁶ That where an original patent claimed a series of dies and disclaimed them as separate devices, the re-issue cannot claim them separately, see *At-*

§ 673. **Re-issued Generic Patent may Embrace One Species:
When Re-issued, Species Patent may Embrace the
Genus.**

The relation subsisting between a generic invention and each of the species falling within that genus also leads to certain peculiar modifications of this rule. A generic invention is distinct from each of the specific inventions which it embraces, and each of these specific inventions is equally distinct from every other. Yet inasmuch as a generic invention cannot be fully described without delineating at least one of its included species, the joinder of a single specific invention with the generic is permitted in a patent for the latter. In the re-issue of a generic patent, therefore, the species which the original describes and which might have appropriately been claimed therein may be protected. But if the specification of the original generic patent describes two or more species, one only can be claimed in the re-issue, as only one could have been joined with the generic in the original. An unwise joinder of particular species with the genus in the prior patent cannot be remedied by a re-issue. Where the original describes two or more species with their genus, and claims the genus and one species, its re-issue cannot claim the genus and a different species. The abandonment of the former species, and the substitution for it of the latter, would be an entire departure from the specific invention which the inventor first attempted to secure, and thus would introduce into the re-issued patent such new matter as the rule peremptorily forbids.¹ A patent for a specific invention cannot re-

water Mfg. Co. v. Beecher Mfg. Co. (1881), 8 Fed. Rep. 608.

See also §§ 680, 687-689, and notes, *post*.

As to the joinder of a combination with its elements, see §§ 472, 528, and notes, *ante*.

§ 673. ¹ In *Ex parte McClintock* (1880), 17 O. G. 267, Paine, Com. : (271) "An applicant who makes a generic invention, which he illustrates by describing two species, may, by inadvertence, accident, or mistake, join

with his generic Claim the specific Claim which subsequently proves least desirable. But this is not the inadvertence, accident, or mistake for which the law provides a remedy by re-issue. That provision is not for the case in which the applicant, having the power to choose, selects the wrong invention, but for the case in which he imperfectly describes or claims the right invention. The inventions covered by a generic and specific Claim are distinct, although dependent, inventions. The only ground

issue to embrace the generic, for these are not only distinct inventions, but as the genus covers all possible species, the re-issue would indefinitely extend the scope of the original patent beyond the invention which it first attempted to protect.² An exception is allowed in favor of the inventor of the genus who described and claimed it in his application for the original patent, but was compelled without his fault to forego his claim and accept a patent for the specific invention alone. On the discovery of the error he is entitled to amend his patent by the insertion of the generic invention both in his Description and his Claims.³

§ 674. Re-issued Patent for an Art may Embrace the Same Art, and sometimes the Apparatus or the Product.

The re-issue of a patent for an art or process, whether composed of one or many different acts and operations, must be confined to the same acts and operations which constitute the essential features of the original invention. No new act can be added; no former operation, which has been described and claimed as necessary to the art, can be omitted.¹ Im-

on which one specific Claim can be joined in the same patent with a generic Claim is that the applicant, in order to support his generic Claim, must describe some one of the species, and may claim what he must describe. If he describes several species, as he is permitted but not required to do, and, by inadvertence, accident, or mistake, selects the wrong species, such inadvertence, accident, or mistake consists, not in an imperfect specification or Claim of either of the inventions, but merely in joining in the dual patent the wrong inventions. The remedy for such an error is not to be found in the substitution of another specific invention in the dual patent by a re-issue, but must be sought in an original patent granted on a new application."

That where the original patent describes only one species of a certain genus, it cannot re-issue to cover another

species of the same genus, see *Ex parte McClintock* (1880), 17 O. G. 267.

That where two species were described and but one claimed, and the other species was then struck out of the Description, the specification was still sufficient and required no re-issue, see *Ex parte Ewart* (1880), 17 O. G. 448.

² That a patent for the species cannot re-issue to cover the genus, see *Ex parte Waters* (1875), 8 O. G. 399.

³ That generic Claims may be inserted in the re-issue though they were struck out of the original application, see *Ex parte Ewart* (1880), 17 O. G. 448.

As to the joinder of generic and specific inventions, see §§ 535, 536, and notes, *ante*.

§ 674. ¹ That a re-issue may contain a full description of processes only adverted to in the original, see *Goodyear Dental Vulcanite Co. v. Smith* (1874),

material steps may be abandoned, or equivalents introduced, and such variations in their order be directed as are not inconsistent with the original specification.² When the art as set forth in the original patent is a combination, its sub-processes and elements may be claimed in the re-issue, if they were first devised by the inventor of the art, were indicated in the original specification, and have not lost their patentable character by his disclaimer or abandonment. Besides the art itself, the re-issue may in certain cases cover the apparatus it employs or the product in which it results. Where these have been invented by the same inventor, have been sufficiently described in the original specification, and have neither been abandoned nor disclaimed, the right to cover them by the re-issue depends on their relation to the art, and the propriety of joining them therewith in the original patent. Thus where the process cannot be performed without the apparatus mentioned, or the product uniformly follows the employment of the process, the inventions are inseparably connected with each other, and the product or the apparatus may be covered by a re-issue of the patent for the art.³

5 O. G. 585; Holmes, 354; 1 Bann. & A. 201.

That a re-issue of a patent for a process cannot add a new step, see *American Middlings Purifier Co. v. Atlantic Milling Co.* (1879), 4 Bann. & A. 148; 15 O. G. 467; 5 Dillon, 127.

² That the re-issue of a patent for a process may omit some of the steps described in the original, if the process remains substantially the same, see *Ex parte Wooten* (1872), 3 O. G. 521.

That where an original, in describing a process, mentioned one material which does not answer the purpose, the re-issue may describe another material of the same class which will serve the same desired end, if it had been used by the inventor before his original application for a patent, see *Ex parte Mayall* (1873), 4 O. G. 582.

³ That a process and its apparatus may be claimed in the same patent

where the process is not the mere function of the apparatus, see § 473, and notes, *ante*.

That an original for a "method of doing" a thing may re-issue for the thing done, the inventions being the same, see *Washburn & Moen Mfg. Co. v. Haish* (1880), 19 O. G. 173; 4 Fed. Rep. 900; 10 Bissell, 65.

That where the original describes both process and product, but claims the process only, it may re-issue to cover the product also, see *Tucker v. Dana* (1881), 7 Fed. Rep. 213; *Anilin v. Hamilton Mfg. Co.* (1878), 13 O. G. 273; 3 Bann. & A. 235; *Goodyear v. Wait* (1867), 5 Blatch. 468; 3 Fisher, 242.

That a re-issue for a product is void, where the original was for the process, unless the use of the process always results in the product, and thus both are but one invention, see *Powder Co. v.*

§ 675. Re-issued Patent for a Machine may Embrace the Same Machine, and sometimes the Product, but not the Process.

The re-issue of a patent for a machine, if the machine be not a combination, must be limited to the same parts or their equivalents associated under the same structural law.¹ The re-issue may vary from the original in matters of mechanical adaptation, and may cover any mode of using the machine which has been properly indicated in the former specification.² When the machine is a combination, the re-issue may embrace such of its elements and sub-combinations as are suggested in the original description, if not abandoned or disclaimed, and if due to the inventive genius of the same inventor. A machine-patent cannot, however, be re-issued to include a process which consists in the mere use of the machine, nor a process in which the patented machine performs a necessary though subordinate part. The former is the function of the machine, and though protected by the patent for the machine is not itself a patentable subject-matter. The latter is an invention far broader than the mechanical devices it employs, and though not independent of them, lies outside the scope of any patent which has been originally confined to them. Thus while an original patent for an art

Powder Works (1878), 98 U. S. 126 ; 15 O. G. 289.

That a re-issue cannot cover a product and a process unless both have been substantially described in the original, see *Penn. Salt Mfg. Co. v. Thomas* (1871), 8 Phila. 144 ; 5 Fisher, 148.

That an original patent confined to a product produced by one process only cannot re-issue to cover the product, however produced, see *Vacuum Oil Co. v. Buffalo Lubricating Oil Co.* (1884), 20 Fed. Rep. 850 ; 22 Blatch. 266 ; 28 O. G. 1101.

That a patent for a process cannot re-issue after four years to cover the product also, see *Union Tubing Co. v. Patterson Co.* (1885), 23 Fed. Rep. 79.

As to the joinder of a process with

its product or apparatus, see §§ 472, 529, and notes, *ante*.

§ 675. ¹ That a re-issue can substitute a device for one employed in the original where they are equivalents, and not otherwise, see *Tucker v. Tucker Mfg. Co.* (1876), 10 O. G. 464 ; 2 Bann. & A. 401 ; 4 Clifford, 397 ; *National Spring Co. v. Union Car Spring Mfg. Co.* (1874), 6 O. G. 224 ; 12 Blatch. 80 ; *Decker v. Grote* (1873), 3 O. G. 65 ; 10 Blatch. 331 ; 6 Fisher, 143.

² That a re-issue may claim modes of constructing or operating a machine, where such modes were described, though not claimed, in the original, see *Morris v. Royer* (1867), 3 Fisher, 176 ; 2 Bond, 66.

might be re-issued to embrace any machine which it may use without enlarging the original invention, no patent for a machine could be re-issued to include the process without extending the protection of the patent to new matter which the original patent neither intended nor attempted to secure.⁸

⁸ In *Wing v. Anthony* (1882), 106 U. S. 142, Woods, J. : (145) "It is quite clear that the original patent covers a mechanism to accomplish a specific result, and that the re-issued patent covers the process by which that result is attained, without regard to the mechanism used to accomplish it. The re-issue is, therefore, much broader than the original patent, and covers every mechanism which can be contrived to carry on the process. In the case of *Powder Company v. Powder Works*, 98 U. S. 126, it was held by this court that when original letters-patent were taken out for a process, the re-issued patent would not cover a composition unless it were the result of the process, and the invention of one involved the invention of the other. The converse of this proposition was decided by this court in *James v. Campbell*, 104 Id. 356. In that case the court said that a patent for a process and a patent for an implement or a machine are very different things, and decided, in substance, that letters-patent for a machine or implement cannot be re-issued for the purpose of claiming the process of operating that class of machines, because, if the claim for the process is anything more than for the use of the particular machine patented, it is for a different invention. To the same effect precisely is the case of *Heald v. Rice*, Id. 737. The present case falls within the rule laid down in the authorities cited."

In *James v. Campbell* (1881), 104 U. S. 356, Bradley, J. : (376) "A patent for a process and a patent for an implement or a machine are very different things. (*Powder Company v. Powder Works*, 98 U. S. 126.) Where a

new process produces a new substance, the invention of the process is the same as the invention of the substance, and a patent for the one may be re-issued so as to include both, as was done in the case of Goodyear's vulcanized-rubber patent. But a process and a machine for applying the process are not necessarily one and the same invention. They are generally distinct and different. The process or act of making a postmark and cancelling a postage-stamp by a single blow or operation, as a subject of invention, is a totally different thing in the Patent Law from a stamp constructed for performing that process." 21 O. G. 337 (343).

That where the original is for a machine and the re-issue for a process, there is *prima facie* a departure, see *Eachus v. Broomal* (1885), 115 U. S. 429 ; 33 O. G. 1265.

That where the original patent is for a machine, it cannot re-issue to cover the process performed by the machine, though the process were described in the original, see *Ex parte Pfaudler* (1882), 22 O. G. 1881 ; *Brainard v. Cramme* (1882), 20 Blatch. 530 ; 22 O. G. 769 ; 12 Fed. Rep. 621 ; *Heald v. Rice* (1882), 104 U. S. 737 ; 21 O. G. 1443 ; *New v. Warren* (1882), 22 O. G. 587 ; *Ex parte Hicks* (1879), 16 O. G. 546.

That a re-issue is void where the original patent was for a machine which accomplishes two purposes, one intended, and the other neither intended nor expected, by the inventor, and the re-issue covers the process performed by the machine in effecting the latter purpose, see *Ex parte Seibert* (1879), 16 O. G. 262.

The product of a machine, if inseparably connected with it and otherwise within the rule of joinder so often stated, may also be claimed in the re-issue.⁴

§ 676. Re-issued Patent for a Manufacture may Embrace the Same Manufacture, and Sometimes the Process or the Apparatus.

An original patent for a manufacture can be re-issued only for the same concrete instrument, or for inventions upon which the production of such manufacture may depend. Whatever essential characteristics have been attributed to the manufacture in the original specification must be found in it as described and claimed in the re-issue; and through all variations of language, and all substitutions of equivalents, the identity of the invention must be distinctly traceable.¹ If it were first described as resulting from certain processes and possessing certain properties, the re-issue cannot depart from this delineation by ascribing it to different processes, or attributing to it other properties due to changes in the mode by which it is produced.² But new methods of applying it to practical use or new connections in which it may be employed can be disclosed, since these involve no alteration in the nature of the invention itself.³ Where a manufacture

⁴ That a re-issue cannot claim the occasional result of the device shown in the original, see *Ex parte Seibert* (1877), 12 O. G. 268.

As to the joinder of a machine with its process or product, see §§ 474, 530, and notes, *ante*.

§ 676. ¹ That where an original patent was for an article in a particular form, a re-issue claiming it under whatever form is void, see *Campbell v. Kavanaugh* (1882), 20 Blatch. 256; 11 Fed. Rep. 83; *N. Y. Bung & Bushing Co. v. Hoffman* (1881), 20 Blatch. 3; 20 O. G. 1451; 9 Fed. Rep. 199.

² That a re-issue cannot claim a product however made, when the original claimed it only as made in a certain way, see *Vacuum Oil Co. v. Buffalo Lubricating Oil Co.* (1884), 22 Blatch.

266; 28 O. G. 1101; 20 Fed. Rep. 850.

That where the original patent is for a product as resulting from a certain process, it cannot be re-issued to cover the same product when resulting from different processes and containing not only some of the qualities of the old product but also new qualities not contained in the old product or producible by the old process, see *Cochrane v. Anilin* (1884), 111 U. S. 293; 27 O. G. 813.

³ That a re-issue for a device is good though the machine to which the device is to be applied is differently described in the original, see *Aultman v. Holley* (1873), 5 O. G. 3; 6 Fisher, 534; 11 Blatch. 317.

That a patent for a new device, as

and a machine or process which produces it are inseparable, an original patent for the manufacture may re-issue to protect also the process or machine.⁴

§ 677. Re-issued Patent for a Composition may Embrace the Same Composition, and sometimes the Ingredients, the Process, or the Apparatus.

A composition of matter being always a true combination, the patent in which it is originally described can re-issue only for the same or equivalent ingredients, united by the same or equivalent modes of intermixture, and resulting in a compound possessing the same or equivalent properties.¹ Substances which are not ingredients, though described in the original as entering into the composition, may be omitted or others may be added without disturbing the identity of the invention, and variations in the mode of intermixture, which do not alter its substantial character, may be introduced.

adapted to one machine, cannot re-issue for the same device as adapted to other and non-analogous machines, but such device must be the subject of a new patent, see *Holmes v. Plainville Mfg. Co.* (1881), 20 Blatch. 123; 9 Fed. Rep. 757.

⁴ That where the original invention was a new product resulting from a new process, the re-issue of a patent for the process or the product may cover both, either in the same or separate patents, see *Tucker v. Burditt* (1879), 3 Bann. & A. 569; *Anilin v. Hamilton Mtg. Co.* (1878), 3 Bann. & A. 235; 13 O. G. 273; *Anilin v. Higgins* (1878), 15 Blatch. 290; 14 O. G. 414; 3 Bann. & A. 462.

As to the joinder of a manufacture with its process or machine, see §§ 475, 531, and notes, *ante*.

§ 677. ¹ In *Dunbar v. White* (1881), 4 Woods, 116, Billings, J.: (117) "Where a patentee in his original Claim and specifications describes his invention in part by specifying a material to be used, but declares that the sole utility or availability of that material in connection

with his device is that it has two properties; and in his re-issued patent, in his Claim and specifications, in the description of his invention, substitutes for his former specification of a material to be used as a part of his device, a description of materials which may be used by specifying only those which have the two properties in which he had formerly declared the utility or availability of the material which he then named consisted, there is no enlargement of the thing patented, and the re-issued patent is, therefore, valid." 23 O. G. 1446 (1446); 15 Fed. Rep. 747 (748).

That a re-issue of a chemical patent is void unless the compound claimed is the same as that described in the original, see *Tarr v. Webb* (1872), 2 O. G. 568; 5 Fisher, 593; 10 Blatch. 96.

That where an original described and claimed a composition of matter as answering a specific purpose, it cannot re-issue to cover the compound as used for all other purposes, see *Francis v. Mellor* (1871), 5 Fisher, 153; 1 O. G. 48.

When the original has sufficiently indicated the nature of the several ingredients, or of their sub-combinations, these may be also claimed in the re-issue if they were discovered by the inventor of the composition and have not already passed from his control into the possession of the public. All arts or instruments invented by the same inventor and necessarily employed in manufacturing the composition, may be joined with it in the re-issue when their essential attributes were suggested in the original patent and they have neither been abandoned nor disclaimed. But no extrinsic matter, such as a mode of packing the compound when completed, or of using it for practical purposes when sold, can be inserted in the patent for the composition either originally or by amendment.² Though these are patentable inventions, the composition is not dependent upon them for its existence, and they are thus incapable of joinder with it in any patent where it forms the principal invention.

§ 678. Re-issued Patent for a Design may Embrace the same Design, and sometimes its Elements and Sub-combinations.

The re-issue of a design-patent must be confined to the design described or suggested in the original specification. The identity of the design is determined by the appearance which it presents to the eye, and the characteristic features of this appearance, as shown in the original, must be preserved in the re-issue. The elements and sub-combinations of the original design, if answering the requirements already mentioned, may be claimed in the re-issue;¹ but where the same article is both a new design and a new manufacture, the inventions are distinct and independent, and a re-issue of a patent for it as the one cannot embrace the article considered as the other.

² That where the original patent describes a composition of matter packed in a certain manner and claims only the compound, it cannot re-issue so as to claim the mode of packing, see *Averill Chemical Paint Co. v. National Mixed Paint Co.* (1881), 22 O. G. 585; 20 Blatch. 42; 9 Fed. Rep. 462.

As to the joinder of a composition with its process or ingredients, see §§ 476, 532, and notes, *ante*.

§ 678. ¹ As to the joinder of designs, their elements and sub-combinations, see §§ 477, 532, and notes, *ante*.

§ 679. Re-issued Patent for an Improvement may Embrace the same Improvement, and sometimes the Apparatus or the Process.

An improvement is an invention subordinate to some existing art, machine, manufacture, composition of matter, or design, and in its essential character corresponds with the invention to which it belongs. The limitations which apply to the re-issue of a patent for an improvement are thus the same that govern a re-issue of the patent for the invention with which the improvement is connected. The re-issue must be confined to the exact improvement, suggested or described in the original patent.¹ It may include processes or implements by which the improvement is produced. It cannot embrace arts or instruments which occupy toward the improvement the relation of either functions or effects.

§ 680. Re-issued Patent cannot Embrace Matter Expressly or Impliedly Excluded from the Invention by the Original Patent.

The nature of the subject-matter which the inventor intended and attempted to describe and claim in his original specifications may be further indicated by the limitations which he has imposed upon it in his original patent; and in consequence of these his re-issue may be confined within narrower boundaries than the character of his invention would otherwise require. As by express disclaimer he may debar himself from covering by re-issue some essential feature of his actual invention, so by a faulty statement of its true scope and attributes in his original description, he may impliedly exclude from the invention matter which but for this he might have claimed in his re-issue.¹ Thus though all

§ 679. ¹ As to the joinder of improvements, see §§ 478, 534, and notes, *ante*. 445; *Funck v. Doty* (1877), 13 O. G. 322; *Wicks v. Stevens* (1876), 2 Woods, 310; 2 Bann. & A. 318.

§ 680. ¹ That matters disclaimed in the original cannot be claimed in the re-issue, see *Beecher Mfg. Co. v. Atwater Mfg. Co.* (1885), 114 U. S. 523; 31 O. G. 1306; *Edgerton v. Furst & Bradley Mfg. Co.* (1881), 21 O. G. 261; 9 Fed. Rep. 450; 10 Bissell, 402; *Leggett v. Avery* (1879), 101 U. S. 256; 17 O. G. That the statements of an inventor in his original patent, as to the nature and scope of his invention, are binding upon him, see *James v. Campbell* (1881), 104 U. S. 356; 21 O. G. 337.

That the omission from the re-issue of the limitations inserted in the origi-

forms of the invention were really the result of his inventive act, and all the uses of which it is capable belong to him if he desires to hold them, he may so set forth the invention as identified with one form only, or as possessing qualities which fit it for a single definite use, that every other form and use become disclaimed by implication, and even though still patentable in another patent, he cannot introduce them into the existing patent by re-issue.² Again, where he mistakes the nature of his invention, and in the original specification attributes the effects which it produces to erroneous causes, upon whose operation he bases his original claims, his subsequent discovery of the true causes cannot be made available to him by a re-issue of his former patent.³ A different application of the principle involved in these cases arises when the inventor has procured two separate patents, in both of which he has described the subject-matter whose incorporation into his re-issue he endeavors to secure. If he has claimed the matter in but one of these patents, this only

nal, renders the re-issue void, see *Searls v. Bouton* (1882), 12 Fed. Rep. 874 ; 20 Blatch. 528 ; 22 O. G. 946.

That the re-issue cannot claim what the patentee, in the original, professed to dispense with, see *Miller v. Bridgeport Brass Co.* (1882), 104 U. S. 350 ; 21 O. G. 201.

That a re-issue enlarging the invention by omitting words found in the original Claim is invalid, see *Matthews v. Iron Clad Mfg. Co.* (1888), 124 U. S. 347 ; 42 O. G. 827.

² That if the original identifies the invention with one form the re-issue cannot claim other forms, see *Steam Gauge & Lantern Co. v. Miller* (1882), 11 Fed. Rep. 718 ; and other cases cited in § 661, note 1, and § 676, note 1, *ante*.

That if the original limits the invention to matter possessing certain qualities or capabilities for certain uses, the re-issue can claim no other qualities or

capabilities, see *Francis v. Mellor* (1871), 5 Fisher, 153 ; 1 O. G. 48.

That the statement, in the original, that certain things "are in quite common use" is such a disclaimer as prevents their being claimed in re-issue, see *Edgerton v. Furst & Bradley Mfg. Co.* (1881), 21 O. G. 261 ; 9 Fed. Rep. 450 ; 10 Bissell, 402.

That where the original restricts the invention to one use, it cannot re-issue to cover other uses, see *Doane & Wellington Mfg. Co. v. Smith* (1883), 15 Fed. Rep. 459 ; 24 O. G. 302 ; *Ex parte Bragg* (1875), 8 O. G. 985 ; *Ex parte Allen* (1872), 2 O. G. 89.

³ That if the original describes and claims the invention as one cause producing the effect, the re-issue cannot claim subsequently discovered causes, see *Eames v. Andrews* (1887), 122 U. S. 40 ; 39 O. G. 1319 ; *Andrews v. Hovey* (1883), 5 McCrary, 181 ; 26 O. G. 1011 ; 16 Fed. Rep. 387.

can re-issue to embrace it.⁴ If it is claimed in neither, it can be covered by a re-issue of the earliest alone.⁵

§ 681. Identity of the Invention Embraced in the Re-issued Patent with that Attempted to be Covered by the Original Patent Determined by Comparing the Respective Specifications.

The identity of the invention claimed in the re-issue with that which the inventor attempted to describe and claim in the original patent is ascertained, in most cases, by a simple comparison of their respective specifications with each other.¹ Where the invention is of a nature admitting of illustration by drawings or models, this is the only investigation which can be made.² Extrinsic evidence is not admissible except to explain

⁴ That where a device is shown in two or more patents, only one of which claims it and this insufficiently, this patent alone can re-issue for it, see *Ex parte Kirby* (1879), 16 O. G. 1095; *Ex parte Locke* (1879), 16 O. G. 1140.

That where a device is described in two patents, and claimed only in one, the later must re-issue for it, even though the inventor is sole patentee in that patent, and he and his assignee are patentees under the other, see *Ex parte Kirby* (1879), 16 O. G. 1095.

That when a device is described in two patents and claimed only in one, and the earlier cannot re-issue for it, the later may, as where it was omitted on purpose from the earlier but by mistake in the later, see *Ex parte Locke* (1879), 16 O. G. 1140.

⁵ That where a device is shown but not claimed in two or more patents, only the earliest can re-issue for it, see *Ex parte Kirby* (1879), 16 O. G. 1095; *Ex parte Locke* (1879), 16 O. G. 1140.

That an earlier patent cannot re-issue to cover an invention described only in a later one of the same general class, see *Seibert Cylinder Oil Cup Co. v. Harper Steam Lubricator Co.* (1880), 4 Fed. Rep. 328.

§ 681. ¹ In *Collar Co. v. Van Dusen* (1874), 23 Wall. 530, Clifford, J. : (558) "Whether a re-issued patent is for the same invention as the surrendered original or for a different one must very largely be determined by a comparison of the two instruments, as the decision must necessarily depend upon the question whether the specifications and drawings of the re-issued patent are not substantially the same as those of the original; and if not, whether the omissions or additions are or are not greater than the law allows to cure the defects of the original specification." 7 O. G. 919 (920).

See also *Kerosene Lamp Heater Co. v. Littell* (1878), 13 O. G. 1009; 3 Bann. & A. 312; *Tucker v. Tucker Mfg. Co.* (1876), 10 O. G. 464; 4 Clifford, 397; 2 Bann. & A. 401; *Stevens v. Pritchard* (1876), 10 O. G. 505; 4 Clifford, 417; 2 Bann. & A. 390; *Ex parte Evans* (1873), 3 O. G. 180; *Metropolitan Washing Machine Co. v. Providence Tool Co.* (1872), Holmes, 161; *Parham v. American Buttonhole, Overseaming, & Sewing Mach. Co.* (1871), 4 Fisher, 468; *Seymour v. Osborne* (1870), 11 Wall. 516.

² That a comparison of the specifica-

the meaning of technical terms, or to apply the language of the Description to its proper subject-matter.³ If on the face of the two specifications, thus compared, it is apparent that the invention claimed in the re-issue is substantially distinct from that attempted to be covered by the original patent, the re-issue is void.⁴ If the diversity is not apparent, the re-issue, so far as this requirement is concerned, will be sustained, it being

tions, drawings, and model alone can be resorted to in order to ascertain the identity of the re-issue with the original, under Sec. 4916 Rev. Stat., where the original patent has drawings or model, see *Ex parte* Seibert (1877), 12 O. G. 268 ; *Ex parte* Baldwin (1876), 9 O. G. 639.

³ In *Seymour v. Osborne* (1870), 11 Wall. 516, Clifford, J. : (545) "Whether a re-issued patent is for the same invention as that embodied in the original patent or for a different one is a question for the court in an equity suit, to be determined as a matter of construction, on a comparison of the two instruments, aided or not by the testimony of expert witnesses, as it may or may not appear that one or both may contain technical terms or terms of art requiring such assistance in ascertaining the true meaning of the language employed. Where the specification and Claim, both in the original and re-issued patents, are expressed in ordinary language, without employing any technical terms or terms of art, the question whether the re-issued patent is for the same invention as that described in the original patent or for a different one is purely a question of construction ; but where both or either contain technical terms or terms of art the court may hear the testimony of scientific witnesses to aid the court in coming to a correct conclusion. Cases doubtless arise where the language of the specification and Claim, both of the surrendered and re-issued patents, is so interspersed with technical terms and terms of art that the testimony of scien-

tific witnesses is indispensable to a correct understanding of its meaning. Both parties in such a case would have a right to examine such witnesses, and it would undoubtedly be error in the court to reject the testimony ; but the case before the court is not of a character to render it expedient to pursue the inquiry."

See also *Heald v. Rice* (1882), 104 U. S. 737 ; 21 O. G. 1443.

That the identity or diversity of the original and the re-issue are to be ascertained only by inspecting the two patents, not by outside evidence, see *Johnsen v. Beard* (1875), 2 Bann. & A. 50 ; 8 O. G. 435.

That parol evidence is not admissible to show that the subject-matter of the re-issue is within the scope of the original invention, where it does not appear in the original description, see *Union Paper Collar Co. v. Van Deusen* (1874), 23 Wall. 530 ; 7 O. G. 919 ; *Glue Co. v. Upton* (1874), 1 Bann. & A. 497 ; 4 Clifford, 237 ; 6 O. G. 837 ; *Sarven v. Hall* (1872), 1 O. G. 437 ; 5 Fisher, 415 ; 9 Blatch. 524 ; *Seymour v. Osborne* (1870), 11 Wall. 516.

That extrinsic evidence may be resorted to in order to apply the descriptions, etc., to their subject-matter, see *Heald v. Rice* (1882), 104 U. S. 737 ; 21 O. G. 1443.

⁴ That if it appears on the face of the re-issued and original patents that the inventions are not identical, the re-issue is void, see cases cited in § 665, note 1, *ante*.

presumed that it is for the same invention as the original until the contrary appears.⁶ In comparing the two specifications, the question is not what the inventor might have set forth in the original patent, but what he did set forth as his invention.⁶ Differences in the Description and the Claims are not material, provided the inventions are the same.⁷ That the invention claimed in the re-issue would not have been an infringement of the former patent affords no test, since such patent must have stood or fallen by its own Claims, and the re-issue is not limited to these. In construing the respective specifications, their Descriptions, drawings, and models are to be taken together, not separately, and the character of the invention gathered from them as a whole.⁸ Drawings omitted

⁶ That if the specifications of the re-issue are consistent with those of the original, the re-issue is valid, see *Thomas v. Shoo Mach. Mfg. Co.* (1878), 3 Bann. & A. 557; 16 O. G. 541; *Herring v. Nelson* (1877), 14 Blatch. 293; 12 O. G. 753; 3 Bann. & A. 55; *Stevens v. Pritchard* (1876), 10 O. G. 505; 4 Clifford, 417; 2 Bann. & A. 390; *Tucker v. Tucker Mfg. Co.* (1876), 10 O. G. 464; 4 Clifford, 397; 2 Bann. & A. 401; *La Baw v. Hawkins* (1874), 1 Bann. & A. 428; 6 O. G. 724; *Chicago Fruit House Co. v. Busch* (1871), 2 Bissell, 472; 4 Fisher, 495; *Carew v. Boston Elastic Fabric Co.* (1871), 3 Clifford, 365; 5 Fisher, 90; 1 O. G. 91; *Sickels v. Evans* (1863), 2 Fisher, 417; 2 Clifford, 203; and cases cited in § 684, note 2, *post*.

In this paragraph, and in the text generally, the doctrine that a re-issue is presumed to be for the same invention as the original until the contrary appears is adhered to, notwithstanding the apparent change of position in the later cases in the Supreme Court as indicated in § 664, note 2, *ante*. So many subordinate rules as to the construction of specifications, the burden of proof, etc., etc., have grown out of the former doctrine that it has not been considered

prudent to disturb the present harmony of the law by the introduction into its authoritative statement of the new views which may safely be expounded and discussed in the notes.

⁶ That in comparing the re-issue with the original patent, the question is not what the inventor originally intended to patent, but what did he in fact invent and try to patent, see *American Wood Paper Co. v. Hest* (1867), 3 Fisher, 316.

That the question is not how the original might have described the invention, but how it did describe it, see *Hammond v. Franklin* (1885), 23 Blatch. 77; 22 Fed. Rep. 833; 30 O. G. 1324.

⁷ That if the inventions are the same, differences of description are immaterial, see cases cited in § 668, notes 1, 2, 3, *ante*.

That if the description, drawings, and model of the re-issue are identical with those of the original, the re-issue is valid though the Claims may differ, see *Black v. Thorne* (1872), 5 Fisher, 550; 10 Blatch. 66; 2 O. G. 388; and cases cited in § 668, notes 5, 6, 7, *ante*.

⁸ That the identity of the re-issue with the original is ascertained by comparing their drawings and specifications as a whole, not separately, see *Searls v.*

from the original patent by mistake may be inspected, and the model, as first filed in the Patent Office, may be examined.⁹ A dilapidated model may be aided by evidence disclosing its primitive condition, if not inconsistent with the drawings and Description;¹⁰ and when a feature claimed in the re-issue is absent from the specification and drawings, the model will be presumed to contain it unless the model is produced.¹¹ Where the model is lost, and the drawings are said to be incorrect, no change can be permitted in the latter to cure the defect, except upon the most conclusive evidence that the invention, as presented in the model, would have justified the change.¹² In any doubt as to the scope of the re-issue specification the files of the re-issue application may be resorted to for its solution.¹³

Worden (1882), 21 O. G. 1955 ; 11 Fed. Rep. 501.

⁹ That the drawings and model originally filed may be examined in reference to the identity of the re-issue with the original, see *Johnsen v. Beard* (1875), 2 Bann. & A. 50 ; 8 O. G. 435.

That the identity of the original and re-issue may be shown by the original drawing or model, or by some part of the drawings which, by mistake, was omitted from the one shown in the original patent, see *Ex parte Baldwin* (1876), 9 O. G. 639.

¹⁰ That where a model is lost or destroyed it may be established by parol, see *Meyer v. Goodyear's India Rubber Glove Mfg. Co.* (1881), 22 O. G. 681 ; 11 Fed. Rep. 891 ; 20 Blatch. 91.

That a dilapidated model may be aided by evidence showing what it once was, if not inconsistent with the original specifications and drawings, in order to support a re-issue, see *Aultman v. Holley* (1873), 11 Blatch. 317 ; 6 Fisher, 534 ; 5 O. G. 3.

That the Office model alone is not

sufficient basis for a new Claim in a re-issue, changing the character of the invention originally patented, see *Flower v. Detroit* (1888), 127 U. S. 563 ; 43 O. G. 1348.

¹¹ That where the specifications and drawings of the original do not show the feature claimed in the re-issue, only the inspection of the model can determine the matter, and if the model is not produced it will be presumed to contain the feature, see *Hendy v. Golden State & Miners' Iron Works* (1883), 17 Fed. Rep. 515 ; 8 Sawyer, 468.

¹² That where the original model is lost and the drawings are said to be incorrect, the court should not change the position of any part represented in the drawing, except upon the clearest proof, see *Royer v. Russell* (1881), 20 O. G. 1819 ; 9 Fed. Rep. 696.

¹³ That the files of the re-issue application may be examined to show the scope of the re-issue, see *Hopkins & Dickinson Mfg. Co. v. Corbin* (1881), 103 U. S. 786 ; 20 O. G. 297.

See also §§ 665, 666 and notes, *ante*.

§ 682. Identity of Subject-Matter of a Re-issued Machine-Patent, how Determined.

In the case of a machine-patent, the identity of the re-issue with the original is determined by the application of a stricter and more conclusive test. A machine is an organism composed of physical parts so arranged as to operate in accordance with a pre-determined structural law. It is capable of exact representation in a drawing or series of drawings, and of equally exact reproduction in a model. Whatever may be the difficulties which attend its verbal description, the failure to indicate its essential parts and their method of arrangement by means either of the drawing or model cannot result from inadvertence, accident, or mistake. If not fraudulent, such failure would at least be evidence that the inventor did not comprehend the invention which he had undertaken to secure, and therefore could not be entitled to a patent. Hence the propriety of the rule that in a machine-patent the identity of the re-issue with the original is to be ascertained by comparing the models and drawings with each other, and that nothing can be embraced in the re-issue which is not found either in the models or the drawings annexed to the original patent. This rule works no hardship to the inventor, since his original patent protects all equivalent parts and arrangements of parts which can be organized under the same structural law, and at the same time it avoids the danger that through some alteration in the parts or their arrangement, as shown in the original drawings or model, a variation in the structural law might imperceptibly be made, and thus a new machine be claimed by the re-issue.

§ 683. Identity of Subject-Matter of the Re-issued Patent, how Determined when the Invention cannot be Represented by Drawings or Model.

In cases where the invention is incapable of representation by a model or by drawings, necessity requires that this question of identity should be settled by such methods as are most available. Language even at its best is ambiguous, and to compel the inventor to abide by the construction which might be put by others on his words alone, would often deprive him

of the most important fruits of his inventive skill. In determining the nature of the invention indicated in his original specification, and attempted to be covered in his original patent, the disadvantage under which he labors through the impossibility of interpreting his verbal description by pictorial or material representations is overcome, in the hearing on his application in the Patent Office, by permitting him to offer extrinsic evidence as to the true character and attributes of the invention which he has undertaken to describe.¹ The

§ 683. ¹ In *Ex parte Dieckerhoff* (1877), 12 O. G. 429, Doolittle, Act. Com. : (480) "The first part of section 4916, requiring that no new matter shall be introduced into the specification, plainly refers to those cases accompanied by drawing and model; and, as was held in *Seymour v. Osborne*, this provision necessarily excluded the right in such cases to open the case to new parol testimony; but the express declaration, in the concluding clause of the section, that where there is neither model nor drawing amendments may be made upon proof satisfactory to the Commissioner that the proposed new matter or amendment was a part of the original invention, establishes a class of certain special cases, as the Supreme Court in the same case admitted. It gives to such applicants the privilege of submitting proof as to matter not embodied in the original patent, and permits the exercise of discretion on the part of the Commissioner in the consideration of such proof. Construing the whole of section 4916 together, as it should be, and keeping in mind the only real and lawful purpose of a re-issue application, to correct accidental mistakes in the original specification and drawing, there is nothing in the last clause, nor any previous one, to authorize a departure from the original invention, and the setting up in a re-issue of a substantially different invention. No amount of proof regarding an entirely

different invention, however satisfactory it might be in showing that the same was within the knowledge of an applicant at the time of applying for his original patent, could justify the Office in allowing its introduction therein by re-issue. To the extent of correcting such errors and omissions as are sometimes supplied by consulting the model and drawing filed with an original application, the clause of the statute under consideration, I think, clearly obtains. It might permit, for instance, of the consideration of all original papers filed in the case, and such other evidence of official action from which the intentions of the parties could be discovered or their rights determined. This practice was illustrated in the case of *Winslow*, 9 Official Gazette, 795, where the patent had been passed upon by the United States Supreme Court, and certain matter was held not to be a part of the patent, but where the Office considered the decisions of inferior courts, a dissenting opinion in the court above, together with numerous affidavits, including one from an examiner in the Patent Office, as showing clearly the fact that the applicant had made the invention and had intended to incorporate the same in his patent and believed that he had done so. No doubt existed in that case as to what the applicant's original invention was, as shown by the records of the Office and the testimony of others relating thereto;

sources and the weight of this extrinsic evidence have not been definitely fixed by law. The statutes merely provide that in this class of cases the proof, upon which any matter omitted from the original specification may be regarded as a part of the original invention, must be satisfactory to the Commissioner, and under this provision papers filed in the Patent Office in connection with the case, and other evidence of official actions, have been received.² But, upon principle, no evidence should be admitted inconsistent with the original specification, drawings, and model. To allow a re-issue for an invention of which no suggestion appears in the original specification, upon parol evidence alone, sets the whole question at large, and opens the door to the perpetration of the gravest frauds upon the public.³

§ 684. Identity of Subject-Matter of the Re-issued Patent Presumed until the Contrary Appears: Re-issued Patent, how Construed.

The invention claimed in a re-issue is presumed to be identical with that attempted to be patented in the original,¹ and

and that it was not definitely set forth and claimed was clearly an inadvertence that could be supplied by the character of proof mentioned. But I am aware of no decision of the Office or the courts which would justify a radical departure from the invention originally indicated or described by means of entirely extraneous proof."

In *Hussey v. Bradley* (1863), 2 Fisher, 362, Hall, J. : (371) "But it is well settled that in deciding upon these applications for a re-issue and the question whether the invention claimed on the re-issue is the same invention intended to be patented on the original application, the Commissioner of Patents is not confined to the Claims, nor even to the examination of the evidence furnished by the specification, models, and drawings accompanying the original application; and that any legal proof to show it to be the same

invention should be received. *Ex parte Ball*; *Ex parte Dyson*; and *Wilson v. Singer*; *Law's Digest*, 620-622." 5 Blatch. 134 (141).

² That the original papers filed in the Patent Office, as well as other evidence, may serve to show whether the inventions are the same, see *Ex parte Dieckerhoff* (1877), 12 O. G. 429.

³ As to the mode of investigating this question of identity in the courts, see § 664, note 2, *ante*.

§ 684. ¹ In *Spaeth v. Barney* (1885), 22 Fed. Rep. 828; Colt, J. : (829) "The re-issue of letters-patent by the Commissioner is *prima facie* evidence that such re-issue is founded on sufficient cause, and is in accordance with law. It is also presumed that the Commissioner acted within his authority under the statute, until the contrary is proved." 30 O. G. 997 (997).

Further, that the allowance of a

this presumption is rebutted only when, from a comparison of the two specifications, it is evident that a substantial difference exists between them.² In aid of this presumption, the

re-issue raises a presumption of the identity of the subject-matter which can be overcome only by strong and controlling evidence, see *Smith v. Goodyear Dental Vulcanite Co.* (1877), 93 U. S. 486 ; 11 O. G. 246 ; *Birdsell v. McDonald* (1874), 6 O. G. 682 ; 1 Bann. & A. 165 ; *Klein v. Russell* (1873), 19 Wall. 433 ; *Hussey v. Bradley* (1863), 5 Blatch. 134 ; 2 Fisher, 362 ; *Potter v. Holland* (1858), 4 Blatch. 238 ; 1 Fisher, 382 ; *O'Reilly v. Morso* (1854), 15 How. 62 ; *French v. Rogers* (1851), 1 Fisher, 133.

That there is also a strong general presumption in favor of the validity of a re-issue and the consequent identity of the inventions, see *Dederick v. Cassell* (1831), 9 Fed. Rep. 306 ; 20 O. G. 1233 ; 14 Phila. 503 ; *Thomas v. Shoe Mach. Mfg. Co.* (1878), 3 Bann. & A. 557 ; 16 O. G. 541 ; *American Middlings Purifier Co. v. Atlantic Milling Co.* (1877), 3 Bann. & A. 168 ; 4 Dillon, 100 ; *Reissner v. Anness* (1877), 13 O. G. 870 ; 3 Bann. & A. 176 ; *Smith v. Goodyear Dental Vulcanite Co.* (1877), 93 U. S. 486 ; 11 O. G. 246 ; *Miller & Peters Mfg. Co. v. Du Brul* (1877), 12 O. G. 351 ; 2 Bann. & A. 618 ; *Tucker v. Tucker Mfg. Co.* (1876), 10 O. G. 464 ; 2 Bann. & A. 401 ; 4 Clifford, 397 ; *Stevens v. Pritchard* (1876), 10 O. G. 505 ; 4 Clifford, 417 ; 2 Bann. & A. 390 ; *Salamander Felting Co. v. Haven* (1875), 3 Dillon, 131 ; 9 O. G. 253 ; *Doherty v. Haynes* (1874), 4 Clifford, 291 ; 6 O. G. 118 ; 1 Bann. & A. 289 ; *Bantz v. Elsas* (1874), 6 O. G. 117 ; 1 Bann. & A. 351 ; *La Baw v. Hawkins* (1874), 6 O. G. 724 ; 1 Bann. & A. 428 ; *Guidet v. Barber* (1873), 5 O. G. 149 ; *Jordan v. Dobson* (1870), 2 Abbott, 398 ; 7 Phila. 533 ; 4 Fisher, 232 ; *Blake v. Stafford* (1868),

3 Fisher, 294 ; 6 Blatch. 195 ; *Morris v. Royer* (1867), 3 Fisher, 176 ; 2 Bond, 66 ; *Forbes v. Barstow Stove Co.* (1864), 2 Clifford, 379 ; *Hussey v. Bradley* (1863), 2 Fisher, 362 ; 5 Blatch. 134 ; *Hussey v. McCormick* (1859), 1 Fisher, 509 ; 1 Bissell, 300 ; *Woodworth v. Edwards* (1847), 3 W. & M. 120 ; 2 Robb, 610 ; *Allen v. Blunt* (1846), 2 W. & M. 121 ; 2 Robb, 530.

That the fact that a re-issue was granted after a severe contest raises a strong presumption in its favor, see *Consolidated Bunging Apparatus Co. v. Peter Schoenhofen Brewing Co.* (1886), 28 Fed. Rep. 428 ; 37 O. G. 786.

² In *Thomas v. Shoe Machinery Mfg. Co.* (1878), 3 Bann. & A. 557, Clifford, J. : (560) "Where the Commissioner accepts a surrender of an original patent and grants a new patent, his decision in the premises, *in a suit for infringement*, is final and decisive, and is not re-examinable in such a suit in the circuit court, unless it is apparent upon the face of the patent that he has exceeded his authority, and that there is such a repugnancy between the old and the new patents that it must be held as matter of legal construction that the new patent is not for the same invention as that embraced and secured in the original. *Seymour v. Osborne*, 11 Wall. 543. . . . Courts of justice will avoid such a conclusion, if they can reasonably do so, by a proper application of the maxim that patents are to receive a liberal construction, and, if practicable, be so interpreted as to uphold and not destroy the right of the inventor. *Turrill v. Railroad*, 1 Wall. 491 ; *Ames v. Howard*, 1 Sum. 482 ; *Blanchard v. Sprague*, 3 Sum. 279 ; *Glue Co. v. Upton*, 6 O. G. 837. Slight changes will not sustain such a defence,

Description, drawings, and model of the re-issue are always so construed, if possible, as to confine the re-issue to the original invention.³ Claims apparently in excess of the original inven-

nor will the court in any case declare the patent void on that account, if, by the true construction of the two instruments, the invention secured by the two instruments is not substantially different from that embodied in the original patent. Inquiries in such a case are restricted to a comparison of the terms and import of the two patents in view of the drawings and Patent Office model. If from these it results that the invention claimed in the re-issue is not substantially different from the one described, suggested, or indicated in the specification or drawings of the original patent or Patent Office model, the re-issued patent must be held valid, as all other alterations and amendments plainly fall within the intent and purpose of the provision in the act of Congress which allows a surrender and re-issue; or in other words, if the re-issued patent does not, upon the face of the instrument, embrace anything not substantially described, suggested, or indicated in the specifications, drawings, or model of the original, the defence that the re-issued patent is not for the same invention as the original must be overruled." 16 O. G. 541 (542).

In *La Baw v. Hawkins* (1874), 1 Bann. & A. 428, Nixon, J.: (429) "The act of the Commissioner in accepting a surrender and granting a re-issue, is final and conclusive, and not re-examinable in a suit in the Circuit Court, unless it is apparent, upon the face of the patent, that he has exceeded his authority, or that there is such a repugnancy between the old and the new patent that it must be held as matter of legal construction that the new patent is not for the same invention as that embraced and secured in

the original patent." 6 O. G. 724 (725).

Further, that the re-issue is presumed to be for the same invention until by comparing it with the original patent the want of identity clearly appears, see *Searles v. Bouton* (1881), 21 O. G. 1784; 12 Fed. Rep. 140; 20 Blatch. 426; *Smith v. Goodyear Dental Vulcanite Co.* (1877), 93 U. S. 486; 11 O. G. 246; *Doherty v. Haynes* (1874), 4 Clifford, 291; 6 O. G. 118; 1 Bann. & A. 289; *Seymour v. Marsh* (1872), 6 Fisher, 115; 2 O. G. 675; 9 Phila. 380.

³ That the question of identity between a re-issue and its original is a question of construction, not of evidence, if the court can understand the inventions from the patents, see *Heald v. Rice* (1881), 104 U. S. 737; 21 O. G. 1443; *Seymour v. Osborne* (1870), 11 Wall. 516.

That the Claims of the re-issue should be construed, if possible, so as to cover only the real invention described in the original, see *Brainard v. Cramme* (1882), 12 Fed. Rep. 621; 22 O. G. 769; 20 Blatch. 530; *Swain Turbine & Mfg. Co. v. Ladd* (1877), 11 O. G. 153; 2 Bann. & A. 488.

That a re-issue may be construed by the original, see *Tyler v. Galloway* (1882), 20 Blatch. 445; 22 O. G. 2072; 12 Fed. Rep. 567; *Coburn v. Schroeder* (1882), 22 O. G. 1538; *Tyler v. Welch* (1880), 3 Fed. Rep. 636; 18 Blatch. 209; 17 O. G. 1508; *Manufacturing Co. v. Ladd* (1880), 102 U. S. 408; 19 O. G. 62; *Klein v. Russell* (1873), 19 Wall. 433; *Ely v. Monson & Brimfield Mfg. Co.* (1860), 4 Fisher, 64.

That where one part of the re-issue seems void, it may be construed with the other parts and the whole together

tion are restricted by interpretation,⁴ and void Claims are rejected without prejudice to such as have been properly allowed.⁵ The entire re-issue specification is considered as an

may stand, see *Carew v. Boston Elastic Fabric Co.* (1871), 3 Clifford, 356 ; 5 Fisher, 90 ; 1 O. G. 91.

That where a re-issue broadening the Claims is granted after a delay of four and a half years it will be construed as covering the same matter as the original, see *Albany Steam Trap Co. v. Felthousen* (1885), 32 O. G. 1239.

That where a specific and complete invention is fully described, and all the papers including the application, etc., show that this was what the patentee intended to claim, there can have been no inadvertence, and the re-issue cannot be broadly construed even though the actual invention were wider than that described, see *Yale Lock Mfg. Co. v. James* (1884), 28 O. G. 917 ; 20 Fed. Rep. 903 ; 22 Blatch. 294.

That a re-issue as well as an original patent is to be so construed, if possible, as to cover the real invention according to the construction given to it by the patentee, see *Klein v. Russell* (1873), 19 Wall. 433.

⁴ That the Claims of the re-issue will not be enlarged by construction, but will be confined to the original invention, if capable of that interpretation, see *Tyler v. Welch* (1880), 3 Fed. Rep. 636 ; 17 O. G. 1508 ; 18 Blatch. 209.

⁵ In *Gage v. Herring* (1882), 107 U. S. 640, Gray, J. : (646) "The invalidity of the new Claim in the re-issue does not indeed impair the validity of the original Claim, which is repeated and separately stated in the re-issued patent. Under the provisions of the Patent Act, whenever through inadvertence, accident, or mistake, and without any wilful default or intent to defraud or mislead the public, a patentee in his specification has claimed more than that of which he was the original

and first inventor or discoverer, his patent is valid for all that part which is truly and justly his own, provided the same is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right ; and the patentee, upon seasonably recording in the Patent Office a disclaimer in writing of the parts which he did not invent, or to which he has no valid claim, may maintain a suit upon that part which he is entitled to hold, although in a suit brought before the disclaimer he cannot recover costs. Rev. Stat. Sects. 4917, 4922 ; *O'Reilly v. Morse*, 15 How. 62, 120, 121 ; *Vance v. Campbell*, above cited. A re-issued patent is within the letter and the spirit of these provisions." 23 O. G. 2119 (2120).

Further, that void Claims in a re-issue do not affect the valid Claims, see *Reed v. Chase* (1885), 25 Fed. Rep. 94 ; 33 O. G. 996 ; *American Diamond Rock Boring Co. v. Sheldon* (1885), 25 Fed. Rep. 768 ; 33 O. G. 1598 ; *Giant Powder Co. v. Safety Nitro Powder Co.* (1884), 10 Sawyer, 23 ; 27 O. G. 99 ; 19 Fed. Rep. 509 ; *Reay v. Raynor* (1884), 22 Blatch. 13 ; 26 O. G. 1111 ; 19 Fed. Rep. 308 ; *Dryfoos v. Wiese* (1884), 22 Blatch. 19 ; 26 O. G. 639 ; 19 Fed. Rep. 315 ; *Havemeyer v. Randall* (1884), 21 Fed. Rep. 404 ; *Hayes v. Bickelhaupt* (1884), 21 Fed. Rep. 567 ; 29 O. G. 368 ; 22 Blatch. 463 ; *Worden v. Searls* (1884), 21 Fed. Rep. 406 ; *Odell v. Stout* (1884), 22 Fed. Rep. 159 ; 29 O. G. 862 ; *Gold & Stock Telegraph Co. v. Wiley* (1883), 17 Fed. Rep. 234 ; *Wood v. Packer* (1883), 17 Fed. Rep. 650 ; *Cote v. Moffitt* (1883), 15 Fed. Rep. 345 ; *Starrett v. Athol Mach. Co.* (1883), 23 O. G. 1729 ; 14 Fed. Rep. 910 ; *Schillinger v. Green-*

honest effort to amend the original specification in conformity with the essential character of the invention, as shown by the state of the art at the date of the original patent,⁶ and only when it is incapable of any reasonable construction, without extending it beyond the limits of the actual invention, is it held to be a departure from the original patent, and on that account invalid.⁷

§ 685. Third Proposition: Amendment by Re-issue not Permitted unless the Imperfections in the Original Patent Arose without Fraud, and from Inadvertence, Accident, or Mistake.

The third proposition asserts that a re-issue cannot be allowed for the correction of an error unless it occurred through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention.¹ This proposition rests in part

way Brewing Co. (1883), 24 O. G. 495 ; 17 Fed. Rep. 244 ; Fetter v. Newhall (1883), 21 Blatch. 445 ; 25 O. G. 502 ; 17 Fed. Rep. 841 ; Tyler v. Galloway (1882), 12 Fed. Rep. 567 ; 20 Blatch. 445 ; 22 O. G. 2072.

That a void Claim in a re-issue may be disclaimed, see Tyler v. Galloway (1882), 12 Fed. Rep. 567 ; 20 Blatch. 445 ; 22 O. G. 2072.

⁶ In Crandall v. Parker Carriage Goods Co. (1884), 20 Fed. Rep. 851, Coxe, J. ; (852) "Where it can be seen that the patentee seeks, by apt words of description, to secure what he has honestly invented and nothing more, the court should hesitate to regard with favor the accusations now so freely made against re-issued patents." 28 O. G. 369 (370).

That a re-issue should be construed in view of the state of the art at the time the original was granted, see Garneau v. Dozier (1880), 102 U. S. 230 ; 19 O. G. 61.

That the state of the art when the original was filed may be shown on the question of identity between the original and re-issue to interpret the original as

compared with the re-issue, see Eachus v. Broomall (1885), 115 U. S. 429 ; 33 O. G. 1265.

⁷ See § 746 and notes, *post*.

§ 685. ¹ In Coon v. Wilson (1885), 113 U. S. 268, Blatchford, J. : (277) "As the rule is expressed in the recent case of Mahn v. Harwood, 112 U. S. 354, a patent 'cannot be lawfully re-issued for the mere purpose of enlarging the Claim, unless there has been a clear mistake inadvertently committed in the wording of the Claim, and the application for a re-issue is made within a reasonably short period after the original patent was granted.' But a clear mistake, inadvertently committed in the wording of the Claim, is necessary without reference to the length of time." 30 O. G. 889 (891).

In *Ex parte Conklin* (1874), 1 MacArthur, 375, MacArthur, J. : (378) "It will be seen by the terms of the statute that in order to entitle a party to the re-issue of a patent it is incumbent on him to show that it is inoperative or invalid by reason of a defective or insufficient specification, or that the patentee had claimed more than he in-

upon the doctrine of fraud and in part upon the doctrines of estoppel and abandonment. A wilful attempt to deceive the public, whether by express misrepresentation or by obscurity and insufficiency of statement, is a fraud. It violates the fundamental principles of contract, upon which the right of an inventor to his patent privilege depends. If such an attempt be proved, the patent is void *ab initio*; its errors are incapable of remedy by any method of amendment; and the inventor forfeits, as a penalty for his wrong-doing, the entire protection he might otherwise have obtained.² An intentional misrepre-

vented, and that the error had arisen by inadvertence, accident, or mistake, and without any fraudulent intention. Unless these circumstances exist in an application of this character, I can find no authority by which the Commissioner can re-issue a patent; as he is an officer of special and limited power, his action must be restricted to the particular cases mentioned in the statute. I refer to these requirements of law because, if the original patent is neither inoperative nor invalid, and if no error has been occasioned by accident or mistake, there must be a presumption of law and fact that the patentee has abandoned to the use of the public everything which he may have invented, but which he did not include in his Claims and specifications. The law presumes that every one who applies for a patent will embody his invention in specifications sufficiently definite to preserve as much of his discovery as he desires to protect by a patent. If, from mistake, he has overlooked anything within the scope of his invention, he may surrender his patent on that ground, and claim a new one, in accordance with amended specifications. The party asking this relief must be denied it unless he brings himself within the statute. When he knows all the facts relating to his own case, but, through culpable negligence or misconduct, has failed to claim all of his discovery, the law will not extend

its aid to him, but will leave him to enjoy only such limited advantages as he has actually secured. The law reserves its remedies for the careful and vigilant who may have been misled from any of the causes mentioned in the statute." 5 O. G. 235 (236).

In *Jordan v. Dobson* (1870), 4 Fisher, 232, Strong, J.: (237) "If the defect or insufficiency of the specifications of the surrendered patents had not arisen from inadvertence, accident, or mistake, and without fraudulent intention, the Commissioner had no right to re-issue the patent." 2 Abbot, 398 (404); 7 Phila. 533 (535).

See also *Ex parte Whitely* (1886), 36 O. G. 1243; *Bate Refrigerating Co. v. Eastman* (1885), 24 Fed. Rep. 645; 32 O. G. 517; *Clements v. Odorless Excavating Apparatus Co.* (1884), 109 U. S. 641; 26 O. G. 353; *Flower v. Rayner* (1881), 5 Fed. Rep. 793; 19 O. G. 425; *Meyer v. Maxheimer* (1881), 20 O. G. 1162; 20 Blatch. 15; 9 Fed. Rep. 99; *Giant Powder Co. v. California Vigorit Powder Co.* (1880), 18 O. G. 1339; 6 Sawyer, 508; 4 Fed. Rep. 720; *Giant Powder Co. v. California Powder Works* (1875), 3 Sawyer, 448; 2 Bann. & A. 131; *Knight v. Baltimore & Ohio R. R. Co.* (1840), Taney, 106; 3 Fisher, 1; *Opinion Atty. Gen.* (1836), 3 Op. At. Gen. 165.

² This doctrine rests not merely upon general principles of law, but upon the

sentation or concealment, without fraudulent design, concludes the party making it as to the character and scope of the invention attempted to be covered by the patent. What has been properly described and claimed is regarded as its true subject-matter; what has been voluntarily omitted or misstated is considered as abandoned to the public, or as permanently excluded from that particular patent;³ and though it may sometimes be made the subject-matter of a future patent, it cannot be incorporated into the existing patent by re-issue. An error which occurs through inadvertence, accident, or mistake, is neither intentional nor fraudulent, but is consistent with an honest attempt to describe and claim the complete invention, as the inventor has himself conceived it and rendered it available for public use.⁴ It is for the purpose of correcting this latter error only that an amendment by re-issue is permitted.

express provisions of the statute. An attempt to deceive the public by a suppression of the truth or the suggestion of a falsehood in the description and specification of the patent is therein made a valid defence in any action based upon the patent. The right to amend a defective patent either by disclaimer or re-issue is also conditioned upon the absence of any fraudulent or deceptive intention on the part of the patentee. Diligence and good faith are alike required of him as qualities of conduct and purpose without which no concession of exclusive privileges to him can be allowed. See *Miller v. Brass Co.* (1882), 104 U. S. 350; 21 O. G. 201.

³ That a re-issue cannot claim matter intentionally omitted from the original, see *Ex parte Mahnken* (1887), 40 O. G. 915; *Shirley v. Mayer* (1885), 23 Blatch. 249; 25 Fed. Rep. 38; 34 O. G. 1391.

⁴ That "mistake" as ground for re-issue is not the same thing as "misunderstanding," see *Ex parte Wilkins* (1883), 24 O. G. 1270.

• That it is immaterial by what mistake or inadvertence a re-issue becomes necessary, see *Stimpson v. Westchester*

R. R. Co. (1846), 4 How. 380; 2 Robb, 335.

That the re-issue affords *prima facie* evidence of inadvertence, but may be overcome by other proof, see *Odell v. Stout* (1884), 22 Fed. Rep. 159; 29 O. G. 862.

That "inadvertence, etc.," exists in reference to the application, not the invention, and occurs only where the former does not describe and claim what the inventor intended to protect, see *Ex parte Mahnken* (1887), 41 O. G. 1269.

That a Claim left out of the original because the applicant did not consider its subject-matter patentable cannot be inserted in the re-issue, see *Ex parte Mahnken* (1887), 40 O. G. 915.

That an error in opinion or judgment is not "mistake or inadvertence," see *Ex parte Mahnken* (1887), 40 O. G. 915.

That a re-issue which was evidently procured to cover other later devices and not to cure faults arising from inadvertence or mistake is invalid, see *Newton v. Furst & Bradley Mfg. Co.* (1886), 119 U. S. 373; 38 O. G. 104.

§ 686. Re-issue not Permitted where the Defects in the Original Patent Arose through Fraud.

With reference to this third proposition, defects and insufficiencies in the Description or Claims of a patent may thus be grouped in three classes: (1) Those which are intentional and fraudulent; (2) Those which are intentional but not fraudulent; (3) Those which are neither intentional nor fraudulent, but which arise from inadvertence, accident, or mistake. Concerning the first class, the law is plain and fully settled. The question as to the existence of a fraudulent and deceptive intention is a question of fact to be determined, upon direct or inferential evidence, by whatever tribunal may have jurisdiction of the controversy in which the question is raised. Thus on an application for a re-issue, the Commissioner may inquire into the original good faith of the patentee, and upon satisfactory proof of bad faith may deny the application. The courts, in ascertaining the validity of a re-issue already granted, may pursue the same investigation, and if a fraudulent intent appears to have been entertained by the original patentee, may treat the re-issue as invalid.¹

§ 687. Re-issue not Permitted to Reject Matter Intentionally Inserted in the Original Patent, nor to Restore Matter Intentionally Excluded.

The line between the second and third classes, though sufficiently clear in statement, is not always easy to define in

§ 686. ¹ The extent of the authority of the courts to inquire into the intention of the patentee in omitting or misstating any feature of the invention in his original patent cannot, at present, be precisely defined. That the decision of the Commissioner on the good faith of the patentee in applying for a re-issue, and on the absence of corruption in allowing it, is final, except upon proceedings brought to repeal the re-issued patent, is conceded; and that a patent may be collaterally attacked, on the ground that its Description and Claims are fraudulent and intended to deceive, is beyond question. A disposition to

enlarge the sphere of judicial authority, and permit the courts to go behind the finding of the Commissioner upon the questions of inadvertence, etc., in ordinary actions on the re-issued patent has recently been manifested; and though indulged with great caution, and with perhaps too much regard for the supposed prerogatives of the Commissioner, is so clearly in the interests of a just administration of the law that its result in bringing all these issues into the jurisdiction of the courts in any suit, in which the validity of the patent is involved, may be considered as already certain. See §§ 714, 715, and notes, *post*.

practice. That matter which has once been deliberately embraced within or excluded from a patent can neither be disclaimed nor reclaimed by an amendment, and that matter unintentionally included or omitted may be afterward rejected or inserted, are rules distinct, precise, and exhaustive. The difficulty is found in ascertaining whether the original misstatement was deliberate or unintentional, and in devising and applying tests by which this question may be settled without relying on the evidence of the inventor as to the object which he had in view. The positions generally taken by the Patent Office and the courts in reference to this question are in harmony with those assumed in regard to other aspects of the doctrines of abandonment and estoppel.¹ Abandonment is always a question of intention, to be gathered in all cases from the conduct of the inventor toward his invention or the public. Estoppel rests upon an actual or presumed intention of the inventor, which is made effective by forbidding him to depart from the position he has once assumed. Errors occurring in the Description or Claims of the original patent are thus held to have been deliberate or unintentional according to the indications afforded by the circumstances causing, or connected with, or relating to the occurrence of these errors. Such circumstances may precede or be concurrent with or subsequent to the issue of the original patent. They may appear upon the face of the patent itself, or in the records of the Patent Office, or in the actions or omissions of the inventor; and whenever from these circumstances it is evident that the inventor deliberately made his attempt to describe and claim the invention in the form and with the limitations inserted in the original specification, any endeavor to correct the statement, by changing that form or discarding those limitations in the re-issue, is unlawful. What circumstances have been treated by the Patent Office or the courts as indicative of such intentional exclusion, will be now considered.

§ 687. ¹ That whenever it may be necessary for the protection of either public or private rights, the doctrine of estoppel, as now applied in courts of law and equity to ordinary trans- actions, will be resorted to in the adjudication of patent causes, see §§ 346 and notes, 357, note 3, 390 and notes, *ante*, and §§ 981, 1021, 1046, 1195, and notes, *post*.

§ 688. Re-issue not Permitted to Enlarge the Claims of the Original Patent by Including Matter once Intentionally Excluded.

It may be premised that this question rarely arises except in cases where the alleged error in the original patent consists in an undue restriction of its Claims.¹ An amendment made in the Description, placing the invention more fully in the possession of the public and not enlarging the privileges of the inventor, is not subject to objection unless the original were fraudulent and the patent, therefore, void. An amendment merely limiting excessive Claims in the original patent is also rather for the public interest than that of the inventor, and when attempted without unreasonable delay seldom encounters opposition. But when the inventor endeavors by amendment to extend his Claims, and thus encroaches on a domain previously left open to the public or occupied by rival inventors, his efforts are naturally subjected to severe adverse criticism and his rights are properly confined within the narrowest limits. Hence it is in cases where the re-issue, though not materially altering the description of the original invention, claims for it essential features differing in number or in character from those claimed for it in the former patent, or where subordinate or dependent inventions, described but not claimed in the original patent, are claimed in the re-issue,

§ 688. ¹ It is not, however, true that the right to a re-issue amending the Description or narrowing the Claims can be exercised without limitation. The patentee owes a duty to the public to present them with an accurate delineation of his invention, and to confine his Claims to the essential features which he has created; and he is open to the imputation of bad faith if he fails to amend his patent in these particulars when such amendment becomes evidently necessary. Thus even a disclaimer cannot save a patent unless made without unreasonable delay; and acquiescence in a faulty description may bar the allowance of a re-issue, if it does not furnish evidence of an original intention to de-

ceive. Illustrations of these principles may be found in the following cases:

That while less delay is allowable in expanding Claims than in restricting them, no unreasonable delay as to either can be permitted, see *Ex parte Matthews* (1884), 26 O. G. 823.

That a defect in the Description may be cured by re-issue, even though the right to cure one in the Claim has been lost by delay, see *Miller v. Brass Co.* (1882), 104 U. S. 350; 21 O. G. 201.

That the original Claims may be reproduced in a re-issue without reference to delay, see *Yale Lock Co. v. Sargent* (1886), 117 U. S. 536; 35 O. G. 497; *Steam Gauge Lantern Co. v. Miller* (1882), 11 Fed. Rep. 718.

that the amendment is attacked, and that the question of deliberate or unintentional exclusion from the previous patent is involved.

§ 689. **Intentional Exclusion Shown by Express Disclaimer in the Original Patent or during the Proceedings in the Patent Office.**

A voluntary and intelligent disavowal of any matter which is embraced in the original description of the invention is conclusive evidence of its intentional exclusion from the patent.¹ This disavowal may consist in an express disclaimer embodied in the specification, or filed subsequently

§ 689. ¹ That an intentional disclaimer of any matter in the original patent prevents its claim in a re-issue is apparent from the authorities cited in § 680, note 1, *ante*. But an unintentional or mistaken disclaimer, arising from an erroneous use of language, as distinguished from a misconception of the nature of the invention, has no such effect. On the contrary, it is one of the chief purposes of a re-issue to correct defects of this kind and to cause the patent to embrace what before it had, under the construction given to its terms, apparently excluded. Thus in *Hussey v. Bradley* (1863), 2 Fisher, 362, Hall, J. : (371) "Even a statement, in an original patent, that a part is old, or a disclaimer of a part, does not, it seems, necessarily prevent such part from being claimed in a re-issued patent, though it would have that effect if made advisedly, and not by inadvertence, accident, or mistake. *Ex parte Hayden*; *Laidley v. James*; *Law's Digest*, 616." 5 Blatch. 134 (141). See also *Daniels v. Chesterman* (1877), 13 O. G. 4; *Poppenhusen v. Falke* (1861), 2 Fisher, 181; 4 Blatch. 493.

That a re-issue may omit a disclaimer found in the original, if such disclaimer has no reference to the essence of the invention and does not limit its claim,

see *Ex parte Hermann* (1876), 10 O. G. 865.

That a disclaimer in the original need not be inserted in the re-issue where it has been judicially determined that such disclaimer was unnecessary, see *Eames v. Andrews* (1887), 122 U. S. 40; 39 O. G. 1319.

That a re-issue, re-instating Claims omitted from a former re-issue in order to substitute wider ones, is valid, see *Celluloid Mfg. Co. v. Zylonite Brush & Comb Co.* (1886), 27 Fed. Rep. 291; 35 O. G. 1228.

That where a specification says that the invention consists in combining the elements, this does not abandon the elements themselves, see *Henderson v. Cleveland Co-operative Stove Co.* (1877), 12 O. G. 4; 2 Bann. & A. 604.

That the withdrawal of a Claim in the Patent Office as unnecessary is not an abandonment of the matter, see *Eames v. Andrews* (1887), 122 U. S. 40; 39 O. G. 1319.

That a re-issue upon the application of an assignee cannot cover matter once disclaimed by the original inventor, see *Putnam v. Hutchison* (1882), 11 Bissell, 233; 12 Fed. Rep. 127; *Ashcroft v. Railroad Co.* (1877), 97 U. S. 189; 13 O. G. 865.

to the issue of the patent, or in the conduct of the inventor toward his application during the proceedings in the Patent Office.² A feature of the invention, whose rejection by the examiner is acquiesced in by the applicant without appeal, is thereby excluded as effectually as by express disclaimer.³ A Claim withdrawn by amendment, either to save the application or escape an interference, is also finally repudiated by the patentee.⁴ Even the acceptance of a patent, containing

² That a re-issue cannot include Claims abandoned in the first application, see *Streit v. Lauter* (1882), 11 Fed. Rep. 309.

That an admission by the patentee in his specification or application cannot be contradicted by him, see *Mollitt v. Rogers* (1881), 8 Fed. Rep. 147.

That matter abandoned in the Patent Office cannot be reclaimed by re-issue, see *Yale Lock Mfg. Co. v. James* (1884), 22 Blatch. 294 ; 28 O. G. 917 ; 20 Fed. Rep. 903.

³ In *Ex parte Hatchman* (1884), 3 Mackey, 288, MacArthur, J. : (289) "We are of opinion that on an application for a patent, when one of the Claims presented is covered by previous inventions and the patents therefor are referred to, and the examiner upon such reference decides against such Claim, and the applicant thereupon, by his attorney, orders the same to be erased and withdrawn, and thus obtains and accepts a patent for the residue of his Claims, he is not entitled to a re-issued patent containing the identical Claim which he has so erased and withdrawn. We also hold that under such circumstances no error has arisen by inadvertence, accident, or mistake, within the meaning of the Patent Law, which would authorize the Commissioner to entertain the application for a re-issue." 26 O. G. 738 (738).

That a Claim rejected by the Patent Office and the rejection acquiesced in cannot be re-instated by re-issue, there being in such cases no accident or mis-

take, see *Ex parte Page* (1888), 43 O. G. 1455 ; *Arnheim v. Finster* (1886), 26 Fed. Rep. 277 ; 34 O. G. 700.

That if the Commissioner on an extension-hearing requires certain matters to be disclaimed and the patentee acquiesces, they cannot be inserted in a re-issue, there having been no inadvertence, see *Union Metallic Cartridge Co. v. United States Cartridge Co.* (1884), 112 U. S. 624 ; 30 O. G. 771.

That a Claim abandoned in the original application on an objection by the Patent Office, but afterward allowed to another applicant, may be inserted in the re-issue, see *Yale Lock Mfg. Co. v. Norwich National Bank* (1881), 19 Blatch. 123 ; 6 Fed. Rep. 377.

⁴ That a re-issue cannot contain Claims which were withdrawn from the application for the original in order to secure its issue, see *Shepard v. Carrigan* (1886), 116 U. S. 593 ; 34 O. G. 1157 ; *Leggett v. Avery* (1879), 101 U. S. 256 ; 17 O. G. 445.

That if an applicant is obliged to include an element in order to procure a patent, he cannot afterwards broaden his Claim by dropping it, see *Shepard v. Carrigan* (1886), 116 U. S. 593 ; 34 O. G. 1157.

That a patentee is bound by the limitations imposed on his patent, whether they were voluntary or enforced by the Patent Office, and if he accepts a Claim not covering his entire invention he abandons the residue, see *Toepfer v. Goetz* (1887), 41 O. G. 933.

That where a Claim was withdrawn

limitations imposed by the Patent Office which narrow the scope of the invention as at first described and claimed in the application, is an irrevocable admission that such limitations are of the essence of the invention attempted to be covered by the patent.⁵ In none of these cases can the undue restriction of the Claim be attributed to inadvertence, accident, or mistake.⁶ The patentee, when he receives his

from the application of an original patent, in order to escape an interference, the re-issue cannot contain such Claim, see *Lee v. Walsh* (1879), 15 O. G. 563 ; *Ex parte Gillen* (1877), 11 O. G. 419.

That Claims cannot be restored after a judgment has been rendered in interference in the patentee's favor on his striking them out, see *Ex parte Cobb* (1879), 16 O. G. 175.

That a defeated contestant in an interference, after accepting a limited patent, cannot claim in his re-issue any matter awarded to his opponent, see *Ex parte Burge* (1877), 13 O. G. 498.

That where a device is adhered to in spite of an interference it cannot afterward be claimed that its retention in that application was a mistake, see *Ex parte Kirby* (1879), 16 O. G. 1095.

That it will not be assumed that contesting parties could have overcome objections raised by the Patent Office, see *Puetz v. Bransford* (1887), 39 O. G. 1427 ; 31 Fed. Rep. 458.

That where the original application was for a product and process both, and was amended to cover only the process, the patent cannot be re-issued to claim the product, see *Giant Powder Co. v. California Powder Works* (1875), 3 Sawyer, 448 ; 2 Bann. & A. 131.

That a proposal to limit the Claim, though made by the applicant to the Patent Office, does not bind the patentee unless it was accepted by the Commissioner, see *Pike v. Potter* (1859), 3 Fisher, 55.

⁵ In *N. Y. Belting & Packing Co. v. Sibley* (1883), 15 Fed. Rep. 386, Low-

ell, J. : (389) "It has been several times decided by the Supreme Court that disclaimers, qualifications, and limitations, imposed upon a patentee by the Patent Office, are forever binding upon him if he chooses to accept a patent containing them. Not only are third persons likely to be misled to their injury by any subsequent enlargement by re-issue, or by a broad construction of Claims thus intended to be limited, but these qualifications are conditions precedent, without which there would have been no grant at all, and, of course, the grant must be taken as it is given." 23 O. G. 1444 (1445). See also *Dodds v. Stoddard* (1883), 24 O. G. 799 ; 17 Fed. Rep. 645 ; *Putnam v. Hutchinson* (1882), 12 Fed. Rep. 127 ; 11 Bissell, 233 ; *Goodyear Dental Vulcanite Co. v. Davis* (1880), 102 U. S. 222 ; 19 O. G. 543.

That a disclaimer, by direction of the Commissioner, in an application for a re-issue, of some modification of the original, does not concede that such modification is not covered by the patent, as it might do if in the original patent, see *Union Metallic Cartridge Co. v. United States Cartridge Co.* (1881), 7 Fed. Rep. 344.

That an applicant limiting his Claims upon a re-issue in view of the objections of the Patent Office is bound by the limitations in suits on the re-issue, see *Crawford v. Heysinger* (1887), 123 U. S. 589 ; 42 O. G. 197.

⁶ Two exceptions have sometimes been recognized as existing under this rule : one, where the limitation in the

patent, knows that it does not cover all he had originally claimed. Instead of pressing his original application until

original patent was imposed through a mistake in the Patent Office; the other, where it resulted from the act of an attorney without special authority for that purpose from the applicant. The modern tendency seems to be to disregard these exceptions, and to compel the patentee to abide by the patent as he receives and accepts it. Thus that a re-issue may claim matters which, through a mistake in the Patent Office, were disclaimed in the original, was held in *American Shoe Tip Co. v. National Shoe Toe Protector Co.* (1877), 11 O. G. 740; 2 Bann. & A. 551; *Ex parte Sexton* (1876), 9 O. G. 251; *Morey v. Lockwood* (1868), 8 Wall. 230.

That where the Patent Office gives an erroneous interpretation to a Claim and thereupon rejects it with the assent of the patentee, the Claim bearing a different interpretation may be re-instated in a re-issue, see *Yale Lock Mfg. Co. v. New Haven Savings Bank* (1887), 32 Fed. Rep. 167; 43 O. G. 115.

The opposite doctrine is asserted in *Ex parte Hatchman* (1884), 3 Mackey, 288; 26 O. G. 738; *Putnam v. Hutchinson* (1882), 11 Bissell, 233; 12 Fed. Rep. 127; and cases cited under note 3, *ante*.

That a patentee having acquiesced in the rejection of broad Claims cannot afterward assert them, though the rejection was improper, see *Blodes v. Rand, McNally, & Co.* (1886), 27 Fed. Rep. 93; 37 O. G. 99.

The present state of the second exception is more doubtful, as the following authorities will show:—

That a disclaimer by an attorney without authority from the patentee is no bar to a re-issue covering the matter disclaimed, see *Lee v. Walsh* (1879), 15 O. G. 563; *Ex parte Murdock* (1879), 16 O. G. 957; *Mann v. Bayliss* (1876), 10 O. G. 789.

That a re-issue may embrace a Claim shown in the original application and erased by a misunderstanding of the attorney, see *Stutz v. Armstrong* (1884), 28 O. G. 367; 20 Fed. Rep. 843.

That material matters cannot be disclaimed by an attorney of his own motion, but only by the applicant himself, though immaterial matter may be disclaimed without the signature of the party, see *Ex parte Murdock* (1879), 16 O. G. 957.

But *per contra*,—

That an erasure of a rejected Claim by an attorney shows that there is no inadvertence, see *Ex parte Hatchman* (1884), 3 Mackey, 288; 26 O. G. 738; *Ex parte Hatchman* (1883), 25 O. G. 979.

That matter disclaimed in the Patent Office by the attorney to escape rejection cannot be reclaimed in a re-issue, though the patentee were ignorant of the disclaimer, see *Arnheim v. Finster* (1885), 24 Fed. Rep. 276; 32 O. G. 256.

That a mistake of a solicitor in procuring a patent with Claims narrower than he was instructed to make cannot be cured by re-issue after years of delay, see *Ives v. Sargent* (1887), 119 U. S. 652; 38 O. G. 781.

That where two rivals employ the same attorney who in good faith limits the application of one to allow priority in some matter to the other, and both acquiesce in the patents so granted for nine years and then discover that the other was its real inventor, no re-issue can be had by him to cover it and neither can hold it, see *Hartshorn v. Saginaw Barrel Co.* (1887), 119 U. S. 664; 38 O. G. 540.

That a Claim rejected in the Patent Office, and the rejection acquiesced in by the attorney for the inventor, cannot be inserted in a re-issue after two years'

his rights have been determined by the court of last resort, he has relinquished a portion of the fruits of his inventive skill, at least from the protection of that particular patent, in order to secure the rest, and whether his course in this respect were wise or unwise, he cannot afterward retrace it and by re-issuing his patent claim the matter once excluded.⁷

delay and after intervening rights have arisen, see *Boland v. Thompson* (1886), 23 Blatch. 440 ; 26 Fed. Rep. 633 ; 35 O. G. 1113.

That a claim stricken out of the original application because disallowed in the Patent Office, and whose subject-matter is not covered by the original patent as accepted by the patentee's solicitor, cannot be inserted in a re-issue, see *Dobson v. Lees* (1887), 30 Fed. Rep. 625.

That the inventor is a foreigner who does not understand English cannot save him if duly put upon his guard in reference to such rejection, see *Boland v. Thompson* (1886), 23 Blatch. 440 ; 26 Fed. Rep. 633 ; 35 O. G. 1113.

⁷ In *Leggett v. Avery* (1879), 101 U. S. 256, Bradley, J. : (259) " If, in any case, where an applicant for letters-patent, in order to obtain the issue thereof, disclaims a particular invention, or acquiesces in the rejection of a Claim thereto, a re-issue containing such Claim is valid (which we greatly doubt), it certainly cannot be sustained in this case. The allowance of Claims once formally abandoned by the applicant, in order to get his letters-patent through, is the occasion of immense frauds against the public. It not unfrequently happens that, after an application has been carefully examined and compared with previous inventions, and after the Claims which such an examination renders admissible have been settled with the acquiescence of the applicant, he, or his assignee, when the investigation is forgotten and perhaps new officers have

been appointed, comes back to the Patent Office, and, under the pretence of inadvertence and mistake in the first specification, gets inserted into re-issued letters all that had been previously rejected. In this manner, without an appeal, he gets the first decision of the Office reversed, steals a march on the public, and on those who before opposed his pretensions (if, indeed, the latter have not been silenced by purchase), and procures a valuable monopoly to which he has not the slightest title. We have more than once expressed our disapprobation of this practice. As before remarked, we consider it extremely doubtful whether re-issued letters can be sustained in any case where they contain Claims that have once been formally disclaimed by the patentee, or rejected with his acquiescence, and he has consented to such rejection in order to obtain his letters-patent. Under such circumstances, the rejection of the Claim can in no just sense be regarded as a matter of inadvertence or mistake. Even though it was such, the applicant should seem to be estopped from setting it up on an application for a re-issue." 17 O. G. 445 (446).

In *Wicks v. Stevens* (1876), 2 Woods, 310, Bradley, J. : (312) " The patent of 1866 was confined to portable revolving cotton-presses. I assume that the re-issued patent extends to all cotton-presses, stationary as well as portable, for, if confined to the latter, the defendant does not infringe it. Had this extension to stationary presses been omitted in the original patent by acci-

§ 690. **Intentional Exclusion Shown by Failure to Claim Matter Clearly Described in the Original Patent unless the Claims are Amended by Re-issue without Unreasonable Delay.**¹

The omission from the Claims of the original patent of any feature of the invention, or of any subordinate or dependent

dent or mistake, it might be corrected in the re-issued patent. But its application to revolving presses generally was first claimed and then abandoned in the application for the original patent of 1866, and the Claim as finally made by the patentee, and to secure which alone his patent issued, was for a combination applicable to portable presses only. It cannot be said, therefore, that a neglect to claim the combination as applicable to revolving presses generally was an inadvertence, accident, or mistake. It was an exclusion designed and understood at the time. Attempts to grasp claims by means of re-issued patents, which, while the evidence is fresh at the time of the original application, the patentee would not have the hardihood to make, are getting too frequent, and are too often acquiesced in by the Patent Office. Perhaps this is not to be wondered at when we consider the persistency with which claims once abandoned are pressed upon the department after the evidence of their futility has been forgotten." 2 Bann. & A. 318 (319).

That where the Patent Office rejects a Claim, an appeal or bill in equity, not a re-issue, is the remedy, see *Arnheim v. Finster* (1886), 26 Fed. Rep. 277; 34 O. G. 700; *Shepard v. Carrigan* (1886), 116 U. S. 593; 34 O. G. 1157; *Mahn v. Harwood* (1884), 112 U. S. 354; 30 O. G. 657; *New York Belting & Packing Co. v. Sibley* (1883), 15 Fed. Rep. 386; 23 O. G. 1444; *Putnam v. Hutchinson* (1882), 12 Fed. Rep. 127; 11 *Bissell*, 233.

§ 690. ¹ The doctrine discussed in

this and the two succeeding paragraphs is one which all the decisions cited in the notes sustain, and which a few of them clearly and exclusively enunciate. In many of the opinions explaining these decisions, however, other theories are introduced and treated as the grounds on which the judgment of the court is based, thereby tending to obscure a proposition which in itself is sufficiently intelligible. These theories have been echoed by one court to another, sometimes in their entirety, sometimes shorn of their most important qualifications, and sometimes generalized into sweeping rules and applied to cases far beyond their legitimate scope, and thus have reduced the law on this topic to a condition of incoherence and uncertainty which is deplorable. To cite these cases without pointing out the chief errors of statement which are to be encountered, and explaining the relation of the most important of these theories to the true principles by which the subject must be governed, would be fruitless.

One of these theories is that a re-issue for the purpose of enlarging the Claims of a patent occupies a position different from that of a re-issue to restrict the Claims or more clearly describe the invention, both in reference to the time within which such re-issue must be sought, and to the mode in which it is affected by the intervening acts of others. Upon what interpretation of the statutes this position rests is explained at length in § 656, note 2, in a discussion of the case of *Miller v. Brass Co.* (1881), 104 U. S. 350. But if it be true that a re-issue for the purpose

invention, which has been clearly described in the specifica-

of enlarging Claims which were unduly restricted in the original is proper (and this is conceded by the theory under review), such re-issue is authorized by the statute whenever the original restriction arose from inadvertence, accident, or mistake, without any reference to lapse of time, or the acts of other parties. The inventor having actually invented more than his original patent has really secured, can lose the excess only by some form of abandonment, and this can never be inferred from mere delay alone, nor from the conduct of third parties. The intention to abandon (and without such intention no abandonment of any kind is possible) is conclusively disproved if the inventor attempted to cover the matter by his original patent, as it is, on the other hand, conclusively established if no such attempt were made. And as an omission or misstatement in a Claim, through inadvertence, accident, or mistake, presupposes an attempt to claim which has failed to accomplish the intention of the claimant, so it can never be true that matter originally misstated or omitted, through accident, mistake, or inadvertence, can have been then abandoned. But if the invention could not have been abandoned by the failure of an attempt to secure its protection, abandonment is certainly not effected by the mere continuance of the patent in its defective state. If the inventor does not relinquish his right to the invention by taking out his patent in its defective form, he surely cannot relinquish it by holding under the defective patent in the belief that it sufficiently protects his actual invention, whatever period may elapse. Not until he acquires such knowledge of the defects as would have made his original acceptance of the patent in that form incompatible with the idea of inadvertence, accident, or mistake in describ-

ing and claiming the invention, can any want of intention to monopolize the entire invention, as he originally attempted to describe it, be imputed to him. But when this knowledge is obtained, or by the exercise of ordinary vigilance could be obtained, his acquiescence in the defects of his original patent has a grave significance. Such acquiescence indicates an intention to abandon whatever the original patent, because of these defects, fails to secure. Were it not for the peculiar language of the statute and the dependence of the re-issued patent, so far as the patentability of the invention is concerned, upon the state of facts existing at the date of the original, it might indeed be held that this acquiescence is in itself an abandonment of the unprotected matter, and a bar to its reproduction in the re-issue. But the statute governing re-issues contains no provision for their refusal on account of the abandonment of the invention after the grant of the original patent. On the contrary, it makes the actions and attempts of the inventor at the date of the original application the sole criterion of his right to a re-issue, and until the case of *Miller v. Brass Co.* the courts had, with scarcely an exception, followed the same rule. See *Battin v. Taggart* (1854), 17 How. 74, overruling *Battin v. Taggart*, 2 Wall. Jr. 102, and asserting that matter described but not claimed does not become abandoned by lapse of time; also *Hussey v. Bradley* (1863), 5 Blatch. 134; 2 Fisher, 362; *McWilliams Mfg. Co. v. Blundell* (1882), 22 O. G. 177; 11 Fed. Rep. 419. Thus the acquiescence of a patentee in a defective patent can have no other weight, either in a subsequent application for a re-issue or in an action involving the validity of a re-issued patent, than as evidence of the real position of the patentee toward his invention at the date

tion, is always *prima facie* evidence of an intention, on the

of his original patent, and of the origin of his omissions and misstatements in intention rather than in accident, inadvertence, or mistake. His negligence in asserting his rights after he becomes aware that they are not sufficiently protected by his existing patent affords ample proof of his original intention to forego them, and it is only as an element in such negligence that the delay of the patentee in obtaining an amendment by re-issue is open to consideration.

The argument here urged is not intended as a denial that Congress could justly have withheld the privilege of a re-issue on the ground of unreasonable delay alone, without regard to the inference it affords as to the original intent of the inventor. But as neither the acts of 1832 or 1836 or 1870, nor the Revised Statutes, prescribe that diligence *per se* is essential to the right to a re-issue, while in reference to a disclaimer it was made an indispensable condition, and as in numerous instances re-issues have been granted after long periods of time, and have been unhesitatingly sustained by the courts, it is a fair conclusion that the legislature, in which the ultimate power to grant or withhold patents resides, never designed that the mere failure to apply for a re-issue, however prolonged, should operate as a forfeiture of the right to amend a patent whose defects originated in the modes described. Nor is it intended to deny that where legislative enactments are deficient, and inadequate to the protection of rights, the courts may act on general principles of justice and equity, and by a species of judicial legislation provide for cases not covered by the letter of the law. Thus if the removal and prevention of the abuses which had arisen in connection with re-issues could not have been accomplished by a true interpretation and

enforcement of the provisions of the statutes, a resort to the doctrine that vested rights may be forfeited by laches or estoppel might have been excusable. But in the explication herein given of the positive law relating to re-issues, it seems evident that the legislative enactment is sufficient for itself, and that no occasion exists for the importation into this subject of those equitable theories which place the inventor entirely at the mercy of the court, although he may in all respects have fulfilled the express precepts of the law.

The effect of the conduct of third parties upon the right of a patentee to a re-issue amending his defective Claims is subject to still narrower limitations. Until he has knowledge, or is put upon such inquiry as would result in knowledge, that his invention is not fully secured by his patent, the actions and assertions of others cannot deprive him of the privilege of a re-issue when he does discover its necessity, either under the language of the statute or under the doctrines of abandonment or laches or estoppel. As was well said by Bradley, J., in *White v. Dunbar* (1886), 119 U. S. 47 (52): "The circumstance that other improvements and inventions, made after the issue of a patent, are often sought to be suppressed or appropriated by an unauthorized re-issue, has sometimes been referred to for the purpose of illustrating the evil consequences of granting such re-issues; but it adds nothing to their illegality." 37 O. G. 1002 (1003). For if, during his ignorance of the defects of his own patent, the patentee ascertains that others use, under a claim of right, that which is in reality the unprotected part of his invention, he must naturally regard them as infringers, whose tortious acts the law permits him to condone or punish at his pleasure. If a third party obtains a

part of the inventor, to exclude it from the operation of that

patent for what appears to be the same invention or one of its protected elements, without an interference with his patent, he may safely assume that the inventions are essentially distinct, and that no occasion for a vindication of his rights has been created. The conduct of other persons is thus without significance on this question except in connection with knowledge on the part of the patentee that his own patent needs amendment in order to protect his entire invention. But since when he attains this knowledge it is his duty to amend his patent without unreasonable delay if he would avoid the inference that the unprotected matter was at the outset intentionally excluded, whether or not third persons are using or have patented the unsecured invention, it is evident that their conduct can become important only when the reasonableness of his delay is to be determined. A period of inaction after the discovery of the defects in his patent, which might well be permitted were no antagonistic interests involved, would be wholly unwarrantable when other patentees or operators were claiming or enjoying the invention, and in proportion to the number and the value of such interests might greater degrees of diligence in applying for the re-issue be required.

If these views of the questions of delay and intervening rights are correct, the true doctrine in reference to both is this : that the Claims of a re-issue may be altered or enlarged to cover the entire invention which the patentee attempted to embrace in his original patent, provided he applies for a re-issue within such a period after he discovers or ought to have discovered the defect as is consistent with an original intention to protect the invention by his patent ; and that upon the consistency of this period of delay with such original

intention, the existence of antagonistic rights and interests in others is one important matter for consideration. That this is also the real doctrine of the cases in which the theory under discussion is set forth will be evident if the whole current of authority is examined, and the relation of each decision to those which it purports to follow as its guides is carefully traced.

Another theory, sometimes found in connection with the preceding is, that where the Claims of an original patent do not cover the entire invention, the defect is necessarily apparent to the patentee on an inspection of the patent, and hence that he is chargeable with notice of the error from the date of his reception of the patent. If this statement were to be regarded as a rule that no amendment by re-issue should be considered as an enlargement of the patent unless the error amended were apparent on the face of the original, the even balance of justice might not be thereby disturbed. But as the assertion of a fact it is not true. In the great majority of instances a failure to claim may be evident on inspection, but in many the nature of the invention may be so complicated, and its essential features so difficult of expression, that the patentee may fairly and honestly believe that he has embraced it in his Claims, while more mature experience or the subsequent decisions of the courts upon his patent may demonstrate his error. Upon the rule of law that when the discrepancy between the invention and the subject-matter of the Claims appears on an examination of the patent the patentee is chargeable with immediate knowledge and must pursue his remedy without delay, there can be no difference of opinion. But that in cases where the patentee does not discover, and with the employment of such vigi-

patent; and this evidence is regarded as conclusive upon him,

lance as the law requires of every assertor of a right could not discover, that his Claims were narrower than his invention, as he had attempted to secure it, it must be assumed either that he had notice at the issue of his patent, or that the correction of the Claims to make them correspond with the invention was not an enlargement, is alike unnecessary and inconsistent with the ordinary rules of law.

The two foregoing theories obtain especial prominence from their apparent recognition in the noted case of *Miller v. Brass Co.* (1881), 104 U. S. 350. Prior to the decision of this case the law of re-issue had been interpreted with great laxity in favor of patentees, and its application in many instances had been exceedingly abused. The Supreme Court availed itself of the opportunity afforded by this case to restore the administration of the law to its proper limits. It discovered and formulated no new principles, but simply reaffirmed the propositions that a re-issue cannot embrace new matter under any circumstances, nor any matter whose omission or misstatement in the original patent was intentional. But in its statement and explanation of these propositions the court labored under a peculiar embarrassment. The evil which it undertook to remedy was the enlargement of the Claims in a re-issue after individuals or the public had acted on the implied abandonment contained in the original. But as the law expressly conferred upon a patentee the right to claim in his re-issue any matter which he had attempted to describe and claim in the original patent, and which he had therein failed to claim through inadvertence, accident, or mistake, the Supreme Court could not repudiate or qualify this right. The question of identity was settled in favor of the pat-

entee, if the original patent disclosed the subject-matter of the re-issue, and at the same time the decision of the Commissioner that the original defect arose from accident, mistake, or inadvertence was regarded as conclusive; and thus no method of avoiding the re-issue, however flagrant the abuse, appeared without a resort to theories which though familiar to equity jurisprudence were hitherto unknown to Patent Law, except as casual *dicta*, uttered in cases upon whose decision they had exercised no influence. Had the Supreme Court asserted its judicial power to re-examine the question of original inadvertence, etc., as it is now beginning to be recognized, and had it announced the doctrine that an original intention to abandon is indicated by a failure to correct the omission or misstatement as soon as it is brought home to the knowledge of the patentee, its decision would have reached the desired result without producing those evils which are engendered by uncertainties in legal rules and by supposed departures from settled principles of law.

Starting from these two theories, several propositions have been formulated by the courts, — some a direct application of the theories to the facts in controversy, and others evidently based on a misunderstanding of the theories themselves. Thus certain cases state that a re-issue to enlarge Claims after long delay is not permissible, making no mention of the further necessary condition that delay cannot begin until the patentee becomes aware of the defect or is put upon inquiry which would result in knowledge. Among these are *Curran v. St. Louis Refrigerator & Wooden Gutter Co.* (1886), 39 O. G. 590; *Tubular Rivet Co. v. Copeland* (1886), 26 Fed. Rep. 706; 34 O. G. 1277; *White v. Dunbar* (1886), 119 U. S. 47; 37 O. G. 1002; *Asmus v. Alden* (1886), 27

unless he has corrected the omission by a re-issue without un-

Fed. Rep. 684 ; 36 O. G. 231 ; Hubel v. Dick (1886), 28 Fed. Rep. 656 ; 24 Blatch. 139 ; 87 O. G. 1480 ; Phillips v. Kisser (1885), 26 Fed. Rep. 308 ; Electric Gas Lighting Co. v. Smith & Rhodes Electric Co. (1885), 23 Fed. Rep. 195 ; 31 O. G. 792 ; Holt v. Kendall (1885), 26 Fed. Rep. 622 ; 35 O. G. 874 ; Arden v. Jowett (1885), 32 O. G. 1241 ; Mahn v. Harwood (1884), 112 U. S. 354 ; 30 O. G. 657 ; Simon v. Neumann (1884), 27 O. G. 918 ; 20 Fed. Rep. 196 ; Vacuum Oil Co. v. Buffalo Lubricating Oil Co. (1884), 22 Blatch. 266 ; 28 O. G. 1101 ; 20 Fed. Rep. 850 ; Flower v. Detroit (1884), 22 Fed. Rep. 292 ; Hayes v. Bickelhaupt (1884), 29 O. G. 368 ; 21 Fed. Rep. 566 ; Turner & Seymour Mfg. Co. v. Dover Stamping Co. (1884), 111 U. S. 319 ; 27 O. G. 1131 ; *Ex parte* Flynn (1883), 23 O. G. 2029 ; Combined Patents Can Co. v. Lloyd (1882), 21 O. G. 713 ; 11 Fed. Rep. 149 ; 15 Phila. 481 ; *Ex parte* Lee (1882), 23 O. G. 342 ; Jones v. Barker (1882), 22 O. G. 771 ; 11 Fed. Rep. 597 ; Sheriff v. Fulton (1882), 22 O. G. 87 ; 12 Fed. Rep. 136.

In some cases the existence of intervening rights, either alone or coupled with delay, is treated as a bar to a re-issue, still without mention of the state of the patentee's knowledge concerning the defect to be amended, as for example, *Asmus v. Alden* (1886), 27 Fed. Rep. 684 ; 36 O. G. 231 ; *Hudnut v. Lafayette Hominy Mills* (1886), 26 Fed. Rep. 636 ; 35 O. G. 1338 ; *Newton v. Furst & Bradley Co.* (1886), 119 U. S. 373 ; 38 O. G. 104 ; *Baltimore Car Wheel Co. v. North Baltimore Passenger Ry. Co.* (1884), 21 Fed. Rep. 47 ; *Wooster v. Handy* (1884), 22 Blatch. 307 ; 21 Fed. Rep. 51 ; 28 O. G. 629 ; *Electric Gas Lighting Co. v. Tillotson* (1884), 22 Blatch. 481 ; 21 Fed. Rep.

568 ; *Flower v. Detroit* (1884), 22 Fed. Rep. 292 ; *Matthews v. Iron Clad Mfg. Co.* (1884), 22 Blatch. 427 ; 21 Fed. Rep. 641 ; 29 O. G. 693 ; *Turner & Seymour Mfg. Co. v. Dover Stamping Co.* (1883), 111 U. S. 319 ; 27 O. G. 1131 ; *Lansburgh v. Hasbrouck* (1883), 21 Blatch. 325 ; 16 Fed. Rep. 566.

Another class of cases may be found in which the judgment of the court is based on the union of one or more of the foregoing propositions with others which would be alone decisive of the controversy. Thus while it is true that new matter can never be claimed in a re-issue, that a re-issue can never be allowed except to cure an unintentional error, that features not disclosed in the original can never be inserted in the re-issue, that an invention once intentionally excluded can never be reclaimed, that the delay of a re-issue for an unreasonable time after the defect was discovered is conclusive evidence of such intentional exclusion, and that any one of these conditions is a complete bar to the allowance or enforcement of a re-issued patent, these cases combine such conditions with each other as if their concurrence were necessary to deprive the patentee of his asserted rights. Among these are the following :

That a re-issue including new matter after unreasonable delay is void, see *Clements v. Odorless Excavating Apparatus Co.* (1884), 109 U. S. 111 ; 26 O. G. 353.

That a re-issue after unreasonable delay cannot claim a new use, thus covering a new mode of use, and a Claim whose novelty rests on such mode of use is invalid, see *Gardner v. Herz* (1886), 118 U. S. 180 ; 35 O. G. 999.

That a re-issue containing new matter is void after eight or nine years, unless the same matter is in some way claimed in the original, see *Electric*

reasonable delay.² The error in this case, if any, consists in a

Gas Lighting Co. v. Smith & Rhodes Electric Co. (1885), 31 O. G. 792 ; 23 Fed. Rep. 195.

That no re-issue can be granted in order to enlarge a Claim unless there is a clear mistake in the wording of the Claim through inadvertence, and no unreasonable delay in applying for a re-issue, see Western Union Tel. Co. v. Baltimore & Ohio Tel. Co. (1885), 25 Fed. Rep. 30 ; Mahn v. Harwood (1884), 112 U. S. 354 ; 30 O. G. 657.

That matter described and intentionally omitted from the Claim is abandoned and cannot be covered by a re-issue, as against the intervening rights of the public, see Railway Register Mfg. Co. v. Broadway & Seventh Ave. R. R. Co. (1886), 26 Fed. Rep. 522 ; 31 O. G. 921.

That a re-issue cannot claim, after fourteen years, an improvement not noticed in the original patent, though it was invented before the original, see Sickels v. Falls Co. (1861), 2 Fisher, 202 ; 4 Blatch. 508.

That a patent for mechanism cannot re-issue eleven years afterward to cover the process, as the inventions are different, see Scrivner v. Oakland Gas Co. (1884), 22 Fed. Rep. 98 ; 10 Sawyer, 390.

That where the original patent describes *inter alia* a part of a machine but states no use for it and makes no claim to it, a re-issue to cover it is invalid, at least after three years, see Reay v. Raynor (1884), 22 Blatch. 13 ; 26 O. G. 1111 ; 19 Fed. Rep. 308.

That where the original patent is limited to a specific device no enlargement of its Claims can be permitted by re-issue after nine years' delay, see Sheriff v. Fulton (1882), 22 O. G. 87 ; 12 Fed. Rep. 136.

Examples of a contrary character in which the independence of these condi-

tions, and the sufficiency of each to prevent the allowance of a re-issue is asserted, may be found in the following : —

That diligence is of no consequence unless the re-issue is for the same invention as the original, see Ives v. Sargent (1887), 119 U. S. 652 ; 38 O. G. 781 ; Russell v. Laughlin (1886), 26 Fed. Rep. 699 ; 35 O. G. 1436 ; Coon v. Wilson (1885), 113 U. S. 268 ; 30 O. G. 889 ; Cowell v. Sessions (1883), 21 Blatch. 421 ; 17 Fed. Rep. 450.

That if the invention is not shown in the original patent there can be no re-issue at any time, see Hammond v. Franklin (1885), 23 Blatch. 77 ; 22 Fed. Rep. 833 ; 30 O. G. 1324.

In addition to the theories herein discussed there are several others which have from time to time found utterance from the bench in reference to this portion of the subject of re-issues. To notice each in detail would be needless. Most of them, if not all, are so far connected with those heretofore considered that it will require little acumen to detect their errors, and little deliberation to correct them. Understanding that no harmony is to be expected between unsound doctrines, and that the only true doctrine is that which fits all cases and distributes justice to all parties, the reader may compare the citations now to follow with each other and with the text, without danger of being misled by epigrammatic *dicta*, or by hastily conceived hypotheses.

² This proposition, be it remembered, is fully true only of cases in which clearly described matter is wholly omitted from the Claims. It is partially true in many cases where the matter has been misstated in the Claims. In those cases of misstatement where the Claim is open to several constructions, some of which would include and others

direct repugnance between the two parts of his specification,

exclude the matter in question, it is, however, false; for here only judicial interpretation can finally determine the real scope of the Claim. Hence the ordinary treatment of omissions and misstatements, as if all stood on equal ground and were to be governed by the same rule, is not correct. To enlarge a Claim by inserting matter which it never before contained or appeared to contain is one thing; to enlarge it by amending a misstatement is quite another. The extracts which follow do not, unfortunately, preserve this distinction, but the mere suggestion that it exists will be sufficient to guard the reader against extending the doctrine of these cases beyond its proper scope, whatever language the judges have seen fit to employ.

In *Wollensak v. Reiher* (1885), 115 U. S. 96, Matthews, J. : (99) "It follows from this that if at the date of the issue of the original patent, the patentee had been conscious of the nature and extent of his invention, an inspection of the patent, when issued, and an examination of its terms, made with that reasonable degree of care which is habitual to and expected of men in the management of their own interests in the ordinary affairs of life, would have immediately informed him that the patent had failed fully to cover the area of his invention. And this must be deemed to be notice to him of the fact, for the law imputes knowledge when opportunity and interest, combined with reasonable care, would necessarily impart it. Not to improve such opportunity under the stimulus of self-interest, with reasonable diligence, constitutes laches, which in equity disables the party who seeks to revive a right which he has allowed to lie unclaimed from enforcing it to the detriment of those who have, in consequence, been led to act as

though it were abandoned. This general doctrine of equity was applied with great distinctness to the correction of alleged mistakes in patents by re-issues in the case of *Miller v. Brass Company*, 104 U. S. 350. It was there declared that where the mistake suggested was merely that the Claim was not as broad as it might have been, it was apparent upon the first inspection of the patent, and, if any correction was desired, it should have been applied for immediately; that the granting of a re-issue for such a purpose, after an unreasonable delay, is clearly an abuse of the power to grant re-issues, and may justly be declared illegal and void; that, in reference to re-issues made for the purpose of enlarging the scope of the patent, the rule of laches should be strictly applied, and no one should be relieved who has slept upon his rights, and has thus led the public to rely on the implied disclaimer involved in the terms of the original patent; and that when this is a matter apparent on the face of the instrument, upon a mere comparison of the original patent with the re-issue, it is competent for the courts to decide whether the delay was unreasonable and whether the re-issue was, therefore, contrary to law and void." 31 O. G. 1301 (1302). *Quere*, whether *Miller v. Brass Co.* does declare that "where the mistake suggested was merely that the Claim was not as broad as it might have been, it was apparent upon the first inspection of the patent?" The author does not so understand the language of Mr. Justice Bradley in that decision. In one part of the opinion he states that in the case at bar the defect was apparent on the first inspection of the patent; and in another portion lays down the general rule that "when, if a Claim is too narrow, — that is, if it does not contain all that the patentee is entitled

and though it might occur through inadvertence, accident, or

to — the defect is apparent on the face of the patent, . . . there can be no valid excuse for delay," etc. But this latter assertion is very far from a declaration that "when Claims are too narrow the defect is apparent on the face of the patent." The construction put by *Wollensak v. Reiher* on this language has sometimes been turned into the rule that when Claims are too narrow the patentee is chargeable with notice of that fact the moment the patent issues, — a rule pregnant with mischief and manifestly contrary to reason and justice. See also *Hoskin v. Fisher* (1888), 125 U. S. 217 ; 43 O. G. 509.

In *Wollensak v. Reiher* (1884), 22 Fed. Rep. 651, Gresham, J. : (652) "When an inventor receives his patent, it is his duty to examine it promptly, see that his invention is properly described, and that his Claims are broad enough to embrace it in all its scope. If, upon a more reading of his patent, it is obvious that he is entitled to a re-issue with broader and more comprehensive Claims, he must make his application speedily. Failure to do this is a dedication to the public of so much of his invention as is not covered by his Claim. The rule of laches is strictly applied in such cases."

In *Mahn v. Harwood* (1884), 112 U. S. 354, Bradley, J. : (360) "The taking out of a patent which has (as the law requires it to have) a specific Claim, is notice to all the world, of the most public and solemn kind, that all those parts of the art, machine, or manufacture set out and described in the specification and not embraced in such specific Claim, are not claimed by the patentee, — at least not claimed in and by that patent. If he has a distinct patent for other parts, or has made application therefor, or has reserved the right to make such application, that is

another matter, not affecting the patent in question. But so far as that patent is concerned, the Claim actually made operates in law as a disclaimer of what is not claimed ; and of all this the law charges the patentee with the fullest notice. Then, what is the situation? The public is notified and informed, by the most solemn act on the part of the patentee, that his Claim to invention is for such and such an element or combination, and for nothing more. Of course what is not claimed is public property. The presumption is, and such is generally the fact, that what is not claimed was not invented by the patentee, but was known and used before he made his invention. But, whether so or not, his own act has made it public property if it was not so before. The patent itself, as soon as it is issued, is the evidence of this. The public has the undoubted right to use, and it is to be presumed does use, what is not specifically claimed in the patent. Every day that passes after the issue of the patent adds to the strength of this right, and increases the barrier against subsequent expansion of the claim by re-issue under a pretence of inadvertence and mistake." 30 O. G. 657 (659).

In *Miller v. Brass Co.* (1881), 104 U. S. 350, Bradley, J. : (352) "But it must be remembered that the Claim of a specific device or combination, and an omission to claim other devices or combinations apparent on the face of the patent are, in law, a dedication to the public of that which is not claimed. It is a declaration that that which is not claimed is either not the patentee's invention, or, if his, he dedicates it to the public. This legal effect of the patent cannot be revoked unless the patentee surrenders it and proves that the specification was framed by real inadvertence, accident, or mistake,

mistake, it could not fail to become apparent on inspection

without any fraudulent or deceptive intention on his part; and this should be done with all due diligence and speed. Any unnecessary laches or delay in a matter thus apparent on the record affects the right to alter or re-issue the patent for such cause. If two years' public enjoyment of an invention with the consent and allowance of the inventor is evidence of abandonment, and a bar to an application for a patent, a public disclaimer in the patent itself should be construed equally favorable to the public. Nothing but a clear mistake or inadvertence, and a speedy application for its correction, is admissible when it is sought merely to enlarge the Claim." 21 O. G. 201 (202).

In *Giant Powder Co. v. California Vigorit Powder Co.* (1880), 18 O. G. 1339, Field, J.: (1340) "The statute authorizing a re-issue was intended to protect against accidents and mistakes, and it is only when thus restricted that it can be regarded as a beneficial statute. If a patentee does not embrace by his specifications and Claim all that he might have done, and there has been no clear mistake, inadvertence, or accident in their preparation, the presumption of law is that he has abandoned to the use of the public everything outside of them, or at least has postponed any additional Claim for further consideration." 6 Sawyer, 508 (522); 4 Fed. Rep. 720 (725).

Further, that no re-issue can be allowed to claim matter clearly described in the original patent but evidently omitted from its Claims, unless the re-issue is applied for within a reasonable time after the grant of the original, see *Ives v. Sargent* (1887), 119 U. S. 652; 38 O. G. 781; *Gage v. Kellogg* (1885), 23 Fed. Rep. 891; 32 O. G. 381; *Reed v. Chase* (1885), 25 Fed. Rep. 94; 33 O. G. 996; *Wooster v. Handy* (1884),

22 Blatch. 307; 21 Fed. Rep. 51; 28 O. G. 629; *Scrivner v. Oakland Gas Co.* (1884), 22 Fed. Rep. 98; 10 Sawyer, 390; *Ives v. Sargent* (1883), 17 Fed. Rep. 447; 21 Blatch. 417; *Combined Patents Can Co. v. Lloyd* (1882), 11 Fed. Rep. 149; 21 O. G. 713; 15 Phila. 481; *Streit v. Lauter* (1882), 11 Fed. Rep. 309; *Holt v. Keeler* (1882), 22 O. G. 1201; 13 Fed. Rep. 464; 21 Blatch. 68; *Hayes v. Seton* (1882), 20 Blatch. 484; 12 Fed. Rep. 120.

That an omission to claim matter evidently belonging to the invention is abandonment, unless the patent is amended by re-issue without delay, see *Hill v. Commissioner* (1885), 4 Mackey, 266; 33 O. G. 757; *Ex parte Conklin* (1874), 5 O. G. 235; 1 MacArthur, 375.

That unnecessary delay in re-issuing is acquiescence in the patent as allowed, and an abandonment of the rest of the invention, see *Ex parte Flynn* (1883), 23 O. G. 2029; *Hayes v. Seton* (1882), 20 Blatch. 484; 12 Fed. Rep. 120.

That delay in re-issuing shows original abandonment, see *Tuttle v. Loomis* (1885), 24 Fed. Rep. 789; 30 O. G. 344.

That any long delay in applying for a re-issue raises a presumption against "mistake and inadvertence," see *Newton v. Furst & Bradley Mfg. Co.* (1882), 14 Fed. Rep. 465; 11 Bissell, 405.

That the greater the discrepancy the shorter should be the time, see *Mahn v. Harwood* (1884), 112 U. S. 354; 30 O. G. 657.

That where a combination-patent fails to claim a sub-combination, the error is an evident one, and the right to the protection of the sub-combination will be abandoned by delay, see *Gage v. Herring* (1883), 107 U. S. 640; 23 O. G. 2119; *Bantz v. Frantz* (1882), 105 U. S. 160; 21 O. G. 2037.

That a re-issue cannot cover a process

of the patent, if examined by the patentee with ordinary care.⁸

after nine years' use of the devices claimed in the original, when the process consists in the use of such devices, see *Brainard v. Crammo* (1882), 22 O. G. 769; 12 Fed. Rep. 621; 20 Blatch. 530.

That the presumption of intentional exclusion from a failure to claim clearly described matter is *prima facie* only, until an unreasonable delay in amending the patent renders such presumption conclusive, appears from the following decisions:—

That a thing not claimed in the original patent is not thereby abandoned *ipso facto* to the public, and may be claimed in a re-issue, see *Selden v. Stockwell Self-Lighting Gas Burner Co.* (1881), 19 Blatch. 544; 20 O. G. 1377; 9 Fed. Rep. 390.

That there is no conclusive presumption, from the absence of Claims from the original covering the matters claimed in the re-issue, that the inventor did not intend to claim them in the original, see *Eickmeyer Hat Blocking Mach. Co. v. Pearce* (1873), 6 Fisher, 219; 3 O. G. 150; 10 Blatch. 403.

That things described but not claimed in the original patent are not thereby abandoned and may be claimed in the re-issue, though they have gone into use, see *Ex parte Conklin* (1872), 2 O. G. 541.

⁸ In *Miller v. Brass Co.* (1881), 104 U. S. 350, Bradley, J.: (351) "It is manifest on the face of the patent, when compared with the original, that the suggestion of inadvertence and mistake in the specification was a mere pretence; or if not a pretence, the mistake was so obvious as to be instantly discernible on opening the letters-patent, and the right to have it corrected was abandoned and lost by unreasonable delay. The only mistake suggested is, that the Claim was not as broad as it might have been. This mistake, if it was a mistake, was apparent upon the first in-

spection of the patent, and if any correction was desired, it should have been applied for immediately." 21 O. G. 201 (201).

That if the inventor clearly perceives the nature of his invention he ought to be able to see whether his Claims protect it, see *Wollensak v. Reiher* (1885), 115 U. S. 96; 31 O. G. 1301. This seems to assume that if an idea is clearly perceived by the mind it can always be so expressed in words as to infallibly present to other minds precisely the same idea, — which is not true, especially in reference to conceptions in science and art. An inventor may believe that his Claims exactly cover his invention, but it does not follow that the judicial mind will arrive at the same conclusion.

That a delay in re-issuing to enlarge Claims is unreasonable if more time is taken than is needed to read the Claims and ascertain the necessity for their correction, see *Hartshorn v. Eagle Shade Roller Co.* (1883), 18 Fed. Rep. 90; 25 O. G. 1191.

That a patentee must examine his patent to see if it covers his invention, and three years' delay in so doing is unreasonable, and a re-issue then is invalid, if the defect is clear, see *Ives v. Sargent* (1886), 119 U. S. 652; 38 O. G. 781.

That where the omission to claim described matter is clear to intelligent persons, but the patentee and assignee were ignorant of it for want of using their means of knowledge, they are chargeable with laches, and if there is any delay in the re-issue, their right is forfeited, see *Ives v. Sargent* (1883), 21 Blatch. 417; 17 Fed. Rep. 447.

That a patentee is chargeable with notice of what the patent contains and is held to reasonable diligence, see *Western Union Tel. Co. v. Baltimore & Ohio Tel. Co.* (1885), 25 Fed. Rep. 30.

That ignorance of law is no excuse

The matter omitted from the Claims being so described in the specification as to place it fully before the public, they have a right to presume that the inventor intended to abandon it altogether, or to withhold it as the subject of a future patent. Under the law, as it existed before re-issues were allowed, such an omission would have operated as an irrevocable dedication of the unclaimed matter to the public, the original patent being unamendable, and the law permitting no new patent for an invention already publicly disclosed. Under the present law, however, these presumptions may be rebutted either by an application for a new patent for the omitted matter before two years of public use or sale have elapsed, or by a timely re-issue of the original patent. In the first case, the new application is independent of the former patent, and must be granted or denied on its own merits. In the second case, the re-issue is invalid when the duration of the period of delay is inconsistent with the idea of an original inadvertence, accident, or mistake.⁴ Upon this question of

for delay in a re-issue, see *Haines v. Peck* (1886), 26 Fed. Rep. 625 ; 35 O. G. 1227.

That a want of knowledge of the language is considered on the question of delay, see *Stutz v. Armstrong* (1884), 28 O. G. 367 ; 20 Fed. Rep. 843 ; *contra*, *Boland v. Thompson* (1886), 23 Blatch. 440 ; 26 Fed. Rep. 633 ; 35 O. G. 1113.

⁴ In *Miller v. Brass Co.* (1881), 104 U. S. 350, Bradley, J. : (355) " Now whilst, as before stated, we do not deny that a Claim may be enlarged in a re-issued patent, we are of opinion that this can only be done when an actual mistake has occurred ; not from a mere error of judgment (for that may be rectified by appeal), but a real *bona fide* mistake, inadvertently committed ; such as a court of chancery, in cases within its ordinary jurisdiction, would correct. Re-issues for the enlargement of Claims should be the exception and not the rule. And when, if a Claim is too narrow, — that is, if it does not contain

all that the patentee is entitled to, — the defect is apparent on the face of the patent, and can be discovered as soon as that document is taken out of its envelope and opened, there can be no valid excuse for delay in asking to have it corrected. Every independent inventor, every mechanic, every citizen, is affected by such delay, and by the issue of a new patent with a broader and more comprehensive Claim. The granting of a re-issue for such a purpose, after an unreasonable delay, is clearly an abuse of the power to grant re-issues, and may justly be declared illegal and void. It will not do for the patentee to wait until other inventors have produced new forms of improvement, and then, with the new light thus acquired, under pretence of inadvertence and mistake, apply for such an enlargement of his Claim as to make it embrace these new forms. Such a process of expansion carried on indefinitely, without regard to lapse of time, would operate most unjustly against the public, and is totally unauthorized by

delay the courts or the Patent Office must decide in view of all the circumstances of the case itself. No unbending rule can be established limiting the time when such amendments must be made.⁶ Analogy seems to require that no

the law. In such a case, even he who has rights, and sleeps upon them, justly loses them. The correction of a patent by means of a re-issue, where it is invalid or inoperative for want of a full and clear description of the invention, cannot be attended with such injurious results as follow from the enlargement of the Claim. And hence a re-issue may be proper in such cases, though a longer period has elapsed since the issue of the original patent. But in reference to re-issues made for the purpose of enlarging the scope of the patent, the rule of laches should be strictly applied; and no one should be relieved who has slept upon his rights, and has thus led the public to rely on the implied disclaimer involved in the terms of the original patent. And when this is a matter apparent on the face of the instrument, upon a mere comparison of the original patent with the re-issue, it is competent for the courts to decide whether the delay was unreasonable, and whether the re-issue was therefore contrary to law and void." 21 O. G. 201 (203).

See also *Hartshorn v. Eagle Shade Roller Co.* (1883), 25 O. G. 1191; 18 Fed. Rep. 90.

⁶ In *Mahn v. Harwood* (1884), 112 U. S. 354, Bradley, J. : (363) "As we have already stated, no invariable rule can be laid down as to what is reasonable time within which the patentee should seek for the correction of a Claim which he considers too narrow. In *Miller v. The Brass Company*, by analogy to the law of public use before an application for a patent, we suggested that a delay of two years in applying for such correction should be construed equally favorable to the public. But this was a mere suggestion by the way,

and was not intended to lay down any general rule. Nevertheless, the analogy is an apposite one, and we think that excuse for any longer delay than that should be made manifest by the special circumstances of the case." 30 O. G. 657 (659).

In *Stutz v. Armstrong* (1884), 20 Fed. Rep. 843, Acheson, J. : (845) "The Supreme Court has laid down no unbending rule by which to determine what is unreasonable delay in applying for the correction of such a mistake as existed here; and it seems to me that each case must be decided upon its special facts and merits. The application here was within two years after the grant of the original letters-patent; the exact lapse of time being one year, ten months, and eight days. Now, while this fact may not be conclusive, it would seem to be entitled to some consideration, in view of that provision of the Patent Laws by which nothing less than two full years' public use of an invention is a bar to an application for a patent. In *Miller v. Brass Co.*, the fact that much more than two years had elapsed between the grant of the original letters-patent and the application for the re-issue was evidently in the mind of Mr. Justice Bradley, and suggested the illustration employed by him on page 352 of the reported case. And in all the like cases in which the Supreme Court has ruled against the validity of the re-issue (so far as I know), the lapse of time has been greatly in excess of two years." 28 O. G. 367 (368).

That no fixed rule determines reasonable time see *Odell v. Stout* (1884), 22 Fed. Rep. 159; 29 O. G. 862.

That reasonable time depends on cir-

longer period should be allowed than that within which a new patent might be issued, and that after two years of public use and sale of the omitted matter its abandonment should be conclusively presumed. But in many instances even this period cannot be properly allowed.⁶ Where the practical importance and commercial value of the omitted matter is evident from the beginning, and where the inventor, therefore, must have known that in its original form the patent did not give him the complete protection which he needed to render all the fruits of his inventive skill available to him, any avoidable delay in the correction of the error is irreconcilable with the hypothesis that the omitted matter was unintentionally excluded. And on the other hand, where the unclaimed invention was not recognized as of material consequence until it had been tested by experience, or where no probability of adverse claims existed, or where the inventor might reasonably have supposed that his original patent would secure to him all that was really valuable in his invention, a delay of some duration is not incompatible with the idea of accident, inadvertence, or mistake in the original omission.⁷ As in all

cumstances, see *Western Union Tel. Co. v. Baltimore & Ohio Tel. Co.* (1885), 25 Fed. Rep. 30.

⁶ That two years is the usual limit for delay, see *Ex parte Flynn* (1883), 23 O. G. 2029.

That two years is in some cases a reasonable time, but not always, see *Mahn v. Harwood* (1884), 112 U. S. 354 ; 30 O. G. 657.

That an excuse for a delay longer than two years must be clearly shown, see *Ives v. Sargent* (1887), 119 U. S. 652 ; 38 O. G. 781.

That where the Claim of the original is clear and its scope plain, nine years' delay is unreasonable, see *Shirley v. Mayer* (1885), 23 Blatch. 249 ; 25 Fed. Rep. 38 ; 34 O. G. 1391.

That where the error, if any, is apparent and the articles claimed in the re-issue have gone into market, twenty-two months is too long a delay, see *Arn-*

heim v. Finster (1886), 26 Fed. Rep. 277 ; 34 O. G. 700.

That a delay of three months in applying for a re-issue is unreasonable when the defect is clear and other claimants intervene, if the only object is to enlarge the original Claims, see *Coon v. Wilson* (1885), 113 U. S. 268 ; 30 O. G. 889.

That a re-issue enlarging Claims within three months is in time, if no rights of others intervene, see *Hammond v. Franklin* (1885), 23 Blatch. 77 ; 22 Fed. Rep. 833 ; 30 O. G. 1324.

That a re-issue in two months is not laches, see *Russell v. Laughlin* (1886), 26 Fed. Rep. 699 ; 35 O. G. 1436.

That a few months' delay is of no consequence, see *Dryfoos v. Wiese* (1884), 22 Blatch. 19 ; 26 O. G. 639 ; 19 Fed. Rep. 315.

⁷ That the question of adverse intervening rights is usually embraced in

other cases where the questions of due diligence or reasonable time are involved, the conduct of the inventor is subject to the interpretation of the courts, and he must abide by their decision whatever may have been his own views as to the reasonableness of his delay.⁸ His delay having been judicially determined to be unreasonable, the inference that he originally intended to exclude the omitted matter from his patent becomes inevitable, and the re-issue cannot be sustained.

that of delay, see *Stutz v. Armstrong* (1884), 28 O. G. 367; 20 Fed. Rep. 843.

That the question whether adverse rights have arisen since the original patent was granted is always important on a re-issue, in reference to the claim of abandonment, see *Stutz v. Armstrong* (1884), 20 Fed. Rep. 843; 28 O. G. 367; *Brainard v. Cramme* (1882), 12 Fed. Rep. 621; 22 O. G. 769; 20 Blatch. 530.

That a patent for a combination issued in 1860, not claiming the sub-combinations, and re-issued in 1876 to cover them after the sub-combinations had been in use by others more than two years, is void for delay, see *Turrell v. Bradford* (1883), 21 Blatch. 284; 23 O. G. 1623; 15 Fed. Rep. 808.

That if sub-combinations are described in the original they may be claimed in the re-issue where there is no unnecessary delay and no injury to intervening rights, see *Hubel v. Dick* (1886), 28 Fed. Rep. 132; 36 O. G. 939; 24 Blatch. 59.

That where delays work an equitable estoppel it is in favor of the public, see *Consolidated Fruit Jar Co. v. Bellaire Stamping Co.* (1886), 27 Fed. Rep. 377; 35 O. G. 627.

That an unavoidable delay in applying for a re-issue does not work an

abandonment, see *Hartshorn v. Eagle Shade Roller Co.* (1883), 18 Fed. Rep. 90; 25 O. G. 1191.

⁸ In *Mahn v. Harwood* (1884), 112 U. S. 354, Bradley, J.: (360) "Conceding that it is for the Commissioner of Patents to determine whether the insertion of too narrow a Claim arose from inadvertence, accident, or mistake (unless where the matter is manifest from the record), the question whether the application for correction and re-issue is or is not made within reasonable time is, in most if not all of such cases, a question which the court can determine as a question of law, by comparing the patent itself with the original patent, and, if necessary, with the record of its inception. The reason for this was fully explained in the case of *Miller v. The Brass Company.*" 30 O. G. 657 (659).

See also *Western Union Tel. Co. v. Baltimore & Ohio Tel. Co.* (1885), 25 Fed. Rep. 30; *Wooster v. Handy* (1884), 28 O. G. 629; 22 Blatch. 307; 21 Fed. Rep. 51; *Miller v. Brass Co.* (1882), 104 U. S. 350; 21 O. G. 201.

That an apparently unreasonable delay in applying for a re-issue renders it invalid, unless the patentee explains the delay by proper evidence, see *Hoskin v. Fisher* (1888), 125 U. S. 217; 43 O. G. 509.

§ 691. Intentional Exclusion not Shown by Failure to Claim Matter not Clearly Described in the Original Patent unless the Defects are Brought to the Knowledge of the Patentee, and he thereafter Unreasonably Delays their Amendment.

An omission from the Claims of the original patent of some feature of the invention, or of some subordinate or dependent invention, which is simply indicated or suggested but not clearly described in the original specification, or a defective statement in the Claims of the original which is consistent with an intention to protect the subject-matter claimed in the re-issue, raises no presumption of intentional exclusion. Such a misstatement or omission is not evident to the inventor upon a mere inspection of the patent, nor does the description so disclose the omitted matter to the public as to warrant any supposition that he has dedicated it to public use. Not until circumstances occur by which his attention is directed to the error, and he becomes aware that his entire invention is not covered by his patent, is he chargeable with negligence in the assertion of his rights.¹ But whenever and by whatever means this knowledge is communicated to him, his obligation to amend his Claims, and so far as necessary his description also, at once arises, and his failure to do this within a reasonable time is sufficient evidence that the original omission did

§ 691. ¹ In *Tuttle v. Loomis* (1885), 24 Fed. Rep. 789, Wallace, J. : (789) "Whether he described in his original patent just the invention he supposed he had made, or whether his invention was really a broader one than he himself supposed it to be, when it became apparent that the real invention was unduly restricted and narrowed by the description, he was entitled to a re-issue if the error arose from inadvertence, accident, or mistake." 30 O. G. 344 (345).

That a mistake not discoverable till after several years may then be corrected, see *Hartshorn v. Eagle Shade Roller Co.* (1883), 18 Fed. Rep. 90 ; 25 O. G. 1191 ; *Poppenhusen v. Falke* (1862), 5 Blatch. 46 ; 2 Fisher, 213.

That a re-issue cannot expand a Claim after eight years except in very peculiar circumstances, see *Tuttle v. Loomis* (1885), 24 Fed. Rep. 789 ; 30 O. G. 344.

That a patentee is always presumed to know what, if vigilant, he could have known, see *Arnheim v. Finster* (1886), 26 Fed. Rep. 277 ; 34 O. G. 700 ; *Ives v. Sargent* (1883), 17 Fed. Rep. 447 ; 21 Blatch. 417.

That to move with alacrity after he discovers the defect does not satisfy the rule, if by due diligence it might have been known earlier, see *Ives v. Sargent* (1883), 21 Blatch. 417 ; 17 Fed. Rep. 447.

not result from any inadvertence, accident, or mistake.² Thus where the omitted matter has actually gone into public use,³ or where another inventor has applied for and obtained a patent which distinctly claims it,⁴ or where the courts interpreting his patent have decided that it does not embrace this feature or subordinate invention,⁵ the inventor may be presumed to

² That upon the discovery of the defect the patentee must act with reasonable diligence or a re-issue cannot be allowed, see *Pope Mfg. Co. v. Marqua* (1883), 15 Fed. Rep. 400; *Turrell v. Bradford* (1883), 15 Fed. Rep. 808; 23 O. G. 1623; 21 Blatch. 284; *Washburn & Moen Mfg. Co. v. Fuchs* (1883), 5 McCrary, 236; 16 Fed. Rep. 661; *Steam Gauge & Lantern Co. v. Miller* (1882), 11 Fed. Rep. 718; *Matthews v. Boston Mach. Co.* (1882), 105 U. S. 54; 21 O. G. 1349; *Sheriff v. Fulton* (1882), 12 Fed. Rep. 136; 22 O. G. 87; *Bantz v. Frantz* (1881), 105 U. S. 160; 21 O. G. 2037; *Johnson v. R. R. Co.* (1881), 105 U. S. 539; 22 O. G. 329; *Miller v. Brass Co.* (1881), 104 U. S. 350; 21 O. G. 201; *In re Conklin* (1874), 5 O. G. 235; 1 MacArthur, 375; *Knight v. Baltimore & Ohio R. R. Co.* (1840), 3 Fisher, 1; Taney, 106.

³ That where matters have been described but not claimed in the original patent, and have gone into use by others, they cannot be claimed in a re-issue after unreasonable delay, see *Wooster v. Handy* (1884), 28 O. G. 629; 22 Blatch. 307; 21 Fed. Rep. 51; *Brainard v. Cramme* (1882), 12 Fed. Rep. 621; 20 Blatch. 530; 22 O. G. 769.

That where an invention has been in use for fifteen years, an original patent cannot be re-issued to cover it, even in favor of the real inventor, but it must be regarded as abandoned, see *Johnson v. R. R. Co.* (1882), 105 U. S. 539; 22 O. G. 329.

That the use of the "new matter," before the original application was filed,

shows that its omission from the application was intentional and was abandonment, see *In re Conklin* (1874), 1 MacArthur, 375; 5 O. G. 235.

That the mode in which the discovery of a mistake in the original was made does not affect the re-issue, see *Poppenhusen v. Falke* (1861), 4 Blatch. 493; 2 Fisher, 181.

⁴ That a re-issue to enlarge Claims, and embrace a new invention which has been patented since the original patent, is not allowable after unreasonable delay, see *Torrent Arms Lumber Co. v. Rodgers* (1884), 112 U. S. 659; 30 O. G. 449.

⁵ In *Poppenhusen v. Falke* (1862), 5 Blatch. 46, Shipman, J.: (53) "It not unfrequently happens that a judicial interpretation of the specification or Claim of a patent, or of both, discloses to the inventor and patentee, for the first time, the defects in the instrument, and shows him that he has unwittingly restricted his rights within narrower limits than his discovery, or has so inartificially described his invention that he has failed to secure any substantial advantage by it. Such a disclosure furnishes a proper occasion for a surrender and re-issue, when the error was inadvertent, and is clearly within the beneficent design of the statute. The judicial mind gives a legal construction to the language of the instrument, and this construction may reveal the fact that the terms used failed to cover the invention. To hold that the inventor should not be allowed to re-state his Claims by the use of new terms, would defeat the object of

have sufficient notice of the defect to make his continued acquiescence in it a conclusive admission that his patent, in its original condition, truly represented and covered the entire invention which he undertook to claim. Concerning the period within which the amendment must be made after such notice can be fairly imputed to the inventor, there is no other rule than that of reasonable time, to be determined by the courts from all the circumstances of the case. Any avoidable delay may prevent him from obtaining a re-issue, not by forfeiting a privilege once possessed, but by proving such an original intentional exclusion that the right to a re-issue could never have existed.⁶

§ 692. Intentional Exclusion not Shown by Mere Delay Alone in the Amendment.

An intention to exclude from the original patent the patentable matter suggested in its description but omitted from its Claims is never inferred from mere delay alone. The

the law, and abridge or strangle the inventor's rights, by reason of the imperfect language in which he had attempted to clothe his discovery." 2 Fisher, 213 (220).

⁶ In *Mahn v. Harwood* (1884), 112 U. S. 354, Bradley, J. : (361) "If any such inadvertence or mistake has really occurred, it is generally easily discernible by an inspection of the patent itself; and any unreasonable delay in applying to have it corrected by a surrender and re-issue is a just bar to such correction. If the specification is complicated and the Claim is ambiguous or involved, the patentee may be entitled to greater indulgence; and of this the court can rightfully judge in each case. No precise limit of time can be fixed and laid down for all cases. The courts will always exercise a proper liberality in favor of the patentee. But in any case, by such delay as the court may deem unnecessary and unreasonable, the right to a re-issue will be regarded as having been abandoned and lost, and

the Commissioner will be held to have exceeded his authority in granting it. Whenever it is manifest from the patent itself, compared with the original patent and cognate documents of record, or from the facts developed in the case, that the Commissioner must have disregarded the rules of law by which his authority to grant a re-issue in such cases is governed, the patent will be considered as void to the extent of such illegality. It is then a question of law, not a question of fact." 30 O. G. 657 (659).

That delay in a re-issue may be explained, see *Wollensak v. Reiher* (1885), 115 U. S. 96; 31 O. G. 1301; *Singer Mfg. Co. v. Goodrich* (1883), 15 Fed. Rep. 455.

That the courts will not assume, without proof, that a re-issue after fourteen years' delay enlarges the original or was sought for that purpose, see *Clark v. Wooster* (1886), 119 U. S. 322; 37 O. G. 1477.

lapse of time, unaccompanied by circumstances from which a purpose to omit what might have been claimed is presumed, cannot affect the right of the inventor to a re-issue of his patent, and to the correction of any error in the description or the Claim that may be necessary to secure the invention which he attempted to protect by his original patent.¹ The amendment of defects occurring through accident, mistake, or inadvertence, and without fraud, may therefore be made at any time when the error is discovered or the amendment may become desirable, provided the amendment does not introduce into the patent any invention not substantially indicated by the original specification.² A patent may thus be

§ 692. ¹ In *Hussey v. Bradley* (1863), 2 Fisher, 362, Hall, J. : (378) " We cannot say, as matter of law, that these re-issues were too late, nor is there any proof of fraud or laches upon which we can, on that ground, declare these re-issued patents void. A re-issue has been upheld when the surrender was made more than sixteen years after the first patent was issued (*Gibson v. Harris*, 1 Blatch. 167), and it was there said that a patent which had been extended to twenty-one years under the general law, and afterward extended to twenty-eight years by special act of Congress, might be surrendered and re-issued after the term of twenty-one years had expired. And see *Woodworth v. Edwards*, 3 W. & M. 120; *French v. Rogers*, and *Goodyear v. Day*, Secs. 27-32, Law's Digest, 614, 615 (vol. i. p. 133). The fact that a portion of these inventions was not claimed in the original patent we have already shown does not defeat the present claims of the patentee, and that even a disclaimer in the original patent of an invention claimed in a re-issued one is not, without other proof, enough to avoid the re-issued patent. *Ex parte Hayden*, and *Laidly v. James*. It is true that in the case of *Batten v. Taggert*, 2 Wall. Jr. 102, Judge Kane decided that if a pat-

entee neglects in his specification to assert his invention as to a certain part, omits to claim specifically such part, and suffers his patent so to stand for a number of years, he cannot afterward surrender his patent and take a re-issue claiming such part, as the use under the former patent, without any claim, will be a dedication to the public; but this decision was overruled by the Supreme Court of the United States in the same case, 17 How. 85, and the cases to which we have already referred are, we think sufficient to show that we cannot, after the action of the Commissioner of Patents in respect to these patents, and without other proof, hold that there has been any abandonment or dedication to the public of the inventions claimed in these re-issued patents." 5 Blatch. 134 (148).

² That a re-issue after a delay of thirteen years is not too late, if the original was defective through a mistake and the re-issue was necessary to cure it, see *Newton v. Furst & Bradley Mfg. Co.* (1882), 11 Bissell, 405; 14 Fed. Rep. 465.

That no part of the invention originally described becomes dedicated to the public by lapse of time, but may be always claimed in a re-issue, see *Battin v. Taggert* (1854), 17 How. 74.

re-issued either during its original term, or during an extension regularly allowed by the Patent Office, or during an additional extension granted by a special act of Congress.³

§ 693. Fourth Proposition: Amendment by Re-issue, when Allowable, may be Made in Any Form and to Any Extent Necessary to Secure the Actual Invention.

The fourth proposition, -- that when an amendment by re-issue is allowable it can be made in any form and to any extent that may be necessary to render the patent effective for the original invention, -- is evident from the nature and object of the amendment itself. The former patent being invalid and affording no protection, or being inoperative and affording less protection than the inventor had a right to claim, the re-issued patent is substituted for it in order that a patent, valid and operative for the entire invention attempted to be covered by the original patent, may exist in favor of the inventor.¹ Whatever is required for the attainment of this object may, therefore, be performed by the re-issue. Not only may the language of the specification be indefinitely varied, but new Claims may be added, or the old may be divided and restated, within any limits not embracing patentable matter which is absent from the original description.² If one re-

³ That an extended patent can be re-issued, see *Ex parte Sexton* (1876), 9 O. G. 251; *Wilson v. Rousseau* (1846), 4 How. 646; 2 Robb, 372.

That a patent granted or extended under a special act may be re-issued like an ordinary patent, see *Page v. Holmes Burglar Alarm Telegraph Co.* (1880), 17 O. G. 737; 17 Blatch. 484; 1 Fed. Rep. 304; 5 Bann. & A. 165; *Hussey v. Bradley* (1863), 2 Fisher, 362; 5 Blatch. 134; *Gibson v. Harris* (1846), 1 Blatch. 167.

§ 693. ¹ That if the first patent is defective a good one may be obtained, see *Treadwell v. Bladen* (1827), 4 Wash. 703; 1 Robb, 531.

² That it is the office of a re-issue to make a defective specification clear and a defective Claim sufficient, see *Russell*

v. Dodge (1876), 93 U. S. 460; 11 O. G. 151; *Aultman v. Holley* (1873), 6 Fisher, 534; 11 Blatch. 317; 5 O. G. 3; *Sarven v. Hall* (1872), 5 Fisher, 415; 9 Blatch. 524; 1 O. G. 437.

That a re-issue may contain new Claims based on the old specification, if such Claims were omitted by mistake, and if the patentee has not been estopped to amend, see *Combined Patents Can Co. v. Lloyd* (1882), 21 O. G. 713; 11 Fed. Rep. 149; 15 Phila. 481; *Swift v. Whisen* (1867), 2 Bond, 115; 3 Fisher, 343.

That the Claims may be enlarged in a re-issue if the invention is the same, see *Jones v. Barker* (1882), 11 Fed. Rep. 597; 22 O. G. 771; *Sharp v. Tift* (1880), 17 O. G. 1282; 2 Fed. Rep. 697; 18 Blatch. 132; 5 Bann. & A.

issue fails to accomplish the desired result another may be granted, and thus successive efforts at amendment may be made until the patent meets in all respects the purpose it was first intended to fulfil.³ Each of these successive re-issues is

399 ; *Rubber Co. v. Goodyear* (1869), 9 Wall. 788.

That a re-issue cannot change the invention by narrowing a Claim in one part and expanding it in another, see *Gage v. Kellogg* (1886), 26 Fed. Rep. 242 ; 36 O. G. 234.

That a re-issue unwarrantably expanding the Claims is void, see *Hoe v. Knap* (1886), 36 O. G. 1244 ; 27 Fed. Rep. 204 ; *Pattee Plow Co. v. Kingman* (1885), 23 Fed. Rep. 801 ; *Nye v. Allen* (1883), 23 O. G. 2328 ; 15 Fed. Rep. 114 ; *Doane & Wellington Mfg. Co. v. Smith* (1882), 24 O. G. 302 ; 15 Fed. Rep. 459.

That the original patent cannot be broadened by re-issue so as to include matter anticipated by prior devices, see *Ives & Miller v. Hartford Spring & Axle Co.* (1882), 11 Fed. Rep. 510 ; 20 Blatch. 333 ; 22 O. G. 1037.

That an inexact Claim in the re-issue which if naturally construed would expand the invention is void, see *Tyler v. Galloway* (1882), 20 Blatch. 445 ; 22 O. G. 2072 ; 12 Fed. Rep. 567.

That if a re-issue does not narrow it must of course expand the Claims of the original, see *French v. Rogers* (1851), 1 Fisher, 133.

That where the specification and drawings are the same as those of the original the re-issue is not granted for making the description more full or for disclaiming old matter, see *McMurray v. Mallory* (1884), 111 U. S. 97 ; 27 O. G. 915.

That the case of *Miller v. Brass Co.*, 104 U. S. 350, does not prohibit new Claims, — it applies the doctrine of equitable estoppel to the patentee after unreasonable delay when others may have

acted on his non-claim, — see *Asmus v. Alden* (1886), 27 Fed. Rep. 684 ; 36 O. G. 231.

That the invention may be divided into distinct Claims in the re-issue, see *Brown v. Deere* (1881), 6 Fed. Rep. 484 ; 2 McCrary, 422 ; 19 O. G. 361 ; *Dederick v. Cassell* (1881), 20 O. G. 1233 ; 9 Fed. Rep. 306 ; 14 Phila. 503.

That the division and enlargement of Claims in a re-issue is not favored, though it is allowed if no new matter is introduced, see *Dederick v. Cassell* (1881), 14 Phila. 503 ; 20 O. G. 1233 ; 9 Fed. Rep. 306.

That if the several Claims of the re-issue cover the same invention as the original and no more, the re-issue is valid, see *American Diamond Rock Boring Co. v. Sheldon* (1885), 25 Fed. Rep. 768 ; 33 O. G. 1598.

That the re-issue is valid though its specification differs from that of the original, if they are consistent with each other, though if inconsistent the re-issue is void, see *Sickles v. Evans* (1863), 2 Clifford, 203 ; 2 Fisher, 417.

That the specification and Claims of the re-issue may differ from those of the original provided they claim nothing except what was present, both in fact and function, either in the original drawings or model, see *Stephenson v. Second Avenue R. R. Co.* (1880), 5 Bann. & A. 116 ; 1 Fed. Rep. 416.

That a re-issue cannot contain any change in the original specification or Claim whereby a new and substantially different invention results, or different effects are produced, see *Salamander Felting Co. v. Haven* (1875), 9 O. G. 253 ; 3 Dillon, 131.

³ In *French v. Rogers* (1851), 1

independent of its predecessors, is unprejudiced by their imperfections, and is presumed to be an honest endeavor to effect the object for which the patent was originally issued.⁴

§ 694. **Single Original Patents may Re-issue in Several Divisions.**

In many cases, on account of the number or the intricate relations of the inventions described in the original patent, the object of the amendment cannot be accomplished by a

Fisher, 133, Kane, J. : (137) "There is nothing in the words of the act, or in the policy which it proclaims, that limits the correction of errors to such as may have been the first discovered. On the contrary . . . it is for the public interest that the surrender and re-issue should be allowed to follow each other just as often as the patentee is content to be more specific or more modest in his Claims."

That successive re-issues may be allowed, until the actual invention receives the desired protection, see *Selden v. Stockwell Self-Lighting Gas Burner Co.* (1881), 19 Blatch. 544 ; 20 O. G. 1377 ; 9 Fed. Rep. 390 ; *Union Paper Collar Co. v. White* (1875), 7 O. G. 698, 877 ; 2 Bann. & A. 60 ; 11 Phila. 479 ; *Wells v. Jacques* (1874), 1 Bann. & A. 60 ; 5 O. G. 364.

That a second re-issue must be for the same invention as the first re-issue, see *Giant Powder Co. v. California Powder Works* (1875), 3 Sawyer, 448 ; 2 Bann. & A. 131 ; *Knight v. Baltimore & Ohio R. R. Co.* (1840), 3 Fisher, 1 ; Taney, 106. This doctrine, unless broadly construed, improperly limits the right of the inventor by committing him irrevocably to any mistake he may make in the first re-issue.

That if a re-issue is void the original may be re-issued in its exact language and be valid, see *Giant Powder Co. v. Safety Nitro-Powder Co.* (1884), 19 Fed. Rep. 509 ; 10 Sawyer, 23 ; 27 O. G. 99.

That the original patent cannot be revived by merely disclaiming all changes made by the re-issue, but a new re-issue must be obtained, see *McMurray v. Mallory* (1884), 111 U. S. 97 ; 27 O. G. 915.

That a first re-issue identical with the original is void, but a second re-issue repeating the original is good, see *Celluloid Mfg. Co. v. Zylonite Brush & Comb Co.* (1886), 27 Fed. Rep. 291 ; 35 O. G. 1228.

That the acceptance of a second re-issue with the original Claims restored admits that the original patent was not invalid or inoperative, see *Celluloid Mfg. Co. v. Zylonite Brush & Comb Co.* (1886), 27 Fed. Rep. 291 ; 35 O. G. 1228.

⁴ That a second re-issue is not prejudiced by the faults of a former one, see *American Diamond Rock Boring Co. v. Sheldon* (1879), 17 Blatch. 209 ; 4 Bann. & A. 551.

That where there are several re-issues of the same patent the law always presumes that each was necessary to cure defects, see *Union Paper Collar Co. v. White* (1875), 2 Bann. & A. 60 ; 7 O. G. 698, 877 ; 11 Phila. 479.

That successive re-issues are not approved, see *Union Paper Collar Co. v. White* (1874), 7 O. G. 698, 877 ; 2 Bann. & A. 60 ; 11 Phila. 479.

That three re-issues of the same patent indicate fairness in each, see *Swift v. Whisen* (1867), 3 Fisher, 343 ; 2 Bond, 115.

mere surrender of the original, and the substitution for it of a single re-issued patent. Where the original specification sets forth a new combination containing many new elements and sub-combinations, or where it contains a description not merely of the principal invention but of numerous subordinate or dependent inventions, the endeavor to describe and claim all these in one re-issue might often lead to hopeless confusion and uncertainty. To obviate this, the inventor is permitted to re-issue his original patent in divisions, covering in each so much of the patentable matter contained in the original description as he deems expedient, and thus receiving a separate patent for each separate part of his invention.¹ In this manner an original patent for a combination may re-issue in one patent for the entire combination, in others for its sub-combinations, and in still others for its elements.² A patent for a manufacture, which can be produced only by a given process, may re-issue in one patent for the process and another for the product.³ The same rule applies in other cases of depend-

§ 694. ¹ That a patent may re-issue in divisions for the distinct inventions embraced in the original, see *Giant Powder Co. v. Safety Nitro-Powder Co.* (1884), 19 Fed. Rep. 509; 10 Sawyer, 23; 27 O. G. 99; *New v. Warren* (1882), 22 O. G. 587; *Dederick v. Cassell* (1881), 9 Fed. Rep. 306; 20 O. G. 1233; 14 Phila. 503; *Selden v. Stockwell Self-Lighting Gas Burner Co.* (1881), 9 Fed. Rep. 390; 19 Blatch. 544; 20 O. G. 1377; *Ex parte Lippincott* (1879), 16 O. G. 632; *Wheeler v. McCormick* (1873), 11 Blatch. 334; 6 Fisher, 551; 4 O. G. 692; *Penna. Salt Mfg. Co. v. Thomas* (1871), 8 Phila. 144; 5 Fisher, 148; *Bennet v. Fowler* (1869), 8 Wall. 445; *Goodyear v. Wait* (1867), 5 Blatch. 468; 3 Fisher, 242.

That re-issue divisions are for separable inventions which can be separately patented, see *Ex parte Herr* (1887), 41 O. G. 463.

That a patent may be re-issued in several divisions, either concurrently or successively, and the original is good to

protect each part until it is covered by a re-issue, see *Ex parte Greaves* (1880), 18 O. G. 623.

That a patent may re-issue in divisions, one division containing the original Claims, and another the new Claims, see *Giant Powder Co. v. Safety Nitro-Powder Co.* (1884), 10 Sawyer, 23; 27 O. G. 99; 19 Fed. Rep. 509.

² That where the original patent is for a combination it may re-issue in separate divisions for each sub-combination, and these are not separate patents for the same invention, see *Wheeler v. McCormick* (1873), 6 Fisher, 551; 11 Blatch. 334; 4 O. G. 692.

That sub-combinations, if operative by themselves, may be re-issued in separate patents, based on the same original, see *Ex parte Wheeler* (1873), 4 O. G. 5.

³ That where the original patent was for a new product resulting from a new process the re-issue may cover both process and product, either in the same or separate patents, see *Tucker v. Burditt*

ent inventions, where the joinder, though allowable, would result disadvantageously to the inventor, and where his patent cannot, therefore, be conveniently re-issued in a single instrument to cover all he has described in the original.

§ 695. **Relation of each Re-issue Division to the Original Patent, and to the Other Divisions.**

As these divisions of the re-issue represent a single original patent, they must be granted to the same patentee, and be confined to the inventions indicated in the former specification.¹ The patentable matter claimed in each must be a complete invention in itself, and not merely a different application of the principal invention.² Each may describe the whole invention, if this be necessary to the explanation of the specific portion which it claims, and each may claim its own part in its separate condition and also as connected with the others.³ One division is not affected by errors or excesses

(1879), 4 Bann. & A. 569; *Anilin v. Hamilton Mfg. Co.* (1878), 3 Bann. & A. 235; 13 O. G. 273.

Whether a patent for a process can re-issue in separate patents, one for the process and the other for the product, *quere*, see *Goodyear v. Honsinger* (1867), 3 Fisher, 147; 2 Bissell, 1.

§ 695. ¹ That all the divisions of a re-issue must issue to the same patentees, see *Ex parte Smith* (1879), 16 O. G. 1233.

That a re-issue in divisions must be confined to the original inventions, see *New v. Warren* (1882), 22 O. G. 587.

² That where a patent is divided upon re-issue each division must be for a distinct part of the original invention, see *Giant Powder Co. v. California Vigorit Powder Works* (1875), 3 Sawyer, 448; 2 Bann. & A. 131.

That a patent cannot be divided upon its re-issue unless there are distinct inventions, not merely different applications to a specific invention under the same genus, see *Ex parte Sexton* (1873), 3 O. G. 409.

³ In *Wheeler v. McCormick* (1873), 11 Blatch. 334, Woodruff, J. : (338) "Where a patentee, having patented an aggregate of several devices, is permitted to surrender his patent and receive new letters-patent for the several devices included in it, it does not follow that his new specifications may not be identical in their description of each and all of the devices included in the original aggregate patent. It is the patentee's selecting out of these devices some or one, being separable and capable of use as a distinct device or devices, and making that or those the subject of his specific Claim, that determines what is covered by each re-issue. The description of an entire machine may be convenient, and sometimes necessary, in order to show the adaptation of the separated device to a useful purpose, and illustrate, not its construction alone, but its application in one practical mode to the purpose for which it was designed. Such a description may be given, but that does not make the patent cover all that is included in the description. In this case,

in the others, but is judged on its individual merits as a separate patent for a separate invention.⁴ All the divisions rest upon the original patent, however, as their common foundation, and an incurable defect in the original, such as a false oath or a fraudulent concealment, renders them altogether void.⁵

§ 696. Re-issued Patent Supersedes the Original and Requires its Surrender to the Government.

The amendment of a patent by re-issue is not, in legal effect, a simple addition to or variation of its description or its claims, — it is the grant of a different patent for the same invention;¹ and since during the life of one patent another

then, it was competent for the patentee to amend his original specification, so as fully and minutely to describe all that was shown in the original or in its drawings or model, and receive patents for each separate device shown therein, or each separate and severable combination of devices, capable of distinct use, and while such specification might be annexed, *in totidem verbis*, to each re-issued patent, define and claim in each such separable and distinct part of his original aggregate invention, the specification in each case showing, as it should, the construction of each separate patented device or combination of devices, so as to give the required information to the public, and illustrating the application of each device or combination to actual use in the construction of an aggregate machine. This does not make one re-issue include all that is described in the specification. All that is included in a specification is not necessarily included in the patent. What is claimed in and secured by the patent is secured not only when used in the mode illustrated by the description of other devices with which it may be used in the specification, but it is secured against its use in connection with other devices of an entirely distinct

character." 4 O. G. 692 (694); 6 Fisher, 551 (555).

That where a patent re-issues in divisions and each division claims its distinct part in combination with the rest, they will not be several patents for the same invention, see *Wheeler v. McCormick* (1873), 11 Blatch. 334; 4 O. G. 692; 6 Fisher, 551.

⁴ That where an original patent is re-issued in divisions, the first division may be valid though the others are void, see *Atwood v. Portland Co.* (1880), 5 Bann. & A. 533; 10 Fed. Rep. 283.

That where a patent is divided upon re-issue, each division stands by itself as for a separate invention, see *Brown v. Selby* (1871), 4 Fisher, 363; 2 Bissell, 457.

⁵ That where a patent re-issues in divisions, each division is treated as a separate Claim under one patent, see *Penna. Salt Mfg. Co. v. Thomas* (1871), 5 Fisher, 148; 8 Phila. 144.

That a re-issue must stand or fall by its own Claim, see *Wisner v. Grant* (1881), 7 Fed. Rep. 922; 18 O. G. 192.

§ 696. ¹ That a re-issue is a new contract between the United States and the party who obtains it, see *Goodyear v. Providence Rubber Co.* (1864), 2 Clifford, 351; 2 Fisher, 499.

for the same invention cannot issue to the same patentee, the grant of the re-issue necessitates the previous surrender and cancellation of the original defective patent. The surrender is accomplished by the delivery of the original patent, or in case of its destruction or loss of a certified copy thereof, to the Patent Office, with a request for a re-issue;² and when this is accepted by the Commissioner, the original patent and all the claims accruing from it, in favor of the parties uniting in the surrender, are extinguished.³ Their patent privileges are thenceforth derived from the re-issued patent only, upon which all their efforts to protect or vindicate their rights to the invention must be based.⁴

² That a surrender is not required by the statute to be in writing, see *Dental Vulcanite Co. v. Wetherbee* (1866), 2 Clifford, 555; 3 Fisher, 87.

³ That all rights of action under the original patent expire with its surrender and re-issue, see *Jones v. Barker* (1882), 11 Fed. Rep. 597; 22 O. G. 771; *U. S. Stamping Co. v. King* (1879), 7 Fed. Rep. 860; 17 Blatch. 55; 17 O. G. 1399; 4 Bann. & A. 469; *Mers v. Conover* (1876), 11 O. G. 1111; *Fry v. Quinlan* (1875), 13 Blatch. 205; *Reedy v. Scott* (1874), 23 Wall. 352; 7 O. G. 463; *Brown v. Hinkley* (1873), 3 O. G. 384; 6 Fisher, 370.

That all rights of action are suspended by a surrender and re-issue application, see *Burrell v. Hockley* (1888), 44 O. G. 1400.

⁴ In *Peck v. Collins* (1881), 103 U. S. 660, Bradley, J. : (664) "Since the decision of this case it has been uniformly held that if a re-issue is granted, the patentee has no rights except such as grow out of the re-issued patent. He has none under the original. That is extinguished. And although for the purpose of fixing a date to the title in a question of priority, and of limiting the period for which the patent is to run, the date of the original patent is important, no damages can be recovered

for any acts of infringement committed prior to the re-issue." 19 O. G. 1137 (1138).

In *Mossitt v. Gaar* (1860), 1 Fisher, 610, Leavitt, J. : (613) "In the liberal and benignant spirit in which our patent system has been conceived and carried out, the thirteenth section of the act of 1836 gives to the patentee a right to correct his description or specification, when its imperfection has resulted from inadvertency, accident, or mistake. This is effected by a surrender of his patent, and obtaining a new patent upon an amended specification. By this means he is protected from some of the effects of his error, and secured in the enjoyment of all his rights as an inventor, after the emanation of the new or corrected patent. But the statute gives no right of action for an infringement occurring under the void patent, and before the re-issue of the new patent. In the present case the grounds on which the old patent was surrendered, and a re-issue authorized, are not before the court. But the court must presume that they were such as, by the language of the thirteenth section, authorized the surrender of the old patent, and the granting of a new one. The only condition on which this can be done is that the original patent is '*inoperative*

§ 697. Surrender of the Original Patent takes Effect upon the Grant of the Re-issued Patent.

Since the surrender, when accepted, abrogates all rights of the surrenderors under the original patent, the question as to the time of such acceptance is of great importance, and formerly was surrounded with considerable difficulty. Prior to the act of 1870 the statutes contained no specific answer to this question, and the decisions of the courts were not in harmony. Under the act of 1832, which first authorized this

or *invalid*' by reason of a failure to comply with the requirements of the statute. The proceeding is, therefore, equivalent to a distinct admission, made in the most solemn form, that the patent has no validity in the sense of entitling the patentee to an action for its infringement. The new patent can be operative only from its date, as affording the patentee a remedy for an infringement. The statute expressly negatives the idea that it was intended to give a retrospective operation to the new patent and entitle the patentee to an action for an infringement previously accruing. It was, doubtless, competent for the legislature to have declared that the new patent should have this effect, but the language used imports the opposite intention. The statute provides, in express terms, that the re-issued patent 'shall have the same effect and operation in law, on the trial of all actions hereafter commenced for causes subsequently accruing, as though the same had been originally filed in such corrected form, before the issuing of the original patent.' Now, the allegation of the plea in this case is that after the cause of action accrued, and after the commencement of this action the plaintiff surrendered his patent. The demurrer admits the truth of this averment. The claim of the plaintiff, then, is based on infringement occurring under the old patent, and not for a cause of action accruing after the date of the re-issued

patent. Clearly the statute affords no remedy for such an infringement. Any other construction of the statute would result in the absurdity of conferring on the patentee, as the result of the surrender of what he admits to be an invalid patent, rights and immunities which he could not claim without such surrender. In other words, the legal effect of the re-issued patent would be to give force and vitality to the original patent, in the face of the admission of the patentee that it was inoperative and invalid. This may be illustrated by supposing that the patentee had made no surrender, but had chosen to rest his rights on the original patent. Is it not clear that there could have been no recovery in that case for an infringement? The patentee would have been met with the unanswerable objection that the patent was invalid, from a fatal omission to comply with the requisition of the statute. And there can be no pretence for claiming that by the surrender of the old patent, and the emanation of a second one, the patentee, as to infringements occurring under the original patent, is placed in a better situation than if there had been no surrender and re-issue." 1 Bond, 315 (317).

That a surrender and re-issue make the patent good as to all subsequent causes of action, though the original were invalid, see *Bloomer v. Stolley* (1850), 5 McLean, 158.

method of amendment, the re-issue was to be awarded upon the surrender of the former patent. As no examination of applications was then required, the surrender and re-issue were reciprocal and concurrent acts, and no interval could have elapsed during which neither patent was in force. The act of 1836, while introducing the system of examining applications and thus requiring greater or less delay between the surrender and the grant of the re-issue, did not change the language of the act of 1832 to meet this new circumstance, or by any other provision indicate the time when the surrender was to take effect. Hence the idea seems to have gained recognition that the surrender and re-issue were not dependent parts of the same transaction, but that the surrender was an absolute destruction of the original patent, and that unless the re-issue were granted the rights of the surrenderors were irretrievably lost. Under this doctrine the applicant for a re-issue occupied the same position as an applicant for an original patent. The patentability of his invention, and his relation to it as its first inventor were again open to investigation, as upon his original application, and a refusal of the re-issue operated as a complete repudiation of his claims.¹ The act of 1870 removed at once these difficulties and doubts by providing that the surrender should take effect only upon the issue of the amended patent.² At present, therefore, the rights of the surrenderors are protected by the original patent until the re-issue is awarded; and if the re-issue be refused, the original patent is returned to its owners, who are thus left to sustain it, so far as they are able, in the courts.³

§ 697. ¹ That under the law, as it stood in 1860, a patent surrendered for re-issue was gone in any event, and the patentee must obtain the re-issue or have nothing, see *Peck v. Collins* (1881), 103 U. S. 660 · 19 O. G. 1137.

But *per contra*, —

That while the re-issue supersedes the original, the surrender and application for a re-issue do not, see *Forbes v. Barstow Stove Co.* (1864), 2 Clifford, 379.

That the surrender and re-issue con-

stitute but one act, and are both alike valid or invalid, see *French v. Rogers* (1851), 1 Fisher, 133.

That if the re-issue is void the original patent still remains valid, see *Woodworth v. Hall* (1846), 1 W. & M. 389; 2 Robb, 517; *Woodworth v. Hall* (1846), 1 W. & M. 248; 2 Robb, 495.

² That before 1870 the surrender took effect from its date, after 1870 from the re-issue, see *Peck v. Collins* (1881), 103 U. S. 660; 19 O. G. 1137.

³ An exception to this rule exists in

§ 698. Surrender of the Original Patent: by Whom Made.

No surrender can be valid and effective unless made with the concurrence of all the owners of the original patent.¹ The patentee, if living and still retaining any undivided interest in the patent, his representatives if he be dead and at his death had not assigned to others his entire patent privilege, and the assignees of any undivided interest in the whole patent, are parties whose consent to the extinguishment of the original patent is absolutely necessary.² The concur-

cases where an examination of the re-issue application on its merits discloses that the invention was originally unpatentable, for want of novelty, priority, or some other essential requisite. In such cases a decision adverse to the re-issue applicant is fatal to the entire patent. Thus in *Peck v. Collins* (1881), 103 U. S. 660, *Bradley, J.*: (664) "It seems to us equally clear that as the law stood when that decision was made, and as it continued to stand in 1866, when the surrender of Mudge's patent took place, a patent surrendered for re-issue was cancelled in law as well when the application was rejected as when it was granted. The patentee was in the same situation as he would have been if his original application for a patent had been rejected. The law declares in terms that 'the specifications and Claim in every such case shall be subject to revision and restriction in the same manner as original applications are.' Act of March 3, 1837, c. 45, Sec. 8, 5 Stat. 193; July 8, 1870, c. 230, Sec. 53, 16 Stat. 205; Rev. Stat. Sec. 4916. The question of his right to any patent at all was opened anew, the same as upon an original application for a patent. Surrender of the patent was an abandonment of it, and the applicant for re-issue took upon himself the risk of getting a re-issue or of losing all. A failure upon the merits, in a contest with other claimants, only gave additional force to the legal effect of the

surrender. Since the surrender of the patent in this case the Patent Laws have undergone a general revision by the act of July 8, 1870, c. 230. In the fifty-third section of that act (being the section relating to the surrender and re-issue of patents), a new clause was introduced, declaring that the surrender 'shall take effect upon the issue of the amended patent;' and this clause is retained in Sec. 4916 of the Revised Statutes. What may be the effect of this provision in cases where a re-issue is refused, it is not necessary now to decide. Possibly it may be to enable the applicant to have a return of his original patent if a re-issue is refused on some formal or other ground which does not affect his original claim. But if his title to the invention is disputed and adjudged against him, it would still seem that the effect of such a decision should be as fatal to his original patent as to his right to a re-issue." 19 O. G. 1137 (1138).

§ 698. ¹ That a surrender is invalid unless all owners of the patent concur, either by consent or ratification, see *Meyer v. Bailey* (1875), 8 O. G. 437; 2 Bann. & A. 73.

² That a surrender for re-issue must be made either by the patentee or by his representatives or assigns, see *Ex parte Wright* (1876), 10 O. G. 587; *Potter v. Holland* (1858), 1 Fisher, 327; 4 Blatch. 206.

That the patentee and the assignee

rence of such owners may be manifested either by joining in the surrender, or by subsequently ratifying it, though under the present practice in the Patent Office the written consent of all the owners must appear upon the face of the application for re-issue in which the surrender of the original patent is embodied.³ Grantees and licensees are not so interested in the original patent as to make their concurrence necessary to the validity of its surrender and re-issue.⁴ Local or individual rights acquired under the former patent remain unaffected by its surrender until the parties in whom such rights are vested voluntarily relinquish them and accept new rights under the re-issue.⁵ The original patent may

of a part interest may join in surrender and application for a re-issue, see *Potter v. Holland* (1858), 1 Fisher, 327; 4 Blatch. 206.

That where the whole interest in a patent has been assigned the surrender should be made by the assignee, or with his consent, and the re-issue granted to him, see *Dental Vulcanite Co. v. Wetherbee* (1866), 3 Fisher, 87; 2 Clifford, 555.

That the assignment of part of a patent does not entitle the assignee to surrender and re-issue that part, see *Ex parte Smith* (1879), 16 O. G. 1233.

That the assignee of an undivided interest in the patent must join with the other owners in a surrender, see *Potter v. Holland* (1858), 4 Blatch. 206; 1 Fisher, 327.

That a surrender by, and a re-issue to, a person other than the owner would not affect the title of the owner, see *Campbell v. James* (1879), 18 O. G. 979; 17 Blatch. 42; 4 Bann. & A. 456.

That an assignee has the same rights under the re-issue as under the original, see *Potter v. Holland* (1858), 1 Fisher, 327; 4 Blatch. 206.

³ That if an assignee ratifies a re-issue it becomes valid as to him, see *Campbell v. James* (1879), 18 O. G.

979; 17 Blatch. 42; 4 Bann. & A. 456; *Meyer v. Bailey* (1875), 8 O. G. 437; 2 Bann. & A. 73.

⁴ That the grantee of a territorial interest is not an "assignee," as the word is used in the statute referring to re-issues, and that a surrender and re-issue is valid though a "grantee" does not consent, see *Meyer v. Bailey* (1875), 2 Bann. & A. 73; 8 O. G. 437; *Commissioner v. Whitely* (1866), 4 Wall. 522.

That neither a grantee nor a licensee can join in a surrender, see *Potter v. Holland* (1858), 4 Blatch. 206; 1 Fisher, 327.

That a re-issue is *prima facie* evidence that the surrender was proper, see *Knight v. Baltimore & Ohio R. R. Co.* (1840), Taney, 106; 3 Fisher, 1.

⁵ In *Potter v. Holland* (1858), 4 Blatch. 206, Ingersoll, J. : (214) "It does not follow from this, however, that because a third person, to whom a patentee has passed his interest in a part of a patent, is entitled to the same right to a re-issued patent that he had to the old one, he is compelled to take under the re-issued one, and thereby compelled to give up the right which he had under the old one. If he were, his rights might be injuriously affected without his consent. If he were so compelled,

thus be in force as to grantees and licensees in some portions of the United States, although as to the owners of the patent, and in other sections of the country, the re-issued patent alone survives.⁶ But the holders of these subordinate interests cannot claim under both patents. By authorizing or by taking the benefit of the surrender and re-issue, they abandon the privileges conferred upon them under the original patent and accept the amended patent as the source and measure of their rights.⁷

§ 699. **Effect of Surrender and Re-issue upon Rights Accruing under the Original Patent.**

The surrender of a patent for re-issue is an admission on the part of the surrenderors that the original patent is defective, and the acceptance of the surrender by the Commissioner is a judgment that its amendment by re-issue is required; but neither the surrender nor its acceptance indicates that the surrendered patent was entirely void.¹ The surrender is a vol-

a grantee under the old patent of an exclusive territorial right would be forced, without his consent, to give up damages which he might be entitled to under the old patent, for a violation of rights secured to him by that patent. And it might so happen that the old patent surrendered was a valid one, and that the re-issued one was invalid; or that the rights secured by the former were important, while the rights secured by the latter were of little consequence."

¹ Fisher, 327 (336).

That the re-issue of a patent is for the purpose of curing defects and perfecting the patent, and cannot destroy vested rights of assignees, etc., see *Harrison v. Ingersoll* (1885), 56 Mich. 36.

⁶ In *Potter v. Holland* (1858), 4 Blatch. 206, *Ingersoll, J.*: (216) "The object of a patent is to secure rights to an invention throughout the whole of the United States. We can discover no good reason why a portion or the whole of the invention, for a particular portion of the United States, may not be secured

by one patent, and the remaining portion of the invention for the residue of the United States be secured by another patent. These two patents would, in effect, constitute together but one patent for the whole invention, for the whole United States. Two patents for separate parts, the separate parts together comprehending only the whole, would in effect be but one patent for the whole; as two separate deeds, for two separate sections of one whole lot of land, would not be, in effect, more than one deed for the whole lot. No more would be secured by the two patents than is authorized by law to be secured, or than could be secured by one. The two, in effect, would constitute but one." 1 Fisher, 327 (338).

⁷ That by asserting rights under a re-issue parties in interest adopt it and to that extent forego their rights under the original, see *Meyer v. Bailey* (1875), 8 O. G. 437; 2 Bann. & A. 73.

§ 699. ¹ That a surrender for re-issue admits that the original is inoperative,

untary extinguishment of former rights, not a concession that such rights never existed, and, therefore, while no suit can be maintained under the original patent nor any infringement of its privileges be made the ground of a recovery, all closed transactions under it remain undisturbed.² Judgments obtained upon it are not vacated.³ Moneys paid under it cannot be reclaimed.⁴ But an infringement which commenced under the original patent is not sanctioned by the surrender, and if it continues in the same or in another form after the grant of the re-issue, an action may be instituted on the latter patent, and damages accruing since the date of the re-issue be obtained.⁵

§ 700. Application for Re-issue: Concurrence of the Inventor therein Necessary, if Living.

An application for the re-issue of a patent granted and assigned before the 8th day of July, 1870, may be made by the owners of the patent with or without the concurrence of the original patentee.¹ Patents granted or assigned since July 8,

see *Moffitt v. Gaar* (1860), 1 Fisher, 310; 1 Bond, 315.

² That a surrender cannot affect rights previously acquired, see *Potter v. Holland* (1858), 4 Blatch. 206; 1 Fisher, 327.

That a contract concerning a patent applies to it after a surrender and re-issue, the re-issue not being a new patent, see *McBurney v. Goodyear* (1858), 11 Cush. 569.

³ That the surrender of a patent for re-issue has no effect upon a right which has passed into a judgment, see *Mers v. Conover* (1876), 11 O. G. 1111.

⁴ That although the surrender extinguishes the original patent, the moneys paid under it cannot be recovered, see *Moffitt v. Gaar* (1861), 1 Black, 273.

⁵ That the acquiescence of the patentee in the use of his invention, under the original patent, does not authorize its use under a re-issue, see *McWilliams*

Mfg. Co. v. Blundell (1882), 22 O. G. 177; 11 Fed. Rep. 419.

That a surrender and re-issue does not deprive the patentee of the right to sue for the unlawful use, after the re-issue, of a machine brought before the re-issue, see *Bliss v. Brooklyn* (1871), 4 Fisher, 596; 8 Blatch. 533; *Carr v. Rice* (1856), 1 Fisher, 198.

§ 700. ¹ That under Sec. 13, act of July 4, 1836, the re-issue was to be granted to the patentee, if he was living and still the owner of the patent; if he was dead and there was no assignment, then to his executor or administrator; and if there was an assignment, to the assignee, see *Potter v. Holland* (1858), 4 Blatch. 206; 1 Fisher, 327.

That under the act of 1836 a re-issue might be granted to an assignee without the knowledge or consent of the patentee, see *Swift v. Whisen* (1867), 3 Fisher, 343; 2 Bond, 115.

1870, can be re-issued only upon the application and oath of the original inventor, if he be living.² Various reasons for this change in the law have been suggested. The oath accompanying the application must aver that the error whose amendment is desired arose through inadvertence, accident, or mistake, and must repeat the allegations of the original oath in reference to priority of invention and the absence of previous public use and knowledge. This oath, after the grant of the re-issue, is *prima facie* evidence upon all the points embraced therein. To permit it to be made by a mere assignee upon his information and belief, when the inventor is living and can, therefore, testify upon his positive knowledge, is an unnecessary relaxation of the ordinary rules of evidence and was properly corrected by the act of 1870. Moreover, the rights of the inventor in his invention are not exhausted by the conveyance of his entire interest in the original patent. Under former laws a re-issue might affect the value of his right to an extension after the expiration of the assigned patent,³ and under present laws an alteration in the description or claims of the existing patent may prejudice his interests in subordinate or dependent inventions which may be indicated in the original specification, but which he did not intend to cover by the original patent or transfer to the assignee. His consent to the re-issue, if he is living and able to accord it, may be, therefore, properly required.

§ 701. Application for Re-issue: by Whom Made.

Under existing laws the application for re-issue must be made by the inventor, if living; on his own behalf if he is still the entire owner of the patent, and on behalf of its real owners if he has assigned the whole or any undivided interest. Where the inventor is dead the owners of the patent, whether his representatives or assignees or both, may make the application, as before the changes in the law.¹ A living inventor

² Rev. Stat. Sec. 4895.

³ That where an assignee has re-issued a patent without the patentee's consent, the latter may apply for an extension of the original, see *Potter v. Braunsdorf* (1869), 7 Blatch. 97.

§ 701. ¹ That an executor may obtain a re-issue, see *Carew v. Boston Elastic Fabric Co.* (1871), 3 Clifford, 356; 5 Fisher, 90; 1 O. G. 91.

That a re-issue to an administrator is presumed to be regular, see *Northwest-*

who refuses to apply for a re-issue on behalf of his assignees, when such an amendment of the patent is legitimate and necessary, may be compelled to do so by a court of equity,—since his assignment of the patent implies a contract on his part to do whatever may be requisite to render the patent effective for the actual invention, and this contract equity will enforce.² But an inventor has no authority to apply for the re-issue of an assigned patent without the consent of his assignees, and his wrongful act in this regard cannot impair their rights.³ A re-issue thus obtained by him is valid or invalid at their election. They may ratify it and enjoy the advantages derived from it, though issued only in his name,⁴

ern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co. (1874), 10 Phila. 227 ; 6 O. G. 34 ; 1 Bann. & A. 177.

² See §§ 1224, 1228-1230, and notes, *post*.

³ That the surrender of an assigned patent is not valid unless made by the assignee or with his consent, see *Ex parte Wright* (1876), 10 O. G. 587 ; *Meyer v. Bailey* (1875), 8 O. G. 437 ; 2 Bann. & A. 73 ; *Barnes v. Morgan* (1875), 3 Hun, 703 ; *Dental Vulcanite Co. v. Wetherbee* (1866), 3 Fisher, 87 ; 2 Clifford, 555.

That a patentee cannot affect the interest of his assignee by any surrender for re-issue, see *Barnes v. Morgan* (1875), 3 Hun, 703.

That an assignment of a patent carries all re-issues if the assignee so elect, see *Littlefield v. Perry* (1874), 21 Wall. 205 ; 7 O. G. 964.

That a re-issue to the patentee is a bar to a re-issue to an unrecorded assignee, see *Whitely v. Fisher* (1870), 4 Fisher, 248.

⁴ In *Potter v. Holland* (1858), 4 Blatch. 206, Ingersoll, J. : (214) " We adopt the rule laid down by Judge Story in the case of *Woodworth v. Stone* (3 Story, 749), that it is not in the power of the patentee, by a surren-

der of his patent, to affect, without their consent, the rights of third persons to whom he has previously passed his interest in the whole or a part of the patent. This consent may be manifested either by joining in the surrender with the patentee, or by previously authorizing it or by subsequently ratifying or approving it. To take advantage and benefit of it would be a ratification. When such consent is given the rights of the party so consenting in and to the old patent are forever gone. It may, too, be considered as a sound and settled principle that a person to whom the patentee has passed his interest in a part of the old patent, is entitled, upon the surrender of the same by the patentee, and the obtaining of a re-issued patent, to the same right under the re-issued patent that he had to the old one. The patentee cannot, by taking a re-issue, deprive him of the same right to it that he had to the old one, if he wishes to take the benefit of such right. *Woodworth v. Hall*, 1 Woodb. & Minot, 248. But when he does take advantage and benefit of the re-issued patent, he consents to give up, and does give up, the right which he had under the old one." 1 Fisher, 327 (335).

See also *Littlefield v. Perry* (1874), 21 Wall. 205 ; 7 O. G. 964, *Dental*

or they may repudiate it and compel him to obtain another, or they may insist upon their privileges under the original patent. To guard against this unauthorized re-issue of an assigned patent, it is the practice of the Patent Office to require proof of the consent of all the owners of the patent, sufficient evidence of which is furnished by the filing of the abstract of their title with the application.⁵

§ 702. Re-issued Patent: to Whom Granted.

The re-issued patent may be granted to assignees of any degree, however remote from the original inventor.¹ The limits within which the original description and claims may be amended, and the consequences of a previous disclaimer or abandonment, are the same as if the application had been made by the inventor. The re-issue is void if any fraud is perpetrated or attempted by the applicant, as where he knows that the original assignor was not the true inventor or that the error whose amendment he desires did not occur in such a manner as alone warrants its correction.² The grant of a re-issue to an assignee is *prima facie* evidence of his title to the patent.³ Parties claiming under the original patent, other

Vulcanite Co. *v.* Wetherbee (1866), 2 Clifford, 555; 3 Fisher, 87; *Burdell v. Denig* (1865), 2 Fisher, 588.

That third parties ratify the re-issue by using or selling rights under it, see *Meyer v. Bailey* (1875), 2 Bann. & A. 73; 8 O. G. 437.

That a re-issue does not *enure* to the benefit of the assignee when obtained by the patentee, the assignee taking by ratification, not by enurement, see *Burdell v. Denig* (1865), 2 Fisher, 588.

That when the patentee obtains a re-issue at the request of the owners of the patent after an assignment of the original it enures to the benefit of the assignees, see *Wing v. Warren* (1872), 5 Fisher, 548; 2 O. G. 342.

⁵ That the Commissioner may require sufficient proof that the assignee consents to the re-issue, see *Ex parte Wright* (1876), 10 O. G. 587.

That a certified abstract of title is the proper evidence of the assignee's consent, see *Ex parte Wright* (1876), 10 O. G. 587.

§ 702. ¹ That a re-issue may be granted to an assignee of any degree, see *Selden v. Stockwell Self-Lighting Gas Burner Co.* (1881), 19 Blatch. 544; 20 O. G. 1377; 9 Fed. Rep. 390; *Swift v. Whisen* (1867), 3 Fisher, 343; 2 Bond, 115.

That a re-issue may be obtained in his own name by the assignee of the executor of the patentee, see *Carew v. Boston Elastic Fabric Co.* (1871), Holmes, 45.

² That a re-issue is void if the applicant knew, at the date of the application for it, that he or his assignor was not the true inventor, see *Singer v. Walmsley* (1860), 1 Fisher, 558.

³ That the grant of a re-issue to an

than its owners, may retain their existing rights or assert them as modified by the re-issue at their option.⁴

§ 703. **Re-issued Patent a Continuation of the Original, and Governed by the Same Law.**

A re-issued patent is a new statement of the contract between the public and the patentee, and binds each of its parties to the same extent as if it were an original patent. It is to be interpreted by the same rules, and is subject to amendment by re-issue or disclaimer in the same manner.¹ Being, however, a continuation in a new form of the original patent, the rights arising under it are governed by the law in force when the original was granted, and the patentability of the invention which it covers is determined by the state of the art as it existed at the date of the original.² The motive for obtaining a re-issue cannot change the rights which it creates, and is not regarded in deciding upon its validity or construing its provisions, except in cases where an actual fraud has been committed.³

assignee is *prima facie* evidence that he has a title to the patent, see *Washburn & Moen Mfg. Co. v. Haish* (1880), 10 Bissell, 65 ; 19 O. G. 173 ; 4 Fed. Rep. 900 ; *American Diamond Rock Boring Co. v. Sheldon* (1879), 17 Blatch. 208 ; 4 Bann. & A. 551.

⁴ That no re-issue of a patent can affect the rights of non-consenting owners or other third parties, see *Potter v. Braunsdorf* (1869), 7 Blatch. 97 ; *Potter v. Holland* (1858), 4 Blatch. 206 ; 1 Fisher, 327.

That a portion or the whole of an invention for a particular part of the United States, and the rest for other parts, may be secured by a re-issue, see *Potter v. Holland* (1858), 4 Blatch. 206 ; 1 Fisher, 327.

That after an extension the re-issue is good for the extended term, see *Gibson v. Harris* (1846), 1 Blatch. 167.

§ 703. ¹ That the Patent Office has

the same power over a re-issue as over the original, see *Ex parte Lippincott* (1879), 16 O. G. 632.

² That the re-issue is a continuation of the original patent, see *Shaw v. Colwell Lead Co.* (1882), 20 Blatch. 417 ; 11 Fed. Rep. 711 ; *Shaw v. Cooper* (1833), 7 Peters, 292 ; 1 Robb, 643.

That a re-issue is governed by the law in force at the date of the original, see *Shaw v. Cooper* (1833), 7 Peters, 292 ; 1 Robb, 643.

That the patentability of the invention claimed in a re-issue is determined by the state of the art at the date of the original application, see *Carroll v. Morse* (1876), 9 O. G. 453 ; *Carlton v. Bokee* (1872), 17 Wall. 463 ; 2 O. G. 520 ; 6 Fisher, 40 ; and § 708, note 2, *post*.

³ That the motive for a re-issue is unimportant, if the inventions are the same, see *Buffum v. Oakland Mfg. Co.* (1879), 4 Bann. & A. 599.

§ 704. Procedure on Applications for Re-issue : The Application.

An application for a re-issue, and the proceedings in the Patent Office thereon, are for the most part governed by the rules which regulate applications for original patents, and which have been already considered in detail. It will be sufficient, therefore, to discuss at this time only the particular points in reference to which the procedure on re-issue applications is exceptional. The application must be based upon a single original patent and must show the original to have been defective through mistake, and point out wherein the mistake consisted.¹ It need not follow the language of the statute.² It comprises a petition, an oath, an abstract of title, and the amended specification, accompanied by such drawings and model as the nature of the case may require. The petition prays for leave to surrender the original patent and for a re-issue upon the amended specification. It may be signed by the true owners of the patent, unless the patent has been granted or transferred since July 8, 1870, in which case the petition must be signed by the inventor if living, and contain the written assent of the present owners.³ If the inventor has deceased, and the petition bears the signatures of the assignees, the fact of his decease must be duly stated. The abstract of title must disclose the names of all persons owning any undivided interest in the original patent ;⁴ and the orig-

§ 704. ¹ That a re-issue can be based on but a single original patent, not on several, see *Washburn & Moen Mfg. Co. v. Fuchs* (1883), 16 Fed. Rep. 661 ; 5 *McCrary*, 236.

² That the application for a re-issue need not follow the language of the statute, see *Gold & Stock Telegraph Co. v. Wiley* (1883), 17 Fed. Rep. 234.

That a re-issue need not be applied for in writing under the statute, though the rules of the Patent Office may require it, see *Dental Vulcanite Co. v. Wetherbee* (1866), 3 *Fisher*, 87 ; 2 *Clifford*, 555.

³ That if the original assignment by the patentee to the first assignee were

made before July 8, 1870, the application for re-issue may be made by the assignee, see *Selden v. Stockwell Self-Lighting Gas Burner Co.* (1881), 19 *Blatch.* 554 ; 20 *O. G.* 1377 ; 9 *Fed. Rep.* 390.

That Sec. 3, act of 1870, proviso 2d, does not require applications for re-issue pending on July 8, 1870, to be made anew, with oath of inventor, etc., see *National Spring Co. v. Union Car Spring Mfg. Co.* (1874), 12 *Blatch.* 80 ; 6 *O. G.* 224.

⁴ That an abstract of title must accompany an application for a re-issue, see *Ex parte Fassett* (1877), 11 *O. G.* 420 ; *Ex parte Wright* (1876), 10 *O. G.* 587.

inal patent, or, if it be lost, a certified copy and an affidavit of the loss, must at the same time be delivered to the Patent Office.

§ 705. Procedure on Applications for Re-issue : The Oath.

Where the petition must be signed by the inventor the oath must also be made by him; in other cases it should be made by the applicants, whoever they may be.¹ In addition to the matters embraced in the oath required in an original application, it must state particularly that the applicant believes the original patent to be inoperative or invalid, with his reasons for such belief, specifying the defects or insufficiencies in the description, or the excessive matter in the Claim, pointing out the errors which constitute the inadvertence, accident, or mistake, with the manner in which they arose, and alleging that such errors occurred without fraudulent or deceptive intention.² It must also disclose the existence of foreign

§ 705. ¹ That under the act of March 3, 1871, the oath of the assignee was sufficient, if the original patent issued before July 20, 1870, but otherwise the oath of the inventor was required, see *National Car Spring Co. v. Union Spring Mfg. Co.* (1874), 6 O. G. 224; 12 Blatch. 80.

That where an assignee filed an application for a re-issue before July 20, 1870, his oath alone was sufficient, see *National Spring Co. v. Union Car Spring Mfg. Co.* (1874), 6 O. G. 224; 12 Blatch. 80.

That an applicant for a re-issue who has assigned his interest, and is still obliged to make oath that the mistake occurred "through inadvertence, etc.," is not merely a formal party and a perfunctory affiant, and his assignee is bound by his statements and declarations, see *Ex parte Mahnken* (1887), 41 O. G. 1269.

² That the oath to a re-issue application must aver that the applicant believes that he is the original and first inventor, and that the invention was never before known or used, and must

allege his citizenship, see *Ex parte Whitely* (1886), 36 O. G. 1243.

That an affidavit, on an application for re-issue, that the original is "not fully valid and available" is not sufficient and the re-issue is void, see *Poage v. McGowan* (1883), 15 Fed. Rep. 398; *Whitely v. Swayne* (1865), 4 Fisher, 117.

That the rule requiring a detailed statement under oath is imperative, and unless observed the application will not be examined, see *Ex parte Whitely* (1886), 36 O. G. 1243; *Ex parte Timken* (1883), 24 O. G. 1088.

That the rule requiring a statement to be filed with a re-issue application, accounting for the defects in the original, is not retroactive, see *Ex parte Pfaudler*, (1882), 23 O. G. 269.

That the statement required to be filed with a re-issue application must set out the facts on which the application is based, not merely the opinions or conclusions of the person who prepares the paper, pointing out the defects which render the original invalid and showing

patents for the same invention, if any have been issued to the applicant or to others by his consent, with their dates and numbers and the extent to which the invention has been used in the United States, in the same manner as on an original application.³

§ 706. Procedure on Applications for Re-issue: The Specification, Drawings, and Model.

The language of the amended specification must correspond with that of the original unless some sufficient reason for a change appears. In an original Description the widest latitude in the use of terms may be permitted, but in the re-issue specification, where the identity of the invention must, at all hazards, be preserved, no unnecessary divergence from the words in which it was originally stated can safely be allowed. New names, new uses, new descriptive matter tend to create uncertainty in this respect, and may easily be made to cover some unwarrantable departure from the original invention. Except where the correction of the errors in the previous description requires the employment of additional or substituted phrasology, the rules followed by the Patent Office in passing upon the formal sufficiency of the amended specification, therefore, restrict it to the statements made in the original.¹ New drawings must accompany the specifica-

how they arose, see *Ex parte* Timken (1883), 24 O. G. 1088; *Ex parte* Wilkins (1883), 24 O. G. 1270; *Ex parte* Pfaudler (1882), 23 O. G. 269.

That a statement of reasons for re-issue, which merely alleges "misunderstanding," is not sufficient, see *Ex parte* Wilkins (1883), 24 O. G. 1270.

That, except for the Patent Office rules, the invalidity of the original need not be sworn to, and though an oath were required its omission would not invalidate the re-issue, see *Hartshorn v. Eagle Shade Roller Co.* (1883), 25 O. G. 1191; 18 Fed. Rep. 90; *Burr v. Duryee* (1862), 2 Fisher, 275.

That it is not imperative on the Patent Office that the fact that the

original is inoperative, should have been judicially ascertained, see *Burr v. Duryee* (1862), 2 Fisher, 275.

³ That under the rules re-issue as well as original applications require an oath disclosing foreign patents and the extent of use in the United States, see *Ex parte* Beck (1880), 17 O. G. 329.

§ 706. ¹ In *Ex parte* Underwood (1872), 1 O. G. 549, Leggett, Com. : (549) "In applications for patents the examiner should interfere as little as possible with the language chosen by the applicant in describing his invention. The largest latitude should be allowed; but in applications for re-issues a different rule does and should prevail. The applicant should be held

tion when the invention is capable of such delineation, conforming in their style, number, and artistic perfection to the regulations governing original drawings. These new drawings are allowed to vary from the old only where the variation appears in the original model or relates to some unimportant matter not affecting the invention claimed. The amendment of the model is, in like manner, limited to features found in the original drawings.

§ 707. Procedure on Applications for Re-issue: Filing of the Application in the Patent Office.

The application, thus composed, is presented to the Patent Office by forwarding it in the usual mode to the Commissioner, accompanied by the statutory fees. This entitles the applicant to the consideration of his case, and if the Commissioner refuses to proceed with its examination, he may be compelled to do so by mandamus.¹ A hearing on an application for re-issue takes precedence over those on ordinary applications, and will be particularly expedited if the term of the original patent has almost expired.² The filing of the

rigidly to the language adopted in his patent, except that a good reason appears for departing from such language. In objecting to the use of new terms, new descriptive matter, etc., the examiner is not bound to give reasons. It is enough that such terms and descriptive matter are new; and it devolves upon the applicant to show good reason for their introduction, or they must be stricken out. A different rule would open a wide door to fraud. A patentee, if allowed to interpolate new uses, new descriptive matter, new names, etc., might, by frequent re-issues, keep full pace with the advancement in the art to which his patent pertains, and might thus appropriate to his own use the improvements and inventions made by others. The rule should be: *liberality with original applications; strict construction with applications for re-issue.*"

See also *Hatch v. Moffitt* (1883), 15 Fed. Rep. 252.

That the specification of the re-issue may be made more full and precise than the original, in order to cover the real invention, see *Washburn & Moen Mfg. Co. v. Haish* (1880), 4 Fed. Rep. 900; 10 Bissell, 65; 19 O. G. 173.

That a re-issue containing a broad Claim binds the patentee even though it does not secure his invention, see *Wisner v. Grant* (1880), 18 O. G. 192; 7 Fed. Rep. 922.

§ 707. ¹ That where an applicant for a re-issue has filed his application and paid his fees and done all he can to make the application effectual, it is the duty of the Commissioner to hear it although he may not have accepted the fees, and if he refuses, a mandamus will lie to compel a hearing, see *Commissioner v. Whitely* (1866), 4 Wall. 522.

² That where a patent has nearly expired, its re-issue may be expedited in the Patent Office, see *Ex parte Evarts* (1874), 5 O. G. 429.

application does not preclude the applicant from resuming his rights under the former patent; but at any time before the re-issue has been granted he may withdraw his application, revoke his surrender, and be restored to his original position.³

§ 708. Procedure on Applications for Re-issue: Examination of the Application on the Merits of the Invention.

The specification annexed to a re-issue application is subject to revision, restriction, division, and other formal corrections in the Patent Office, to the same extent as an original specification.¹ An examination of the application on its merits involves an inquiry into the patentability of the invention therein described and claimed, into the identity of such invention with the invention attempted to be covered by the former patent, and into the cause from which

³ In *Forbes v. Barstow Stove Co.* (1864), 2 Clifford, 379, Clifford, J. : (385) "The surrender is, undoubtedly, as is contended by the respondents, the act of the party making the application; but it is a mistake to suppose that the application may not be withdrawn, under leave of the Commissioner, for good cause shown, at any time before the proceedings are fully completed and duly recorded. The re-issued letters-patent, as a general rule, have the effect to supersede the original patent, but a pending application for that purpose cannot receive any such construction, no matter how nearly the proceedings may have approached to a consummation, so long as they are not finally completed. Prior to the issuing of the new patent, what is called a surrender in the case is in general nothing more than a preliminary offer to that effect, as the necessary means of obtaining a re-issue; and even when not so intended in the outset it may be subsequently so treated by the Commissioner, at the request of the party applying for the re-issue."

§ 708. ¹ That the re-issue application will not be examined unless the statement is sufficient, see *Ex parte Timken* (1883), 24 O. G. 1089.

That the Claims of a re-issue application will not be examined on their merits in connection with the sufficiency of the statement, but in their proper order, see *Ex parte Timken* (1883), 24 O. G. 1089.

That in a re-issue application the examiner must first determine the sufficiency of the application itself; and if the applicant is not entitled to a re-issue the proceedings will terminate, but if the application and statement are sufficient an examination on the merits will be had, and if it then appears that the original was not inoperative, etc., or that its defects did not result from mistake, etc., or that the claim of the applicant is barred by the references cited, etc., the application will be rejected, the reasons for the rejection stated, and an opportunity given for an appeal, see *Ex parte Ernst* (1885), 33 O. G. 235.

the alleged error in the original arose. In examining the patentability of the invention the same questions as to its novelty, utility, abandonment, and the priority of the applicant's inventive act, are presented as on original applications, and the claim of the applicant as to any one of these questions is not aided by the fact that the invention has already once received the protection of a patent, and that the validity of the patent has been vindicated in the courts.² Even the repetition in the re-issue application of the exact Claims of the original patent does not exempt them from this examination or from the judgment which may be pronounced upon them by the Patent Office. The novelty of the invention is determined according to the state of the art at the date of the original application, not at that of the re-issue, since if the invention was then new to the public no subsequent advances in the arts can deprive it of the novelty which it possessed when the inventor first endeavored to protect it.³ Its utility is measured by the usual standards. Abandonment is evidenced by more than two years' public use and sale before the original application, by an omission to claim it in the original patent after clearly describing it and an unreasonable delay in curing the omission by a re-issue, and by any other conduct of the inventor, either before or since the issue of the original patent, which proves an intention upon his part to dedicate the invention to the public.⁴ That the invention

² That in an application for a re-issue, its Claims are subject to revision by the Patent Office though they have been sustained by the courts, see *Ex parte Cox* (1873), 3 O. G. 2.

³ That on an application for a re-issue the patentability of the invention will be examined in view of the state of the art at the time when the original patent was applied for, see *Carroll v. Morse* (1876), 9 O. G. 453; *Carlton v. Bokee* (1872), 17 Wall. 463; 2 O. G. 520; 6 Fisher, 40.

That on an application for a re-issue the right of the re-issue applicant to the inventions claimed in his re-issue application will be examined in view of the

state of the art as indicated by inventions made both before and since the original was granted, and by the claims of rival inventors, see *Sargent v. Burge* (1876), 10 O. G. 285.

That the re-issue is void for want of novelty if the original was, see *Jones v. McMurray* (1877), 3 Bann. & A. 130; 2 Hughes, 527; 13 O. G. 6.

⁴ That on an application for a re-issue two years' public use of the invention before the original application may be shown, and will be fatal, see *Funck v. Doty* (1878), 14 O. G. 157.

That for all purposes of abandonment by public use and sale, the date of the re-issue is the date of the original,

was first conceived and reduced to practice by the alleged inventor is established *prima facie* by the oath accompanying the application, but may be contradicted by the records of the Patent Office or the personal knowledge of the examiner. The practice in regard to the objections and references of the examiner, as well as to amendments, arguments, rejections, and appeals, is similar to that in cases of original applications.

§ 709. Procedure on Applications for Re-issue: Examination of the Application as to the Identity of the Invention with that Described in the Original Patent.

In examining the identity of the invention claimed in the re-issue application with that attempted to be covered by the original patent, the examiner must be guided, not by his personal judgment or discretion, as in amendments to original applications, but by the rules specifically prescribed in the statutes and the decisions of the courts. The inventions are not identical unless all the essential characteristics of the one described and claimed in the re-issue application were described or attempted to be described in the original specification, drawings, or model as part of the patented invention.¹ In a machine-patent, for reasons hitherto recited, this identity must appear by a comparison of the drawings and models, which can be amended only by each other.² In other cases where drawings and models exist, the identity is determined

see *Shaw v. Colwell Lead Co.* (1882), 11 Fed. Rep. 711 ; 20 Blatch. 417.

That Sec. 32, act of 1870, making two years' delay in prosecuting an application an abandonment of it, does not relate to re-issue applications, see *Ex parte Galusha* (1873), 3 O. G. 321.

That things abandoned before the issue of the original patent cannot be claimed in the re-issue, see *Ex parte Conklin* (1872), 2 O. G. 543.

§ 709. ¹ That on an application for a re-issue, parol evidence is not admissible to enlarge the scope of the invention beyond that shown in the original specification, drawings, and model, see *Glue*

Co. v. Upton (1874), 6 O. G. 837 ; 4 Clifford, 237 ; 1 Bann. & A. 497 ; *Collar Co. v. Van Deusen* (1874), 23 Wall. 530 ; 7 O. G. 919 ; *Cahart v. Austin* (1865), 2 Clifford, 528 ; 2 Fisher, 543.

² That under the act of 1870 the Commissioner, in allowing a re-issue, cannot look outside the original specification, drawings, and model, except that in machine-patents, where the model is no longer in existence, extrinsic proof may be examined to determine what the machine really was, see *Giant Powder Co. v. California Powder Works* (1875), 3 Sawyer, 448 ; 2 Bann. & A. 131.

by comparing the entire descriptions, as contained in these and in the specifications to which they are annexed, with one another. Where there are no drawings or models, and the description in both the original and the re-issue applications, therefore, rests in words alone, extrinsic proof may be offered and received to establish this identity.³

§ 710. Procedure on Applications for Re-issue: Examination of the Application as to the Mode in which the Defects in the Original Arose.

The examination into the cause from which the alleged error in the original arose may be conducted according to the discretion of the Commissioner, provided it be done without prematurely disclosing the pendency of the re-issue application. The affidavit of the applicant is *prima facie* proof that the error occurred through inadvertence, accident, or mistake, and without fraudulent or deceptive intention; but this is open to contradiction or to confirmation by the records of the Patent Office, the affidavits of its officers, or any other evidence satisfactory to the Commissioner which can be obtained without a violation of the secrecy to which the applicant is entitled. The existence of this condition must be established before the re-issue can be legally allowed.¹ But

³ That on an application for a re-issue the Commissioner may examine the original specifications, drawings, model, or any other legal proof, in order to ascertain the identity of the inventions, see *Hussey v. Bradley* (1863), 2 Fisher, 362; 5 Blatch. 134.

That where no model or drawing accompanies the original patent great care should be exercised to exclude new matter from the re-issue, see *Ex parte Gottstein* (1877), 11 O. G. 1061.

That extraneous evidence as to a model destroyed by fire, or other lost records, will not be received on a re-issue application, see *Ex parte Williams* (1878), 14 O. G. 202.

§ 710. ¹ That no re-issue ought to be allowed by the Commissioner unless the applicant shows that the original was

defective through mistake, and not through fraud, and points out in what the mistake consisted, see *Ex parte Conklin* (1874), 1 MacArthur, 375; 5 O. G. 235.

That an assignee cannot re-issue to cover additions unless he proves that the additions were made by the inventor, and were intended to be patented by him, and were omitted by mistake, see *Opinion Atty. Gen.* (1833), 2 Op. At. Gen. 572.

That the testimony of the patentee, who re-issued his patent after thirteen years, that "he thought" the original was defective and ought to cover the additional matter, does not prove original inadvertence or mistake, see *Newton v. Furst & Bradley Mfg. Co.* (1886), 119 U. S. 373; 38 O. G. 104.

the question relates to the intention of the inventor at the date of his original application, not to his conduct since that time, except so far as it throws light on his intention then; and if the error then was unintentional, his subsequent attitude toward individual third parties cannot estop him from asserting his right to amend his patent.²

§ 711. Procedure on Applications for Re-issue: Interferences.

An application for a re-issue is liable to be placed in interference with a pending original application, with another application for re-issue, or with an unexpired patent, whenever the inventions claimed in each are apparently identical. An interference will be declared, under the rules, between an application for a re-issue and a conflicting original application, if the original application was pending when the patent whose re-issue is desired was granted, or if the party presenting the original application makes oath that he performed his own inventive act before the filing of the application for the patent upon which the proceedings in re-issue have been based. An interference will be declared between two or more conflicting applications for re-issue when their respective patents were granted upon applications pending at the same time, or when the applicant for the re-issue of the later patent avers on oath that his inventive act preceded the filing of the application for the earlier patent. An interference will be declared between an application for a re-issue and a conflicting unexpired patent when the original applications for both patents were pending at the same time, and the re-issue applicant makes oath that his inventive act occurred before the original application of the other patentee

² That an applicant for a re-issue is not estopped from claiming it by his conduct toward outside parties, see *Ex parte Roe* (1874), 5 O. G. 397. This case rests upon the doctrine that an estoppel in favor of individual parties does not enure to the public benefit, and is consequently no bar to a re-issue of the patent as against the public. But if it be true, as many cases seem to indicate, that an inventor may estop himself to claim the inven-

tion as against the public, or that estoppel may constitute one step in that series of events which results in an abandonment of the invention to the public by the act of some rival inventor, there is no reason why a re-issue applicant should not be bound by his commissions or omissions to the same extent as any other claimant of an invention. See §§ 346, 357, 390, and notes, *ante*.

was filed, or when the original application for the patent whose re-issue is desired was filed after the other patent had been granted and the re-issue applicant presents an affidavit that his invention was completed before the filing of the application for the earlier patent. Where an interference has been declared between a patent and an application, and pending the interference an application is made for the re-issue of the patent, the re-issue application is examined on its individual merits, and if allowed, will take the place of the original patent in the interference.¹ A re-issue application, describing but not claiming an invention involved in interference, may be amended by the insertion of such Claim and be, thereupon, admitted to the contest. The proceedings upon an interference are the same whether the applications are for a re-issue or for an original patent.

§ 712. Procedure on Applications for Re-issue: Appeals.

From an adverse decision of the examiners upon any question relating to the merits of the application, an appeal lies to the examiners-in-chief, and thence successively to the Commissioner, the Supreme Court of the District of Columbia, and to the Supreme Court of the United States, except in interference cases, where the decision of the Commissioner is final. Although an application for re-issue has been duly allowed and passed by the examiners, the patent is still subject to the control of the Commissioner, and like an original patent may be withheld by him upon sufficient grounds.¹ If

§ 711. ¹ That where the original patent is in interference, and not the re-issue-application, the re-issue-application will be examined, and on the surrender and cancellation of the original patent will be substituted for it, see *Ex parte Zay* (1881), 19 O. G. 1496.

That where the re-issue-application contains no Claim involved in the interference declared with the original, the application should not be placed in interference, see *Ex parte Zay* (1881), 19 O. G. 1496.

That where a patent has been surrendered for re-issue, an interference de-

clared, an adverse decision rendered, and a re-issue refused, the patent is entirely avoided, see *Peck v. Collins* (1881), 103 U. S. 660; 19 O. G. 1137.

§ 712. ¹ That a re-issue patent, though signed, may be withheld on account of a protest against its issue, see *Ex parte Hunt* (1879), 15 O. G. 831.

That after the Patent Office decides to re-issue a patent, a stranger cannot have access to the records of the proceedings in order to discover objections and contest it, see *Dec. Sec. Int.* (1883), 23 O. G. 629.

refused by one Commissioner his successor should not grant it without a careful re-examination of the case, and a clear conviction that the former judgment was erroneous.²

§ 713. Date and Term of Re-issued Patent.

A re-issued patent bears the date of the original for all purposes, except as the foundation of an action for infringement.¹ When the term of the re-issue is expressed in years, the term runs from the grant of the original.² When the original was limited by the duration of a foreign patent, the re-issue is subject to the same limitation.³ The rights of all parties claiming under the re-issue, whether as against the public or against rival claimants, are held to have accrued when the original patent issued, and are interpreted and enforced according to the circumstances then existing.⁴ All rights of action for the infringement of the original patent are, however, extinguished by its surrender, and suits pending at the date of the re-issue are abated.⁵

² That a re-issue withheld by one Commissioner will not be granted by his successor without a careful examination of the case, see *Ex parte Hunt* (1879), 15 O. G. 831.

§ 713. ¹ That the re-issue bears the date of the original, except as to suits for infringement, see *House v. Young* (1867), 3 Fisher, 335; *Hussey v. Bradley* (1863), 2 Fisher, 362; 5 Blatch. 134; *Bloomer v. Stolley* (1850), 5 McLean, 158; *Woodworth v. Hall* (1846), 1 W. & M. 248; 2 Robb, 495; *Stanley v. Whipple* (1839), 2 McLean, 35; 2 Robb, 1; *Shaw v. Cooper* (1833), 7 Peters, 292; 1 Robb, 643; *Grant v. Raymond* (1832), 6 Peters, 218; 1 Robb, 604.

That the decision of the Commissioner that the date of the invention described in the re-issue was the date of the original patent is final, see *House v. Young* (1867), 3 Fisher, 335.

² That a re-issue granted for a specific term begins at the date of the original patent, see *Whitely v. Fisher* (1870), 4 Fisher, 248.

³ That the law, not the language of the patent, decides when a re-issue becomes operative, see *Whitely v. Fisher* (1870), 4 Fisher, 248.

⁴ That the rights of the patentee under the re-issue are governed by the law in force at the date of the original, see *Shaw v. Cooper* (1833), 7 Peters, 292; 1 Robb, 643.

⁵ That the surrender extinguishes the original patent, and all rights of action under it fall with it, see *Jones v. Barker* (1882), 22 O. G. 771; 11 Fed. Rep. 597; *Peck v. Collins* (1880), 103 U. S. 660; 19 O. G. 1137; *Moffitt v. Gaar* (1861), 1 Black, 273.

That as all pending suits fail with a surrender of the patent for re-issue, there can be no continuance to obtain a re-issue, see *Jones v. Barker* (1882), 22 O. G. 771; 11 Fed. Rep. 597.

That a re-issue can affect only suits subsequently begun, see *United States Stamping Co. v. King* (1879), 17 O. G. 1399; 17 Blatch. 55; 7 Fed. Rep. 860; 4 Bann. & A. 469.

§ 714. Decision of Commissioner in Allowing a Re-issue, how far Conclusive.

The effect of a decision of the Commissioner in granting a re-issue, and the extent to which his decision is reviewable by the courts, are questions which have given rise to much discussion.¹ Upon principle, the problem seems to be a simple

§ 714. ¹ Upon the effect of the award of a re-issue by the Commissioner the courts are to this day undecided, and the judgments of different tribunals are apparently irreconcilable. In several earlier cases it was held that the action of the Commissioner was conclusive unless fraud in obtaining and allowing the re-issue was alleged and proved. His power to determine the identity of the inventions covered by the re-issued and original patents was treated as final, and except in such palpable and unwarranted enlargements as implied a fraud, the re-issue could not on this ground be impeached. Thus in *Whitely v. Swayne* (1865), 4 Fisher, 117, Leavitt, J. : (123) "It is insisted by the counsel for the complainant, that the decision of the Commissioner of Patents in granting the re-issues is conclusive, and that the court cannot look into anything that transpired antecedently to the grant to impeach the validity of the re-issued patent. This is undoubtedly the settled law in this country, so far at least as to the identity of the original invention, and the invention as described and claimed in the application for the re-issue, unless fraud in the transaction is alleged. The Commissioner is supposed to have all the qualifications necessary to an intelligent decision of that question, and there are strong reasons why his action should be regarded as final. Such I understand to be doctrine of the Supreme Court of the United States, as announced in numerous reported cases. 4 How. 404 ; 15 How. 62 ; 17 How. 84 ; Law's Dig. 617. But I am not aware that the Supreme

Court have decided in any case that it is not competent to inquire whether the Commissioner has exceeded his authority in granting a patent, without a compliance with the requirements of the statute. He has clearly no power to dispense with what the statute declares to be necessary prerequisites to the grant. And if it appears from the papers and records of the Office in evidence that the statutory requirements have not been complied with, it is within the power of a court, and its plain duty, to hold the patent to be void. Such was the doctrine announced by Judge Hall in the case of *Ransom v. Mayor of New York*, Law's Dig. App. 57. The learned judge says : 'Things specified in this section (6th section of the act of 1836) are prerequisites to the granting of a patent, and unless these prerequisites are complied with, a party sued for an infringement of the patent may show that they have not been complied with, and in that mode defeat the action of the supposed inventor.' The soundness of this doctrine cannot be successfully controverted. It would be straining the doctrine of presumptions in favor of the legality of the acts of a public officer to an unreasonable extent to hold that a patent is legal and valid where the records and papers of the Office show conclusively that essential statutory provisions had been disregarded."

Also in *Swift v. Whisen* (1867), 3 Fisher, 343, Leavitt, J. : (351) "But the statute makes it the special duty of the Commissioner of Patents to examine closely every application for a re-

one. The Commissioner is a judicial officer, empowered under

issue, and he is vested with no authority to grant a re-issue except under circumstances where the statute has been complied with. It is to be supposed, in support of the exercise of the authority of the Commissioner of Patents under the law, that all the requisites of the statute have been complied with, and hence it is the uniform doctrine of all the courts of the United States that they will presume that the law has been complied with, and they refuse, except under special circumstances referred to in the act, to go into any inquiry back of the grant by the Commissioner of Patents of these re-issues; in other words, to a certain extent they consider the action of the Commissioner upon the right of parties to a re-issue to be conclusive; presuming that all the requirements of the law have been enforced, have been complied with, in the case. The decisions upon the general doctrine to which I have referred, namely, to the effect that the action of the Commissioner is conclusive upon the question of the identity of the inventions embraced or described in the re-issue and in the original patent, would seem to be harmonious. There is no case, that I am aware of, in conflict with this general proposition; and these decisions rest upon the fact that in deciding whether the re-issue is for the same invention, the Commissioner of Patents, who acts, of course, under the obligation of an oath, acts in that particular in a judicial capacity. His decisions, therefore, on points of that kind, have the force and effect of judicial decisions, and courts are reluctant to go back of those decisions and to inquire whether the re-issue has been properly granted or not, except in cases where it is made apparent that the re-issue was obtained by fraud, or for the purposes of deception and imposition.

But if any facts appear in the progress of a trial, which are sufficient to satisfy a jury that there has been fraud in the procurement of a re-issue, — either actual fraud, or circumstances which may be supposed to amount to constructive fraud, — the re-issued patent will be held invalid. There is a plain distinction between actual fraud and constructive fraud. The statute refers, specially, to cases of collusion, — fraudulent, corrupt collusion between the applicant for the patent and the Commissioner of Patents. If it is apparent that there has been any improper collusion between them, and that the patent has been granted corruptly, then, of course, that is an act of positive fraud that will invalidate any patent to which it applies. And there may be also constructive fraud, where it is made manifest that the re-issued patent is fraudulently extended beyond the claims of the original patent for a deceptive purpose, for the purpose of imposition upon the public, and where there is no just foundation for such a claim in the original patent; where, in fact, the re-issue goes altogether beyond the scope of the original invention and incorporated an element that was not contemplated or intended by the original patentee in his original patent. Cases of this kind have occurred in the progress of the execution of the patent laws of the country where re-issues have been fraudulent, — that is, where they have been tainted with this constructive fraud; where it appeared that, for a deceptive purpose, a party applying for a re-issue had sought to embrace an element in the re-issued patent that was not claimed and did not pertain to the original invention, for the purpose of taking advantage of other parties in the community who were using that element which he had fraudulently

certain circumstances to issue letters-patent, and while acting

made a part of his original invention." 2 Bond, 115 (125).

See also *Jordan v. Dobson* (1870), 2 Abbott, 398 ; 7 Phila. 533 ; 4 Fisher, 232.

It soon, however, became evident that the imputation of such comprehensive powers to the Commissioner on a mere *ex parte* proceeding was at variance with the rights of individuals and with public policy. The position was then adopted by the courts that whenever it appeared on the face of the original and re-issued patents that the inventions embraced therein were not identical, the Commissioner had exceeded the authority conferred upon him by the statutes and that the award of the re-issue might be held invalid ; and, on the other hand, that where the want of identity was not apparent on comparing the two patents, the action of the Commissioner could not be impeached on any ground whatever, except for fraud in allowing the re-issue, and this only in a proceeding instituted for that purpose. This position has been maintained in numerous cases and is still adhered to by many of our courts. Thus in *Seymour v. Osborne* (1870), 11 Wall. 516, Clifford, J. : (543) "Where the Commissioner accepts a surrender of an original patent and grants a new patent, his decision in the premises, in a suit for infringement, is final and conclusive, and is not re-examinable in such a suit in the Circuit Court, unless it is apparent upon the face of the patent that he has exceeded his authority, that there is such a repugnancy between the old and the new patent that it must be held, as matter of legal construction, that the new patent is not for the same invention as that embraced and secured in the original patent."

In *Jordan v. Dobson* (1870), 4 Fish-

er, 232, Strong, J. : (237) "It must be assumed, therefore, he did determine there were defects in the former specifications arising from inadvertence, accident, or mistake, without any fraudulent intention. And having thus determined, his decisions are conclusive. They are not re-examinable, except so far as he decided there was no fraud. It is now settled that the granting of a renewed patent is so far conclusive upon the question of the existence of error in the original patent arising from inadvertency, accident, or mistake, that it leaves nothing open but the fairness of the transaction. *Stimpson v. Westchester R. R. Co.*, 4 Howard, 380 ; *Woodward v. Stone*, 3 Story, C. C. R. 749 ; *Allen v. Blunt*, 3 Story, C. C. R. 742 ; *Curtis on Patents*, 280." 2 Abbott, 398 (404) ; 7 Phila. 533 (536).

In *Collar Co. v. Van Dusen* (1874), 23 Wall. 530, Clifford, J. : (558) "Unless, however, it is apparent upon the face of the new patent that the Commissioner has exceeded his authority, his decision is final and conclusive, as the jurisdiction to re-issue patents is vested in him subject to a single exception, that if there is such repugnancy between the old and the new patent that it must be held, as matter of legal construction, that the re-issued patent is not for the same invention as that embraced and secured in the original patent, then the re-issued patent is invalid." 7 O. G. 919 (920).

In *Wells v. Jacques* (1874), 1 Bann. & A. 60, Nixon, J. : (68) "His application is made to the Commissioner of Patents, and that officer, not this court, is the tribunal in which Congress has vested the power of determining whether sufficient reasons exist to grant the re-issue. His decision in the matter is final, in the sense that there is no appeal from it ; and it does not seem to

within his jurisdiction his judgments are conclusive and can-

be re-examinable here, unless it is evident upon the face of the re-issue that he has exceeded his authority, and that there is such a repugnancy between the old and the re-issued patent that it must be held, as a matter of legal construction, that they are not the same invention. *Seymour v. Osborne*, 11 Wall. 543." 5 O. G. 364 (366).

In *Birdsall v. McDonald* (1874), 6 O. G. 682, Swayne, J. : (683) "The Commissioner of Patents awarded the re-issue. The subject was placed by the law within his jurisdiction. His decision is to be held *prima facie* correct in all cases, and it is conclusive, unless impeached for fraud, or unless it is clear upon the face of the several specifications that the re-issue is not for the same thing as the original patent. Where a remedy is sought for fraud it must be in an independent proceeding had directly for that purpose by a bill in equity in the name and by the authority of the United States." 1 Bann. & A. 165 (170).

In *Russell v. Dodge* (1876), 93 U. S. 460, Field, J. : (464) "The decision of the Commissioner in granting the re-issue is, it is true, so far conclusive as to preclude in the present suit for infringement any inquiry into its correctness outside of the patents themselves. His action, in any case within the limits of his authority, is not open to collateral impeachment. But that authority being limited to a re-issue for the same invention as that embraced in the original patent, a re-issue for anything more is necessarily inoperative and void. To determine the identity of the invention the two patents may be compared. Thus compared, the re-issue here appears on its face to be for a different invention, and the Commissioner, therefore, exceeded his authority in issuing it." 11 O. G. 151 (152).

In *Kells v. McKenzie* (1881), 20 O. G. 1663, Brown, J. : (1663) "Under this section it is now settled that the decision of the Commissioner re-issuing the patent is final and conclusive, and is not subject to review in any court, except as to the identity of the invention. But if it be apparent upon the face of the patent that he has exceeded his authority, and has thus acted without jurisdiction, and that there is a manifest repugnancy between the old and new patent, then it must be held, as a matter of legal construction, that the new patent is not for the same invention as that embraced and secured in the original patent." 9 Fed. Rep. 284 (286).

In *Spaeth v. Barney* (1885), 22 Fed. Rep. 828, Colt, J. : (829) "The authorities are numerous and conclusive to the effect that where the Commissioner accepts the surrender of an original patent, and grants a new patent, his decision is final and conclusive in a suit for infringement, unless it is apparent on the face of the patent that he has exceeded his authority; that there is such a repugnancy between the old and the new patent that it must be held, as matter of legal construction, that the new patent is not for the same invention as that embraced in the original patent." 30 O. G. 997 (997).

To the same effect see *American Diamond Rock Boring Co. v. Sheldon* (1879), 17 Blatch. 208; *Thomas v. Shoe Mach. Mfg. Co.* (1878), 16 O. G. 541; 3 Bann. & A. 557; *Russell v. Dodge* (1876), 93 U. S. 460; 11 O. G. 151; *Union Paper Collar Co. v. White* (1875), 11 Phila. 479; 7 O. G. 698, 877; 2 Bann. & A. 60; *La Baw v. Hawkins* (1874), 1 Bann. & A. 428; 6 O. G. 724; *Miligan & Higgins Glue Co. v. Upton* (1874), 6 O. G. 837; 4 Clifford, 237; 1 Bann. & A. 497; *Nicholson Pave-*

not be collaterally attacked.² If he exceeds the limits of his jurisdiction, as fixed by law, his acts are void.³ The courts

ment Co. v. Elizabeth (1873), 3 O. G. 522 ; 6 Fisher, 424 ; Parham v. American Buttonhole, Overseaming, & Sewing Machine Co. (1871), 4 Fisher, 468 ; Chicago Fruit House Co. v. Busch (1871), 2 Bissell, 472 ; 4 Fisher, 395 ; Blake v. Stafford (1868), 6 Blatch. 195 ; 3 Fisher, 294 ; Middletown Tool Co. v. Judd (1867), 3 Fisher, 141 ; Potter v. Holland (1858), 4 Blatch. 235 ; 1 Fisher, 382.

That a re-issue cannot be attacked by an infringer unless fraudulent or contrary to law or issued to the wrong party, see Dental Vulcanite Co. v. Wetherbee (1866), 3 Fisher, 87 ; 2 Clifford, 555.

The abuses which arose under this doctrine were its inevitable consequence. As any re-issue which the Patent Office could be prevailed upon to grant, whether it were for the original invention or not, and whether the defects which it corrected were intentional or otherwise, became impregnable in the courts unless the repugnancy between it and the original was manifest on the inspection of the two patents, patentees whose original patents covered all they had invented or at that time thought of claiming as their inventions, naturally took advantage of the general and indefinite language of their original specifications, and based upon them re-issue claims far beyond the limits of their own inventive acts, and under this doctrine vindicated their unwarranted assumptions even in the highest tribunal of the nation. In the effort to prevent or thwart these abuses the courts had recourse to various theories, in order, if possible, to remedy the evil without placing a further limitation on the powers of the Commissioner. By holding that the decision of the Patent Office on the origin of the amended defect, as

well as on the identity of the inventions, was reviewable, they would at once have removed all difficulty ; since by permitting an inquiry into the character of the actual invention, and the intentional or unintentional omission or misstatement in the original specification, they would have limited every re-issued patent to the exact inventions which the patentee originally intended to secure. Reverence for the settled course of decisions forbade this heroic remedy and led to the introduction of other doctrines, intended to protect intervening public and private rights, which have in their turn created new difficulties and required perpetual explanation and modification in the courts. The current of legal and judicial opinion, however, seems to be moving steadily toward the only true solution of this question, as set forth in the remainder of this paragraph and in the cases cited in its notes.

² That the Commissioner's action in granting a re-issue is not open to review in cases where he has jurisdiction, see Ball v. Langles (1880), 102 U. S. 128 ; 18 O. G. 1405 ; Wells v. Gill (1872), 2 O. G. 590 ; 6 Fisher, 89.

³ In Odell v. Stout (1884), 22 Fed. Rep. 159, Sage, J. : (161) "The action of the Commissioner of Patents is not *res adjudicata*. Cook v. Ernst, 2 O. G. 89. He is not an officer in whom, under the constitution, judicial power can be vested. Grant v. Raymond, 6 Pet. 242. If he were, the proceedings for procuring original letters and re-issues are *ex parte* and would not estop defendants, charged as infringers, upon questions affecting the validity of the patent. But the statutes, prescribing his powers and duties, vest in the Commissioner of Patents a discretion, which in some matters is final, and in others subject

have power to inquire whether a given act was within his jurisdiction or exceeded it, and according to the result of this inquiry they may treat his act as valid or invalid.⁴ In refer-

to review. The authorities are not uniform; but the later cases, and some of not so recent date, are in harmony with the ruling made by Chief Justice Marshall in *Grant v. Raymond*, that the correct performance of all those preliminaries on which the validity of an original patent or of a re-issued patent depends, is always examinable in the court in which a suit for its violation is brought." 29 O. G. 862 (863).

In *Giant Powder Co. v. California Vigorit Powder Co.* (1880), 18 O. G. 1339, Field, J. : (1340) "The Commissioner is an officer of limited authority, and whenever it is apparent upon inspection of the patents that he has acted without authority or has exceeded it, his judgment must necessarily be regarded as invalid." 6 Sawyer, 508 (522); 4 Fed. Rep. 720 (725).

In *Glue Co. v. Upton* (1874), 6 O. G. 837, Clifford, J. : (838) "Jurisdiction to re-issue patents is vested in the Commissioner, and his decision in such an application is final and conclusive, and not re-examinable in a suit in the Circuit Court, unless it is apparent upon the face of the patent that the Commissioner has exceeded his authority, or that there is such a repugnancy between the old and the new patent that it must be held, as matter of legal construction, that the new patent is not for the same invention as that embraced and secured in the original patent." 4 Clifford, 237 (239); 1 Bann. & A. 497 (499).

That Sec. 4916, Rev. Stat., does not enlarge the powers of the Commissioner on a re-issue, see *Powder Co. v. Powder Works* (1878), 98 U. S. 126; 15 O. G. 289.

That the decision of the Commissioner on a re-issue is not final except within his jurisdiction, see *Flower v.*

Rayner (1881), 19 O. G. 425; 5 Fed. Rep. 793; *Metropolitan Washing Mach. Co. v. Providence Tool Co.* (1872), Holmes, 161.

That no patent, whether re-issue or original, can be legal if the statutory prerequisites are not fulfilled, and where the non-fulfilment appears on the face of the patent or by the records of the Patent Office, the Commissioner has evidently exceeded his jurisdiction and the patent is void, see *Whitely v. Swayne* (1865), 4 Fisher, 117.

⁴ In *Giant Powder Co. v. California Vigorit Powder Co.* (1880), 18 O. G. 1339, Field, J. : (1340) "As the power to accept a surrender and issue new letters is vested exclusively in the Commissioner of Patents, his decision in the matter is not open to collateral attack in a suit for the infringement of re-issued letters. His action, like that of all officers specially designated to perform a particular duty of a judicial character for the government, is presumed to be correct until impeached by regular proceedings to annul or modify it. He must judge, in the first instance, of the sufficiency of the original specification, whether the same is defective in any particular, whether such defect was the result of an unintentional error, and if so, to what extent a new or additional specification should be allowed to describe correctly the invention claimed; and it is to be assumed in every case that he has done his duty. The decisions of the Supreme Court to this effect are numerous, and the doctrine is among the settled rules of Patent Law. But it does not preclude the examination of the original and re-issued patents to see whether or not they disclose on their face a case in which the Commissioner had authority to act or whether

ence to re-issues the statutes confer on the Commissioner the power to amend a defective patent by re-issuing it in a corrected form. At the same time they prohibit the exercise of this power in such a manner as to introduce into the re-issue any new invention,⁵ or to cure any defect which was originally intentional, or fraudulent.⁶ In accepting a surrender and

he has exceeded his authority in issuing letters for an invention different from that described in the original patent. If they disclose a case in which the Commissioner has no jurisdiction to act, or a case in which, by his determination, he has exceeded his jurisdiction, the re-issued letters must fall. His determination can have no greater conclusiveness than that of the judgment of a regular judicial tribunal, and we all know that although such judgment cannot be collaterally attacked by showing that the evidence upon which the court acted was insufficient, that improper testimony was admitted, that the court erred in its rulings upon matters of law, or that the verdict of the jury was against the weight of evidence, yet the record of the judgment can in all cases be examined to see whether the court had jurisdiction of the subject-matter and of the person of the defendant, and if such jurisdiction be wanting the judgment is ineffectual for any purpose. So here upon all matters outside of the patents which the Commissioner was to hear, and upon the weight of which he was to determine, his judgment is conclusive in the present suit; but if the patents disclose a case in which he had no jurisdiction or in which he exceeded it, his determination carries with it no efficacy." 6 Sawyer, 508 (520); 4 Fed. Rep. 720 (723).

That where the Commissioner exceeds his authority in re-issuing a patent, under a mistake of law, the matter may be reviewed in actions for infringement, see *Mahn v. Harwood* (1884), 112 U. S. 354; 30 O. G. 657.

That the courts presume that in allowing a re-issue the Commissioner has done his duty, see *Spaeth v. Barney* (1885), 22 Fed. Rep. 828; 30 O. G. 997; *Jordan v. Dobson* (1870), 2 Abbott, 398; 7 Phila. 533; 4 Fisher, 232.

⁵ That the Commissioner has exceeded his jurisdiction when the re-issue on its face covers a different invention from that described in the original, see *Giant Powder Co. v. California Vigorit Powder Co.* (1880), 6 Sawyer, 508; 4 Fed. Rep. 720; 18 O. G. 1339; *Bull v. Langles* (1880), 102 U. S. 128; 18 O. G. 1405; *Russell v. Dodge* (1876), 93 U. S. 460; 11 O. G. 151.

That Sec. 4916, Rev. Stat. governs the mode of proof but does not give the Commissioner power to grant a re-issue for a different invention, or to determine conclusively that inventions are the same, see *Averill Chemical Paint Co. v. National Mixed Paint Co.* (1881), 22 O. G. 585; 20 Blatch. 42; 9 Fed. Rep. 462; *Powder Co. v. Powder Works* (1878), 98 U. S. 126; 15 O. G. 289.

⁶ In *Flower v. Rayner* (1881), 5 Fed. Rep. 793, Nixon, J. : (795) "A careful reading of the section shows that the Commissioner has power to grant a re-issue only in special cases and under particular circumstances. The original patent must be inoperative or invalid, either for defective or insufficient specifications, or from claiming as new more than the patentee has the right to claim; and, in addition to this, the error which is sought to be corrected must have arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention. If the party in-

granting a re-issue, the Commissioner, who has entire control over the language of a patent, thus acts within his jurisdiction, provided that the defects in the original patent arose without fraud, through inadvertence, accident, or mistake, and that no new matter is embraced in the re-issue. The courts cannot so far review this action as to declare that the original patent was not defective, that the surrender and re-issue were on that account of no effect, and that the original patent is consequently still in force. Nor can they hold that the original operative and valid patent was extinguished by the surrender, but that being originally valid and operative it could not be the subject of re-issue, and, therefore, that no patent in favor of the patentee can now exist. Endless confusion would arise if the jurisdiction of the Commissioner upon these points were not final.⁷ But on the other hand, where the Commissioner, in

interested can bring himself within these conditions and limitations, the Commissioner is authorized to issue a new patent for the same invention. When the original shows upon its face that the grounds and reasons for the re-issue do not exist, or where a comparison of the letters-patent disclose different inventions, the re-issue is void, as an act unauthorized by the law." 19 O. G. 425 (425).

See also *Giant Powder Co. v. California Vigorit Powder Co.* (1880), 4 Fed. Rep. 720; 6 Sawyer, 508; 18 O. G. 1339.

That although other courts declare that the decision of the Commissioner in allowing a re-issue is final, the Supreme Court of the District of Columbia, on appeal from the decision of the Commissioner in refusing a re-issue do not hold such decision conclusive, but require evidence of original inadvertence, accident, or mistake, see *In re Conklin* (1874), 1 MacArthur, 375; 5 O. G. 235.

⁷ The recent disposition to treat the action of the Commissioner in awarding a re-issue as reviewable has, in one case,

carried the court so far that, in appearance at least, it has decided that the inoperativeness or invalidity of the original patent may be re-examined, and if the opinion of the court differs from that of the Commissioner on that question, the re-issue may be declared void. Thus in *Giant Powder Co. v. California Vigorit Powder Co.* (1880), 4 Fed. Rep. 720, Field, J. : (723) "As thus seen, a re-issue can only be had when the original patent is inoperative or invalid from one of two causes, — either by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new; and even then the patentee can only obtain a re-issue where the error has arisen from inadvertence, accident, or mistake, and without any fraudulent or deceptive intention. As the power to accept a surrender and issue new letters is vested exclusively in the Commissioner of Patents, his decision in the matter is not open to collateral attack, in a suit for the infringement of re-issued letters. His action, like that of all officers especially designated to per-

accepting the surrender and granting the re-issue, has included in the re-issued patent any new matter, or any matter

form a particular duty of a judicial character for the government, is presumed to be correct until impeached by regular proceedings to annul or modify it. He must judge, in the first instance, of the sufficiency of the original specification, — whether the same is defective in any particular; whether such defect was the result of an unintentional error, and if so, to what extent a new or additional specification should be allowed to describe correctly the invention claimed; and it is to be assumed in every case that he has done his duty. The decisions of the Supreme Court to this effect are numerous, and the doctrine is among the settled rules of Patent Law. But it does not preclude the examination of the original and re-issued patents, to see whether or not they disclose on their face a case in which the Commissioner had authority to act, or whether he has exceeded his authority in issuing letters for an invention different from that described in the original patent. If they disclose a case in which the Commissioner had no jurisdiction to act, or a case in which by his determination he has exceeded his jurisdiction, the re-issued letters must fall. His determination can have no greater conclusiveness than that of the judgment of a regular judicial tribunal; and we all know that although such judgment cannot be collaterally attacked by showing that the evidence upon which the court acted was insufficient, that improper testimony was admitted, that the court erred in its rulings upon matters of law, or that the verdict of the jury was against the weight of evidence, yet the record of the judgment can in all cases be examined to see whether the court has jurisdiction of the subject-matter and of the person of the defendant;

and if such jurisdiction be wanting, the judgment is ineffectual for any purpose. So here, upon all matters outside of the patents which the Commissioner was to hear, and upon the weight of which he was to determine, his judgment is conclusive in the present suit; but if the patents disclose a case in which he had no jurisdiction, or in which he exceeded it, his determination carries with it no efficacy. This is general and universal law, although we find expressions in opinions that the only question left over for the consideration of the court, in a suit for infringement of re-issued letters, is whether the new and the old patent are for the same invention, — the expressions would be more accurate if they were, — that seldom could any other question be raised, for seldom will it appear without the consideration of extrinsic evidence whether or not the original patent was invalid or inoperative from a defect of specifications. Suppose, for illustration, that the specifications in two patents, the original and the re-issued, were identical in their language, — or, differing in phraseology, were identical in meaning, — would it be pretended that, though their identity would be thus manifest on their face from a comparison of the two, and that the Commissioner in granting the re-issue had accordingly acted in a case not warranted by the statute, it must be assumed that the re-issue was properly granted, and that the action of the Commissioner could not therefore be questioned? The decisions support no such conclusion. The Commissioner is an officer of limited authority; and whenever it is apparent upon inspection of the patents that he has acted without authority, or has exceeded it, his judgment must necessarily be regarded

which was fraudulently or intentionally excluded from the

as invalid. His action must be restricted to the particular cases mentioned in the statute. That only authorizes a re-issue when, from an unintentional error in the Description of the invention, the patent is invalid or inoperative, or when the Claim of the patentee exceeds his invention. It is not sufficient that the patent does not cover all that the patentee could have claimed if his specifications had come up to his invention. If he has invented or discovered something beyond his original specifications and Claim, his course is not to endeavor to cover it by a re-issue, but to seek a separate patent for it. The statute authorizing a re-issue was intended to protect against accidents and mistakes, and it is only when thus restricted that it can be regarded as a beneficial statute. If a patentee does not embrace by his specifications and Claim all that he might have done, and there has been no clear mistake, inadvertence, or accident in their preparation, the presumption of law is that he has abandoned to the use of the public everything outside of them, or at least has postponed any additional claim for further consideration." 18 O. G. 1339 (1340); 6 Sawyer, 508 (520). See also *Flower v. Rayner* (1881), 19 O. G. 425; 5 Fed. Rep. 793.

This position has been since discussed and repudiated by Lowell, J., in *Smith v. Merriam* (1881), 6 Fed. Rep. 713, where he says: (715) "A case has been brought to my notice, decided by Mr. Justice Field, on his circuit, which is supposed by the patent lawyers to indicate a new departure in the law of re-issued patents. The high authority and great importance of that decision will be my apology for a discussion, which, a few weeks since, would have been unnecessary. The case is *The*

Giant Powder Co. v. The California Vigorit Powder Co., 18 O. G. 1339; s. c. 4 Fed. Rep. 720. In it the learned judge is understood to declare that if the court can discover, upon a comparison of the two instruments, that there was no defective specification to be amended, and that the Claim was not broader than the invention, the action by the Commissioner in granting a re-issue was in excess of his jurisdiction, and void; and that if the patentee claims too little, instead of too much, his specification is not defective by reason of that mistake, but all which he did not claim was dedicated to the public. I do not mean to say that I consider the decision to be as extensive as this; but it is so understood by some members of the bar; and there are remarks in the opinion which lend a color to such a construction. The Revised Statutes simply re-enact the law upon this subject which has been in force since 1836: 'Whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the Commissioner shall, on the surrender of such patent, and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued.' Section 4916. The most natural construction of this law would perhaps be that if a patent should be inoperative by reason of a defective specification, or invalid for claiming too much, the defect might be supplied, or the excessive Claim be reduced, by re-issue. But the courts have given a very different inter-

original patent, he has exceeded his jurisdiction, and the Claims

pretation, -- much wider in most respects, and narrower in only one. They do not permit a defective specification to be supplied, excepting from the drawings or model; but they do permit the Claim to be varied, provided the same invention is described in both patents, and hold that the decision of the Office that the occasion had arisen for granting a re-issue is final. The law is extremely liberal, perhaps too much so, and has been much abused; but if we change it suddenly we shall make a destruction of titles which it is impossible to contemplate without dismay. If the court is to decide, by inspection of the original patent, that it was not defective, the result is this: that after a patentee, upon the best advice which he can obtain, has been instructed that his specification needs amendment, and obtains a new patent, the court may say, 'We are unable to see any defect, and your re-issue, however honestly obtained, is bad, because your original patent was so good.' The mistake is one of law, and the Commissioner does not usually decide the law finally; but as to the mere question of the necessity for a re-issue, supposing the new patent itself to be unobjectionable, his decision has always been held to be final; and this for an unanswerable reason, that no patentee, however honest or careful, can be safe in obtaining a re-issue, if he is to be informed, when he gets into court, that the judge is unable to see why he should have surrendered his first patent. The slighter and more obviously unobjectionable the change, the stronger will be the argument that there was no occasion to make it; so that honest and careful patentees will be the most likely to suffer. It does not help the matter to call the action of the Commissioner an excess of jurisdiction. I know that the

courts have called these mistakes jurisdictional. They did this to overrule, without positively saying so, the early cases which held the action of the Commissioner within his jurisdiction to be final. It is obvious that the Commissioner has the same jurisdiction to issue a bad patent as to issue a good one. As his action is *ex parte* it does not bind the world, excepting in certain matters which it is both unjust and inconvenient to review. A mistake by him as to the necessity of issuing a new patent is not an excess of jurisdiction, but a mistake in a matter clearly within his jurisdiction; and the real question is whether it is one which the courts will correct by destroying a new patent after the old one has been surrendered. Upon questions of the validity of a patent, or of a re-issue, in all great matters of novelty and construction and patentability, the decision of the Commissioner is not final, though his jurisdiction is undoubted; but I repeat that urgent reasons of justice require that upon the mere question whether the paper called a re-issue shall be given, his finding should be, as it has hitherto always been held to be, conclusive. Again, if it be found that the Claims of the original patent were valid, and that the re-issue for the same invention states the Claim or Claims in a different way, — though it may be a better way for the patentee, — the change does not of itself vitiate the new patent; but, on the contrary, the original Claims are conclusively presumed to have been made as they were through inadvertence, accident, or mistake. The law is so well settled that most of the reports do not contain the Claims of the two patents: but I suppose that no re-issue has ever contained the exact Claims of the original, and this can be discovered, incidentally, in many of

of the re-issued patent must be held invalid so far as such new

the cases, and positively in some, where the very point is passed upon. See *Allou v. Blunt*, 3 Story, 742; *Stimpson v. Westchester R. Co.*, 4 How. 380; *O'Reilly v. Morse*, 15 How. 62; *Batten v. Taggart*, 2 Wall. Jr. 101; s. c. 17 How. 74; *Bennet v. Fowler*, 8 Wall. 444; *The Goodyear Cases*, 2 Wall. Jr. 283, 356; 2 Cliff. 351; 9 Wall. 798; *Seymour v. Osborne*, 11 Wall. 516; *Roberts v. Ryer*, 91 U. S. 150; *Marsh v. Seymour*, 97 U. S. 348; remarks of Bradley, J., in *Powder Co. v. Powder Mills*, 98 U. S. 136, and of the same learned judge in *Carlton v. Bokee*, 17 Wall. 463, where he intimates that a re-issue may be good as to those Claims which agree with the invention, and void as to others which exceed it; *Cochrane v. Deener*, 94 U. S. 780; *Conover v. Roach*, 4 Fisher, 12; *Stevens v. Pritchard*, 10 O. G. 505; *Herring v. Nelson*, 14 Blatch. 298; *Johnson v. Flushing R. Co.*, 15 Blatch. 192; *Anilin Co. v. Higgins*, id. 290; *Pearl v. Ocean Mills*, 11 O. G. 2. None of these cases, unless it be *Batten v. Taggart*, 17 How. 74, — which is perhaps inconsistent with *Leggett v. Avery*, 101 U. S. 256, — has been overruled; and a great many similar cases could be cited. It has been brought out a little more decidedly by the later cases that the invention must be the same; but it has never been held in the Supreme Court, or any circuit court, so far as I can discover, that the Commissioner's decision is not final as to the propriety of a re-issue, as distinguished from its validity upon what may be called its merits; or that the Claims may not be varied to express the real invention. The Claim is part of the specification, and if defective may be amended. *Russell v. Dodge*, 93 U. S. 460, in which the decision is given by Mr. Justice Field, and which is cited by him in

The Powder Co.'s Case, merely decides that a re-issue which claims a different invention is void. A similar decision has been made at this term of the Supreme Court, in giving which Mr. Justice Strong states the law in the old way, that the Commissioner's decision is final as to the mistake, but not as to the identity of invention. *Ball v. Langles*, 18 O. G. 1405. The only cases which he cites are *Seymour v. Osborne*, and *Russell v. Dodge*, which he evidently considers to be consistent with each other." 19 O. G. 601 (602).

Further, that the decision of the Commissioner as to the defectiveness of the original patent and the necessity for a re-issue is final, see *Combined Patent Can Co. v. Lloyd* (1882), 11 Fed. Rep. 149; 21 O. G. 713; 15 Phila. 481; *Selden v. Stockwell Self-Lighting Gas Burner Co.* (1881), 19 Blatch. 544; 20 O. G. 1377; 9 Fed. Rep. 390; *Christman v. Rumsey* (1879), 58 How. Pr. 114; 17 Blatch. 148; 17 O. G. 903; 4 Bann. & A. 506; *Judson v. Bradford* (1878), 16 O. G. 171; 3 Bann. & A. 539; *Kerosene Lamp Heater Co. v. Littell* (1878), 3 Bann. & A. 312; 13 O. G. 1009; *Thomas v. Shoe Machinery Mfg. Co.* (1878), 16 O. G. 541; 3 Bann. & A. 557; *Lorillard v. McDowell* (1877), 11 O. G. 640; 13 Phila. 461; 2 Bann. & A. 531; *Miller & Peters Mfg. Co. v. Du Brul* (1877), 12 O. G. 351; 2 Bann. & A. 618; *Ex parte Conklin* (1874), 5 O. G. 235; 1 MacArthur, 375; *Wells v. Jacques* (1874), 5 O. G. 364; 1 Bann. & A. 60; *Jordan v. Dobson* (1870), 4 Fisher, 232; 2 Abbott, 398; 7 Phila. 533; *Blake v. Stafford* (1868), 3 Fisher, 294; 6 Blatch. 195.

That the decision of the Commissioner that the re-issue is necessary is final, no matter how many times the

matter or intentionally excluded matter is concerned.⁸ Upon

patent has already been re-issued, see *Union Paper Collar Co. v. White* (1875), 7 O. G. 698, 877; 11 Phila. 479; 2 Bann. & A. 60.

Furthermore, that the decision of the Commissioner is final on the collateral questions which must be settled, and the issues of fact which must be determined, before a surrender can be accepted and a re-issue allowed, unless the statute permits defences on these points, see *Mahn v. Harwood* (1884), 112 U. S. 354; 30 O. G. 657; *Giant Powder Co. v. Safety Nitro-Powder Co.* (1884), 19 Fed. Rep. 509; 10 Sawyer, 23; 27 O. G. 99; *American Diamond Rock Boring Co. v. Sheldon* (1879), 17 Blatch. 208; 4 Bann. & A. 551; *Anilin v. Higgin* (1878), 15 Blatch. 290; 14 O. G. 414; 3 Bann. & A. 462; *Judson v. Bradford* (1878), 3 Bann. & A. 539; 16 O. G. 171; *Herring v. Nelson* (1877), 14 Blatch. 393; 12 O. G. 753; 3 Bann. & A. 55; *American Nicholson Pavement Co. v. Elizabeth* (1873), 3 O. G. 522; 6 Fisher, 424; *Hoffheins v. Brandt* (1867), 3 Fisher, 218.

⁸ Although the decision of the Commissioner in accepting a surrender and awarding a re-issue is final so far as the substitution of the re-issued for the original patent is concerned, the courts still have the power to declare the Claims of the re-issued patent invalid for any of those general reasons which apply to original patents, or for the special reason that such Claims contain matter which the Commissioner had no jurisdiction to allow. But, as in all other cases, the courts will so construe the re-issued patent, if possible, as to avoid this latter objection, and will confine it, if its language will reasonably permit, to such subject-matter as constituted the original invention, and was not intentionally omitted or misstated in the orig-

inal patent. Where the re-issued patent repeats, as it usually does, one or more of the original Claims, these may be held valid, though all additional Claims are rejected as beyond the scope of the amending power; and thus, except in a few cases, the duty of the courts is limited to the construction of the re-issued patent. That in constructing a re-issued patent it must be restricted to the subject-matter indicated in the original specifications as belonging to the actual invention is settled by an unbroken current of authority. See §§ 663-669 and notes, *ante*, and § 746 and notes, *post*.

See also *Russell v. Dodge* (1876), 93 U. S. 460; 11 O. G. 151; *Collar Co. v. Van Dusen* (1874), 23 Wall. 530; 7 O. G. 919; *Bridge v. Brown* (1871), Holmes, 53; *Goodyear v. Berry* (1868), 3 Fisher, 439; 2 Bond, 189; *Cahart v. Austin* (1865), 2 Fisher, 543; 2 Clifford, 528; *Hussey v. Bradley* (1863), 2 Fisher, 362; 5 Blatch. 134; *Poppenhusen v. Falke* (1861), 2 Fisher, 181; 4 Blatch. 493.

That the courts may inquire into the origin of the defect for whose amendment the re-issue was obtained, and confine the operation of the re-issued patent to matter not intentionally omitted or misstated in the original, has often been denied, see *Asmus v. Alden* (1886), 27 Rep. Fed. 684; 36 O. G. 231, *Western Union Tel. Co. v. Baltimore & Ohio Tel. Co.* (1885), 25 Fed. Rep. 30; *Thomas v. Shoe Machinery Mfg. Co.* (1878), 3 Bann. & A. 557; 16 O. G. 541; *Blake v. Stafford* (1868), 3 Fisher, 294; 6 Blatch. 195; *Middletown Tool Co. v. Judd* (1867), 3 Fisher, 141.

The contrary has, however, been asserted in recent decisions, and is undoubtedly the correct position. Thus in *Mahn v. Harwood* (1884), 112 U. S.

this latter question the whole field of inquiry should be open to the courts, and while the decision of the Commissioner is *prima facie* correct and the burden of proof rests on those who controvert it, the identity of the invention claimed in the re-issue with that described in the original patent, and the origin of the corrected error in inadvertence, accident, mistake, or fraud, should be exhaustively investigated.⁹

354, Bradley, J. : (359) "The same defence may be established by showing from the record that there was no inadvertence, accident, or mistake in drawing up the specification of the original patent ; for the statute only gives a re-issue when the original is defective by inadvertence, accident, or mistake." 30 O. G. 657 (658).

In *Odell v. Stout* (1884), 22 Fed. Rep. 159, Sage, J. : (161) "The granting of a re-issue is *prima facie* evidence of inadvertence, accident, or mistake, as the granting of original letters is *prima facie* evidence of invention. This evidence may be overcome. It is not conclusive." 29 O. G. 862 (863).

The entire doctrine of abandonment by an unreasonable delay in applying for a re-issue is in reality only another mode of stating that the courts may inquire into the existence of original inadvertence, accident, or mistake; and every decision in favor of that doctrine is an indirect assertion that on this point the decision of the Commissioner is not conclusive. See §§ 690-692, and notes, *ante*, and also *Western Union Tel. Co. v. Baltimore & Ohio Tel. Co.* (1885), 25 Fed. Rep. 30 ; *Wollensak v. Reiher* (1885), 115 U. S. 96 ; 31 O. G. 1301.

⁹ The method of investigation which may be pursued by the courts in reviewing the action of the Commissioner on the two questions here discussed is also as yet undetermined. It has been generally considered that the inquiry must be limited to the documentary evidence afforded by the original and re-issued patents, and by the records of the action

of the Patent Office on the original and re-issue applications ; and in some cases it has been held that unless in these the repugnancy of the inventions, or the intentional omission or misstatement in the original patent, were apparent the decision of the Commissioner was conclusive. Thus in *Blake v. Stafford* (1868), 6 Blatch. 195, Shipman, J. : (199) "As the law now stands, I regard the decision of the Commissioner as final and conclusive, unless impeached for fraud in his or the patentee's acts, or for some irregularity arising on the face of the papers, or for a clear repugnance between the original and re-issued patents. Under the Act, the Commissioner has the power to decide, and in every acceptance of a surrender and every re-issue does decide, that the original patent was inoperative and invalid by reason of a defective specification or by claiming too much, and that the error arose by inadvertency, accident, or mistake, and without any fraudulent or deceptive intention. He is authorized to grant a new patent for the same invention and for no other, and when he grants the new one, the presumption is that it embraces the same invention as the original. The jurisdiction of the Commissioner is final and conclusive, unless, as already stated, fraud or collusion somewhere is proved, or some irregularity is apparent on the face of the papers, or there is a plain repugnance between the old and new specifications." 3 Fisher, 294 (300).

See also *Mahn v. Harwood* (1884), 112 U. S. 354 ; 30 O. G. 657 ; *Giant*

§ 715. **Re-issued Patent not Collaterally Attackable for Fraud in Procuring the Re-issue.**

Neither a re-issued nor an original patent can be collaterally attacked on the ground that it was granted through the fraud either of the applicant or the Commissioner. This question can be raised only on a proceeding to repeal the patent.¹ Evidence of such fraud may be found in grossly

Powder Co. v. California Vigorit Powder Co. (1880), 4 Fed. Rep. 720; 6 Sawyer, 508; 18 O. G. 1339; *Wells v. Gill* (1872), 2 O. G. 590; 6 Fisher, 89.

In several particulars, however, this rule has been necessarily departed from, and there seems no sufficient reason why it should be at all regarded. Evidence outside the record must sometimes be admitted to ascertain the character of the actual original invention and its identity with that embraced in the re-issue; and in determining the question of original inadvertence, etc., by the reasonableness of the delay in obtaining a re-issue, all the circumstances attending the delay may be, as they constantly are, subjected to examination, and the validity or the scope of the Claims of the re-issue be thus indirectly decided by matters appearing only by parol. The reluctance of the courts to formally adopt this position, and throw the whole field of inquiry upon these two questions open for any and every ordinary method of investigation seems to arise from an exaggerated view of the authority of the Commissioner and the effect of his decision in allowing a re-issue. As this fundamental doctrine becomes clearer and more accurately stated it may be confidently expected that these resulting questions will be settled on a rational basis, and that the same latitude of inquiry will be permitted as to the cause of the alleged defect in the original patent, as is now enjoyed in reference to the patentability of the invention and the priority of the inventive act.

§ 715. ¹ In reference to this question also the law has undergone marked alterations. It was formerly held that the question of fraud in obtaining the re-issue was open and might be submitted to the jury. See *Stimpson v. Westchester R. R. Co.* (1846), 4 How. 380; 2 Robb, 335; and § 714, note 1, *ante*. In *Graham v. Mason* (1860), 5 Fisher, 1; 4 Clifford, 88, it was suggested that a re-issue can be collaterally attacked either for fraud or want of identity. The current of authority is, however, to the contrary, and in spite of occasional apparent departures from the doctrine it may be regarded as the settled law that no objection to the re-issued patent on the ground of fraud in the patentee in procuring it, or corruption in the Commissioner in allowing it, can be raised except in a proceeding instituted by the United States for its repeal. Thus in *Giant Powder Co. v. Safety Nitro-Powder Co.* (1884), 10 Sawyer, 23, Sawyer, J. : (25) "The question whether there is a fraud in the surrender and application for a re-issue is one of fact, for the officers of the Patent Office alone to decide, and their determination is conclusive in a collateral proceeding." 27 O. G. 99 (100); 19 Fed. Rep. 509 (511).

In *Thomas v. Shoe Mach. Mfg. Co.* (1878), 3 Bann. & A. 557, Clifford, J. : (559) "Authority to accept the surrender of an original patent and to grant a re-issue is conferred upon the Commissioner, and, in a case arising under the Patent Law then in force, the Supreme Court, more than thirty years

and unwarrantably extended Claims, or in descriptive matter clearly intended to mislead the public, or in extrinsic facts which manifest bad faith on the part of the patentee or corruption on the part of the Commissioner.² This rule does

ago, decided that where an act was to be done or a patent granted upon proofs to be had before a public officer upon which he was to decide, the fact that such officer had done the act or granted the patent was *prima facie* evidence that the proofs had been regularly made and that they were satisfactory, even though the patent did not contain any recitals that the prerequisites to the grant had been fulfilled; and such continued to be the rule until the question came up under a later act, when the Supreme Court held that the granting of a re-issued patent closed all inquiry into the existence of inadvertence, accident, or mistake, and left open only the question of fraud for the jury. *Railroad v. Stimpson*, 14 Pet. 458; *Stimpson v. Railroad*, 4 How. 384. Since that time it has been definitely settled that neither re-issued nor extended patents can be abrogated by an infringer, in a suit against him for damages or profits, upon the ground that the letters-patent were procured by fraud in prosecuting the application for the same before the Commissioner. *Rubber Co. v. Goodyear*, 9 Wall. 797." 16 O. G. 541 (541).

In *La Baw v. Hawkins* (1874), 1 Bann. & A. 428, Nixon, J. : (429) "I take no notice of the denial in the defendant's answer, that the letters-patent were surrendered for good and lawful cause, or that they were inoperative or invalid, or deficient or insufficient in any respect, because that question is not open for examination here. Since the case of *Seymour v. Osborne*, 11 Wall. 516, it seems to be settled that neither re-issued nor extended patents can be abrogated by an

infringer, in a suit against him for an infringement, upon the ground that the letters-patent were procured by fraud in prosecuting the application for the same before the Commissioner." 6 O. G. 724 (725).

In *Johnsen v. Beard* (1875), 2 Bann. & A. 50, Woodruff, J. : (51) "I understand the Supreme Court to have settled, distinctly and finally, that this court cannot enter into the examination of any question of fraud upon the Commissioner who granted the re-issue, or of any matter which is outside of the record; and that the only power which the courts have over re-issues, when their validity is sought to be impeached upon such grounds, is to look at the record of the original patent and of the re-issue, and to determine upon their face whether or not, as matter of law, the re-issue is a lawful one, without inquiring by what means it was procured, and without inquiring what matters of fact were involved *de hors* the record. The act of the Commissioner in granting the re-issue is final and conclusive." 8 O. G. 435 (436).

See to the same effect *Schillinger v. Crawford* (1886), 37 O. G. 1349; 4 Mackey, 450; *Miller & Peters Mfg. Co. v. Du Brul* (1877), 2 Bann. & A. 618; 12 O. G. 351; *Birdsell v. McDonald* (1874), 6 O. G. 682; 1 Bann. & A. 165; *Milligan & Higgins Glue Co. v. Upton* (1874), 6 O. G. 837; 4 Clifford, 237; 1 Bann. & A. 497; *Corn Planter Patent* (1874), 23 Wall. 181; 6 O. G. 392; *Seymour v. Osborne* (1870), 11 Wall. 516.

² In *Goodyear v. Berry* (1868), 2 Bond, 189, *per Curiam* : (202) "If the Claims of a re-issued patent clearly imply an

not forbid the admission, in a suit for the infringement of a re-issued patent, of testimony tending to establish that the alleged defects in the original patent arose from a fraudulent or deceptive intention on the part of the inventor, or prevent the courts from holding that the endeavor to correct such fraudulent defects by the re-issue cannot be sustained.³

expansion of the invention beyond the Claims of the original patent there is always ground for a presumption that there was a fraudulent intent to anticipate and cover subsequent inventions, and thus bar the door against patents for all subsequent discoveries. This is clearly against the policy of our patent-right system, and has been wisely condemned by the uniform decisions of the courts of the United States." 3 Fisher, 439 (449).

That where a re-issue fraudulently misleads the public it is void, see *Aultman v. Holley* (1873), 6 Fisher, 534; 11 Blatch. 317; 5 O. G. 3; *Swift v. Whisen* (1867), 3 Fisher, 343; 2 Bond, 115.

That a re-issue is not fraudulent merely because its object was to enlarge the scope of the original patent and was first suggested by judicial construction, see *Poppenhusen v. Falke* (1862), 2 Fisher, 213; 5 Blatch. 46.

That fraud, whether actual or constructive, renders a re-issue void, see *Swift v. Whisen* (1867), 3 Fisher, 343, 2 Bond, 115.

That if a re-issue is fraudulent all its Claims are void, see *Odell v. Stout* (1884), 22 Fed. Rep. 150; 29 O. G. 862.

³ Fraud in obtaining a re-issue must not be confounded either with a fraudulent attempt to conceal the true nature of the invention from the public, which is a good defence under the statute against any patent, or with a fraudulent and deceptive intention in the omission or misstatement in the original patent now corrected in the re-issue, which according to the authorities cited in the notes to the last paragraph is a valid objection to a re-issue whenever its validity can be inquired into by the courts. The first is a matter between the government and the patentee, and is properly adjudicated only in a proceeding by the government to rescind its own grant. The other two concern the public generally, and the defendant in an infringement suit in particular, and may, therefore, be set up by him in his defence, and so far as the suit against him is concerned be conclusively determined by the courts.

CHAPTER III.

OF THE REPEAL OF LETTERS-PATENT.

§ 716. Three Classes of Persons Interested in the Repeal of Letters-Patent: Infringers : Prior Inventors : The Public.

THREE distinct rights are either limited or suspended by the grant of a patent, and three classes of persons are thus interested in its repeal. The first class embraces those persons who practise the invention in violation of the exclusive privilege conferred upon the patentee, and who thereby become liable to compensate him for the injury unless his patent can be shown to be invalid. The second class consists of prior inventors whose monopoly is denied or restricted in its enjoyment on account of the existence of an antagonistic patent, and whose rights never can be perfectly secured until the adverse patent is repealed. The third class are the general public whose free use of the invention is suspended while the patent is in force, and whose power to grant a later valid patent to a different and more meritorious inventor has been impaired by the mistaken issue of the first. For the protection of the rights of all these persons against unlawful patents the law properly provides measures commensurate with the requirements of the different classes, whereby the patents may either be declared inoperative in reference to certain individuals or may be universally and permanently repealed.

§ 717. Interests of Infringers Protected without Special Proceedings for a Repeal.

The rights of the first class are sufficiently preserved by the protection afforded to the third class, of which they are always members, and by allowing them to defend themselves in any suit for a violation of the patent by showing that, as to all

the points involved in such suit, the patent is invalid. Those who simply practise the invention require no other relief against an unlawful patent than that which frees them from a liability to pay for its infringement. It is not necessary that the validity of the patent in itself, or as a public grant, be called in question, nor that the judgment of the court pronounce it null and void. The statutes in permitting an infringer to attack the patent upon every matter relating to the patentability of the invention and the priority of the patentee's inventive act, and in conferring upon the court the power to declare the patent invalid so far as the pending controversy is concerned, have secured the practical employer of the art or instrument against an undue interference with his rights under color of an unlawful patent, except in cases where the invalidity of the patent arises from the fact that it was originally obtained by fraud. In these cases the infringer is left to the protection accorded to him as a member of the general public. It is true that it might often be to his advantage were he allowed in his defence to show that the patentee had secured his grant by fraud or by corruption, but for obvious reasons such defence cannot be made. The issue of a patent is the decree of a tribunal to whom the duty of awarding patents to the original inventors of patentable arts and instruments has been confided by the law, and its decrees within its jurisdiction, like those of other courts, cannot be collaterally impeached. Thus though an infringer may defeat the operation of the patent, as against himself, on the ground that if it covers the invention which he uses the Patent Office had no jurisdiction to award it, either because the invention was not patentable or because the patentee was not its first inventor, he cannot claim in his defence that a grant within the jurisdiction of the Patent Office is invalid because it was corruptly or fraudulently obtained.¹ This is a question which can be raised only by a proceeding instituted for that pur-

§ 717. ¹ That a patent cannot be collaterally attacked for fraud in procuring it, but may be set aside and repealed on a direct proceeding for that purpose, see *Eureka Co. v. Bailey Wash-* ing Mach. Co. (1870), 11 Wall. 488; *Crompton v. Belknap Mills* (1869), 3 Fisher, 536; *Goodyear v. Providence Rubber Co.* (1864), 2 Clifford, 351; 2 Fisher, 499.

pose on behalf of the authority from whom the grant has been improperly procured; and an infringer can, therefore, avail himself of this mode of relief only as a member of the general public, and through the measures which the law prescribes for their protection.

§ 718. Interests of Prior Inventors Require Special Proceedings for a Repeal.

The second class of persons require for their protection an additional proceeding. A prior inventor has not only the right to use his own invention, and when sued for the infringement of an earlier patent to defend upon the ground of his own previous inventive act, but he also has the right to that monopoly of the invention which the law confers upon him as a recompense for his inventive skill. An out-standing patent to a subsequent inventor cannot take away this right, nor prevent the issue of a later patent to the first inventor whenever his superior title is established; but the later lawful patent does not abrogate the former, nor relieve the true inventor from that cloud upon his title which arises from the existence of the earlier patent to his rival. To the complete enjoyment of his monopoly the extinguishment of the unlawful interfering patent becomes necessary, and as no power has been bestowed upon the Patent Office to recall it, the statutes have provided a specific method for securing its repeal.

§ 719. Interests of the Public Require Special Proceedings for a Repeal.

The third class of these persons, or the general public, possess collective rights beyond those which subsist in individuals, for whose protection against unlawful patents special measures are required. Such members of the public as infringe upon these patents may defend against them in the manner just described. Prior inventors, also members of the public, may remove interfering patents by the mode particularly provided for that purpose. But neither of these methods secures to the collective public the entire enjoyment of their natural and legal rights. The collective public are

entitled to all those benefits, direct or indirect, which flow from the free use of every industrial device that is not covered by a lawful patent; and the enjoyment of these benefits cannot be made conditional upon the willingness of individuals to infringe existing patents or their ability to successfully defend against them. An unlawful patent is practically as complete an obstacle to the public enjoyment of an invention as a lawful patent could be, until by some means the unlawful patent is virtually or actually destroyed; and the public interest thus demands the establishment of such forms of procedure as may lead to its immediate repeal. Moreover, by the issue of one patent for a given invention the public, acting through the government, exhaust their power to confer on any one this particular monopoly. Two conflicting monopolies in the same invention cannot exist, since the idea of a monopoly excludes all competition. Hence, whether the first patent be lawful or unlawful, while it remains in force no second patent can be granted, for the entire monopoly resides in him to whom the first was issued and nothing remains in the public to be bestowed upon another through the second. The practice of the Patent Office in allowing patents to prior inventors, notwithstanding earlier patents to later inventors, is not based on any theory that more than one monopoly can be created by the public, but is a mere device for putting both the claimants on equal ground before the courts, in order that their adverse claims to the monopoly may be determined. Whenever, therefore, an unlawful patent is obtained, the public are unlawfully deprived of their right to grant a lawful patent, and the recovery of this right by the repeal of the unlawful patent becomes a duty not only to themselves collectively but to that individual member of the public upon whom the monopoly ought legally to be conferred.

§ 720. Two Special Proceedings Provided for the Repeal of Unlawful Patents.

This description of the rights invaded by unlawful patents, and of the methods by which alone these rights can be protected, indicates that for two of these three classes of persons

special remedies must exist. Of the protection afforded to infringers by permitting them to avail themselves of any defence against the patent, except that of fraud in its procurement, nothing further need be stated here, — the subject being specially considered later in its proper place. Prior inventors and the general public, however, require each their own modes of redress, resulting in the repeal of the unlawful patent, in one case as to the contending claimant only, and in the other as to all mankind. These are to form the present subjects of examination.

SECTION I.

OF THE REPEAL OF PATENTS IN THE INTEREST OF PRIOR INVENTORS.

§ 721. Proceedings for a Repeal in the Interest of Prior Inventors under the Acts of 1790, 1793, and 1836.

The right of a prior inventor to institute proceedings for the repeal of a patent improperly granted to a subsequent inventor, or to one who simply pirated the invention, has been always expressly recognized by our Patent Law. The acts of 1790 and 1793 contained provisions by virtue of which actions could be instituted by any person, resulting, if successful, in the abrogation of the alleged unlawful patent.¹ The act of 1836, having secured by different methods the protection of the rights of all other individuals, restricted private actions for the repeal of patents to the prior inventor, conferring upon him the power thus to attack conflicting patents, whether the Patent Office had recognized his superior claims by granting him a patent or had refused his application on the ground of the outstanding earlier patent.² In

§ 721. ¹ The act of 1790, Sec. 5, and the act of 1793, Sec. 10, were substantially identical. They provided for the issue of a rule against the owner of any patent, upon the application of any person averring under oath that the patent was obtained surreptitiously by or upon

false suggestion, commanding the owner of the patent to show cause why the patent should not be repealed, and directed that unless such cause were shown a decree of repeal should be entered against the defendant.

² Act of 1836, Sec. 16, " *And be it*

this proceeding the court not only had authority to repeal the unlawful patent, but where the prior inventor had been denied a patent in the Patent Office on account of the unlawful patent, it could adjudicate upon his title to the patent, and in pursuance of this judgment the Commissioner could award it to him as the lawful patentee.³

§ 722. Proceedings for a Repeal in the Interest of Prior Inventors under the Act of 1870.

The act of 1870 still further limited this privilege of instituting private actions for repeal, by requiring the prior inventor to satisfy the government of his superior title, and obtain a patent, before attacking the alleged unlawful patent of his adversary. The act of 1836, as has been seen, afforded the defeated applicant a double remedy, extinguishing the rival patent and reversing the unfavorable judgment of the Patent Office on his individual claims. The act of

further enacted, That whenever there shall be two interfering patents, or whenever a patent on application shall have been refused on an adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted, any person interested in any such patent, either by assignment or otherwise, in the one case, and any such applicant in the other case, may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties, and other due proceedings had, may adjudge and declare either the patents void in the whole or in part, or inoperative and invalid in any particular part or portion of the United States, according to the interest which the parties to such suit may possess in the patent or the inventions patented, and may also adjudge that such applicant is entitled, according to the principles and provisions of this Act, to have and receive a patent for his invention, as specified in his Claim, or for any part thereof, as the fact of priority

of right or invention shall in any such case be made to appear. And such adjudication, if it be in favor of the right of such applicant, shall authorize the Commissioner to issue such patent, on his filing a copy of the adjudication, and otherwise complying with the requisitions of this Act. *Provided, however*, That no such judgment or adjudication shall affect the rights of any person except the parties to the action and those deriving title from or under them subsequent to the rendition of such judgment." See also Sec. 10, act of 1839.

³ That a patent can be declared void under Sec. 16, act of 1836, and Sec. 10, act of 1839, only when two patents interfere, or the Commissioner refuses a patent, or the Supreme Court of the district refuses it upon appeal, see *Merserole v. Union Paper Collar Co.* (1869), 3 Fisher, 483; 6 Blatch. 356.

That courts cannot declare a patent void under Sec. 17, act of July 4, 1836, see *Merserole v. Union Paper Collar Co.* (1869), 6 Blatch. 356; 3 Fisher, 483.

1870 separated these proceedings. In cases where the application of the prior inventor was denied on account of the existing patent, it gave him the same opportunity to vindicate his rights to a patent which he enjoyed under the act of 1836, but it did not permit him to join with this proceeding another, having for its object the repeal of the opposing patent.¹ This separation was correct in principle. The grant of a patent raises a strong *prima facie* presumption of its validity. The refusal of a patent by the Patent Office is also *prima facie* evidence that the applicant has no right to a monopoly. To permit a defeated applicant to attack an interfering patent in the face of these two presumptions is inconsistent with a due regard to the rights of the existing patentee. Not until he has overcome the presumption arising from his own defeat by obtaining a reversal of the adverse judgment, and by the allowance of a patent in his favor has put himself on equal ground with the earlier patentee, ought he to be permitted to bring his adversary into court in defence of the prior patent, or compel him to incur the risk of its repeal.² The present law thus adequately protects the

§ 722. ¹ In the act of 1870, Secs. 52 and 58 represent and reproduce the matter contained in Sec. 16 of the act of 1836. Sec. 52 is substantially identical with Sec. 4915 of the Revised Statutes, which is as follows: "Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity, and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his Claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adju-

dication, and otherwise complying with the requirements of law. In all cases where there is no opposing party, a copy of the bill shall be served on the Commissioner, and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not." Sec. 58 appears as Sec. 4918, Rev. Stat., and is quoted in § 723 and notes, *post*. By comparing these with Sec. 16, act of 1836, given in note 2, § 721, *ante*, the precise division in the law effected by the act of 1870 will be perceived.

² That no suit to annul a patent can be brought by a private party unless there are two outstanding interfering patents, see *Mowry v. Whitney* (1871), 14 Wall. 434; 1 O. G. 499; 5 Fisher, 513.

That a suit to defeat another's patent cannot be brought till the plaintiff receives his own, see *Hoeltge v. Hoeller* (1870), 2 Bond, 386.

interests of all parties, and far more accurately than the old preserves a proper order and sequence in its remedies.

§ 723. Proceedings for a Repeal in the Interest of Prior Inventors under the Revised Statutes of 1874.

The relief afforded to the defeated applicant is prescribed by Section 4915 of the Revised Statutes, and has already been discussed in its appropriate connection.¹ Proceedings for the repeal of interfering patents are governed by Section 4918.² According to this section any person interested in one of two or more interfering patents,³ or in the practice of the invention which it claims, may bring a bill in equity against the owners of the adverse patent, praying for relief against the interfering patentee or any party holding under him.⁴ Upon due notice

§ 723. ¹ See §§ 571, 604, and notes, *ante*.

² Rev. Stat. Sec. 4918: "Whenever there are interfering patents any person interested in any one of them, or in the working of the invention claimed under either of them may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either of the patents void in whole or in part, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the right of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment."

³ That Sec. 4918, Rev. Stat., relates only to interfering patents for the same invention, when the plaintiff claims to be the original inventor, see *Celluloid Mfg. Co. v. Goodyear Dental Vulcanite Co.* (1876), 10 O. G. 41; 13 Blatch. 375.

That two patents for distinct articles do not interfere under Sec. 4918, though one is an improvement on the other, see *Pontlarge v. N. Y. Bung & Bushing Co.* (1884), 28 O. G. 370; 20 Fed. Rep. 314.

That two patents interfere under Sec. 16, act of 1836, only when they claim in whole or in part the same invention, as under Secs. 8 and 12, see *Gold & Silver Ore Separating Co. v. United States Disintegrating Ore Co.* (1869), 3 Fisher, 489; 6 Blatch. 307.

That no action lies by a junior patentee to obtain a decision that his patent does not conflict with a prior one, see *Celluloid Mfg. Co. v. Goodyear Dental Vulcanite Co.* (1876), 10 O. G. 41; 13 Blatch. 375.

That patents can be adjudged void only under Sec. 16, act of 1836, and Sec. 10, act of 1839, and then only when two patents interfere or when a patent is refused by the Commissioner or a justice of the Supreme Court of the District of Columbia on appeal, see *Merserole v. Union Paper Collar Co.* (1869), 3 Fisher, 483; 6 Blatch. 356.

⁴ That an assignee before the patent, if his assignment was duly recorded, may sue one to whom the patent issued

to the adverse parties, and after such proceedings according to the usual course of equity as the nature of the controversy requires the court may declare either of the patents void in whole or in part, or inoperative or invalid in any particular portion of the United States, according to the interest of the parties in the patent or the invention patented.⁵ This judgment binds only the parties to the suit and those deriving title under them after such judgment has been rendered.⁶

§ 724. Nature and Effect of the Proceedings for a Repeal in the Interest of Prior Inventors.

The power conferred by this section upon the prior inventor and those claiming under him is broad enough to meet all

after its denial to his assignor, and have the patent annulled and a new one granted to him, see *Gay v. Cornell* (1849), 1 Blatch. 506.

That equity will not entertain a bill to vacate an extension after the extension has expired, but will dismiss it on demurrer, see *Bourne v. Goodyear* (1869), 9 Wall. 811.

⁵ That a proceeding under Sec. 4918, Rev. Stat., is a chancery proceeding and is regulated by chancery practice, as also under Sec. 739, see *Liggett & Myers Tobacco Co. v. Miller* (1880), 5 Bann. & A. 237; 1 McCrary, 31; 17 O. G. 798; 1 Fed. Rep. 203.

That a bill to annul a patent must be brought in the district where the defendant resides or is found, see *Prentiss v. Ellsworth* (1846), 27 O. G. 623.

That in a suit for repeal under Sec. 4918, Rev. Stat., no provision exists for notice to parties outside the district in which the suit is brought, see *Liggett & Myers Tobacco Co. v. Miller* (1880), 1 Fed. Rep. 203; 17 O. G. 798; 1 McCrary, 31; 5 Bann. & A. 237.

That in a suit for repeal under Sec. 4918, Rev. Stat., the defendant is not compelled to file a cross-bill in order to obtain affirmative relief, and if he does

so it may be dismissed without costs, see *American Clay Bird Co. v. Ligowski Clay Pigeon Co.* (1887), 31 Fed. Rep. 466; *Lockwood v. Cleveland* (1881), 6 Fed. Rep. 721.

That in a suit to annul an interfering patent the court may defeat the defendant's patent, although the plaintiff's patent is void, being anticipated by his own prior patents, see *American Clay Bird Co. v. Ligowski Clay Pigeon Co.* (1887), 31 Fed. Rep. 466.

That a delay of five years in instituting proceedings to annul a patent tends to show a want of good faith in the petitioner, see *Sawyer v. Massey* (1885), 25 Fed. Rep. 144.

That on a bill to repeal a patent in the Federal Courts, the preliminary statement as to the date of the invention on an interference in the Patent Office does not bind the assignees of the inventor, see *Union Paper Bag Mach. Co. v. Crane* (1874), Holmes, 429; 6 O. G. 801; 1 Bann. & A. 494.

⁶ That the judgment on a bill to annul an interfering patent binds only the parties to the suit and their subsequent assignees, see *Mowry v. Whitney* (1871), 14 Wall. 434; 1 O. G. 499; 5 Fisher, 513.

conceivable emergencies.¹ Whenever the rights of one person are derived from the lawful patent of the first inventor, and are in any manner limited or violated by another person under cover of the unlawful patent of a subsequent inventor, redress commensurate with the injury may be obtained and the unlawful patent declared void so far as it affects the antagonistic interests of the contending parties.² The judgment of repeal may embrace the whole patent, as in cases where its entire patentable subject-matter was first produced by the inventive genius of the adverse claimant, or may include only the particular inventions which are covered by the rival patent and are found by the court to have been first invented by the rival patentee. Both patents are equally before the court for judgment and either may be repealed, so far as the contending parties are concerned, to any extent which may be necessary in order to secure to the party claiming under the prior inventor of each art or instrument the unqualified enjoyment of the monopoly to which he is entitled.³ In this proceeding the

§ 724. ¹ That in proceedings to annul under Sec. 4918, the courts are not bound by the decisions of the Patent Office, see *Holliday v. Pickhardt* (1887), 24 Blatch. 201; 29 Fed. Rep. 853; *Minneapolis Harvester Works v. McCormick Harvesting Mach. Co.* (1886), 28 Fed. Rep. 565; 37 O. G. 566; *Hubel v. Tucker* (1885), 23 Blatch. 297; 24 Fed. Rep. 701.

² That under Sec. 58, act of 1870, the court may order the defeated patent to be delivered to the clerk and cancelled by him, and sent to the Secretary of the Interior with a copy of the decree, see *Sturges v. Van Hagen* (1873), 6 Fisher, 572; 4 O. G. 579.

That where the court annuls a patent it may enjoin the patentee from instituting actions thereon, see *Sawyer v. Massey* (1885), 25 Fed. Rep. 144.

That a junior patentee cannot be enjoined from suing under his patent on the motion of the prior patentee, pending a suit by the prior patentee to cancel the junior patent, when the

junior patent was granted after a full hearing in the Patent Office, on an interference with the prior patentee, see *Asbestos Felting Co. v. Salamander Felting Co.* (1876), 10 O. G. 828; 13 Blatch. 453.

³ That Sec. 4918, Rev. Stat., allows the court to declare either or both patents void, in whole or in part, see *Foster v. Lindsay* (1875), 8 O. G. 1032; 3 Dillon, 126; 2 Bann. & A. 172; *Foster v. Lindsay* (1874), 7 O. G. 514; 1 Bann. & A. 605.

That on a bill to annul, the court can declare either patent void, but not both, see *American Clay Bird Co. v. Ligowski Clay Pigeon Co.* (1887), 31 Fed. Rep. 466.

That on a petition to annul, if it appears that one patentee abandoned his experiments, and after the issue of a patent to his rival renewed them and patented the invention, the rival patent will be sustained, see *Hutchinson v. Everett* (1885), 35 O. G. 1110; 26 Fed. Rep. 531.

patentability of the inventions described and claimed in the antagonistic patents is not in issue. Priority of invention is the only point in controversy, and judgment, therefore, is awarded to the party who derives his title from the first inventor.⁴

SECTION II.

OF THE REPEAL OF PATENTS IN THE INTEREST OF THE PUBLIC.

§ 725. Proceedings for a Repeal in the Interest of the Public Rest upon Fundamental Principles of Sovereignty, not on mere Legislative Acts.

Whether the public, as a collective body, can institute proceedings for the repeal of letters-patent, under the present provisions of our law, has been a matter of dispute. Adhering to the theory that such proceedings can be authorized only by express acts of legislation, some courts have held that in the absence of a statute conferring this power on the people it did not exist. In obedience to this doctrine it has been

⁴ That the only issues on a petition to annul an interfering patent are interference and priority, see *Sawyer v. Massey* (1885), 25 Fed. Rep. 144; *Pentlarge v. Pentlarge* (1884), 22 Blatch. 10; 19 Fed. Rep. 817; *contra*, *Foster v. Lindsay* (1875), 8 O. G. 1032; 2 Bann. & A. 172; 3 Dillon, 126; *Foster v. Lindsay* (1874), 7 O. G. 514; 1 Bann. & A. 605.

That on a petition to annul an interfering patent, under Sec. 4918, the defendant cannot set up by plea as a defence, if holding under a later patent, that the invention was in use before the plaintiff's inventive act, see *Pentlarge v. Pentlarge* (1884), 22 Blatch. 10; 19 Fed. Rep. 817.

That on proceedings for repeal under Sec. 4918, Rev. Stat., a plea that the plaintiff's patent is void for want of novelty is improper, see *Pentlarge v.*

Pentlarge (1884), 22 Fed. Rep. 412; 22 Blatch. 120.

That when on a suit to repeal under Sec. 4918, Rev. Stat., the defendant pleads that the plaintiff's patent is void for want of novelty, and this plea is overruled as improper, and the plea is amended, the defendant cannot set up the same matter in his answer, it being *res adjudicata* in that case, see *Pentlarge v. Pentlarge* (1884), 22 Blatch. 120; 22 Fed. Rep. 412.

That where, after an interference judgment, patents are granted to both parties, and the party to whom priority was adjudged institutes proceedings to annul the other patent, the latter patentee is not estopped to deny that the invention was new and patentable, see *Holliday v. Pickhardt* (1887), 29 Fed. Rep. 853; 24 Blatch. 201.

decided, in two cases of considerable prominence, that the acts of 1790 and 1793 bestowed this privilege upon the public; that the act of 1836, while enlarging the defences permitted to infringers, withdrew the public privilege of a repeal; and that as subsequent statutes have not revived it, no such privilege now exists.¹ But in the light of principle, as well

§ 726. ¹ In *Attorney-General v. Rumford Chemical Works* (1876), 9 O. G. 1062, Shepley, J. : (1066), "This leads us to the consideration of the protection afforded by the provisions of the patent acts to the rights of the general public, and to the history of the legislation upon that branch of the subject. The fifth section of the act of 1790, the first act of Congress in relation to this subject (1 Stat. at Large, 111), provided a form and mode of proceeding to repeal a patent 'obtained surreptitiously, by or upon false suggestion,' upon complaint made under oath before the judge of the district court where the defendant resided, and motion within a year after the issuing of the patent, but not afterward. The patent issued under this act without any oath of the applicant and any previous examination, and want of novelty and originality are not included in the list of defences authorized by the sixth section. The act of 1793 extended the time of limitation for commencing proceedings to repeal the patent to three years, and enlarged the defences in actions for infringement, opening the defence for want of novelty and originality. These provisions clearly show that it was deemed necessary that authority for proceedings to repeal letters-patent should be conferred by statute. . . . (1067) These acts of 1790 and 1793, including these provisions conferring jurisdiction upon the Federal courts over proceedings for the repeal of letters-patent, were repealed by the act of 1836. That act was substantially re-enacted and codified by the act of 1870, and in the Revised Statutes of

1874. The act of 1836 contained no provision authorizing any proceeding to repeal letters-patent upon the ground that they were obtained 'surreptitiously, by or upon false suggestion,' but the sixteenth section provided a remedy in the case of conflicting patents, and for a repeal of the one which the court should adjudge had been improvidently issued. This takes the place of the remedy to which, in case of conflicting grants, the subject is entitled as matter of right in England. For the protection of the general public, in place of the provision for a proceeding in the nature of a *scire facias* to repeal the patent, to be instituted within three years, as provided in the act of 1793, it sought to provide safeguards against the issue of letters-patent upon false suggestion, and ample security against any injury to the citizen, to whom it opened every possible defence against injury resulting from any mistake or oversight of the Commissioner in issuing the patent. In fact, every defence against a patent that can well be imagined was left open to the citizen whose interests were affected by it, excepting only the one which, in *Whitney v. Mowry*, the Supreme Court decided was not open, -- the question of fraud upon the government in obtaining the grant. To guard against such a fraud it provided for the examination by the Examiner and for a Commissioner and the subsequent proceedings hereinbefore stated, it being made the duty of the Examiner and the Commissioner to protect the rights of the public. The jurisdiction conferred by acts of 1790

as of the recent decisions of the Supreme Court, this position cannot be maintained. The right of the public to withdraw

and 1793 upon the Federal courts to repeal a patent, and which, without express grant, it is believed did not inhere in those courts, is nowhere conferred by the acts of 1836 or 1870, or in the Revised Statutes of 1874. It would seem to be a great stretch of power and assumption of jurisdiction for one circuit court, in the absence of any such express authority conferred by act of Congress, to repeal and vacate a patent which may have been originally granted upon the decree of another circuit court, upon appeal from the Commissioner, and adjudged valid, perhaps, in litigation respecting it in still another circuit court in another circuit. The better opinion upon this brief and imperfect review of the legislation of Congress upon this subject would seem to be that Congress had deliberately transferred the jurisdiction over the question of the protection of the rights of the general public to the *quasi* judicial decision of the Examiner and the Commissioner, or the actual judicial decision of the Federal courts upon appeal from the Commissioner, and fully protected the rights of the individuals against whom patents might be sought to be enforced, by opening to them every defence essential to the preservation of their rights and the protection of their interests. The decisions in the Federal courts sustaining proceedings in equity to vacate letters-patent granting lands obtained by fraud, furnish no precedent in case of letters-patent for inventions. The United States, as an owner of lands, has equal rights and is entitled to equal remedies with an individual owner. In granting lands the United States conveys that in which it has the fee. In issuing letters-patent for inventions, nothing is granted which belonged before to the United States. The issue

of the letters-patent is in compliance with an act of Congress. The rights and remedies of the parties are dependent solely on the statute enactments, and do not grow out of any previous ownership of the supposed subject of the grant, as in the case of a conveyance of lands." 32 Fed. Rep. 608(621).

In *United States v. American Bell Telephone Co.* (1887), 41 O. G. 123; 32 Fed. Rep. 591, the same position is maintained. This case involved one of the most important patents ever issued in this country, and was exhaustively argued on both sides by several of the foremost members of the American Patent Law Bar. In rendering its judgment the court reviewed the history of legislation and judicial decision on this question, and arrived at conclusions which may be summed up as follows:

1. That all rights and remedies of patentees arise out of the Constitution and the acts of Congress, and where these are silent no right or remedy exists.

2. That the power to cancel a patent is not embraced among general equity powers, as in England, — the patent being there a royal grant, but here resting wholly on statute.

3. That a bill to cancel a patent cannot be maintained in the name of the United States in the absence of an express statute to that effect.

4. That the power to cancel a land patent does not extend to patents for inventions, since the government grants the land but not the invention.

5. That under the acts of 1790 and 1793 a patent could be cancelled on *scire facias* if surreptitiously obtained, but under later acts this is a ground of defence in infringement suits, and there only.

Of these conclusions the first and

from the grantee a grant improperly secured rests upon foundations deeper than the current enactments of the legislative

fourth seem to contain the fundamental propositions out of which the others are deduced, and the value of the decision as an authority thus depends on the truth of these premises and the soundness of the logical processes by which the others are inferred from them.

Firstly, then, is it true that all the rights and remedies of patentees arise out of the Constitution and the acts of Congress, and that where these are silent no right or remedy exists? The power to grant a monopoly in an invention was an attribute of sovereignty at common law, and was recognized as such by the courts of common law in the very heat of the contest against odious monopolies. (See § 9 and notes, *ante*.) It was claimed and exercised by the several States as an attribute of their common-law sovereignty, not only before but after the adoption of the Federal Constitution. (See § 45 and notes, *ante*.) The rights created by the grant of such a monopoly were defined and enforced, both in England and in our several States, according to the common principles and methods of law and equity, — in most cases without any statute to declare the right or to prescribe the remedy. When the Federal Constitution was framed it was optional with the people of the United States either to bestow this among other attributes of sovereignty upon the national government or to retain it within the sole possession of the individual States. They chose the former policy, and conferred upon the United States the same power to create monopolies in favor of inventors, throughout the entire country, that was already exercised by the several States within their respective areas, and that had been immemorially known to and sanctioned by the common law. In this provision of

the Constitution they adopted the very words and phrases of the English law, defined the monopoly in terms of established meaning, and evidently contemplated the reproduction on this side the Atlantic of the system which had proved its value in the mother country. Under this clause of the Constitution Congress immediately passed the act of 1790, which is evidently little more than the formulation of the doctrines announced in previous decisions of the British common-law courts, and whose interpretation would have been impossible without constant recourse to the sources from which it was drawn. All later acts of Congress are mere developments and modifications of this earlier act, and bear a similar relation to the common law. Historically, therefore, the rights and remedies of patentees arise, not from the statutes, but from the common law, and though the common law has been to some extent declared and amplified by statutes, it cannot be assumed either that all the rights of patentees have been expressly named in these enactments, or that no remedies exist except those which are there particularly prescribed.

In practical jurisprudence the same fact appears. The earlier cases decided under our acts of Congress were adjudicated with constant reference to the decisions of the English courts. Equity asserted jurisdiction and applied its remedies unhesitatingly before the act of 1819, and when no chancery relief was given by statute. All questions as to the nature and scope of the monopoly, as to the forms of infringement, as to the course of pleading, mode of trial, and (except under the acts of 1790 and 1793) as to the measure of compensation in both tribunals, were settled by well-known law or equity

department of the government. It is a right inherent in the sovereign *jure regio*, and by the common law and in the his-

rules and independently of any express legislation. Whatever injury the patentee may sustain other than by the infringement of his patent, as by the slander of his title, the fraudulent discovery and appropriation of his secret pending his efforts to procure a patent, etc., must be redressed, if at all, according to the ordinary legal or equitable methods without the aid of statutes. The course of applied justice thus contradicts the proposition that all these rights and remedies rest on the Constitution and the acts of Congress, and that no right or remedy exists except as they bestow it.

It is doubtless true that if the Federal Constitution had not contained the clause referred to, or its equivalent, the United States would have received no power to create a monopoly in favor of the inventor. It is also true that if Congress had never passed an act to carry this clause into effect, no patents ever could have been granted by the Federal Government. But it does not thence follow that when Congress has legislated on the subject and established a patent-system clothed with the authority to issue patents for inventions, all rights under such patents and all remedies for their violation must be found declared and specified in the statutes by which this authority is conferred. As in every other instance where express legislation relates to subject-matter already known to the common law, the statute does not exclude what it does not mention or impliedly repeal, but both the written and unwritten law must be construed together and taken as the measure of the rights and remedies with which they deal.

But were it conceded that all the rights and remedies of patentees arise out of the Constitution and the acts of Con-

gress, what inference can from this be drawn that the United States is without remedy against a fraudulent monopoly? Either the patentee has a right to retain a patent which he has procured by fraud, or the government which has been deceived, acting for the public which has been defrauded, has the right to cancel it. It will hardly be pretended that the written law confers such right upon the patentee, and thence according to the line of argument adopted by the court, the right to a repeal is vested in the United States. But neither the common law nor the principles of equity jurisprudence afford an apology for such a claim on behalf of the fraudulent patentee; on the contrary, in both tribunals the power of the government to interfere at once and restore to the public the privileges of which they have been unjustly deprived has constantly been recognized as a part of that same attribute of sovereignty by whose exercise the monopoly has been created. If the United States has not this power it is because the Federal Constitution, in conferring upon the national government the authority to create monopolies, divorced from this authority its necessary correlate, — the authority to rescind unlawful monopolies, — leaving the latter in the States as part of their reserved sovereignty, or extinguishing it altogether, — either of which positions is absurd, though scarcely more so than the claim that such a defect of sovereignty can be removed by any act of Congress.

Not to pursue this criticism further, can there be any serious doubt that the United States has power to repeal unlawful patents, irrespective of any special provision of the Constitution to that effect, or any act of Congress conferring that authority, but solely as a part of

tory of English jurisprudence has always been recognized as embraced in the prerogative by which the grant itself is au-

its sovereignty over the subject-matter of monopolies for inventions as delegated to it by the express language of the Constitution? And if this be not doubted what answer shall be given to the further question, — whether, possessing this power, the Federal government can exercise it for the protection of the public interests in the ordinary modes known to the law from which ours is derived or must await the designation by some act of Congress of a proceeding in which its repealing power could be applied?

It will divest this question of some of its obscurity if we remove from the discussion certain matters which have had great weight with the courts in the two cases now under review, but which have really no bearing whatever on the principle involved. In the acts of 1790 and 1793 provisions for the repeal, by *scire facias*, of patents issued upon false suggestion, were inserted which by later statutes were impliedly annulled, and now have no place in our written Patent Law. Assuming that these provisions were intended by Congress to afford the government a method for rescinding unlawful patents in the interest of the public, their repeal and the failure to provide such methods in the recent statutes has been accepted as a powerful argument in favor of the view that under present laws the government is left without a remedy. This is, in fact, the substance of the reasoning in the first case cited, which is closely followed in the second. But the slightest examination of these provisions will disclose that the remedy afforded by them was a private not a public remedy. The proceeding was to be instituted by a private person who was to be liable for the costs if his effort failed. It was to have been brought

within a limited time after the patent issued, and was particularly designed to afford relief in cases where the patentee was not the first and true inventor of the matter covered by his patent. The awarding of the remedy was entirely at the discretion of the court. The United States could not be made a party to the suit, either originally or by substitution, and was held by the courts to be entirely without interest in the controversy, except as the public may always benefit by a decision that a patent is invalid. (See *Wood v. Williams* (1834), *Gilpin*, 517; *1 Robb*, 717.) Now what possible connection can there be, either in law or logic, between this grant of a private remedy, or the substitution for it of other private remedies under later statutes, and the power of the United States, in its sovereign capacity, to interfere for the rescission of a monopoly unlawfully obtained? As it could not avail itself of this provision, the passage of the statute affords no indication that an act of Congress was necessary to enable it to exercise its power. As the repeal of this provision could not deprive it of any remedy, such repeal is no proof that its remedies do not exist. The arguments derived from these provisions are thus aside from the whole question at issue, leaving it to be determined upon independent grounds of fact and principle.

Stripped of this veil of fallacy the exact question may be stated thus: Either the United States has never had a remedy by means of which it might recall a patent fraudulently obtained; or it has always had and still retains the remedies known to equity and the common law. Each of these alternatives excludes the other, and one or the other of them must be true. Applying to this question the test of fundamental

thorized. Still more essential is it to our own patent system, where the issue of a patent creates a contract between the

principle we then inquire whether a sovereignty, in the exercise of sovereign authority, can ever confer upon an individual a privilege which curtails its own freedom of action and invades the common rights of all its subjects, beyond its own power to revoke the privilege when it discovers that the grant has been obtained by fraud. If so, the nation is more helpless than any private citizen. Through its ignorant or unfaithful servants it may commit itself to the most foolish or injurious measures without the ability to retrace its steps or to correct its errors. Such a condition of affairs is not contemplated by any theory of political society, or any system of civilized jurisprudence. The power to create necessarily embraces the power to destroy, and if modes are provided in which creative power may be exerted, and none for the administration of destructive energy, the latter must be exercised, when needed, in any manner which may have before been known to and sanctioned by the customary law. That this is true whenever the government has been defrauded into a grant of public property, has never been disputed. That it applies equally whenever public right has been unlawfully restrained, follows from the same principles of justice and the inherent nature of the sovereign power.

To avoid this conclusion, the court, in the case now considered, adopts the *dictum* of the earlier judge, that in the issue of letters-patent for an invention nothing is granted which before belonged to the United States, and therefore, although fraudulent, the patent cannot, like a land grant, be recalled. This is the fourth of our formulated propositions, and in it resides whatever real force the arguments on this side of the controversy possess.

That the government never owned

and does not grant the *invention* to the patentee may be at once conceded, but this concession by no means disposes of the point in question. In a land grant the government transfers to private owners the property which it held, not as its own, but in trust for the whole people. By that transfer it decreases the entire amount of public property, and restricts its own power of dominion and conveyance over the land conferred. Thus when such a grant is obtained through fraud, the government and the public both sustain an injury, which known equitable and legal remedies are sufficient to redress. On the other hand, when the government grants a simple franchise it transfers no public property nor does it limit its own rights in any manner or degree. Other franchises of similar character may be indefinitely bestowed, and however numerous they may be, the privileges of the people at large are not affected. In such cases, as there is no injury, even where fraud is practised in procuring the grant, there is no occasion for a remedy, unless, in view of public policy, the government sees fit to inflict upon the fraudulent grantees the penalty of forfeiture. The positions taken by our courts in reference both to land grants and to franchises are, therefore, sound in principle and recognize the government as supplied with all the remedies it can require.

The judges, in the two cases now examined, repudiate all similarity between a patent for an invention and a land grant, and identify it with a franchise both in nature and effect. This is obviously an error. The issue of a patent does not confer a simple franchise; it creates a monopoly. Although the government and the public do not own the invention, they do possess rights in reference to it of the most important

inventor and the public which like all other contracts may

character, which are suspended or relinquished by the grant of letters-patent. The government has the right to bestow upon the first and true inventor of that invention an absolute and undisputed monopoly, free from all doubts as to his title, and this right is relinquished by the actual issue of a patent to any patentee. The public, whom the government represents, have an unquestioned natural right to use the invention freely upon its voluntary publication by the inventor, and to invent and use the art or article for themselves in case he does not see fit to disclose it. This right is immediately suspended by the issue of a patent, and cannot be regained until the patent has expired or been repealed. Both of these rights are of the highest value to the nation, and their invasion by fraudulently obtaining the issue of a patent is an injury equal in enormity and in disaster to the public to that which any fraudulent land grant could occasion. No better illustration of this statement can be needed than the patent whose repeal was sought in the case at bar, — a patent which if fraudulently procured has not only deprived the government of the power to confer a merited monopoly on an illustrious and successful inventor, but has been made an engine of oppression on the public from one end of the country to the other. If this question is to be determined by analogy it is thus evident that the doctrine applied to land grants, and not that to franchises, must furnish us with the desired solution. Though the correspondence in subject-matter is not exact, the rights involved are of the same general character and vest in the same persons, while the wrongs committed by the fraud affect interests of equal importance, and demand as summary relief.

In *United States v. American Bell Telephone Co.* (1888); 128 U. S. 315;

45 O. G. 1311, the principles asserted in this criticism of the two cases before mentioned have just been adopted, in substance, by the Supreme Court of the United States as the grounds of its reversal of the decision in *United States v. American Bell Telephone Co.*, and its consequent rejection of *Atty. Gen. v. Rumford Chemical Works* as a reliable authority upon the point in question. Mr. Justice Miller there presents these considerations in a different arrangement from that here pursued, but reaches his results by the same general methods, unqualifiedly asserting the right of the United States to proceed in equity for the repeal of patents fraudulently obtained, although no statutory power or remedy to that effect has been conferred upon them.

In *United States v. Gunning* (1883), 21 Blatch. 516, Wallace, J.: (517) "Notwithstanding the expression of opinion by Judge Shepley, in *Attorney General v. Rumford Chemical Works* (2 Banning & Arden, 298), in favor of the defendants' position, it is believed there is no sound reason why a bill will not lie in such a case, as well as where the subject of the grant is land or is a franchise or right of a different kind. The learned judge laid much stress upon the consideration that, in issuing letters-patent for inventions, nothing is granted which belonged before to the United States, and that the rights and remedies of the parties to such grants are dependent solely on the statute enactments, and do not grow out of any previous ownership of the subject of the grant; and it was his view that in such a case, express authority for proceedings to annul the grant must be conferred, in order to sanction them. The same reasoning would preclude a State from proceedings to annul the charter of a corporation created by its Legislature, if obtained through fraud. Yet it is a

be rescinded for non-performance of conditions precedent, or avoided when originally obtained by fraud.

§ 726. Patents Repealable at Common Law in the Interest of the Public in Three Classes of Cases.

At common law a grant by the sovereign was revocable in three classes of cases: (1) Where the same subject-matter had been previously granted; (2) Where the grant had been procured by fraud; (3) Where the subject-matter of the grant could not legally be granted.¹ Under our law the first

familiar principle that grants of corporate franchises, obtained through fraud practised upon the Legislature, are void when the State elects to set them aside by a judicial rescission. (Morawetz, Corp. § 148.) He also refers to the provisions of the Patent Acts of 1790 and 1793, which authorized proceedings for the repeal of patents obtained surreptitiously or by false suggestion, as indicating that Congress deemed it necessary that authority for proceedings to repeal letters-patent obtained through fraud should be conferred by statute. These provisions, however, permitted such proceedings to be taken by any person who chose to complain, — a right which did not and does not exist unless expressly conferred. A bill in equity lies to set aside letters-patent obtained by fraud, but only between the sovereignty making the grant and the grantee. (Field v. Seabury, 19 How. 323.) No inference can be justly drawn, therefore, from these provisions, that Congress deemed it requisite to confer express authority upon the United States to maintain such a suit, nor, from the absence of such provisions in the existing laws, that Congress intended to withhold such authority." 26 O. G. 356 (356), 18 Fed. Rep. 511 (512).

In *Mowry v. Whitney* (1871), 14 Wall. 434, Miller, J.: (440) "The 16th section of the Patent Act of 1836 seems to have in view the same distinc-

tion made by the common law in regard to annulling patents, for while it authorizes individuals claiming under conflicting patents, or one whose claim to a patent has been rejected because his invention was covered by a patent already issued, to try the conflicting claim in chancery, and authorizes the court to annul or set aside a patent so far as may be found necessary to protect the right, the suit by individuals is limited to that class of cases. And it is provided that the decree shall be of no validity except between the parties to the suit. The general public is left to the protection of the government and its officers." 1 O. G. 499 (500); 5 Fisher, 513 (515).

§ 726. ¹ In *Mowry v. Whitney* (1871), 14 Wall. 434, Miller, J.: (439) "The ancient mode of doing this in the English courts was by *scire facias*, and three classes of cases are laid down in which this may be done: (1) When the king by his letters-patent has by different patents granted the same thing to several persons, the first patentee shall have a *scire facias* to repeal the second; (2) When the king has granted a thing by false suggestion, he may by *scire facias* repeal his own grant; (3) When he has granted that which by law he cannot grant, he, *jure regis*, and for the advancement of justice and right, may have a *scire facias* to repeal his own letters-patent. . . . It will be observed that in the case of a conflict

class has been modified in character and provided with a special remedy. The common law conclusively presumed the first patent to be valid as against all patents subsequently granted, and thus repealed only the later patent in favor of the former. Our law recognizes no conclusive presumption in the interest of either the prior or the later patent, but sustains the one granted to the first and true inventor and repeals all others. The method by which this is accomplished, without invoking the aid of the public, was discussed in the last section.

§ 727. Proceedings for a Repeal in the Interest of the Public Necessary when the Patent was Obtained by Fraud.

The second class of cases directly involves the interests of the whole people and can be remedied only by governmental interference. A patent procured by fraud not only confers no just rights on the patentee, but as long as it exists it constitutes an unwarrantable limitation on the sovereign power. So far as it affects the interests of individual citizens it is also an act of oppression, in aid of which the sanction of the government has been unlawfully obtained. But no ability to secure himself against its operation resides in any individual. It is a grant within the jurisdiction of the grantor, and therefore cannot be collaterally attacked. Nor is the injury sustained by individuals from the fraud and falsehood of the patentee so distinct from that inflicted on the general public that any private action can be instituted to redress it.¹

under two patents granting the same rights, the *scire facias* may, according to the authorities cited, be brought in the name of one of the patentees; but in the other cases, when the patent was obtained by a fraud upon the king, by false suggestion, or where it was issued without authority, and for the good of the public and right and justice it should be repealed, the writ is to issue in the king's name or his attorney-general's. It is also said that when a patent is granted to the prejudice of the subject, the king of right is to permit

him upon his petition to use his name for the repeal of it, in *scire facias* at the king's suit." 1 O. G. 499 (500); 5 Fisher, 513 (514).

§ 727. ¹ In *Mowry v. Whitney* (1871), 14 Wall. 434, Miller, J.: (441) "The reasons for requiring official authority for such a proceeding are obvious: (1) The fraud, if one exists, has been practised on the government, and as the party injured, it is the appropriate party to assert the remedy or seek relief. (2) A suit by an individual could only be conclusive in result

Hence, as such frauds upon the Patent Office cannot be prevented, and as in the inevitable course of things patents from time to time are granted upon false suggestions or upon concealments which amount to fraud, the revocation of such patents is a duty which the public owes to itself both as a sovereign and as a community of individuals.

§ 728. Proceedings for a Repeal in the Interest of the Public sometimes Necessary where the Subject-matter of the Patent cannot Lawfully be Patented.

How far and when the government is called upon to interfere in cases of the third class is a question of more difficulty. The grant of a subject-matter which is by law incapable of being granted carries upon its face the evidence of its own invalidity. The power of the sovereign is not limited by it even in appearance, nor is the subject estopped from denying its efficiency in a collateral proceeding. Thus while the authority of the government to revoke the grant cannot be doubted, the cases in which this becomes necessary in the interest of the public or for individual protection are comparatively rare. Under our patent system the security af-

as between the patentee and the party suing, and it would remain a valid instrument as to all others. (3) The patentee would or might be subjected to innumerable vexatious suits to set aside his patent, since a decree in his favor in one suit would be no bar to a suit by another party. If, on the other hand, an individual finds himself injured, either specially or as a part of the general public, it is no hardship to require him to satisfy the attorney-general that the case is one in which the government ought to interfere, either directly by instituting the suit, or indirectly by authorizing the use of its name, by which the attorney-general would retain such control of the matter as would enable him to prevent oppression and abuse in the exercise of the right to prosecute such a suit. It would seriously impair the value of the title

which the government grants after regular proceedings before officers appointed for the purpose, if the validity of the instrument by which the grant is made, can be impeached by any one whose interest may be affected by it, and would tend to discredit the authority of the government in such matters." 1 O. G. 499 (500); 5 Fisher, 513 (516). See also § 715 and notes, *ante*.

That the unintentional issue of a patent cannot be set up except in a direct proceeding to vacate the patent, see *Doughty v. West* (1869), 3 Fisher, 580; 6 Blatch. 429.

That the United States cannot sue to repeal a patent on grounds that have been urged against the patent in an infringement suit when the patent was sustained, see *United States v. Colgate* (1884), 32 Fed. Rep. 624.

forded against unlawful patents of this character by the proceedings in the Patent Office, and by the defences permitted to alleged infringers, is usually sufficient, and in such cases the government will not interfere. But where the invalidity of a patent has been established by repeated decisions of the courts, and it is being used as a mere instrument of oppression against citizens who, though aware of its true character, cannot avoid incurring trouble and expense in their defence against it, the public cannot justly refuse to withdraw the appearance of authority, under which the wrong is perpetrated, by the immediate and final revocation of the patent.

§ 729. Proceedings for a Repeal in the Interest of the Public are by Bill in Equity in the Name of the United States.

The proceeding for the repeal of an unlawful patent of the second or third classes is by a bill in chancery in the name of the government or its Attorney-General.¹ Such proceedings are instituted with great caution. The Attorney-General

§ 729. ¹ In *Mowry v. Whitney* (1871), 14 Wall. 434, Miller, J.: (440) "The *scire facias* to repeal a patent was brought in chancery where the patent was of record. And though in this country the writ of *scire facias* is not in use as a chancery proceeding, the nature of the chancery jurisdiction and its mode of proceeding have established it as the appropriate tribunal for the annulling of a grant or patent from the government. This is settled so far as this court is concerned by the case of *the United States v. Stone*, in which it is said that the bill in chancery is found a more convenient remedy. A bill of this character was also sustained in the English chancery in the case of *The Attorney-General v. Vernon*, on the ground of the equitable jurisdiction in matters of fraud. And in the case of *Jackson v. Lawton*, Chancellor Kent says that in addition to the writ of *scire facias* which has ceased to be applicable with us, there is another remedy, by bill

in the equity side of the court of chancery." 1 O. G. 499 (500); 5 Fisher, 513 (515).

That proceedings to repeal a patent under the act of 1793 were in the nature of a *scire facias*, see *Ex parte Wood* (1824), 9 Wheat. 603; 1 Robb, 438; *Stearns v. Barrett* (1816), 1 Mason, 153; 1 Robb, 97.

That only the attorney-general, in the name of the United States can sue to limit or repeal a patent, see *Celluloid Mfg. Co. v. Goodyear Dental Vulcanite Co.* (1876), 10 O. G. 41; 13 Blatch. 375; *United States v. Doughty* (1870), 7 Blatch. 424.

That the power of the attorney-general to sue for a repeal gives no power to a defendant in an infringement suit to bring the matter before the courts, see *New York and Baltimore Coffee Polishing Co. v. New York Coffee Polishing Co.* (1881), 20 Blatch. 174; 9 Fed. Rep. 578.

must be satisfied that sufficient grounds exist for submitting the question to the courts, and if he is in doubt he may be guided by the opinion of the Commissioner.³ In cases where the patent is alleged to have been fraudulently obtained he may act at the instigation of a private party, but not in cases where the matter urged as the reason for refusal could be employed by the relator in his own defence against the patent.³ In whosoever interest and for whatever purpose the proceedings are commenced, they remain always under his control, and can be prosecuted or discontinued by him as his judgment of the merits of the controversy may require.⁴

§ 730. Procedure and Judgment upon a Bill for Repeal.

Upon this bill in equity the process, pleadings, hearing, and decrees follow the usual course of chancery proceedings.¹ All persons to be affected by the repeal of the patent must be made parties, and the grounds of the repeal must be established beyond reasonable doubt. The effect of a judgment in favor of the public is to extinguish the patent and all rights accruing under it, even in the hands of an innocent *bona fide* purchaser; and the owners of the patent must thereupon sur-

³ That the name of the United States should be used in a bill for repeal only when the Commissioner is satisfied that the patent should be repealed, or the courts have doubted the validity of the patent, or the patent was fraudulently obtained, see Opinion Atty. Gen. (1874), 6 O. G. 723.

⁸ That a bill to repeal a patent on the ground of a false oath will not lie in the name of the United States in the interest of private parties, though they file a bond indemnifying the United States, if the same matters could be set up in their defence when sued, see *United States v. Frazer* (1884), 22 Fed. Rep. 106.

⁴ That suits to annul patents are wholly within the control of the United

States attorney, and there is no obligation resting on him to institute or proceed with them, see *New York and Baltimore Coffee Polishing Co. v. New York Coffee Polishing Co.* (1881), 9 Fed. Rep. 578; 20 Blatch. 174.

§ 730. ¹ That pending a suit on behalf of the United States for the repeal of a patent, an injunction to restrain or suspend actions for infringement will not be granted, the United States having no interest in such actions, see *United States v. Colgate* (1884), 22 Blatch. 412; 21 Fed. Rep. 318.

That the institution of a suit to repeal a patent raises no presumption of its invalidity, see *American Bell Telephone Co. v. National Improved Telephone Co.* (1886), 27 Fed. Rep. 663.

render it to the Patent Office that it may be duly cancelled.² Costs may be decreed against any owners of the patent whose false suggestions led to its original issue, but not against an owner who was not a party to the fraud.

² That a patent will be repealed on account of the fraud of the patentee, when he was not the true inventor, although his co-owner was not a party to the fraud, but was a *bona fide* assignee for valuable consideration, no costs, however, being decreed against him, see *United States v. Gunning* (1884), 23 Blatch. 31; 22 Fed. Rep. 653.

CHAPTER IV.

OF THE CONSTRUCTION OF LETTERS-PATENT.

§ 731. Nature and Scope of the Patent Monopoly Determined by the Legal Interpretation of the Letters-Patent.

THE character and scope of a patent privilege is determined by the construction given to the letters-patent.¹ The patented invention is not necessarily the art or instrument which has been actually discovered or produced by the inventor, nor that which he endeavored to protect or thinks he has protected by his patent;² it is the art or instrument which his patent really describes and claims, according to its true legal interpretation. Hence all his rights in reference to the exclusive use of his invention, and all the rights of the public to its free enjoyment, depend in the last resort upon the meaning which the law attaches to the language of his patent. The duty of interpreting letters-patent, therefore, imposes vast responsibilities upon the tribunal to which it is confided, and its proper discharge demands a high degree of industrial skill and knowledge.

§ 732. Interpretation of Letters-Patent a Matter of Law for the Court.

The duty of interpreting letters-patent has been committed to the courts.¹ A patent is a legal instrument, to be construed,

§ 731. ¹ That a patent grants just what the courts construe it to grant, see *Serrell v. Collins* (1857), 1 Fisher, 289. to be, but on what the patent covers when properly construed, see *Masury v. Anderson* (1873), 11 Blatch. 162; 6 Fisher, 457; 4 O. G. 55.

² That the opinions of patentees on legal questions connected with their patents are not binding on them, see *Adams v. Edwards* (1848), 1 Fisher, 1.

That the rights of a patentee do not rest on what he supposes the invention

§ 732. ¹ In *Emerson v. Hogg* (1845), 2 Blatch. 1, Betts, J. : (6) "It is the province and the duty of the court to settle the meaning of the patent, and, if that cannot be ascertained satisfac-

like other legal instruments, according to its tenor. Whether its Claims are valid or invalid, whether or not they embrace a given invention, and what may be the actual nature of the invention which they do embrace, are questions of law for the court, to be decided upon an inspection of the instrument itself.² No evidence of any kind, no opinions of other persons, can have any direct influence upon this decision. Where technical terms are used, or where the qualities of substances or operations mentioned or any similar data necessary to the comprehension of the language of the patent are unknown to the judge, the testimony of witnesses may be received upon these subjects, and any other means of information be employed.³ But in the actual interpretation of the patent the

torily upon the face of the specification, the law declares it insufficient for ambiguity and uncertainty. (Godson on Pat. 109, and Supp. 29; Phillips on Pat. 249, 252.) The meaning of the terms employed, in view of the object the inventor had in contemplation, and to ascertain the extent of his claim, must be determined and declared by the court. The specification is laid before the jury as defined and settled by the exposition of the court, and the matters of fact presented by the respective parties to support or defeat the patent are then to be examined and applied as if the construction fixed by the court had been incorporated in the specification."

Further, that the interpretation of a patent is a matter of law for the courts, see *National Car Brake Shoe Co. v. Terre Haute Car & Mfg. Co.* (1884), 19 Fed. Rep. 514; 28 O. G. 1007; *Jackson v. Allen* (1876), 120 Mass. 64; *Union Sugar Refinery v. Matthiesson* (1865), 2 Fisher, 600; 3 Clifford, 639; *Page v. Ferry* (1857), 1 Fisher, 298; *Parker v. Hulme* (1849), 1 Fisher, 44; *Davoll v. Brown* (1845), 1 W. & M. 53; 2 Robb, 303.

That the construction of the patent is for the court, its application to the facts is for the jury, see *Teese v. Phelps* (1855), 1 McAllister, 48.

That it is for the court to say what the patent covers, and for the jury to say if the patent is sufficiently clear and full to enable the public to practise the invention, see *Parker v. Stiles* (1849), 5 McLean, 44; *Davis v. Palmer* (1827), 2 Brock. 298; 1 Robb, 518.

² That the construction of a specification is for the court as a matter of law, see *Conover v. Roach* (1857), 4 Fisher, 12; *Emerson v. Hogg* (1845), 2 Blatch. 1.

That the construction of the Claims of a patent is matter of law for the court, unless technical terms require evidence to explain them, see *Ransom v. Mayor of N. Y.* (1856), 1 Fisher, 252.

That whether a given element is claimed as essential or not is a question for the court, see *Vance v. Campbell* (1859), 1 Fisher, 483.

That the question as to the validity of the Claims is largely a question of law, see *Burdett v. Estey* (1878), 15 O. G. 877; 15 Blatch. 349.

That the court need not construe the patent for the jury in an action on a contract unless so requested, see *Holiday v. Rheem* (1852), 18 Pa. St. 465.

³ In *Day v. Stellman* (1859), 1 Fisher, 487, Giles, J. : (491) "The court would remark that while the interpretation and construction of all written instru-

court proceeds upon its own responsibility, as an arbiter of the law, giving to the patent its true and final character and force.

§ 733. Advantages of Confiding the Interpretation of Letters-Patent to the Courts as Matter of Law.

Apart from the general principles upon which this duty of interpretation is entrusted to the court, there are advantages attending it which the inventor could not otherwise enjoy.¹ To treat the nature of the patented invention as a matter of fact, to be inquired of and determined by a jury, would at once deprive the inventor of the opportunity to obtain a permanent

ments is for the court, it nevertheless will bring to its aid the testimony of witnesses to explain terms of art, and make itself acquainted with the material with which the contracts deal, and with the circumstances under which they were made; but neither the testimony of witnesses in general, nor of professors, experts or mechanics, can be received, to prove to the court what is the proper or legal construction of any instrument of writing. Such evidence is inadmissible."

That extraneous matters may be considered to aid construction when it becomes necessary, see *Day v. Cary* (1859), 1 Fisher, 424.

That the court is not to be controlled by expert evidence in the construction of the patent nor as to the novelty of the invention, see *Jackson v. Allen* (1876), 120 Mass. 64.

§ 733. ¹ In *Parker v. Hulme* (1849), 1 Fisher, 44, Kane, J.: (46) "The specification being an instrument of writing, and the words of which it is made up having a fixed and plain import, its interpretation is a matter exclusively for the court, who must explain it. This part of the case is not for the jury, who for the purposes of this cause will adopt and act upon the interpretation given to it by the court. There is great reason and im-

portance for this distribution of the respective duties of the court and the jury. The import of the instrument is purely a question of law. The interpretation of complicated instruments of writing is a special occupation, requiring, like all others, special training and practice. The judge, from his training and discipline, is more likely to give a proper interpretation to such instruments than a jury; and he is, therefore, more likely to be right in performing such a duty than a jury can be expected to be. The action of a judge, in such a case as that of interpreting the specification, is moreover open to review and correction, by reconsideration on his part, or by the revisal of a superior or appellate court, where his reasoning can be tested. This is not so with a jury, who assign no reasons for their opinion, cannot be called on and are not permitted to review or reverse their action, and who, passing upon many questions in their private deliberations, do not declare by their verdict upon what particular elements they at last unite in a verdict; and it is impossible for a court to analyze them. The rule is, therefore, established, that on the judge is placed the responsibility, and he must declare the proper interpretation of written instruments." See also §§ 1017, 1174-1184 and notes, *post*.

and universal definition of his rights under the patent, and in each case of infringement it would subject him to the danger of a false interpretation, from the consequences of which he could not escape. By confiding this duty to the court, however, its decision as to the nature of the patented invention becomes reviewable to the same extent as any other legal question, and when his patent has received the interpretation of the Supreme Court of the United States the inventor can maintain his privilege, as thus interpreted, against all opponents without further controversy in reference to its true limitations.²

§ 734. Interpretation of Letters-Patent Governed by both General and Special Rules.

In the construction of letters-patent the courts are guided by certain well-established rules which are intended to secure the reciprocal rights of the inventor and the public. Most of these rules are found in the decisions of the courts themselves, and are characterized by that liberal spirit which our law has always displayed toward the inventor. In discussing them in detail it will be convenient to consider, first, the general rules applicable to all letters-patent, and second, the special rules adopted in particular cases.

SECTION I.

OF THE CONSTRUCTION OF LETTERS-PATENT: GENERAL RULES.

§ 735. First General Rule: Patents are to be Liberally Construed in Favor of the Inventor.

The fundamental rule governing the construction of a patent, and of each of its individual parts, requires that it be liberally interpreted in favor of the patentee.¹ The patent privilege is

² That the construction given to a patent by the Supreme Court is final, see *Goodyear Dental Vulcanite Co. v. Davis* (1877), 3 Bann. & A. 115; 12 O. G. 1. ¹ That a patent will be liberally construed, see *Trader v. Messmore* (1875), 1 Bann. & A. 639; 7 O. G. 385; *Carew v. Boston Elastic Fabric Co.* (1871), 1 O. G. 91; 5 Fisher, 90; 3 Clifford, 356; *Francis v. Mellor* (1871), 5 Fisher, 153; 8 Phila. 157;

§ 735. ¹ That a patent will be liber-

property, and its extent and value are not to be limited, nor is its title to be disturbed, on any doubtful grounds.² It is created by a grant from the sovereign power, and for that reason every presumption of law is in support of its validity, and such construction must be given to the letter of the grant as will most perfectly secure the proposed benefit to the grantee.³ It is the consideration of a contract made between the inventor and the public, and the instrument describing it must, therefore, be interpreted in the interest of the inventor to whom the consideration moves.⁴ Thus in whatever aspect

1 O. G. 48; *Rubber Co. v. Goodyear* (1869), 9 Wall. 788; *Union Sugar Refinery v. Matthiesson* (1865), 2 Fisher, 600; 3 Clifford, 639; *Imlay v. Norwich & Worcester R. R. Co.* (1858), 1 Fisher, 340; 4 Blatch. 227; *Potter v. Holland* (1858), 1 Fisher, 382; 4 Blatch. 238; *Goodyear v. Railroad* (1853), 2 Wall. Jr. 356; 1 Fisher, 626; *Parker v. Sears* (1850), 1 Fisher, 93; *Davoll v. Brown* (1845), 1 W. & M. 53; 2 Robb, 303; *Ryan v. Goodwin* (1839), 3 Sumner, 514; 1 Robb, 725; *Blanchard v. Sprague* (1839), 3 Sumner, 535; 1 Robb, 734; *Ames v. Howard* (1833), 1 Sumner, 482; 1 Robb, 689; *Whitney v. Emmett* (1831), Baldwin, 303; 1 Robb, 567.

That the specification is to be read in a liberal spirit, see *Hamilton v. Ives* (1873), 6 Fisher, 244; 3 O. G. 30; *Goodyear v. Railroad* (1853), 1 Fisher, 626; 2 Wall. Jr. 356.

That the specification of a patent should be so construed as to sustain it if possible, see *Goodyear v. Berry* (1868), 3 Fisher, 439; 2 Bond, 189; *Johnson v. Willimantic Linen Co.* (1866), 33 Conn. 436.

That a Claim is to be construed liberally by the specifications, drawings, and state of the art, see *Smith v. Prior* (1873), 2 Sawyer, 461; 6 Fisher, 469; 4 O. G. 633.

² In *Blandy v. Griffith* (1869), 3 Fisher, 609, Swayne, J.: (620) "The

rights secured by a patent for an invention or discovery are as much property as anything else, real or incorporeal. The titles by which they are held, like other titles, should not be overthrown upon doubts or objections capable of a reasonable and just solution in favor of their validity. This principle should be steadily borne in mind by those to whom is intrusted the administration of civil justice." See also *Francis v. Mellor* (1871), 1 O. G. 48; 8 Phila. 157; 5 Fisher, 153; *Goodyear Dental Vulcanite Co. v. Gardiner* (1871), 3 Clifford, 408; 4 Fisher, 224.

³ That the presumptions are in favor of a patent and it should be liberally construed, see *Potter v. Holland* (1858), 4 Blatch. 238; 1 Fisher, 382; *Rex v. Mussary* (1738), 1 Web. 41; 1 Abb. P. C. 8.

That Claims will be construed, if possible, to sustain the patentee's right to all he has invented, see *Ransom v. Mayor of N. Y.* (1856), 1 Fisher, 252.

⁴ In *C. A. Yale Cigar Mfg. Co. v. Yale* (1884), 30 O. G. 1183, Dyrenforth, Act. Com.: (1188) "It is a contract between the public and the patentee, to be supported on the ground of mutual considerations, and, being essentially a bargain, is to be construed like other contracts to which there are two parties, each having rights and interests involved in its stipulation."

That the language of a patent must be

the patent privilege may be viewed, justice and legal principle both find expression in this rule, — that the presumption is in favor of the patentee, and that all doubtful points must be resolved in such a manner as to support his claims.

§ 736. **Whorein a Liberal Construction of Letters-Patent Consists.**

A liberal construction is given to the patent when its terms are so interpreted as to sustain the patent and cause it to protect the actual invention.¹ The law recognizes that Claims and Descriptions often are, and in the nature of things often must be, unskillfully drawn, and must, therefore, in many cases fail to represent unequivocally the invention which the patentee endeavored to secure.² To apply such Claims and Descriptions to the invention as it really exists, by giving to each word and phrase that one of its legitimate meanings which makes the whole Claim or Description correspond most accurately with the essential characteristics of the true invention, is to give the patent that liberal construction which the law requires.³

construed so as to effectuate the intention of the parties, and must be limited in scope if the inventor so intended, see *Harris v. Allen* (1883), 15 Fed. Rep. 106.

§ 736. ¹ In *Corning v. Burden* (1853), 15 How. 252, Grier, J. : (269) "It is true that the patentee, after describing his machine, has set forth his Claim in rather ambiguous and equivocal terms, which might be construed to mean either a process or machine. In such case the construction should be that which is most favorable to the patentee, '*ut res magis valeat quam pereat.*' His patent having a title which claims a machine, and his specification describing a machine, to construe his Claim as for the function, effect, or result of his machine, would certainly endanger, if not destroy, its validity. His Claim cannot change or nullify his previous specification with safety to his patent."

That a patent should be liberally construed so as not to limit the invention

beyond the facts, see *Schillinger v. Gunther* (1877), 11 O. G. 831; 14 Blatch. 152.

That a patent will be construed to sustain the Claim, though the specification must be broadly interpreted in order to do it, see *Mallory Mfg. Co. v. Marks* (1881), 20 O. G. 1521; 20 Blatch. 32; 11 Fed. Rep. 887.

That the court should interpret a patent as persons skilled in the art would, see *Tondeur v. Stewart* (1886), 37 O. G. 672; 28 Fed. Rep. 561.

² That in construing patents the court will remember that the specification and Claims are often unskillfully drawn, see *Henderson v. Cleveland Co-operative Stove Co.* (1877), 2 Bann. & A. 604; 12 O. G. 4.

³ That a patent is to be construed by applying its words to its subject-matter, see *Goodyear Dental Vulcanite Co. v. Gardiner* (1870), 4 Fisher, 224; 3 Clifford, 408.

That the construction of patents is to

§ 737. Rule of Liberal Construction does not Authorize a Departure from the Language of the Letters-Patent.

This rule of liberal construction does not, however, confer upon the court the power to change the language of the patent, or to give to words or phrases a meaning wholly different from their own.¹ To interpret the terms of a patent is one act; to create new terms, either directly by substituting other terms or indirectly by adopting new significations for existing terms, is an entirely distinct act; and no authority to perform the latter act has ever been committed to the courts.² If the language of a patent is erroneous, if the inventor has discovered much and described little, if subsequent events have taught him that his patent is narrower than his actual invention, his remedy is by a new patent or by an amendment of his old patent, not by its forced construction.³ The court, interpret-

be practical, not fanciful, see *Davoll v. Brown* (1845), 1 W. & M. 53; 2 Robb, 303.

That a patent for an art cannot be limited to the apparatus used for practising the art, see *Hammerschlag Mfg. Co. v. Bancroft* (1887), 32 Fed. Rep. 585.

§ 737. ¹ That a patent will be interpreted by its own terms, see *Goodyear Dental Vulcanite Co. v. Davis* (1880), 102 U. S. 222; 19 O. G. 543.

That a patentee should be held strictly to the language of his Claim, see *De-long v. Bickford* (1882), 13 Fed. Rep. 32; 22 O. G. 2242.

That a patent is not to be enlarged by construction beyond what is explicitly described and claimed, see *Keystone Bridge Co. v. Phoenix Iron Co.* (1877), 95 U. S. 274; 12 O. G. 980.

² That while a patent is to be fairly construed, no new specification can be made by implication, see *Sickels v. Gloucester Mfg. Co.* (1856), 1 Fisher, 222.

That Claims must be construed by the language which is employed, not by what might have been employed, see *Patent Clothing Co. v. Glover* (1887), 40 O. G. 1135; 24 Blatch. 542.

³ In *Detmold v. Reeves* (1851), 1 Fisher, 127, Kane, J.: (131) "If he has discovered much and discloses little; if there has been revealed to him one of the *arcana* of nature, and he communicates to the world only one or more of its derivatives and secondary truths, he patents no more than he has proclaimed. He will not be allowed afterward, when the extent of his right shall be the subject of controversy, either by expanding into a general expression what was limited before in a particular form, or by tracing out for us the line that leads back from consequences to remote causes, to initiate us, inferentially, into the radical mystery of his invention, and then argue that he had described it by implication from the first, and so claimed ownership of it in his patent."

That the court cannot consider that a Claim might have been broader if it is actually too narrow, see *Becker v. Hastings* (1884), 28 O. G. 98; 22 Fed. Rep. 827.

That if the patentee accepts a patent with narrow Claims they cannot be enlarged by construction, see *Sutter v. Robinson* (1886), 119 U. S. 530; 38

ing the patent, cannot depart from the letter of the instrument, either by excluding present terms or by interpolating others which do not appear. Its duty is discharged, and its authority exhausted, when it defines the character of the patented invention according to that significance of the words employed by the inventor in claiming and describing it which is most in harmony with its known essential attributes.

§ 738. Rule of Liberal Construction does not Authorize an Equivocal or Elastic Interpretation of the Claims.

Nor does the rule permit of such interpretations as render the inventor's Claims elastic or ambiguous.¹ The object of interpretation is to make the indefinite exact and the doubtful plain. An invention, whether it be an art or an instrument, has a concrete existence which is capable of precise definition and of clear description. It is only where the language of the patent fails to define with precision, or to describe with clearness, that any especial exercise of the interpretative power becomes necessary, and it must then be employed for the removal not the creation of ambiguities, and for the erection not the destruction of limitations to the in-

O. G. 230; *Roemer v. Peddie* (1886), 27 Fed. Rep. 702; 37 O. G. 338.

That a Claim cannot be enlarged by construction to cover what was intentionally omitted, see *Bate Refrigerating Co. v. Eastman* (1885), 24 Fed. Rep. 645; 32 O. G. 517.

That peculiarities of shape or arrangement will not be construed as distinctive features of the invention in order to save the Claim, unless the Description or Claim suggest it, see *Bradley & Hubbard Mfg. Co. v. Charles Parker Co.* (1885), 25 Fed. Rep. 907; 34 O. G. 249.

That details are not construed as essential features in order to save the Claim unless referred to in the Claim, especially where the Description merely recommends them, see *Roemer v. Neumann* (1885), 26 Fed. Rep. 102.

That a Claim is not to be construed to cover later inventions, see *Root v.*

Lamb (1881), 19 O. G. 937; 7 Fed. Rep. 222.

That a patent will not be construed so liberally as to cover all that the patentee now thinks he might have covered, see *Trader v. Messmore* (1875), 7 O. G. 385; 1 Bann. & A. 639.

That if a patent does not cover all that the patentee intended to claim, he must amend it, the difficulty not being removable by construction, see *Becker v. Hastings* (1884), 22 Fed. Rep. 827; 28 O. G. 98.

§ 738. ¹ That patents are not to be so liberally construed as to permit ambiguous or elastic Claims, see *Parker v. Sears* (1850), 1 Fisher, 93.

That intentionally loose and ambiguous Claims are not favored in the construction, see *Taylor v. Garretson* (1871), 5 Fisher, 116; 9 Blatch. 156.

ventor's Claim.² Every invention is a unit, distinct from every other invention, however similar in purpose or appearance, and except in cases where there is a joinder of inventions a patent covering one does not afford protection to the other. To construe a patent in such a manner that it may apply to either of these separate inventions at the pleasure of the inventor defeats the very object for which the power has been confided to the courts. While the patentee is entitled to the broadest definite interpretation which his language will legitimately bear, and is presumed to claim the invention to its full extent as so defined, the patent, when interpreted, must point out the invention whose protection it secures with a completeness and exactness which distinguish it from every other. Ambiguities and inaccuracies in essential portions of the patent, which cannot be removed by such interpretation, render the patent to that extent inoperative and void.

§ 739. Rule of Liberal Construction Permits an Interpretation in Accordance with the Real Nature of the Invention unless the Language of the Patent Clearly Forbids it.

Where the language of a patent is clear and capable of but one meaning, the duty of the court is fulfilled by interpreting its words and phrases in their proper sense, and defining the invention in accordance with this interpretation.¹ If,

² That a patent cannot be extended by construction to embrace any invention which it does not specifically claim, see *Van Camp v. Maryland Pavement Co.* (1888), 43 O. G. 884.

That Claims are not to be expanded by construction so as to cover more than the patentee first intended, see *Couse v. Johnson* (1879), 16 O. G. 719; 4 *Bann. & A.* 501.

That limited Claims are not to be expanded into general ones by implication or otherwise, see *Detmold v. Reeves* (1851), 1 *Fisher*, 127.

That the courts will not enlarge Claims by construction, see *Burns v. Meyer* (1879), 100 U. S. 671; *Railway*

Co. v. Sayles (1878), 97 U. S. 554; 15 O. G. 243; *Keystone Bridge Co. v. Phoenix Iron Co.* (1877), 95 U. S. 274; 12 O. G. 980.

That a Claim for the special arrangement of parts must be construed to cover only the special parts and special arrangement, see *Buzzell v. Andrews* (1885), 25 *Fed. Rep.* 822; 34 O. G. 830.

§ 739. ¹ That the specification and Claims ought to be construed to mean just what they seem to mean, see *Anders v. Gilliland* (1880), 19 O. G. 177.

That when Claims are clear and explicit they cannot be restricted or en-

as thus defined, the invention is not patentable either for want of novelty, utility, or inventive skill, or on account of previous dedication to the public, the inventor must abide the consequences, procuring an amendment of his patent when it does not correctly represent his actual invention, or relinquishing his claims entirely when what he has invented proves to be not entitled to protection. But when the language is not clear, or is capable of various constructions, recourse to extrinsic facts is often necessary to ascertain the sense in which in this particular case it must be understood.² The most important of these facts is the nature of the actual invention which the patent was intended to secure.³ This

larged by reference to features not mentioned therein nor implied thereby, see *Funck v. Doty* (1878), 14 O. G. 157.

That the patentee is not limited to the literal import of his description, but may depart from it provided he does not change the principle nor make material alterations in its operation, see *Grier v. Castle* (1883), 17 Fed. Rep. 523; 24 O. G. 1176.

² That the construction of a patent depends on its words, or where these are ambiguous, on other circumstances, see *Evans v. Eaton* (1818), 3 Wheaton, 454; 1 Robb, 243.

³ In *Van Marter v. Miller* (1879), 15 Blatch. 562, Wallace, J.: (563) "In construing a patent, it is first pertinent to ascertain what, in view of the prior state of the art, the inventor has actually accomplished; and this having been found, such a construction should be given as will secure the actual invention to the patentee, so far as this can be done consistently with giving due effect to the language of the specification and Claim." 4 Bann. & A. 124 (124).

In *Page v. Ferry* (1857), 1 Fisher 298, Wilkins, J.: (302) "The intention of the inventor, so as to effect the object designed, is to govern the con-

struction of the language he employs. Inventors are not always educated or scientific men. Some most useful inventions have sprung from an illiterate source. Genius is not always blessed with the power of language. Courts look to the manifest design in order to remove any ambiguity arising from the terms employed. But this ambiguity must not be such as would perplex an ordinary mechanic in the art to which it applies."

In *Winans v. Denmead* (1853), 15 How. 330, Curtis, J.: (341) "Now, while it is undoubtedly true that the patentee may so restrict his Claim as to cover less than what he invented, or may limit it to one particular form of machine, excluding all other forms though they also embody his invention, yet such an interpretation should not be put upon his Claim if it can fairly be construed otherwise; and this for two reasons: (1) Because the reasonable presumption is that, having a just right to cover and protect his whole invention, he intended to do so, — *Haworth v. Hardcastle*, Web. P. C. 484; (2) Because specifications are to be construed liberally, in accordance with the design of the Constitution and the Patent Laws of the United States to promote the progress of the useful arts, and allow in-

being known the language of the patent must be construed to correspond with its essential attributes, unless such a construction would do violence to the terms employed. In that event a different interpretation must be given, although the eventual defeat of the patent may be thus ensured.

§ 740. Nature of the Invention Shown by State of Art at Date of Invention.

The nature of the invention attempted to be covered by the patent is sometimes evident upon its inspection or upon an examination of its practical operation. When this is not the case an investigation of the state of the art at the date of the invention may be instituted.¹ Every invention is a step

ventors to retain to their own use, not anything which is matter of common right, but what they themselves have created."

Further, that the patent is to be construed by the nature of the invention, see *Steam Gauge and Lantern Co. v. Ham Mfg. Co.* (1886), 28 Fed. Rep. 618; *Hoff v. Iron Clad Mfg. Co.* (1886), 35 O. G. 1230; *Fitch v. Bragg* (1881), 20 O. G. 1589; 8 Fed. Rep. 588; *Washburn & Moen Mfg. Co. v. Haish* (1881), 7 Fed. Rep. 906; 10 Bissell, 83; *Robinson v. Sutter* (1880), 10 Bissell, 100; 19 O. G. 127; 8 Fed. Rep. 828; *Whitnum v. Seaman* (1880), 5 Bann. & A. 95; 17 O. G. 626; 4 Fed. Rep. 436; *Clark v. Kennedy Mfg. Co.* (1877), 11 O. G. 67; 14 Blatch. 79; *Merrill v. Yeomans* (1877), 94 U. S. 568; 11 O. G. 970; *Good-year Dental Vulcanite Co. v. Davis* (1877), 12 O. G. 1; 3 Bann. & A. 115; *Bruff v. Ives* (1877), 11 O. G. 924; 14 Blatch. 198; *Mann v. Bayliss* (1876), 10 O. G. 789; *Bussey v. Wager* (1875), 9 O. G. 800; *Glue Co. v. Upton* (1874), 4 Clifford, 237; 6 O. G. 837; 1 Bann. & A. 497; *Barnes v. Straus* (1872), 2 O. G. 62; 9 Blatch. 553; 5 Fisher, 531; *McDougal v. Eames* (1872), 2 O. G. 87; *Taylor v. Garretson* (1871), 5 Fisher, 116; 9 Blatch. 156; *Coffin v.*

Ogden (1869), 7 Blatch. 61; 3 Fisher, 640; *Woodman v. Stimpson* (1866), 3 Fisher, 98.

That a patent will be so construed, if possible, as to protect the entire invention, see *Henderson v. Cleveland Co-operative Stove Co.* (1877), 2 Bann. & A. 604; 12 O. G. 4; *Hamilton v. Ives* (1873), 6 Fisher. 244; 3 O. G. 30.

That a specification should be construed with reference to the purpose of the invention, see *Roberts v. Schreiber* (1880), 2 Fed. Rep. 855; 18 O. G. 125; 5 Bann. & A. 491.

That a patentee is entitled to such a construction of his patent as will enable it to protect all forms of his invention, though he has described but one, unless he has restricted himself to certain forms in his Claims, see *Grier v. Castle* (1883), 24 O. G. 1176; 17 Fed. Rep. 523; *Winans v. Denmead* (1853), 15 How. 330.

That the construction given to the patent by the patentee will be sustained, if it is consistent with the language used, see *Tondeur v. Stewart* (1886), 28 Fed. Rep. 561; 37 O. G. 672; *Bradley v. Dull* (1884), 19 Fed. Rep. 913; 27 O. G. 625; *Klein v. Russell* (1873), 91 Wall. 433.

§ 740. ¹ That patents are to be construed in view of the state of the art,

forward in the progress of the art to which it belongs, and the character of that step is often best determined by examining the condition of the art immediately before the step was taken and comparing it with the condition to which such step advanced the art. The difference between these must be the precise result of the inventor's act, and when it can be clearly ascertained it affords the safest guide to the exact scope of his invention. The state of the art at the date of the invention may be shown by previous patents, by the processes or instruments then known to the art, or by the testimony of persons acquainted with its general history and development.²

see *Grier v. Wilt* (1887), 120 U. S. 412; 38 O. G. 1365; *Railway Register Mfg. Co. v. Broadway & Seventh Ave. R. R. Co.* (1886), 26 Fed. Rep. 522; 34 O. G. 921; *Reed v. Chase* (1885), 25 Fed. Rep. 94; 33 O. G. 996; *Buckingham v. Porter* (1884), 10 Sawyer, 289; 36 O. G. 820; 26 Fed. Rep. 759; *Jones v. Barker* (1882), 22 O. G. 771; 11 Fed. Rep. 597; *Sutro v. Moll* (1881), 8 Fed. Rep. 909; 19 Blatch. 89; *Root v. Lamb* (1881), 7 Fed. Rep. 222; 19 O. G. 937; *Washburn & Moen Mfg. Co. v. Haish* (1880), 10 Bissell, 83; 7 Fed. Rep. 906; *Webster Loom Co. v. Higgins* (1879), 16 O. G. 675; 15 Blatch. 446; 4 Bann. & A. 83; *Van Marter v. Miller* (1879), 4 Bann. & A. 124; 15 Blatch. 562; *Blaisdell v. Tuffts* (1878), 15 O. G. 881; *Bruff v. Ives* (1877), 11 O. G. 924; 14 Blatch. 198; *Clark v. Kennedy Mfg. Co.* (1877), 14 Blatch. 79; 11 O. G. 67; *Estabook v. Dunbar* (1876), 10 O. G. 909; 2 Bann. & A. 427; *Salamanca Felting Co. v. Haven* (1875), 9 O. G. 253; 2 Bann. & A. 164; 3 Dillon, 131; *Burden v. Corning* (1864), 2 Fisher, 477; *Pitts v. Wemple* (1855), 1 Bissell, 87; 2 Fisher, 10.

That a patent must be construed to claim only what the state of the art shows to be new, see *Scott v. Evans* (1882), 11 Fed. Rep. 726.

That where the scope of the art is limited the Claim must receive a narrow construction, see *Adams v. Bellairo Stamping Co.* (1886), 28 Fed. Rep. 360; 36 O. G. 567.

That the specification will be construed in view of the state of human knowledge and not as intending the impossible, see *Tilghman v. Mitchell* (1864), 2 Fisher, 518.

That a patent is construed by the state of the art at the date of the invention, and the description is limited to what thus appears to be new, see *Neacy v. Allis* (1882), 22 O. G. 1621; 13 Fed. Rep. 874; *Jones v. Barker* (1882), 11 Fed. Rep. 597; 22 O. G. 771; *Giant Powder Co. v. California Vigorit Powder Co.* (1880), 4 Fed. Rep. 720; 18 O. G. 1339; 6 Sawyer, 508.

That it is the state of the art at the date of the invention, not the application, which gives its meaning to the patent, see *Sprague v. Adriance* (1877), 14 O. G. 308; 3 Bann. & A. 124.

Contra, — That every patent is construed according to the state of the art at the date of the patent, see *Salamanca Felting Co. v. Haven* (1875), 3 Dillon, 131; 9 O. G. 253; 2 Bann. & A. 164.

² That a specification will be construed by a history of the art and the

§ 741. Nature of the Invention Shown by Other Acts and Circumstances.

The character of the actual invention may also be evidenced by other statements of the inventor concerning its essential attributes. His allegations after the patent has been issued are of little weight, whether they tend to narrow or enlarge the scope of his invention.¹ But the position he assumed before the Patent Office while applying for a patent, the claims he then asserted, the concessions he there made, are all important indications as to the true nature of the idea of means which he embodied in his concrete invention and which he has endeavored to describe and claim in his patent.² Thus his correspondence with the Patent Office, the application, the amendments filed, the disclaimers offered, the objections raised and answered or avoided, are proper matters for examination by the court.³ Besides these, any other

invention, see *Giant Powder Co. v. California Vigorit Powder Co.* (1880), 6 Sawyer, 508; 18 O. G. 1339; 4 Fed. Rep. 720.

That the description in a patent is to be construed in the light of prior patents, and its general terms are to be restricted by them, see *Parsons v. Colgate* (1882), 15 Fed. Rep. 600; 24 O. G. 203; 21 Blatch. 171.

That the patent will be construed in the light of the uncontradicted testimony as to prior devices, in order to ascertain its real scope, see *Day v. Combination Rubber Co.* (1880), 17 O. G. 1347; 2 Fed. Rep. 570; 5 Bann. & A. 385.

§ 741. ¹ That the Claims may be construed in connection with the testimony of the patentee as to the actual invention, see *Matthews v. Iron Clad Mfg. Co.* (1888), 124 U. S. 347; 42 O. G. 827.

That a patent will not be narrowed from its evident meaning for the reason that the patentee and former owner says that his invention was not as broad as his specification, see *Union Paper Bag*

Mach. Co. v. Pultz & Walkley Co. (1878), 15 Blatch. 160; 15 O. G. 423; 3 Bann. & A. 403.

² That the terms of the application and the proceedings in the Patent Office are to be considered in construing Claims, see *Otis Bros. Mfg. Co. v. Crane Bros. Mfg. Co.* (1886), 27 Fed. Rep. 550.

That a patentee cannot insist that his patent shall be construed to cover matter which he was compelled to abandon in the Patent Office in order to obtain a patent, and the records of the Office may be examined on this question, see *Sutter v. Robinson* (1886), 119 U. S. 530; 38 O. G. 230.

³ That the meaning of a patent may be ascertained by examining the correspondence of the inventor with the Patent Office during the application, see *Goodyear Dental Vulcanite Co. v. Davis* (1880), 102 U. S. 222; 19 O. G. 543.

That a patent cannot be construed to cover articles which the Commissioner and the patentee agreed were outside it when the patent was issued, and this agreement may be shown by the corre-

facts may be considered which in the judgment of the court tend to disclose the object of the patent and thereby lead to a correct construction of its terms.⁴

§ 742. **Second General Rule: Entire Patent Construed together as an Indivisible Instrument.**

Subordinate to the fundamental rule that a patent must be liberally interpreted in order to accomplish, if possible, the purpose for which it was issued, is the rule that in ascertaining this purpose the entire patent must be construed together, and effect given to all its parts as members of a single indivisible instrument.¹ The vital force of a patent resides in

spondence between them, see *Pike v. Potter* (1859), 3 Fisher, 55.

That a patent is to be construed without reference to previous correspondence with the Office, or to rejected applications, see *Piper v. Brown* (1870), 4 Fisher, 175; *Holmes*, 20; *Goodyear Dental Vulcanite Co. v. Gardiner* (1870), 4 Fisher, 224; 3 Clifford, 408.

That a patent may be construed, if necessary, by the intention of the inventor in the use of words, and for ascertaining this the records of amendments in the specification, &c., in the Patent Office may be examined, see *Trader v. Messmore* (1875), 1 Bann. & A. 639; 7 O. G. 385.

That where an application, being rejected, is amended by adding new features and the patent is then allowed, it cannot be construed as covering the invention described in the rejected application, see *Milligan v. Lalancé & Grosjean Mfg. Co.* (1884), 21 Fed. Rep. 570; 29 O. G. 367.

That where the patentee acquiesces in the limitation of his Claims by the Patent Office, the court cannot construe the patent to cover anything thus excluded, see *Crawford v. Heysinger* (1887), 123 U. S. 589; 42 O. G. 197; *Phoenix Caster Co. v. Spiegel* (1886), 26 Fed. Rep. 272; *Otis Bros. Mfg. Co. v. Crane*

Bros. Mfg. Co. (1886), 27 Fed. Rep. 550.

That a patentee acquiescing in the rejection of broad Claims must be restricted to those allowed, though the rejection was improper, see *Blades v. Rand, McNally, & Co.* (1886), 27 Fed. Rep. 93; 37 O. G. 99.

That a patent in the hands of an assignee cannot be construed to cover matter excluded from the Claims by a wrongful rejection in the Patent Office, see *Blades v. Rand, McNally, & Co.* (1886), 27 Fed. Rep. 93; 37 O. G. 99.

⁴ That no construction of a patent by acquiescence can arise in one year only, see *Johnston Ruffler Co. v. Avery Mach. Co.* (1886), 28 Fed. Rep. 193.

§ 742. ¹ In *Carver v. Braintree Mfg. Co.* (1843), 2 Story, 432, Story, J.: (446) "There is no magic in words; and above all, in patents, the court looks through the whole patent and specification, in order to ascertain what the thing claimed and patented is; whether it is for an entirety or for various distinct improvements, capable of a distinct operation and independent use in the same machine, or for both, or whether it is for a combination of two or more things in a particular machine, to produce a given result, or for a simple or single improvement in a particular

its Claims. These measure the protection which the inventor seeks and the exclusive privilege which he obtains. Where they are clear, explicit, unmistakable, they need no aid, and are not aided, by reference to the other portions of the patent.² But when they are obscure or capable of different interpretations, the whole Description, drawings, model, oath, and title are to be considered as exponents of the Claims, and as determining the meaning and application of their words. No one of these descriptive portions of the patent can control the others.³ The name given to the invention in the title or the

machine; or whether it is for any one or more of them. There is no artificial or universal rule of interpretation of such instrument beyond that which common-sense furnishes, which is to construe the instrument as a whole, and to extract from the descriptive words and the Claim what the invention is which is intended to be patented, and how far it is capable of exact ascertainment, and how far it is maintainable in point of law, supposing it clear from all ambiguity." 2 Robb, 141 (155).

See also *American Wood-Paper Co. v. Heft* (1867), 3 Fisher, 316; *Morris v. Barrett* (1859), 1 Bond, 254; 1 Fisher, 461; *Day v. Cary* (1859), 1 Fisher, 424; *Pitts v. Wemple* (1855), 2 Fisher, 10; 1 Bissell, 87; *Pitts v. Whitman* (1843), 2 Story, 609; 2 Robb, 189.

² That the specification and drawings are useful only to construe the Claim, see *Pitts v. Wemple* (1855), 1 Bissell, 87; 2 Fisher, 10.

That where a Claim is clear and explicit its language controls its meaning, without referring to the specification, see *Rich v. Close* (1870), 4 Fisher, 279; 8 Blatch. 41.

³ In *Francis v. Mellor* (1871), 1 O. G. 48, McKennan, J. : (50) "Patents are to be construed liberally, so as to sustain and not destroy the right of the inventor. Hence the whole of the specification may and should be looked at, to learn from the description of the

invention not only how to make it, but to ascertain what it really is. By the requirements of the statute the description must be in full, clear, and exact terms, and it is, therefore, an authorized guide to an accurate comprehension of what the patentee meant to claim as his invention. It is not only where the specification is expressly referred to that the Claim is to be construed in connection with it; but, as a general rule, the explanations contained in it are to be taken as the inventor's own interpreter of the meaning of his Claim, and of the essential qualities of the invention protected by his patent. *Turrill v. R. R. Co.*, 1 Wall. 511; *Curtis on Patents*, Secs. 453 and 454." 5 Fisher, 153 (157); 8 Phila. 157 (158).

In *Ransom v. Mayor of New York* (1856), 1 Fisher, 252, Hall, J. : (260) "In order to determine what the plaintiffs claim as their invention, we are to look to the specification annexed to their patent, which specification is in the language of the alleged inventors themselves, is made by law a portion of the patent, and must be referred to for the purpose of determining what the patentees claimed as their invention, and what the Government have agreed to secure to them as their exclusive privilege. In determining the construction of these Claims (and their construction is a question of law exclusively for the court, and not for the determination of the

oath should be consistent with its character as set forth in the specification; the drawings and the model should in

jury, unless, indeed, there may be technical terms, or terms which need explanation by the evidence given before the jury), it is proper that the court should refer to the whole specification, and consider the whole of it in connection."

In *Pottibone v. Dorringer* (1818), 4 Wash. 215, Washington, J. : (217) "But there can be no doubt that where the construction of the patent and specification, as to the subject of the grant, is doubtful, the affidavit, if more precise, may be resorted to to explain the ambiguity. It would seem to be particularly proper to do so for restraining general expressions in the specification; as the oath required to be taken by the act of Congress is, that the inventor does verily believe that he is the true inventor of the art, machine, or improvement for which he solicits a patent." 1 Robb, 152 (155).

Further, that the entire specification, with the drawings, model, oath, and title are to be considered as interpreting the Claims, see *Matthews v. Iron Clad Mfg. Co.* (1888), 124 U. S. 347; 42 O. G. 827; *Ex parte Holt* (1884), 29 O. G. 171; *Bruce v. Marder* (1882), 20 Blatch. 355; 22 O. G. 1039; 10 Fed. Rep. 750; *Brainard v. Cramme* (1882), 20 Blatch. 530; 22 O. G. 769; 12 Fed. Rep. 621; *Holly v. Vergennes Mach. Co.* (1880), 4 Fed. Rep. 74; 18 O. G. 1177; 18 Blatch. 327; *Matthews v. Schoneberger* (1880), 18 O. G. 1464; 4 Fed. Rep. 635; 18 Blatch. 357; *Evans v. Kelly* (1880), 9 Bissell, 251; 5 Bann. & A. 71; 23 O. G. 192; 13 Fed. Rep. 903; *Robinson v. Sutter* (1880), 10 Bissell, 100; 19 O. G. 127; 8 Fed. Rep. 828; *Day v. Combination Rubber Co.* (1880), 17 O. G. 1347; 5 Bann. & A. 385; 2 Fed. Rep. 570; *National Car Brake Shoe Co. v. Lake Shore & Michigan Southern R. R. Co.* (1880), 4 Fed.

Rep. 219; 18 O. G. 1179; 9 Bissell, 503; *Burko v. Partridge* (1878), 58 N. H. 349; *Bruff v. Ives* (1877), 11 O. G. 924; 14 Blatch. 198; *Fuller v. Yentzer* (1876), 94 U. S. 288; 11 O. G. 551; *Estabrook v. Dunbar* (1876), 2 Bann. & A. 427; 10 O. G. 909; *Metropolitan Wringing Mach. Co. v. Young* (1876), 14 Blatch. 46; *Westinghouse v. Gardner & Ranson Air Brake Co.* (1875), 2 Bann. & A. 55; 9 O. G. 538; *Wells v. Jacques* (1874), 1 Bann. & A. 60; 5 O. G. 364; *Ex parte Marsh* (1872), 2 O. G. 197; *Roberts v. Dickey* (1872), 1 O. G. 4; 4 Fisher, 532; 4 Brews. (Pa.) 260; *Carew v. Boston Elastic Fabric Co.* (1871), 3 Clifford, 356; 5 Fisher, 90; 1 O. G. 91; *Francis v. Mellor* (1871), 5 Fisher, 153; 1 O. G. 48; 8 Phila. 157; *Seymour v. Osborne* (1870), 11 Wall. 516; *Coffin v. Ogden* (1869), 7 Blatch. 61; 3 Fisher, 640; *Turrill v. Railroad Co.* (1863), 1 Wall. 491; *Hayden v. Suffolk Mfg. Co.* (1862), 4 Fisher, 86; *Whipple v. Middlesex Co.* (1859), 4 Fisher, 41; *Bell v. Daniels* (1858), 1 Fisher, 372; 1 Bond, 212; *Ransom v. Mayor of N. Y.* (1856), 1 Fisher, 252; *Kittle v. Merriam* (1855), 2 Curtis, 475; *Winans v. Denmead* (1853), 15 How. 330; *Corning v. Burden* (1853), 15 How. 252; *Hogg v. Emerson* (1850), 11 How. 587; *Hogg v. Emerson* (1848), 6 How. 437; 2 Robb, 655; *Davoll v. Brown* (1845), 1 W. & M. 53; 2 Robb, 303; *Ryan v. Goodwin* (1839), 3 Sumner, 514; 1 Robb, 725.

That the Claims of a patent must be construed by the specification, and if the latter describes an entire article, the separable parts of the article are not regarded as inventions unless so claimed, see *Evans v. Kelly* (1880), 23 O. G. 192; 13 Fed. Rep. 903; 9 Bissell, 251; 5 Bann. & A. 71.

That an element limited to a peculiar

their respective modes disclose the precise features which are presented by the language of the Description; but variations between these are not to be regarded, provided their examination as a whole reveals the essential attributes of the invention claimed.⁴ This rule applies equally to cases where the patent covers several inventions. As these must be mutually dependent and co-operative in order to be capable of joinder, the Claim for each may be, so far as necessary, elucidated and defined by the descriptions of the others.⁵

construction in one Claim will be limited in the same way in construing other Claims, see *Railway Register Mfg. Co. v. Third Avenue R. R. Co.* (1887), 42 O. G. 379.

That a doubtful specification may be aided by the drawing, see *Tinker v. Wilber Eureka Mower & Reaper Mfg. Co.* (1880), 1 Fed. Rep. 138; 5 Bann. & A. 92; *Banker v. Bostwick* (1880), 18 O. G. 61; 3 Fed. Rep. 517; 5 Bann. & A. 463; *Ingels v. Mast* (1873), 6 Fisher, 415; *Foss v. Herbert* (1856), 1 Bissell, 121; 2 Fisher, 31; *Hogg v. Emerson* (1850), 11 How. 587; *Burrall v. Jewett* (1830), 2 Paige (N. Y.), 133.

That drawings are to be construed by the specifications, see *Hamilton v. Ives* (1873), 6 Fisher, 244; 3 O. G. 30.

That drawings cannot be so used as to change the character of the invention described in the specification, see *Hailes v. Albany Stove Co.* (1887), 123 U. S. 582; 42 O. G. 95.

That the drawing may show that the machine claimed under the patent is not the one for which it issued, see *Burrall v. Jewett* (1830), 2 Paige (N. Y.), 133.

That the drawings may be interpreted by the model, see *Aiken v. Dolan* (1867), 3 Fisher, 197.

That Claims will be construed by the drawings and model, see *Hancock Inspirator Co. v. Jenks* (1884), 21 Fed. Rep. 911.

That a clause in the application immediately connected with the Claim, and evidently stating what the inventor intended to secure, will be construed as part of the Claim, see *La Rue v. Western Electric Co.* (1886), 28 Fed. Rep. 85; 36 O. G. 453; 24 Blatch. 18.

⁴ That the names and terms used by the patentee are to be construed in view of the entire specification and drawings, see *Foye v. Nichols* (1882), 8 Sawyer, 201; 13 Fed. Rep. 125; 22 O. G. 2243.

That the title of the invention should agree with the specification, see *Good-year v. Railroad* (1853), 1 Fisher, 626; 2 Wall. Jr. 356.

That the title of the invention in the patent does not control, but is to be taken in connection with the specification and drawings, and a liberal construction given to all, see *Bell v. Daniels* (1858), 1 Bond, 212; 1 Fisher, 372; *Sickels v. Gloucester Mfg. Co.* (1856), 1 Fisher, 222.

⁵ That a construction making two Claims cover the same thing will be avoided if possible, see *Tondeur v. Stewart* (1886), 28 Fed. Rep. 561; 37 O. G. 672.

That one Claim cannot be so construed as to render another Claim of the same patent meaningless, see *Cohansey Glass Mfg. Co. v. Wharton* (1886), 28 Fed. Rep. 189; 36 O. G. 343.

§ 743. Second General Rule Authorizes the Restriction of the Claims by the Other Portions of the Patent, but not their Enlargement.

In thus construing the Claims of a patent by its descriptive portions, the scope of the Claims may often be restricted, but can never be enlarged.¹ The Claims are based on the description, the invention secured to the patentee being always identical with or contained in that communicated to the public; and therefore the interpretation given to the Claims must limit them to the invention previously described, however wide and comprehensive they might otherwise appear.² To meet extended Claims the rule of liberal construction requires all other members of the patent to be interpreted as broadly as the legitimate use of language, drawings, or models will permit, but when the Claims exceed such an interpretation of the descriptive matter they must be restricted by it or must wholly fail.³ The converse of this proposition, however, is

§ 743. ¹ That the Claim may be illustrated, not enlarged, by the other parts of the specification, see *Yale Lock Co. v. Greenleaf* (1886), 117 U. S. 554; 35 O. G. 386.

² That a general Claim will be limited to the invention described in the specification, see *Ex parte Hahn* (1875), 8 O. G. 597; *U. S. Steam Gauge Co. v. American Steam Gauge Co.* (1874), 5 O. G. 208; *Holmes*, 309; *Cammeyer v. Newton* (1874), 5 O. G. 753; 12 *Blatch*. 122; 1 *Bann. & A.* 294; *Mitchell v. Tilghman* (1873), 19 *Wall*. 287; 5 O. G. 299; *Forsyth v. Clapp* (1873), 4 O. G. 527; *Holmes*, 278; 6 *Fisher*, 528; *Smith v. O'Connor* (1873), 4 O. G. 633; 2 *Sawyer*, 461; 6 *Fisher*, 469; *Roberts v. Dickey* (1872), 4 *Fisher*, 532; 1 O. G. 4; 4 *Brews. (Pa.)* 260.

That general words in a Claim are limited by particular words in the specification, see *Knox v. Murtha* (1871), 9 *Blatch*. 205; 5 *Fisher*, 174.

That a Claim cannot receive a construction broader than the invention as shown in the specification, see *Anders v. Gilliland* (1880), 19 O. G. 177.

That general words in a Description or Claim are to be limited by the real nature of the invention, see *Fischer v. Hayes* (1881), 6 *Fed. Rep.* 76; 20 O. G. 239; 19 *Blatch*. 26.

That Claims are not limited by drawings when the specification shows that the real invention was broader, see *Hamilton v. Ives* (1873), 6 *Fisher*, 244; 3 O. G. 30.

³ That a general description at the beginning of the specification will be construed by the subsequent specific directions for making the invention, and the description of its peculiar properties, see *Holt v. Kendall* (1885), 26 *Fed. Rep.* 622; 35 O. G. 874.

That a Claim is to be construed by the specification, and if the specification describes only the entire article the Claims do not cover each separate part of it, see *Evans v. Kelly* (1880), 13 *Fed. Rep.* 903; 9 *Bissell*, 251; 5 *Bann. & A.* 71; 23 O. G. 192.

That the Claims of a patent cannot be enlarged by the correspondence of the inventor with the Patent Office, nor by the proceedings pending the appli-

not type. Although the Claims must follow the description, it is not necessary that they cover all the patentable matter there described. The inventor may abandon portions of it to the public, or reserve them for the protection of a future patent. Whatever of such matter the legitimate meaning of his Claims, in their widest sense, embraces, they must be construed to hold, but beyond this meaning they cannot be enlarged by general terms in the description, or by its statement of other and distinct inventions.

§ 744. Third General Rule: Words and Phrases Interpreted, if possible, in their Ordinary Sense.

Subject to the preceding rules are those which govern the signification of the individual words and phrases employed by the inventor in his Description and Claims of the invention, and by the Patent Office in framing the letters-patent. Unless the contrary appears, a word has its ordinary meaning.¹ If commonly applied in different senses, it may be used in one part of the patent to denote a certain object, and in another to denote a different object,—its sense in each connection being determined by the object to which it relates.² If it has varied in its meaning since the date of the invention, it must be taken as including only the acts or things to which it then re-

cation, see *Goodyear Dental Vulcanite Co. v. Gardiner* (1871), 3 Clifford, 408 ; 4 Fisher, 224.

That clear and distinct Claims will govern where the specification is ambiguous, see *McKesson v. Carnrick* (1881); 9 Fed. Rep. 44 ; 21 O. G. 137 ; 19 Blatch. 158.

That a process cannot be inferred by the court from a description of its product, see *Western Electric Co. v. Ansonia Co.* (1885), 114 U. S. 447 ; 31 O. G. 1305.

§ 744. ¹ That words used in a specification have their usual meaning unless the contrary appears, see *Root v. Lamb* (1881), 7 Fed. Rep. 222 ; 19 O. G. 937 ; *Day v. Cary* (1859), 1 Fisher, 424 ; *Goodyear v. Cary* (1859), 4 Blatch. 271.

That terms known in the art are

construed as there used, see *Day v. Stelman* (1859), 1 Fisher, 487.

That under Sec. 4888, Rev. Stat., the specification must point out the exact invention, and the patent must be taken as it reads, in the light of common knowledge, until the contrary appears, see *McCloskey v. Dubois* (1881), 19 O. G. 1286 ; 20 O. G. 371 ; 8 Fed. Rep. 710 ; 19 Blatch. 205.

That where a specification misuses words, their ordinary meaning will still have weight, see *Root v. Lamb* (1881), 19 O. G. 937 ; 7 Fed. Rep. 222.

² That the meaning of words in a specification is dependent on the context, and the same words may mean different things in different connections, see *Drummond v. Greenough* (1879), 16 O. G. 959.

ferred and not those which it has more recently embraced.³ Words also are interpreted according to the intent of the inventor, as indicated by their use in the specification, or in the art to which the invention appertains, or in his correspondence with the Patent Office.⁴ Ambiguous words, if capable of no intelligible construction and the object of the patent can be made clearly known without them, may be rejected as surplusage.⁵ General words may be limited in meaning, and special words extended, as the interpretation of the entire instrument requires. The arrangement of words in a sentence is of little moment, if its purport can be accurately discovered.⁶

§ 745. Practical Application of the Foregoing Rules.

In construing a patent in accordance with these rules the first object of attention is the Claim. If this requires no explanation, the court expounds it by the ordinary meaning of its words and defines the invention which it covers.¹ If

³ That the language of a patent will be construed by its meaning at the date of the patent, not by that subsequently acquired, see *McDougal v. Eames* (1872), 2 O. G. 87.

That names are interpreted by evidence of their meaning at the time when they were used, not afterward, see *Florence Sewing Mach. Co. v. Grover & Baker Sewing Mach. Co.* (1872), 110 Mass. 70.

⁴ That the language of a specification is to be interpreted according to the evident intention of the inventor, see *Union Paper Bag Co. v. Nixon* (1873), 6 Fisher, 402 ; 4 O. G. 31.

That general terms and special words are construed to cover the real invention if it can be done without violence to the language of the Claim, see *Fitch v. Bragg* (1881), 20 O. G. 1589 ; 8 Fed. Rep. 588 ; *Estabrook v. Dunbar* (1876), 10 O. G. 909 ; 2 Bann. & A. 427.

⁵ That ambiguous words will be construed to suit the real nature of the invention, see *White v. Allen* (1863), 2 Clifford, 224 ; 2 Fisher, 440.

That ambiguous words in the specification will be controlled by the Claim or treated as superfluous, see *McKesson v. Carnrick* (1881), 9 Fed. Rep. 44 ; 19 Blatch. 158 ; 21 O. G. 137.

That phrases in a specification have no fixed meaning, but are to be interpreted by the courts, see *Union Paper Bag Co. v. Nixon* (1873), 6 Fisher, 402 ; 4 O. G. 31.

⁶ That the specification is construed rather by the true import of the words used than by any arrangement of words, see *Allen v. Hunter* (1855), 6 McLean, 303.

§ 745. ¹ In *Rich v. Close* (1870), 4 Fisher, 279, Woodruff, J. : (283) "It is quite true that in the construction of a Claim reference is to be had to the descriptive portion of the specification, or to any other portion of it, to ascertain the true interpretation of the Claim. But where the Claim is such as to leave no room for construction, where it is clear and explicit, and especially where there is nothing in the specification which shows that the patentee did not

explanation is required, the entire field of inquiry is open. The nature of the actual invention is sought in the history of the art, in the formal statements of the inventor before his patent issued, and in other facts which indicate its character. To this invention the entire description of the patent is applied, and whatever has been properly described and might, therefore, lawfully be claimed, is taken as the true interpretation of the Claim so far as the legitimate use of language will allow.² By this method of construction the rights of the inventor are secured to the fullest extent which is compatible with the preservation of the public right. Whenever he fails of complete protection it is through his own faults of statement, which he may correct by a re-issue.

SECTION II.

OF THE CONSTRUCTION OF LETTERS-PATENT: SPECIAL RULES.

§ 746. Special Rules: Pioneer Patents: Re-issued Patents: Patents Granted by Act of Congress.

In addition to the foregoing general rules, certain special rules of construction have arisen from the application of these

mean just what the plain language of the Claim imports, we are not aided by and have no need of aid from such specification." 8 Blatch. 41 (44).

That a Claim must be construed by its terms when they are clear, and cannot be enlarged by the context, see *White v. Dunbar* (1886), 119 U. S. 47; 37 O. G. 1002.

That where the import of a Claim is clear it cannot be enlarged by the Description, see *Railway Register Mfg. Co. v. Third Avenue R. R. Co.* (1887), 42 O. G. 379.

² In *Johnson v. Root* (1858), 1 Fisher, 351, Sprague, J.: (355) "In determining what it is that the plaintiff has secured to him by his patent from the Government, the court looks, in the first place, at what is called, technically, the

Claim, which is the summing up, at the close of the patent, or specification preceding, the Claim being in the terms: 'What I claim to have invented, and wish to secure by letters-patent, is ———,' and then a condensed statement of what he wishes to have secured to him by his patent. But in construing that we take into view the whole of what precedes it in the specification, and also such extraneous facts presented by the evidence as may aid in giving the true construction to the patent, particularly the documents from the Patent Office which have preceded the granting of the patent itself." See also *Woodman v. Stimpson* (1866), 3 Fisher, 98; *Whipple v. Baldwin Mfg. Co.* (1858), 4 Fisher, 29; and § 739 and notes, *ante*.

general rules to particular cases. A pioneer patent, introducing to the public some art or instrument entirely new, must be interpreted as liberally as its language will permit in order to protect the original conception in its widest form, notwithstanding any Description or Claim for specific details which the patent may contain.¹ A re-issued patent, if ambiguous and uncertain in itself, may be aided by referring to the specifications, drawings, and model of the original.² A patent granted by special act of Congress, upon representations made by the inventor as to the real nature of his invention, must be limited to the invention as thus represented, whatever else the terms of the patent might otherwise include.³

§ 746. ¹ That the Claims of a pioneer patent are to be construed broadly, see *Kirk v. DuBois* (1887), 42 O. G. 297; *Hammerschlag Mfg. Co. v. Bancroft* (1887), 40 O. G. 1339; 32 Fed. Rep. 585; *May v. County of Fond du Lac* (1886), 27 Fed. Rep. 691; *Thayer v. Spaulding* (1886), 27 Fed. Rep. 66; 36 O. G. 1044; *Worswick Mfg. Co. v. City of Buffalo* (1884), 22 Blatch. 157; 27 O. G. 1239; 20 Fed. Rep. 126; *Pickhardt v. Packard*, (1884), 23 Blatch. 23; 30 O. G. 179; 22 Fed. Rep. 530.

That a pioneer patent is not to be limited to specific details if it is fairly open to a liberal construction, see *Hammerschlag v. Scamoni* (1881), 7 Fed. Rep. 584; 20 O. G. 75.

That when a new art is discovered and patented the Claims of the patent are broadly construed so as to cover all means of practising it, see *Standard Measuring Machine Co. v. Teague* (1883), 15 Fed. Rep. 390; *Kimball v. Hess* (1883), 15 Fed. Rep. 393; 26 O. G. 107.

That on a question of joinder the rule of construction is most liberal, see *Ex parte Herr* (1887), 41 O. G. 463.

² That the Claims of a re-issue, if obscure, may be interpreted by the original specifications and drawings, see *Bussey v. Wager* (1875), 9 O. G. 300.

That an original patent can be referred to in order to construe the re-issue, see *Reedy v. Scott* (1874), 23 Wall. 352; 7 O. G. 463.

That in construing a re-issued patent the new matter claimed may be referred to as interpreting the good Claims, but only so far as it could properly have appeared in the original specification, see *Schillinger v. Cranford* (1885), 4 Mackey, 450; 37 O. G. 1349.

³ That a patent granted by special act of Congress will be limited by representations made by the patentee to Congress in order to obtain the patent, see *Union Mfg. Co. v. Lounsbury* (1863), 2 Fisher, 389.

That a patent, having been irregularly granted and afterwards confirmed by special act of Congress, is to be governed and construed by the law in force when it was originally granted, see *New American File Co. v. Nicholson File Co.* (1881), 20 O. G. 524; 8 Fed. Rep. 816.

§ 747. Special Rules: Claims for Combinations: Improvements:
Joint Inventions.

A Claim for a combination is to be construed liberally in order to support the combination, although another Claim is made for a special arrangement of the same elements.¹ Where a combination apparently claimed is shown to be old, the Claim may be interpreted to cover the particular elements employed, if the language of the Claim is capable of that construction.² The use of the word "combination" in some Claims, and not in others, indicates an intention to exclude the combination from the latter.³ A patent for an improvement will be read in the light of the original invention and its own relations thereto.⁴ A patent for a joint invention,

§ 747. ¹ That a Claim for a combination will be construed broadly, though another Claim is made for a special arrangement of the same elements, see *Ex parte Marsh* (1872), 2 O. G. 197.

That in patents for combinations the limitations imposed by the inventor, especially after the rejection of a Claim, must be strictly construed in favor of the public as disclaimers, see *Sargent v. Hall Safe & Lock Co.* (1885), 114 U. S. 63; 31 O. G. 661.

That a patent for a combination cannot be construed to cover an element expressly disclaimed, see *Shaver v. Skinner Mfg. Co.* (1887), 41 O. G. 232.

That the courts cannot by construction eliminate a claimed element of a combination simply because it is practically useless, see *Williams v. Stolzenbach* (1885), 23 Fed. Rep. 39; 30 O. G. 891.

That all claimed elements are to be regarded as material in construing the patent, see *Sargent v. Hall Safe & Lock Co.* (1885), 114 U. S. 63; 31 O. G. 661; and §§ 156, 278, 282, 527, and notes, *ante*.

That a Claim for a combination includes everything which is either expressed or necessarily implied to be material, see *Thompson v. Gildersleeve* (1888), 43 O. G. 886.

That a Claim for an arrangement of all the parts constituting the article is construed as a Claim for the article itself, see *Donoughe v. Hubbard* (1886), 27 Fed. Rep. 742; 35 O. G. 1561.

That a Claim for a process consisting of several steps may be limited by the state of the art and the Description of the patent to the instrumentalities described, or their equivalents, which are essential to the performance of the process, see *Lawther v. Hamilton* (1888), 42 O. G. 487.

That a Claim for a combination may be construed as a Claim for a manufacture, see *Duff v. Calkins* (1883), 25 O. G. 601.

That a Claim for a combination covers all its effects though they are not named, see *Thompson v. American Bank Note Co.* (1888), 45 O. G. 347.

² That a Claim for a combination shown to be old may be construed as a Claim for the particular devices employed, see *Clough v. The Gilbert & Barker Mfg. Co.* (1878), 15 O. G. 1009.

³ That the use of the word "combination" in some Claims but not in others excludes the idea of it from the latter, see *Burden v. Corning* (1864), 2 Fisher, 477.

⁴ That a Claim for an improvement is

which is subsidiary to a prior sole invention, cannot be so construed as to embrace the sole invention.⁵

§ 748. Special Rules: Claims for Principles, Functions, or Effects.

A Claim for the principle or force employed in an invention will be interpreted, if possible, as a Claim for the instrument or operation by which the force is applied to its appropriate object.¹ A Claim for a function, where the specification describes the device or apparatus which performs it, will be construed as intended to cover such apparatus or device.² A Claim for a result or effect will be considered as a Claim for the means by which the effect is produced, if the specification, as a whole, is open to that interpretation.³

§ 749. Special Rules: Claims for an Entirety not Divisible: Claims for Separate Devices not Consolidated.

A Claim for an entire instrument or process, consisting of several steps or divisible parts, cannot usually be divided by construction in such a manner as to cover these independent members.¹ If the interpretation given to the invention by the specification, however, indicates that these steps or parts

to be construed in view of the original and its relations to it, see *Brown v. Selby* (1871), 2 Bissell, 457; 4 Fisher, 363.

That the court can determine whether two designs are the same by comparing them, see *Jennings v. Kibbe* (1882), 10 Fed. Rep. 669; 22 O. G. 331; 20 Blatch. 353; and §§ 201-207, 306, and notes, *ante*.

⁵ That a joint invention, subsidiary to a prior invention of one of the joint inventors, cannot be so construed as to include it, see *Hopkins & Dickinson Mfg. Co. v. Corbin* (1878), 14 Blatch. 396; 14 O. G. 3.

§ 748. ¹ That a Claim will not be construed to cover a principle if it can be so interpreted as to apply to a device, see *Union Paper Bag Co. v. Nixon* (1873), 4 O. G. 31; 6 Fisher, 402; and §§ 508, 509 and notes, *ante*.

² That functional Claims will be construed, if possible, as Claims for what performs the function, see *Albany Steam Trap Co. v. Felthousen* (1884), 22 Blatch. 169; 20 Fed. Rep. 633; *Mfg. Co. v. Ladd* (1877), 11 O. G. 153; 2 Bann. & A. 488; *Ex parte Shippen* (1875), 8 O. G. 727; and § 518 and notes, *ante*.

³ That a Claim for a result will be construed, if possible, to be a Claim for a means of effecting a result, see *Palmer v. Gatling Gun Co.* (1881), 8 Fed. Rep. 513; 19 Blatch. 392; 20 O. G. 815; *Henderson v. Cleveland Co-operative Stove Co.* (1877), 2 Bann. & A. 604; 12 O. G. 4; and § 519 and notes, *ante*.

§ 749. ¹ That a Claim for a whole cannot be divided by construction so as to cover the parts, see *Evans v. Kelly* (1880), 9 Bissell, 251; 13 Fed. Rep. 903; 23 O. G. 192; 5 Bann. & A. 71.

are the true means conceived by the inventor, the Claim may be extended to embrace them.² Two apparently separate Claims cannot be construed together as one Claim and be thus supported by each other.³

§ 750. Special Rules: Foreign Words: "Substantially as Described:" "Generic," etc.

Foreign words occurring in a patent are to be interpreted by the context and the real object of the inventor, and to receive such meaning as will effect his intention.¹ The phrase "substantially as described," in the Claim, signifies much or little, as the patentee evidently designed.² This phrase is always supposed to be incorporated in the Claim, whether or not it is actually inserted.³ In any case it relates only to the material features of the invention, as shown by its purpose and by the elements which compose it and

² That effect is to be given to the whole description in the specification and drawings, and if it can be seen that the patentee intended to claim the parts separately, the patent must be so construed, see *National Car Brake Shoe Co. v. Lake Shore & Michigan Southern R. R. Co.* (1880), 9 Bissell, 503; 18 O. G. 1179; 4 Fed. Rep. 219.

³ That two apparently separate Claims cannot be construed as one, and be supported by each other, see *Seymour v. McCormick* (1856) 19 How. 96.

That two patents cannot be construed to supplement each other, see *Blades v. Rand, McNally, & Co.* (1886), 27 Fed. Rep. 93; 37 O. G. 99.

That a Claim covering a class, where the invention is only one of the class, is confined to the invention, see *Opinion Atty. Gen.* (1856), 8 Op. Atty. Gen. 269.

§ 750. ¹ That foreign words will be interpreted by the context, and the real nature of the invention, see *White v. Allen* (1863), 2 Fisher, 440; 2 Clifford, 224.

² That the phrase "substantially as

described" means much or little, as the intention of the patentee requires, see *Seymour v. Osborne* (1869), 3 Fisher, 555.

³ That the words "substantially as described" are always understood in the Claim, and refer to the specification, see *Matthews v. Schoneberger* (1880), 4 Fed. Rep. 635; 18 O. G. 1464; 18 Blatch. 357; *Westinghouse v. Gardner & Ranson Air Brake Co.* (1875), 2 Bann. & A. 55; 9 O. G. 538; *Mitchell v. Tilghman* (1873), 19 Wall. 287; 5 O. G. 299; and § 517 and notes, *ante*.

That Claims referring to the specification must be construed by it, see *Gottfried v. Phillip Best Brewing Co.* (1879), 5 Bann. & A. 4; 17 O. G. 675; *Sickels v. Evans* (1863), 2 Fisher, 417; 2 Clifford, 203.

That the Claim may be construed by the specification so as to be good, though on its face it covers only a function or a result, if it refers to the specification by the words "substantially as described," see *Seymour v. Osborne* (1870), 11 Wall. 516; *Seymour v. Osborne* (1869), 3 Fisher, 555.

enable it to accomplish its results.⁴ The similar phrase "as herein described" likewise refers to the specification for a fuller and more exact statement of the subject-matter of the Claim.⁵ The word "specification" is sometimes employed to denote both the Claim and the Description, and sometimes only the Description. In statutes and elsewhere, when it is used alone, it has the former meaning; when the word "Claim" is also used, it has the latter.⁶ The term "generic" varies in its application. It is a relative term, the same invention being generic as to some inventions and specific as to others.⁷ It is to be interpreted according to the nature of the operation or instrument to which it is applied, and the position of such instrument or operation in the art to which it belongs. The word "manufacture" may denote the article made, or the means by which it is produced.⁸

⁴ In *Waterbury Brass Co. v. Miller* (1871), 9 Blatch. 77, Woodruff, J.: (97) "They relate only to material features of the combination specified, and these are to be ascertained by considering the object or purpose of the machine, and what are the elements of the combination which create its distinctive character, and are effective in producing the peculiar result for which the contrivance is made." 5 Fisher, 48 (68).

That in the Claim the words "in the manner and for the purposes herein specified" should not be construed to cover every part shown in the drawings and Description, nor to confine the invention to the precise form therein shown, see *Reed v. Chase* (1885), 25 Fed. Rep. 94; 33 O. G. 996.

⁵ That the words "as herein described" or "set forth" refer to the specification, and may embrace elements not mentioned in the Claim, see *Vance v. Campbell* (1859), 1 Fisher, 483.

That the words in the Claim "all as shown and described" limits the Claim to the exact thing shown, see *Osceola Mfg. Co. v. Pie* (1886), 28 Fed. Rep. 83.

⁶ In *Wilson v. Coon* (1880), 18 Blatch. 532, Blatchford, J.: (535) "The word 'specification,' when used separately from the word 'claim,' in § 4916, means the entire paper referred to in § 4888, namely, the written description of the invention, 'and of the manner and process of making, constructing, compounding, and using it,' and the Claims made. The word 'specification,' meaning Description and Claims, is used in that sense in §§ 4884, 4895, 4902, 4903, 4917, 4920, and 4922. In some cases, as in §§ 4888 and 4916, the words 'specification and claim' are used, and in § 4302 the word 'description' and the word 'specification' are used. But it is clear that the word 'specification,' when used without the word 'claim,' means Description and Claim." 19 O. G. 482 (482); 6 Fed. Rep. 611 (615). See also §§ 655-657 and notes, *ante*.

⁷ That the term "generic" is relative, the same invention being "generic," as to some, and "specific" as to others, see *Ex parte Ewart* (1880), 17 O. G. 448; and §§ 535, 536, and notes, *ante*.

⁸ That the word "manufacture" may

§ 751. Special Rules: Terms Admitting of Degrees: Other Terms.

Terms admitting of degrees — such as “tight,” “hard,” “hot,” and the like — refer to that degree which is best suited to the purposes of the invention as indicated by its practical use.¹ The phrase “in any other convenient manner” includes every method which the invention can perform.² “Suitable materials” embrace all known materials proper for the purpose.³ The “making” or “selling” of a substance is essentially distinct from its “use,” and a patent for the latter does not confer upon the patentee any exclusive right to the former.⁴ Other special words are interpreted in view of the practical character of the invention and as they would ordinarily be employed by persons skilled in the art.⁵

mean the article made, or the work of making it, see *Shaw v. Colwell Lead Co.* (1882), 20 Blatch. 417; 11 Fed. Rep. 711.

§ 751. ¹ That terms admitting of degrees of meaning, such as “tight,” “hard,” etc., mean such degree as is suited to the purposes of the invention, see *Robinson v. Sutter* (1881), 8 Fed. Rep. 828; 19 O. G. 127; 10 Bissell, 100.

The words “to be hardened,” in a Description, mean to be made as hard as possible, see *Monce v. Adams* (1874), 7 O. G. 177; 1 Bann. & A. 126; 12 Blatch. 1.

² That in the specification the phrase “or in any other convenient manner,” is construed to cover such manner as the device can perform, see *Illinois Central R. R. Co. v. Turrill* (1876), 94 U. S. 695; 12 O. G. 709.

³ That the phrase “suitable materials” means “known materials,” see *Bailey Washing & Wringing Mach. Co. v. Lincoln* (1871), 4 Fisher, 379.

⁴ That a patent for the “use” of a thing does not cover the making and selling of it, see *Keystone Bridge Co.*

v. Phoenix Iron Co. (1872), 5 Fisher, 468; 1 O. G. 471.

⁵ That “jointly” in a Claim may mean “by united action,” not necessarily “simultaneously,” see *Gold & Stock Telegraph Co. v. Commercial Telegram Co.* (1885), 23 Blatch. 199; 23 Fed. Rep. 340; 31 O. G. 1558.

That “perfect” means perfect according to the standard required in the art, see *Adams v. Bridgewater Iron Co.* (1886), 26 Fed. Rep. 324; 34 O. G. 1045.

That “free from defect” means sufficiently free for practical purposes, see *Adams v. Bridgewater Iron Co.* (1886), 26 Fed. Rep. 324; 34 O. G. 1045.

That “concavo-convex” means such a degree of each as mechanical judgment may show to be needed, see *Temple Pump Co. v. Goss Pump & Rubber Bucket Mfg. Co.* (1887), 39 O. G. 467; 30 Fed. Rep. 446.

That the words “or other part” mean “or other equivalent part,” and do not render the Claim uncertain, see *Babcock & Wilcox Co. v. Pioneer Iron Works* (1888), 43 O. G. 756.

CHAPTER V.

OF THE TRANSFER OF LETTERS-PATENT.

§ 752. Patented Inventions are Property, and as Such Transferable.

A PATENTED invention, being capable of exclusive possession and dominion, is property, and occupies the same legal position and is governed by the same legal rules as any other object of human ownership. The patentee has the same rights in it, and the same authority over it, that are vested in him as to any class of property.¹ His title to it rests on the same ultimate basis of prior occupancy, receives the same sanction and vindication through the provisions of positive law, and is held and enjoyed upon the same general conditions of subservience to the rights of others and to the public good. And as, like most species of property, its value to its owner resides principally in his power to dispose of it for different property, its transfer by the patentee to other persons is restricted only by the nature of the property itself.² Of what forms of transfer a patented invention is capable is thus an inquiry preliminary to any discussion of the modes by which it may be practically conveyed.

§ 753. Property in a Patented Invention Twofold: the Invention, and the Monopoly.

The property in a patented invention is composed of two different elements, distinct in their origin, in their nature,

§ 752. ¹ That an invention belongs to the inventor as fully as any other property, see *Sloat v. Patton* (1852), 1 Fisher, 154; and § 61 and notes, *ante*. *Campbell v. James* (1880), 2 Fed. Rep. 338; 18 Blatch. 92; 18 O. G. 1111; *Parker v. Haworth* (1848), 4 McLean, 370; 2 Robb, 725.

² That every patent and every interest in a patent is transferable, see *Howe v. Chatham* (1885), 64 Tex. 36; *Pope Mfg. Co. v. Gormully & Jeffrey Mfg. Co.* (1888), 34 Fed. Rep. 893.

and in the subordinate rights into which they may be divided. The first of these elements is the property in the invention itself. This element originates in the inventive act by which the invention was produced, consists of the right to practise the invention, and is divisible into the subordinate rights to make, use, and sell the art or instrument invented. The second element is the property in the patent privilege by which the invention is protected. This element originates in a grant of the sovereign power acting under the enactments of positive law, consists in the right to prevent all persons except the patentee from practising the invention, and is divisible into the subordinate rights to prohibit the making, use, or sale of the invention except upon such terms or by such persons as the patentee may deem expedient, and to obtain redress for its forbidden making, use, or sale. The first of these two elements is wholly independent of the second. It exists equally whether the invention is patented or not, and it may be transferred by the inventor either as a whole or as to any one or more of its subordinate rights. Nor does this element draw after it the second. While the invention remains a secret with the inventor or his transferees, their enjoyment of its benefits may be exclusive, but if it becomes known to others, their ownership of the invention confers upon them no power to prevent its general use. The necessity for the second element then first arises, and this being obtained bestows authority on the inventor to restrict the practice of the invention within such limits as he pleases, and to recover compensation from all persons who infringe on his exclusive rights. This second element is thus a mere prohibitory power.¹ While it confers a monopoly on

§ 753. ¹ *In re Brosnahan* (1883), 4 McCrary, 1, Miller, J. : (5) "It is to be observed that no constitutional or statutory provision of the United States was, or ever has been, necessary to the right of any person to make an invention, discovery, or machine, or to use it when made, or to sell it to some one else. Such right has always existed and would exist now if all patent laws were repealed. It is a right which may

be called a natural right, and which, so far as it may be regulated by law, belongs to ordinary municipal legislation ; and it is unaffected by anything in the Constitution or Patent Laws of the United States. The sole object and purpose of the laws which constitute the patent and copyright system is to give to the author and the inventor a monopoly of what he has written or discovered, — that no one else shall make

the inventor, it neither creates the invention nor any of the rights which accrue from the inventive act. On the contrary, it presupposes their existence, and if they do not exist the grant of the monopoly is void. Both its own nature and the purposes for which it is bestowed, however, render it so far dependent on the former element that it cannot subsist except in the inventor or in those to whom he has conveyed some interest in the invention; though any interest in the invention less than the exclusive right to make and use and sell may be transferred by the inventor without bestowing any part of his monopoly. Hence in every patented invention there are two objects capable of alienation,—the invention or the right to make, use, and sell the patented art or instrument, and the monopoly or the right to prohibit others from practising the invention, and to obtain redress for its forbidden making, use, or sale. The principles which govern the alienation of these objects are very different.

§ 754. **Property in the Invention Transferable without Restriction.**

The alienation of the invention, or the rights to make, use, or sell, is unrestricted by the nature of the property or the rules of law. The owner of the invention may confer these rights, either separately or together, upon one person or upon many different persons, and each may exercise the rights so conferred without reference to the others.¹ He may transfer them before or after the patent is granted, and may or may

or use or sell his writings or his invention without his permission; and what is granted to him is the exclusive right, not the abstract right, but the right in him to the exclusion of everybody else.

. . . (6) the purpose of the Patent Law and of the constitutional provision are answered when the patentee is protected against competition in the use of his invention by others; and when the law prevents others from infringing on his exclusive right to make, use, or sell, its object is accomplished." 18 Fed. Rep. 62 (64).

Further, that a patent gives only a

right to exclude others from practising the invention, see *De Witt v. Elmira Nobles Mfg. Co.* (1875), 5 *Hur.*, 301; *Hawks v. Swett* (1875), 4 *Hun.*, 146; 6 *Thomp. & C.* 529; *Bloomer v. McQuewan* (1852), 14 *How.* 539.

§ 754. ¹ That the rights to make, to use, and to sell, are essentially distinct and may be separately granted, see *Dorsey Revolving Harvester Rake Co. v. Bradley Mfg. Co.* (1874), 12 *Blatch.* 202; *Adams v. Burke* (1873), 17 *Wall.* 453; 33 *O. G.* 114; *Jenkins v. Greenwald* (1857), 2 *Fisher.* 37; 1 *Bond.* 128.

not unite with this transfer a conveyance of the entire monopoly or any lawful interest therein.² Such transfer does not take effect by virtue of his patent, if he has procured one, nor does its validity as against him depend on the legality of the monopoly which he has received. Its sole relation to the patent arises from the fact that the patentee is not permitted to exercise the prohibitory powers of his monopoly against those to whom he has transferred a right to the invention, and is compelled in certain cases to employ these powers for their protection.

§ 755. Property in the Monopoly Transferable only within Certain Limits.

The alienation of the monopoly created by the patent is, on the other hand, restricted both by its own nature and the rules of law. Of its own nature it is indivisible, except as to the territorial area over which it may be exercised.¹ That each of two independent persons should possess the power to prohibit the practice of an invention in the same locality involves a contradiction of terms; for as this prohibitory power cannot exist apart from the property in the invention, each would at once have a right to make, use, and sell the patented invention and yet be subject to the prohibition of the other. An indivisible monopoly may reside in one person or in several. It may be vested in one owner as to one section of

² That a sale of the patented device and of the right to use it, conveys no part of the monopoly, see *Goodyear v. Beverly Rubber Co.* (1859), 1 Clifford, 348.

§ 755. ¹ In *Gayler v. Wilder* (1850), 10 How. 477, Taney, C. J. : (494) "For it was obviously not the intention of the legislature to permit several monopolies to be made out of one, and divided among different persons within the same limits. Such a division would inevitably lead to fraudulent impositions upon persons who desired to purchase the use of the improvement, and would subject a party who, under a mistake as to his rights, used the invention

without authority, to be harassed by a multiplicity of suits instead of one, and to successive recoveries of damages by different persons holding different portions of the patent right in the same place."

Further, that the monopoly is indivisible except as to locality, see *Sanford v. Messer* (1872), 2 O. G. 470; 5 Fisher, 411; *Holmes*, 149; *Burr v. Duryee* (1862), 2 Fisher, 275; *Metropolitan Washing Machine Co. v. Earle* (1861), 3 Wall. Jr. 320; 2 Fisher, 203; *Goodyear v. Railroad* (1853), 1 Fisher, 626; *Suydam v. Day* (1846), 2 Blatch. 20; and § 61 and notes, *ante*.

country and in a different owner as to another, but wherever it exists, it must exist as an entirety. It might indeed be possible, in theory, to sever the monopoly in correspondence to the rights embraced in the invention, conferring upon one person the power to prohibit all others from making the invention, upon another the power to forbid its use, and upon another the authority to prevent its sale; but the practical result of such divisions upon the rights of the respective monopolists, as well as upon those of the owners of these various interests in the invention, would be too disastrous to be long tolerated by an industrial community. The law, therefore, peremptorily forbids such multiplication of monopolies, and provides that the prohibitory powers bestowed upon the patentee shall be regarded as indivisible in subject-matter, and constitute but one monopoly in any given portion of the United States.²

§ 756. Transfers of Two Classes: First Class Transfers both the Invention and the Monopoly.

These differences between the alienability of an invention and that of the monopoly created by the patent indicate the differences between the two great classes of conveyances by which the transfer of an interest in a patented invention is effected. One of these classes operates directly both on the invention and on the monopoly. It not only conveys the entire or partial interest in the invention, conferring on the transferee the right to practise it, but it also bestows upon him the prohibitory power by virtue of which he can, within the area specified in his conveyance, prevent all other persons from enjoying it, and compel those who transgress to make him compensation for the injury. And as the power to prohibit includes the power to relieve from prohibition, this transferee, in alienating rights, in his turn, to practise the invention, emancipates his alienees from the restrictions of

² In *Gayler v. Wilder* (1850), 10 How. 477, Taney, C. J. : (495) "Unquestionably, a contract for the purchase of any portion of the patent right may be good as between the parties as a license, and enforced as such in the courts of justice. But the legal right in the monopoly remains in the patentee, and he alone can maintain an action against a third party who commits an infringement upon it." See also *Sanford v. Messer* (1872), 5 Fisher, 411; *Holmes*, 149; 2 O. G. 470.

the monopoly to an extent commensurate with their respective interests in the invention.

§ 757. Second Class Transfers the Invention, but not the Monopoly.

The second class of conveyances operates directly only upon the invention. It transfers no interest in the monopoly, though it protects the transferee against the exercise of the prohibitory powers and enables him in certain cases to invoke them in his favor. It vests in him no authority either to forbid others to practise the invention, or to bestow upon them the right to its enjoyment; though when his interest in the invention is made alienable by the express terms of his conveyance, or by legal implication, his alienee receives the same rights, under the same restrictions and with the same degree of deliverance from the monopoly. Such a conveyance does not rest upon the patent nor affect the exclusive ownership of the monopoly by the patentee or those to whom, by the first class of conveyances, it has been transferred. Its sole operation upon the monopoly is that of an estoppel, — the transferor, and all persons who derive a title to the monopoly from him after the transfer of such interest in the invention, being estopped from enforcing their prohibitory powers against the transferee in such a manner as to impair the value of the interest transferred.

§ 758. No Transfer can be of the First Class unless it Conveys the Entire Interest, or an Undivided Portion of the Entire Interest, in the Invention for the Whole or for Some Definite Part of the United States.

The final test to which the conveyance of an interest in a patented invention is to be subjected, in order to determine whether it belongs to the former or the latter class, is found in the same difference between the alienability of an invention and of a monopoly. As the monopoly is created and subsists only to secure the benefits of the invention to its lawful owners, so the monopoly cannot exist except in one who owns the entire interest or a partial interest in the invention. It thus resides originally in the patentee, who

is the owner of the invention at the issue of the patent, and must remain in him until legally conveyed by him to others.¹ But the monopoly being indivisible in subject-matter cannot be transferred in connection with any one of the subordinate rights in the invention and still vest in the patentee in reference to the other rights which he retains. If he conveys the right to make the invention, or the right to use it or to sell it, or any two of these without the third, the monopoly is not affected, since it cannot follow these rights into the alienee, and therefore must remain entirely in the patentee. Nor where these subordinate rights in the invention are themselves divided and conveyed can the monopoly be divided and transferred with them. The conveyance of a right to make and use and sell the invention, leaving in the patentee an independent right to make and use and sell, is proper as a transfer of the invention, but has no operation upon the monopoly; for the monopoly, being indivisible, must either follow the rights conferred upon the transferee and reside in its entirety in him, or continue undivided in the patentee; and the retention by the latter of his rights in the invention is inconsistent with an intention to confer the whole monopoly upon another. But the alienation of the entire interest in the invention or of an undivided portion of the entire interest, either for the whole or any sectional part of the United States, operates also as the transfer of a similar interest in the monopoly. When the patentee conveys the exclusive right to make, use, and sell the invention he has no longer any occasion for the exercise of the prohibitory powers created by the patent, while they become essential to his alienees for the assertion and vindication of their exclusive rights. If he transfers an undivided portion of the entire interest in the invention, he thereby confers upon his transferees rights equal to his own, in all respects, in the invention, and receives them into co-ownership with himself in the monopoly which is now as essential to their protection as it was to his.² And the monopoly being divisible as to locality,

§ 758. ¹ That there are no owners of a patent except the patentee and his assignees or grantees, see *Jordan v. Dob-*

son (1870), 2 *Abbott*, 398; 4 *Fisher*, 232; 7 *Phila.* 533.

² That an assignment of an undivided

when he bestows on any person the exclusive rights in the invention or an undivided portion of the exclusive rights within a given area, the monopoly to the same territorial extent passes entirely, in the first case, to the alienee, and in the second, resides undivided in the joint-ownership of both.³ From these principles it is evident that no conveyance can belong to the first class, and directly operate upon the monopoly, unless it transfers the entire interest in the invention or an undivided portion of such entire interest either for the whole or some defined part of the United States, and that every conveyance which leaves in the owner of the patented invention any distinct and independent right therein is of the second class, and can have no effect on the monopoly, except as it estops the owner of the patent from asserting his prohibitory powers in opposition to the rights conferred by him upon his alienee.

§ 759. First Class Divisible into Two Sub-Classes according to the Territorial Limits of the Monopoly Granted.

The first class of conveyances may evidently be subdivided into two inferior classes on the line fixed by the divisibility of the monopoly,—one subdivision embracing those conveyances which transfer the entire interest in the invention, or an undivided portion of the entire interest, for the whole United States; the other subdivision including those by which the entire interest, or an undivided part thereof, within some specified area is alienated.¹ The difference between these subdivisions

part of a patent makes the assignee and the patentee joint-owners, see *Potter v. Holland* (1858), 4 Blatch. 206; 1 Fisher, 327.

³ That the sale of the exclusive right to make, use, and vend in a particular place confers a portion of the patent privilege, see *Goodyear v. Beverly Rubber Co.* (1859), 1 Clifford, 348.

§ 759. ¹ In *Gayler v. Wilder* (1850), 10 How. 477, Taney, C. J. : (494) “ By the eleventh section of the act of 1836, the patentee may assign his whole interest, or an undivided part of it. But if

he assigns a part under this section, it must be an undivided portion of his entire interest under the patent, placing the assignee upon an equal footing with himself for the part assigned. Upon such an assignment, the patentee and his assignees become joint-owners of the whole interest secured by the patent, according to the respective proportions which the assignment creates. By the fourteenth section, the patentee may assign his exclusive right within and throughout a specified part of the United States, and upon such an assignment the

relates, not to the nature, but to the territorial limits of the rights and powers which they confer: A conveyance of the former species vests in the transferee, either alone or jointly with his transferor or others, the right to practise the invention, and to exercise prohibitory authority, anywhere within the United States. A conveyance of the latter species has the same effect within the boundaries which it describes.

**§ 760. Forms of Transfer Corresponding to the Foregoing Classes :
First Class, Assignment and Grant: Second Class, License.**

The acts of Congress in providing for the transfer of interests in letters-patent, and the Federal courts in adjudicating upon the rights of parties to such transfer, have conformed to the essential nature of a patented invention, as thus described, and to the principles upon which its alienation must inevitably be based. The statutes recognize only two modes by which the monopoly may be transferred, — one by a conveyance of the entire interest in the invention, or of an undivided part thereof, for the whole country ; the other by a conveyance of a similar interest, or part interest, within some portion of the United States.¹ To the former conveyance the courts have given the technical name of an Assignment; the latter they have called a Grant.² The conveyance of the subordinate rights in the invention, either separately or united, without affecting the monopoly otherwise than by estoppel, is also permitted ; and the interests thus created are fully vindicated and sustained. To this conveyance custom and judicial sanction have attached the name of License.³

assignee may sue in his own name for an infringement of his rights. But in order to enable him to sue, the assignment must undoubtedly convey to him the entire and unqualified monopoly which the patentee held in the territory specified, — excluding the patentee himself, as well as others. And any assignment short of this is a mere license." See also *Littlefield v. Perry* (1874), 21 Wall. 205 ; 7 O. G. 964.

§ 760. ¹ That there can be no assign-

ment except of either an entire interest or an undivided interest in the whole United States, or of an entire interest, or an undivided interest, in a certain territory, see *Littlefield v. Perry* (1874), 21 Wall. 205 ; 7 O. G. 964.

² That the terms "assignee" and "grantee" are not synonymous, see *Potter v. Holland* (1858), 1 Fisher, 327; 4 Blatch. 206.

³ That there are three forms of conveyance : Assignment, Grant, and Li-

§ 761. **Transfer of Patented Inventions Unrestricted except by their own Nature.**

Subject to the restrictions established by the nature of a monopoly, a patented invention is as freely alienable as any other personal property.¹ Every interest therein may reside in one owner or in several joint-owners, and may be enjoyed in any way which is compatible with the character of the interest itself.² The rights and obligations created between the parties by the transfer of these interests are governed by the ordinary rules which are applied to all contracts. The prohibitory powers, which vest in the owners of the monopoly by virtue of the patent, are controlled and exercised according to the special provisions of the Patent Law.³ These will now be examined in detail, in reference to each of the forms of conveyance — Assignment, Grant, and License — in their order.

SECTION I.

OF THE TRANSFER OF LETTERS-PATENT: ASSIGNMENT: GRANT.

§ 762. **Assignment Defined: Its Effect.**

An assignment is a transfer of the entire interest in a patented invention, or of an undivided portion of such entire interest, as to every section of the United States.¹ It operates

cense, see *Potter v. Holland* (1858), 1 *Fisher*, 327; 4 *Blatch*. 206.

§ 761. ¹ That all interests in patents are assignable, see *Campbell v. James* (1880), 2 *Fed. Rep.* 338; 18 *Blatch*. 92; 18 *O. G.* 1111.

That any contract may be made concerning patents provided it does not enlarge the right, see *Star Salt Caster Co. v. Crossman* (1878), 3 *Bann. & A.* 281; 4 *Clifford*, 568.

That under the laws of New York an assignment which suspends the power of alienation longer than the lives of the assignors does not create a perpetuity, since all may join in a transfer at

any time, see *Ladd v. Mills* (1884), 22 *Blatch*. 242; 20 *Fed. Rep.* 792.

² That a patent may be assigned either in whole or in part, see *Parker v. Haworth* (1848), 4 *McLean*, 370; 2 *Robb*, 725; *Boyd v. McAlpin* (1844), 3 *McLean*, 427; 2 *Robb*, 277.

³ That an assignment and all rights under it rest on the statute, see *Gayler v. Wilder* (1850), 10 *How.* 477; *Suydam v. Day* (1846), 2 *Blatch*. 20; and § 61 and notes, *ante*.

§ 762. ¹ In *Potter v. Holland* (1858), 4 *Blatch*. 206, *Ingersoll, J.*: (211) "An assignee is one who has had transferred to him in writing the whole interest of the

both upon the invention and upon the monopoly, and conveys them, either wholly or in part, to the assignee. When the entire interest is assigned, it substitutes the assignee for the original patentee, conferring upon him, to their full extent, the rights embraced in the invention and the prohibitory powers bestowed by the patent.² Where an undivided interest is transferred, it places the assignee upon an equality, in all respects, with his assignor and the original patentee, vesting in him complete but not exclusive rights and powers as to the monopoly and the invention.³

§ 763. **Assignments Distinguished from Grants : from Licenses.**

To determine whether a given conveyance is an assignment or a grant involves little practical difficulty,—the essential difference between them consisting in the territorial area to which they relate.¹ An assignment and a license are, how-

original patent, or any undivided part of such whole interest, in every portion of the United States ; and no one, unless he has had such an interest transferred to him, is an assignee." 1 Fisher, 327 (333).

² That the assignment of a patent is a sale of personal property, see *Holden v. Curtis* (1819), 2 N. H. 61.

That an assignee, as well as a patentee, is entitled to an injunction, see *Jenkins v. Greenwald* (1857), 1 Bond, 126 ; 2 Fisher, 37.

³ That an assignment of an undivided interest makes the assignor and assignee joint-owners of the patent, see *Potter v. Holland* (1853), 4 Blatch. 206 ; 1 Fisher, 327.

§ 763. ¹ In *Meyer v. Bailey* (1875), 2 Bann. & A. 73, McKennan, J.: (76) "What is meant by an assignee seems now to be settled by repeated adjudication, and by the explicit definition of the act of 1836. In *Taylor v. Fuel*, 6 Cranch, it was held, under the act of 1793, that one to whom was transferred all the rights secured by a patent, excepting certain counties in the State of

Vermont, was not an assignee within the meaning of the law, but a mere grantee of a sectional interest in the patent ; and in *Whittemore v. Cutter*, 1 Gallison, 429, it was held that the transferee of an undivided part of an entire patent was an assignee. From these decisions it results that only a person who is invested with the entire ownership of a patent or an undivided part of the whole is to be regarded as an assignee. Such, also, is the import of the act of 1836, in the eleventh section of which it is provided that 'every patent shall be assignable in law, either as to the whole interest or any undivided part thereof, by any instrument in writing,' and this assignment, 'and also every grant and conveyance of the exclusive right under any patent to make and use the thing patented within and throughout any specified portion of the United States, shall be recorded,' &c. The distinction established by previous judicial decisions between an assignee and the grantee of a sectional interest in a patent is evidently contemplated by this section, as it is also by the fourteenth sec-

ever, more easily confounded. They are alike in that each may apply to the entire United States, and each may operate upon all the rights embraced in the invention. They are unlike in that an assignment transfers also some interest in the monopoly, while a license leaves the monopoly unaffected in the hands of the licensor, except that it cannot be enforced against the rights conferred by him upon the licensee.² Now if the monopoly were separable from the invention, and were customarily transferred by a distinct conveyance, no question as to the character of any given instrument of transfer should arise. But inasmuch as certain transfers of the invention *ipso facto* convey the monopoly, and as every instrument transferring the monopoly must also pass some interest in the invention, and as a license as well as an assignment may operate upon all the rights included in the invention, it often becomes doubtful to which of these two classes a given instrument should be referred. The test is

tion, which authorizes the bringing of suits by 'patentee, assignee, or grantee of the exclusive right within and throughout some specified part of the United States.'" 8 O. G. 437 (438).

In *Potter v. Holland* (1858), 4 Blatch. 206, Ingersoll, J. : (211) "There are three classes of persons in whom the patentee can vest an interest of some kind in the patent. They are an assignee, a grantee of an exclusive sectional right, and a licensee. An assignee is one who has had transferred to him in writing the whole interest of the original patent, or any undivided part of such whole interest, in every portion of the United States; and no one, unless he has had such an interest transferred to him, is an assignee. A grantee is one who has had transferred to him, in writing, the exclusive right under the patent, to make and use, and to grant to others to make and use, the thing patented, within and throughout some specified part or portion of the United States. Such right must be an exclusive sectional right, excluding the patentee therefrom. A licensee is one who has had transferred to

him, in writing or orally, a less or different interest than either the interest in the whole patent, or an undivided part of such whole interest, or an exclusive sectional interest." 1 Fisher, 327 (333).

That the distinctions between patentees, assignees, grantees, and licensees are the same under the act of 1870 as under the act of 1836, see *Nelson v. McMann* (1879), 16 O. G. 761; 16 Blatch. 139.

² In *Howe v. Wooldredge* (1866), 12 Allen 18, Gray, J. : (22) "An assignment (and possibly a license to make, use, and sell) is a transfer of a part of the franchise granted by the government to the patentee; a mere license to use a single machine, or a sale of a single machine, transfers no part of the franchise, but simply discharges that machine from the operation of the franchise, and puts it upon the common ground of other property."

That an assignment and a license are entirely different, see *Theberath v. Celluloid Mfg. Co.* (1880), 5 Bann. & A. 577; 3 Fed. Rep. 143.

this: If the conveyance vests in the alienee the entire interest in the invention, or if it makes him a joint-owner with the alienor in such entire interest, it transfers the monopoly to the same extent as the invention, and is an assignment. But if it leaves in the alienor any exclusive right whatever in the invention, or if the rights conferred upon the alienee are not exclusive rights vesting in him alone or in him jointly with his alienor, the monopoly is not transferred and the conveyance is a license.³ Thus the conveyance of an exclusive right

³ In *Gamewell Fire-Alarm Telegraph Co. v. Brooklyn* (1882), 14 Fed. Rep. 255, Wallace, J.: (256) "The statutory power of assignment, as is said in *Littlefield v. Perry*, 21 Wall. 205, 219, 'has been so construed by the courts as to confine it to the transfer of an entire patent, an undivided part thereof, or the entire interest of the patentee or an undivided part thereof throughout a certain specified portion of the United States.' In that case there was in one instrument a conveyance of the entire patent, and there was also an instrument, executed concurrently, called a supplementary agreement, which contained a reservation of the right of the patentee to apply the invention himself to certain specified purposes. The two instruments were construed as a conveyance of the title to the patent, with a license back from the assignees to the patentee; and upon this construction the assignees were held as vested with the legal title. From the reasoning of the opinion it is evident, if there had never been a transfer of the patentee's right to the limited use of the invention, the interest transferred would not have been considered as vesting the statutory title in the assignees. In the present case the transfer was only of a right to use and vend the invention for limited purposes in specified places; the right to use and vend it for general purposes remaining intact until it was conveyed to the Western Union Telegraph Company.

The right transferred was not an undivided part of an entire patent, or an undivided part of the entire interest of the patentee in specified territory, but was a segregated right for a particular employment of the invention. The complainant was, therefore, merely a licensee, within the rule established in *Gayler v. Wilder*, 10 How. 477; the right transferred to him being less than that of the entire and unqualified monopoly. The case of *Ingalls v. Tice*, 13 Reporter, 676, is directly in point. There the transfer to the complainant was of the sole and exclusive right to sell the patented article in certain specified territory; and as the right of the patentee to make and use the invention did not pass by the instrument, it was held that complainant did not acquire the legal estate, and, the patentee not having been made a party to the suit, a demurrer for that reason was sustained." 22 O. G. 1978 (1978). In this opinion the court, in speaking of the "entire patent," employs the usual language in reference to the subject of an assignment. As every Claim in a patent is, in effect, a separate patent, and may be the subject of a distinct assignment, the phraseology here and elsewhere found must be understood with that limitation. See *Pope Mfg. Co. v. Gornully & Jeffrey Mfg. Co.* (1888), 34 Fed. Rep. 893.

See further, on the difference between assignment and license, § 808 and notes, *post*.

to make, *or* use, *or* sell, for any special purpose, is a mere license, since the exclusive rights remaining in the alienor are his distinct and separate property, and require for their protection an ownership by him of the prohibitory powers which, being indivisible, cannot abide in him and at the same time pass to his alienee. For the same reason the transfer of a simple non-exclusive right to make *and* use *and* sell the invention is not an assignment. The alienor retains the same rights in himself, holding them as his own, and not in common with his alienee; his rights are still exclusive against all other persons except the alienee; and hence in order to preserve them the indivisible monopoly must still reside in him. On the other hand, the transfer of an exclusive right to make *and* use *and* sell, or, what is of the same effect as to all classes of inventions except arts or processes, of the exclusive right to make *and* sell the invention, or of an undivided interest in such exclusive right, vests the entire invention and consequently the monopoly also in the alienee, either alone or jointly with the alienor, and hence is an assignment.⁴

§ 764. Character of Assignment Determined by its Subject-Matter, not by its Terms or Conditions.

The character of a conveyance, as thus determined by its subject-matter, cannot be varied by the terms and conditions upon which the transfer has been made. These belong to the contract in pursuance of which the transfer was effected, not to the nature of the transfer itself. The parties may annex such qualifications to the conveyance, and impose such obligations upon themselves in reference to their respective rights, as they may deem expedient, — if the instrument transfers any interest in the invention which carries the monopoly, it is an assignment or a grant, but otherwise is a license. Thus, though they should provide that the consideration for the transfer shall be paid by the alienee to the alienor in the form of periodic royalties, or that the title of the alienee shall become forfeited by breach of certain specified conditions, — pro-

⁴ That the assignment of the right monopoly, see *Nellis v. Pennock Mfg. Co.* (1882), 15 Phila. 493; 13 Fed. Rep. 451; 22 O. G. 1131.

visions which are generally annexed only to licenses, — the conveyance will be none the less an assignment or a grant, if in its subject-matter it embraces any interest in the monopoly.¹

§ 765. *Assignment, by whom Made.*

An assignment of a patented invention can be made only by one in whom the ownership of both the invention and the monopoly resides. At the outset this double ownership vests in the patentee, — his right to the invention arising from his own inventive act; his right to the monopoly being conferred upon him by the patent.¹ Unless transferred by an assignment, or territorially divided by a grant, this ownership remains in him while living, and at his death passes to his executor or administrator as trustees for his heirs or devisees. Hence until the patentee has made either an assignment or a grant, the entire ownership resides in him, and he only can transfer it to another. If his first transfer is an assignment of the entire ownership, his own interest in the patented invention ceases, and no further transfer can be made except by his assignee. The same effect follows each succeeding assignment of the entire ownership, vesting the exclusive title to the invention in the successive assignees.² If any holder of the entire ownership assigns an undivided interest therein, the title and the power of assignment vest equally in all the owners of the patented invention, and each may now assign his interest, without restriction by the others.³ But when the

§ 764. ¹ That the fact that an assignee must account and pay a royalty does not make him a mere licensee, see *Littlefield v. Perry* (1874), 21 Wall. 205; 7 O. G. 964.

That a clause of forfeiture for non-performance does not show that the assignee is a mere licensee, see *Littlefield v. Perry* (1874), 21 Wall. 205; 7 O. G. 964.

§ 765. ¹ That the legal title to a patent vests in the patentee on its issue, see *Consolidated Electric Light Co. v. Edison Electric Light Co.* (1885), 25

Fed. Rep. 719; 33 O. G. 1597; 23 Blatch. 412.

² That the power to assign, grant, and license vests in the assignees of the patent, of whatever degree, see *Selden v. Stockwell Self-Lighting Gas Burner Co.* (1881), 19 Blatch. 544; 20 O. G. 1377; 9 Fed. Rep. 390.

³ That the owner of a distinct interest in a patent may assign his own share, see *May v. Chaffee* (1871), 2 Dillon, 385; 5 Fisher, 160.

See also §§ 796, 798, and notes, *post.*

patentee or any subsequent assignee of the entire ownership divides it territorially by a grant, no further assignment of the patented invention is possible unless, perhaps, by a conveyance in which all the owners join.⁴ The ownership of the grantor, like that of the grantee, is then a mere sectional ownership, subject to further grants either within the same or narrower territorial limits, but not to an assignment which must relate to the entire ownership within the United States. The transfer of a right to practise the invention, as distinguished from a right in the monopoly, does not, however, affect the title to the patented invention. A patentee or assignee or grantee may license others to make use or sell without thereby diminishing his power to alienate his interest, or change the nature of the rights of which that interest consists.⁵ Upon the death of any owner of a patented invention, his ownership and power of alienation are transferred to his administrators or executors by the express provisions of the statutes, to be preserved and exercised by them in the same manner as by himself when living, though for the benefit of his heirs and devisees.⁶ The power of infants and married women to assign their interests in patented inventions is governed by the local law.⁷

§ 766. Assignment, by whom Made when the Owner is Insolvent.

The rule that an assignment can be made only by the actual owner of the patented invention admits of no exception in the

⁴ That co-owners may unite in one assignment though they own different territory, see *Ladd v. Mills* (1884), 22 Blatch. 242 ; 20 Fed. Rep. 792.

⁵ See § 782 and notes, *post*.

⁶ That an administrator may assign a patent when renewed in his own name, see *Brooks v. Jenkins* (1844), 3 McLean, 432.

That an assignment by one administrator gives a perfect title unless others can show a better, see *Donoughe v. Hubbard* (1886), 27 Fed. Rep. 742 ; 35 O. G. 1561 ; *Bradley v. Dull* (1884), 27 O. G. 625 ; 19 Fed. Rep. 913.

That the assignment of a patent by

one of two administrators is good and will pass the entire interest in the patent, see *Wintermute v. Redington* (1856), 1 Fisher, 239.

See also § 406 and notes, *ante*, and §§ 800, 801, and notes, *post*.

⁷ That an infant must assign by guardian, but the guardian is governed by the local law, see *Fetter v. Newhall* (1883), 21 Blatch. 445 ; 25 O. G. 502 ; 17 Fed. Rep. 841.

That the power of a married woman to assign a patent depends on the provisions of the local law, see *Fetter v. Newhall* (1883), 21 Blatch. 445 ; 25 O. G. 502 ; 17 Fed. Rep. 841.

interest of creditors. Valuable as his property therein may be, it cannot be subjected to the payment of his debts by any of the ordinary methods of involuntary alienation. This is not due to any peculiar sanctity which the law attaches to this class of property, but to the fact that the statutes which create the monopoly provide no other mode of transferring it than through the voluntary act of its real owner. The ownership of a patented invention cannot be seized and sold on execution by a sheriff like a personal chattel, nor like other incorporeal rights does it vest in a receiver or a trustee in insolvency by virtue of the judicial decree of the court by which these various officials are appointed.¹ Thus neither a bankrupt court, nor a court of equity, nor any person acting under their authority, can affect the ownership of a patented invention without the actual or presumed co-operation of the individual in whom such ownership is vested by the issue of

§ 766. ¹ That a patent privilege cannot be seized and sold on execution, nor set off to a judgment creditor, see *Carver v. Peck* (1881), 131 Mass. 291; *Pacific Bank v. Robinson* (1881), 57 Cal. 520; *Stevens v. Gladding* (1854), 17 How. 447; *Stephens v. Cady* (1852), 14 How. 528.

That the patent privilege does not vest in a receiver merely by virtue of his appointment, see *Dick v. Struthers* (1885), 25 Fed. Rep. 103; 34 O. G. 131.

That a receiver, as such, has no power to convey the legal title to a patent, see *Adams v. Howard* (1884), 23 Blatch. 27; 22 Fed. Rep. 656; *Gordon v. Anthony* (1879), 16 O. G. 1135; 16 Blatch. 234; 4 Bann. & A. 248.

That a receiver, as such, may convey the equitable title, see *Adams v. Howard* (1884), 23 Blatch. 27; 22 Fed. Rep. 656.

That a trustee in insolvency does not acquire the patents of the insolvent by virtue of his appointment as trustee, see *Campbell v. James* (1880), 2 Fed. Rep. 338; 18 Blatch. 92; 18 O. G. 1111;

Gordon v. Anthony (1879), 16 Blatch. 234; 16 O. G. 1135; 4 Bann. & A. 248; *Ashcroft v. Walworth* (1872), 5 Fisher, 528; 2 O. G. 546; *Holmes*, 152.

That a State has power to enact a statute by virtue of which an assignee in insolvency will become entitled to the patents of the insolvent, and a court of equity will be empowered to compel the insolvent to transfer them to the assignee, see *Barton v. White* (1887), 144 Mass. 281.

That under § 5046, Rev. Stat., a right to the patents of the bankrupt vested in the trustee by virtue of his appointment, see *Carver v. Peck* (1881), 131 Mass. 291; *Prime v. Brandon Mfg. Co.* (1879), 16 Blatch. 453; 4 Bann. & A. 379.

That under § 5046, Rev. Stat., the rights of the trustee were superior to those of an assignee of record whose assignment was made by the bankrupt after the bankruptcy, see *Prime v. Brandon Mfg. Co.* (1879), 16 Blatch. 453; 4 Bann. & A. 379.

the patent or by assignment from the patentee. Either of these courts may have the power to compel the owner to transfer the ownership by an assignment to the receiver or trustee, and a court of equity, on his refusal, may treat the equitable rights as vested in the creditors and appoint a trustee for the owner to convey the legal title, in his name and behalf, to the officer in charge of his bankrupt estate, but the title in all such cases is still derived from him on whom it was originally conferred.² That Congress has the power at any time to meet this difficulty, by creating methods of involuntary alienation, there can be no doubt, but in the absence of such statutes and judicial orders, the patented invention remains entirely and exclusively under the control of its owner, and may be retained or conveyed by him at his pleasure without reference to any existing condition of insolvency.³

§ 767. Assignment, to whom Made.

An assignment of a patented invention may be made to any person without regard to age, capacity, or citizenship.¹ A corporation may become the owner both of the invention and monopoly without receiving special charter-powers for that purpose, although such powers might be required in order to enable it to practise the invention.² Every assignee, of whatever degree of removal from the original patentee, occupies the same position and enjoys the same rights as any of his predecessors or co-owners, and is entitled to all the privileges

² That an insolvent court or court of equity may compel the insolvent to assign his patents to the trustee or receiver, see *In re Keach* (1884), 14 R. I. 571; *Pacific Bank v. Robinson* (1881), 57 Cal. 520; 20 O. G. 1314; *Murray v. Ager* 1881), 1 Mackey, 87; 20 O. G. 1311; *Barnes v. Morgan* (1875), 3 Hun, 703; 6 Thomp. & C. 105; *Ashcroft v. Walworth* (1872), 2 O. G. 546; 5 Fisher, 528; Holmes, 152.

That if the insolvent refuses to convey when ordered by the court, it may appoint a trustee to make the assignment, see *Murray v. Ager* (1881), 1 Mackey, 87; 20 O. G. 1311.

See further on this subject, §§ 803-805 and notes, *post*.

³ That an assignment of all the assignor's property except such as is exempt by law does not carry a patent-right, see *Campbell v. James* (1880), 18 O. G. 1111; 2 Fed. Rep. 338; 18 Blatch. 92.

§ 767. ¹ That married women or infants may be made assignees, see *Fetter v. Newhall* (1883), 21 Blatch. 445; 25 O. G. 502; 17 Fed. Rep. 841.

² That a corporation may take the assignment of a patent without special charter powers for that purpose, see *Dorsey Harvester Rake Co. v. Marsh* (1873), 6 Fisher, 387.

and is subject to all the obligations conferred or imposed by the statutes upon the patentee and his assignees.³

§ 768. Form of Assignment: General Requisites.

No particular form for an assignment is prescribed.¹ It

¹ In *Seldon v. Stockwell Self-Lighting Gas Burner Co.* (1881), 19 Blatch. 544, Blatchford, J. : (552) " 'The assignee' means the assignee in any degree and however remote. By § 4884 the grant is directed to be made to 'the patentee, his heirs, or assigns.' This is not limited to the first assignee. So § 4898, in declaring that 'every patent, or any interest therein, shall be assignable,' and that 'the patentee or his assigns' may convey an exclusive right under the patent, for the whole or any specified part of the United States, clearly means that an assignee in any degree is an assignee for all purposes. All parts of the statute are to be construed harmoniously in this respect, as there appears to be no good reason for a contrary construction. It is true that § 4 of the Patent Act of February 21st, 1793 (1 U. S. Stat. at Large, 322), used the words 'assignees of assigns, to any degree;' but the absence of the words 'to any degree' cannot, in view of all the provisions of the present statute, be regarded as restricting the meaning of the word 'assignee.' " 20 O. G. 1377 (1378) ; 9 Fed. Rep. 390 (396).

§ 768. ¹ That assignments are governed wholly by statute, see *Suydam v. Day* (1846), 2 Blatch. 20.

That an assignment is not valid unless it complies with the laws of the United States, see *Higgins v. Strong* (1836), 4 Blackf. (Ind.) 182.

That an assignment requires no special form, see *Siebert Cylinder Oil Cup Co. v. Beggs* (1887), 32 Fed. Rep. 790 ; *Campbell v. James* (1880), 18 O. G. 1111 ; 18 Blatch. 92 ; 2 Fed. Rep. 338.

That an assignor, having only a residuary interest, may convey that by assigning "all his right, title, and interest," whether his prior assignment is recorded or not, see *Turnbull v. Weir Plow Co.* (1874), 7 O. G. 173 , 1 Bann. & A. 544 ; 6 Bissell, 225.

That a certificate of the patentee that another person owns part of the patent is not an assignment, unless so intended, see *Kearney v. Lehigh Valley R. R. Co.* (1886), 27 Fed. Rep. 699.

That a certificate that the holder is the owner of $\frac{1}{4}$ of the patent and property of the M. T. Co., and "will receive shares of stock to that amount when the company is formed" is not an assignment, see *Hope Iron Works v. Holden* (1870), 58 Me. 146.

That if the description of the patent in the assignment be intelligible it is sufficient, see *Myers v. Turner* (1855), 17 Ill. 179.

That the deed need not set out the specification of the invention, if it is otherwise clearly shown, see *Hill v. Thuermer* (1859), 13 Ind. 351.

That the vendee of a patent must exercise ordinary care in inspecting the specification and Claims to see what the invention is, see *Edmunds v. Myers* (1854), 16 Ill. 207 ; *Edmunds v. Hildreth* (1854), 16 Ill. 214.

That circumstantial variance between the patent and its description in the assignment does not show fraud or prevent the title from passing, see *Case v. Morey* (1818), 1 N. H. 347 ; *Holden v. Curtis* (1819), 2 N. H. 61.

That the sale of an improvement is valid if the patent referred to in the conveyance so describes the improve-

must be made in writing and be signed by the assignors.² It must also contain operative words unequivocally indicating an intention to convey an interest both in the invention and in

ment that a person skilled in the art could make it, though it does not describe the original machine, see *Harmon v. Bird* (1839), 22 Wend. 113.

² That an assignment must be in writing, see *Gottfried v. Miller* (1882), 104 U. S. 521; 21 O. G. 711; *Blakeney v. Goode* (1876), 30 Ohio St. 350; *Ashcroft v. Walworth* (1872), 2 O. G. 546; *Holmes*, 152; 5 Fisher, 528; *Jordan v. Dobson* (1870), 4 Fisher, 232; 2 Abbott, 398; 7 Phila. 533; *Davy v. Morgan* (1868), 56 Barb. 218.

That an agreement based on a parol assignment is void for want of consideration, see *Davy v. Morgan* (1868), 56 Barb. 218.

That a patent is personal property, and but for the statute could be conveyed by parol, see *Springfield v. Drake* (1876), 58 N. H. 19.

That an oral agreement for the sale of an invention before patent, is not a contract for goods under the Statute of Frauds, see *Somerby v. Buntin* (1875), 116 Mass. 279.

That an agreement to hold a patent in trust for another may be by parol, see *Blakeney v. Goode* (1876), 30 Ohio St. 350.

That a parol contract to assign will pass an equitable title which a court of equity will enforce, see *Burr v. De La Vergne* (1886), 102 N. Y. 415; *Whitney v. Burr* (1885), 115 Ill. 289.

That equitable interests and rights to the proceeds of the sales of patents may be created by parol, see *Blakeney v. Goode* (1876), 30 Ohio St. 350.

That a verbal assignment vests in the assignee an equitable right to grant licenses, and notes given for such licenses are upon sufficient consideration, see *Burke v. Partridge* (1873), 58 N. H. 349.

That a parol agreement to assign and to allow the assignee to take out the patent in his own name, is valid, see *Lockwood v. Lockwood* (1871), 33 Iowa, 509.

That a parol agreement by the inventor to permit another to receive the patent in his own name for value, if carried out, can be shown and the value recovered, see *Lockwood v. Lockwood* (1871), 33 Iowa, 509.

That the legal title to a patent can be transferred only by a written instrument, signed by the owner of the patent, see *Ashcroft v. Walworth* (1872), 2 O. G. 546; *Holmes*, 152; 5 Fisher, 528.

That a contract binds the parties who participate in it, though signed only by one party representing the rest, see *Bean v. Clark* (1887), 40 O. G. 1454.

That an assignment executed by attorney must be signed with name of the principal and sealed with his seal, see *Machesney v. Brown* (1886), 38 O. G. 1130; 29 Fed. Rep. 145; 24 Blatch. 168.

That an assignment by an attorney in his own name is invalid, the signature of the owner being essential, see *Pryor v. Coulter* (1830), 1 Bailey (S. C.), 517.

That where the owner of a patent consents in writing to its transfer by another, it is as good as if the transfer were made directly by himself, see *Sherman v. Champlain Transportation Co.* (1858), 31 Vt. 162.

That a conveyance by a corporation with its seal, and by its president with his seal, is good as to both, see *Campbell v. James* (1879), 18 O. G. 979; 17 Blatch. 42; 4 Bann. & A. 456.

That a corporation may assign letters-patent although some shares of its

the monopoly.³ A contract to sell the patented invention, therefore, is not an assignment, though it may be enforced in equity, and meanwhile operate by estoppel as a license.⁴ But an irrevocable power of attorney, giving full control over the patented invention, may vest the entire ownership at once in the attorney named, and however widely differing in form from a conveyance may be a true assignment.⁵ Whether a given instrument is or is not an assignment must be determined from its subject-matter, as described in the instrument itself. Parol evidence is not admissible to vary its terms except in cases of mutual mistake.⁶ The motive for an assignment is immaterial.⁷ A seal is not required.⁸

§ 769. Assignment before Patent : Its Form and Effect.

An assignment of a completed invention may be made either before or after the issue of the patent.¹ An inventor has, by

capital stock may be under attachment in a suit against a stockholder, see *Gottfried v. Miller* (1881), 104 U. S. 521 ; 21 O. G. 711.

That a forged assignment may be ratified *in pais*, see *Campbell v. James* (1879), 17 Blatch. 42 ; 18 O. G. 979 ; 4 Bann. & A. 456.

³ In *Campbell v. James* (1880), 18 Blatch. 92, Wheeler, J. : (101) "All interests in patents are assignable by instrument in writing. No particular form is required ; but still there must be some operative words expressing at least an intention to assign, in order to constitute an assignment." 18 O. G. 1111 (1114) ; 2 Fed. Rep. 338 (347).

⁴ That a contract for the purchase of part of a patent-right may be good as a license, see *Sauford v. Messer* (1872), 5 Fisher, 411 ; 2 O. G. 470 ; Holmes, 149.

⁵ That an irrevocable power of attorney may be an assignment, see *Hartshorn v. Day* (1856), 19 How. 211.

That an irrevocable and exclusive power to act as "sole agent" for making and selling an article, and to pay the proceeds to the principal less the commission is not an assignment, see

Kempton v. Bray (1868), 99 Mass. 350.

That where the owners of a patent assign to a third party in trust to exercise certain powers on their behalf, the assignee possesses an authority coupled with an interest, see *Ladd v. Mills* (1884), 22 Blatch. 242 ; 20 Fed. Rep. 792.

⁶ That parol evidence cannot vary the terms of an assignment, except in mutual mistake, see *Knowlton Platform & Car Coupling Co. v. Cook* (1879), 70 Me. 143 ; *Hammond v. Pratt* (1879), 16 O. G. 1235 ; *Ruggles v. Eddy* (1872), 5 Fisher, 581 ; 10 Blatch. 52.

⁷ That the motive for an assignment is immaterial, see *Siebert Cylinder Oil Cup Co. v. Phillips Lubricator Co.* (1882), 10 Fed. Rep. 677.

That a conveyance made to deceive the Patent Office is inoperative, see *Prime v. Brandon Mfg. Co.* (1879), 16 Blatch. 453 ; 4 Bann. & A. 379.

⁸ That it is not required that an assignment of a patent be under seal, see *Gottfried v. Miller* (1882), 104 U. S. 521 ; 21 O. G. 711 ; *Van Ostrand v. Reed* (1828), 1 Wend. 424.

§ 769. ¹ That an assignment of an

virtue of his inventive act, not merely the ownership of his invention, but an inchoate right to the monopoly which is to become vested upon his application for and receipt of letters-patent. This ownership of the invention, and inchoate right to the monopoly, together with the right to perfect his title to the monopoly by obtaining letters-patent, is made assignable by law equally with the patented invention; and an assignment covering these rights and properly recorded secures to the assignee both the invention and monopoly immediately on the issue of the patent.² To authorize an issue of the patent directly to the assignee, however, the instrument of assignment must contain a written request to the Commissioner of Patents that the letters-patent may be granted to the assignee, or to the assignee and the inventor jointly if the conveyance operates upon an undivided interest, and must be filed for record in the Patent Office before the date fixed for the payment of the final fee.³ Such a convey-

invention before patent is valid, see *Cam-meyer v. Newton* (1876), 94 U. S. 225 ; 11 O. G. 287 ; *Hammond v. Mason & Hamlin Organ Co.* (1875), 92 U. S. 724 ; *Continental Windmill Co. v. Empire Windmill Co.* (1871), 8 Blatch. 295 ; 4 Fisher, 428 ; *Appleton v. Bacon* (1862), 2 Black, 699 ; *Rathbone v. Orr* (1850), 5 McLean, 131 ; *Herbert v. Adams* (1825), 4 Mason, 15 ; 1 Robb, 505.

That the right to an invention dates from its discovery, see *Wintermute v. Redington* (1856), 1 Fisher, 239.

That a mortgage of a future invention will cover it, though the invention be divided and patented in different patents under different names, see *Hollins v. Mallard* (1854), 10 How. Pr. 540.

See as to this whole subject §§ 409-411 and notes, *ante*.

² Sec. 4895, Rev. Stat.

That a sale by the inventor before the patent issues secures the invention to the vendee after the patent is granted, see *Rathbone v. Orr* (1850), 5 McLean, 131.

That an assignment of "one third of the full and exclusive right to the invention as set forth and described" in a specification about to be filed carries a one-third interest in all the patentable devices described and claimed in such specification and in all patents obtained therefor, see *Puetz v. Bransford* (1887), 31 Fed. Rep. 458 ; 39 O. G. 1083.

That alterations in one of such devices and the procuring a separate patent therefor do not take it out of such assignment, see *Puetz v. Bransford* (1887), 31 Fed. Rep. 458 ; 39 O. G. 1053.

That an assignee may accept a different patent in the room of the one agreed to be assigned, and if acting on such acceptance is estopped to claim the other, see *Topliff v. Topliff* (1887), 122 U. S. 121 ; 40 O. G. 115.

³ That the patent cannot issue to the assignee unless the assignment contains a request to that effect, and is duly entered for record as prescribed by the rules, see *Wright v. Randell* (1881), 19 Blatch. 495 ; 21 O. G. 493 ; 8 Fed. Rep.

ance transfers to the assignee the legal as well as equitable title to the patented invention; and if by any fraud or accident the letters-patent should be issued in the name of the inventor only, the property in the invention and monopoly will, nevertheless, be vested in the assignee.⁴ An instrument purport-

591; *Hammond v. Pratt* (1879), 16 O. G. 1235.

That the Patent Office cannot take notice of an equitable interest, whose existence is contingent on the issuing of a patent, see *Martin v. Olney* (1876), 9 O. G. 1107.

That the assignment of a future patent, not containing a request that the patent issue to the assignee, is not recordable, and if recorded is not notice, see *Wright v. Randell* (1881), 8 Fed. Rep. 591; 19 Blatch. 495; 21 O. G. 493; *Gay v. Cornell* (1849), 1 Blatch. 506.

⁴ That no legal title exists till the patent issues, see *Pontiac Knit Boot Co. v. Merino Shoe Co.* (1887), 31 Fed. Rep. 286.

That the issue of a patent to an assignee gives him the legal title, see *Perkins v. U. S. Electric Light Co.* (1883), 24 O. G. 204; 21 Blatch. 308; 16 Fed. Rep. 513.

That a patent may issue to the assignee of an assignee, see *Consolidated Electric Light Co. v. Edison Electric Light Co.* (1885), 25 Fed. Rep. 719; 33 O. G. 1597; 23 Blatch. 412.

That the patent may issue to any assignee of record if the rights of paramount owners are not thereby affected, see *Consolidated Electric Light Co. v. Edison Electric Light Co.* (1885), 25 Fed. Rep. 719; 33 O. G. 1597; 23 Blatch. 412.

That where a patent issues to the first of several successive assignees, all whose assignments were on record pending the application, the title vests in the last, see *Consolidated Electric Light Co. v. McKeesport Light Co.* (1888), 34 Fed. Rep. 335; 44 O. G. 110; Con-

solidated Electric Light Co. v. Edison Electric Light Co. (1885), 25 Fed. Rep. 719; 33 O. G. 1597; 23 Blatch. 412.

That it is not necessary that the true owner of the patent be made the nominal patentee, see *Consolidated Electric Light Co. v. Edison Electric Light Co.* (1885), 25 Fed. Rep. 719; 33 O. G. 1597; 23 Blatch. 412.

That an assignment, made before the issue of the patent and recorded in the Patent Office, and conveying all the right of the inventor and the legal title which he expects to obtain, and requesting that the patent issue to the assignee, transfers the right to the assignee although the patent actually issues to the assignor, see *Gayler v. Wilder* (1850), 10 How. 477.

That an assignment made before the patent issues, requesting an issue to the assignee, will vest the legal title in the assignee on recording the assignment though the patent had been ordered to be issued to the assignor before the assignment was made, and was actually issued to him before the assignment was recorded, see *United States Stamping Co. v. Jewett* (1880), 7 Fed. Rep. 869; 18 O. G. 1529; 18 Blatch. 469.

That where an applicant assigns, requesting the patent to issue to the assignee, and the assignment is not recorded until after the patent issues, and subsequently to such record the patentee assigns to another, the title of the first assignee dates from the date of the record and prevails over the second assignee, see *U. S. Stamping Co. v. Jewett* (1880), 18 Blatch. 469; 7 Fed. Rep. 869; 18 O. G. 1529.

ing to be an assignment, but not containing this request or not recorded in due season, does not convey the legal title to the patented invention. It may create an equitable title which a court of chancery will enforce against the inventor and against all other parties who, having notice of the assignment, subsequently become interested in the invention; but it cannot prevail over a later assignment which confers a legal title upon a *bona fide* assignee who has no notice of the former.⁵ In the absence of such intervening legal titles, the patent issues to the inventor, as if no equitable title had been previously created, and chancery compels him to receive and hold it as trustee for his equitable assignees, or to convey it to them by a regular assignment.⁶

⁵ That an assignment before patent, not requesting the issue to the assignee, is a contract to assign the patent after issue, and creates an equitable title in the assignee, see *Hammond v. Pratt* (1879), 16 O. G. 1235; *Newell v. West* (1875), 13 Blatch. 114; 9 O. G. 1110; 2 Bann. & A. 113; 8 O. G. 598; *Troy Iron & Nail Co. v. Corning* (1852), 14 How. 193.

That the equitable title of an assignee before patent without request, etc., cannot prevail over the legal title of subsequent *bona fide* purchasers without notice, see *Davis Wagon Wheel Co. v. Davis Wagon Co.* (1884), 22 Blatch. 221; 20 Fed. Rep. 699; *Wright v. Randell* (1881), 19 Blatch. 495; 21 O. G. 493; 8 Fed. Rep. 591.

⁶ That an equitable prevails over the legal title in a court of equity, and the legal owner is treated as trustee for the equitable owner, see *Whiting v. Graves* (1878); 3 Bann. & A. 222; 13 O. G. 455. See also § 786 and notes, *post*.

That the interest in an invention cannot be assigned by parol so as to entitle the assignee to the patent as against the patentee, see *Hammond v. Pratt* (1879), 16 O. G. 1235.

That a contract to assign a future

patent can be specifically enforced in equity, see *Hagood v. Rosenstock* (1885), 23 Blatch. 95; 23 Fed. Rep. 86; *Hammond v. Pratt* (1879), 16 O. G. 1235; *Ex parte Edison* (1875), 7 O. G. 423.

That a court of equity will not aid an inventor to obtain a patent in violation of his own agreements, see *Runstetler v. Atkinson* (1883), 23 O. G. 940.

That an assignee before patent, having notice of a prior unrecorded assignment, and with such notice procuring the patent to be issued to himself, takes the legal title in trust for the first assignee and may be compelled to convey to him, see *Pontiac Knit Boot Co. v. Merino Shoe Co.* (1887), 31 Fed. Rep. 286.

That specific performance will not be decreed in favor of one who has repeatedly broken the contract, though the defendant first transgressed it, see *Ohio Steel Barb Fence Co. v. Washburn & Moen Mfg. Co.* (1886), 26 Fed. Rep. 702; 35 O. G. 1337.

That no specific performance will be decreed where it would avail nothing, or where the petitioner has not acted equitably, see *Werden v. Graham* (1883), 24 O. G. 101; 107 Ill. 169.

That though a specific performance

§ 770. Assignment of Extension.

When the law provides for the grant of an extension to the patentee, he may assign his right to the extension in the same manner, even before the original patent has been issued.¹ Such an assignment creates an equitable title in the assignee, which becomes operative on the grant of the extension, and thereupon both the invention and monopoly vest in him according to the terms of his conveyance.² If the assignee is already an owner of the patented invention under the original patent, the effect of such extension is merely to prolong the period of his existing ownership. If his ownership is to commence with the extension, or to be enlarged thereby, and a

has been rendered impossible through the fraudulent act of the defendant, the court will not decree it, see *Kennedy v. Hazelton* (1888), 128 U. S. 667; *Kennedy v. Hazelton* (1888), 33 Fed. Rep. 293.

That an employer cannot compel his employee to assign a patent to him unless there was an agreement to that effect, see *Hapgood v. Hewitt* (1886), 119 U. S. 226; 37 O. G. 1247.

That where a workman is hired to invent, and agrees that his inventions shall belong to his employer, the employer is their real owner, see *Joliet Mfg. Co. v. Dice* (1883), 105 Ill. 649.

That a contract to sell the patent privilege is made good by securing a second patent when the first is void, see *Stanley v. Whipple* (1839), 2 McLean, 35; 2 Robb, 1.

That under a contract to assign several methods the assignee is not bound to accept an assignment of one, though the others are open to the public, see *Serviss v. Stockstill* (1873), 30 Ohio St. 418.

That an agreement to transfer property on the happening of a certain event gives an immediate right thereto upon the happening of the event, see *McBurney v. Goodyear* (1853), 11 Cush. 569.

See further §§ 408-414 and notes, *ante*, and §§ 786, 1228, 1229, and notes, *post*.

§ 770. ¹ That an extension may be assigned before it is granted, see *Consolidated Fruit Jar Co. v. Mason* (1877), 7 Daly, 64; *Ex parte Holmes* (1873), 4 O. G. 581; *Nicholson Pavement Co. v. Jenkins* (1872), 14 Wall. 452; 1 O. G. 465; 5 Fisher, 491; *Railroad Co. v. Trimble* (1870), 10 Wall. 367; *Clum v. Brewer* (1855), 2 Curtis, 506.

That an extension may be contracted for, but not assigned, before it is granted, see *Day v. Candee* (1853), 3 Fisher, 9.

That an assignment of an extension, before even the original patent has issued, is valid, see *Ex parte Holmes* (1873), 4 O. G. 581.

² That an agreement to assign an extension is valid in equity, see *Prime v. Brandon Mfg. Co.* (1879), 16 Blatch. 453; 4 Bann. & A. 379; *Newell v. West* (1875), 8 O. G. 598; 2 Bann. & A. 113; 13 Blatch. 114; 9 O. G. 1110; *Pitts v. Hall* (1854), 3 Blatch. 201.

That an assignment of a future extension becomes operative on the grant of the extension, see *Gear v. Grosvenor* (1873), 3 O. G. 380; *Holmes*, 215; 6 Fisher, 314; *Railroad Co. v. Trimble* (1870), 10 Wall. 367.

That an agreement to sell an extension creates an equitable title, and becomes a legal title when the price is paid, see *Hartshorn v. Day* (1856), 19 How. 211.

now conveyance after the extension thus becomes necessary to perfect his legal title, chancery will enforce the preceding equitable assignment by compelling the patentee to execute such further transfer as may be required.³ Though the extension be not granted until after the death of the patentee, his previous assignments bind it in the hands of his executors or administrators, who without the consent of his heirs or devisees, and without any order from the local court of Probate, may procure the extension and complete the title of the assignee.⁴

§ 771. **Contract to Assign Future Inventions not an Assignment.**

A contract for the transfer of inventions not yet in being is valid as a contract, but is not an assignment.¹ The subject-matter of an assignment is an existing invention, not only conceived as an idea of means but actually reduced to practice, and thus invested with the inchoate or perfected right to that monopoly which must always pass with the invention in this form of conveyance.² An intended or incomplete invention rests merely in purpose and expectation. It does not clothe the proposed inventor with any special privileges or entitle him to any rights in the monopoly which, if his purpose were accomplished, he might be able to secure. The transfer of such future inventions is a mere executory contract to assign them if they happen to be made.³ It binds the

³ That an inchoate right to an extension may be sold, and a contract for such sale specifically enforced in equity, see *Newell v. West* (1875), 8 O. G. 598; 13 Blatch. 114; 9 O. G. 1110; 2 Bann. & A. 113; *Aiken v. Dolan* (1867), 3 Fisher, 197.

⁴ That an administrator may fulfil a contract to convey an extension, by procuring the extension and assigning it, no order of the Probate Court and no consent of the heirs being necessary, see *Newell v. West* (1875), 13 Blatch. 114; 8 O. G. 598; 9 O. G. 1110; 2 Bann. & A. 113.

See also as to the assignment of an extension, § 412 and notes, *ante*, and §§ 779, 844, and notes, *post*.

§ 771. ¹ That the right to an invention can be transferred before it is completed and while its value is prospective and contingent, see *Marshall v. Peck* (1833), 1 Dana, 609; and §§ 368, 409, and notes, *ante*.

² That an assignment entitling the assignee to have a patent issued to him must be a formal assignment of a completed invention, not an agreement to assign future inventions, see *Runstetler v. Atkinson* (1883), 23 O. G. 940.

³ That an instrument purporting to convey inventions not yet in being is a mere executory contract, not an assignment, see *Ex parte Edison* (1875), 7 O. G. 423.

inventor, and if the inventions are completed it gives the other party a contract right which equity can protect and make effectual when the interests of third parties without notice are not thereby prejudiced.⁴

§ 772. **Assignment Before Patent Favored in Law.**

An assignment of a patented invention before the grant of letters-patent is not regarded as the transfer of a lawsuit or a controverted right, and is consequently favored by the law.¹ Even where a patent has been once applied for and refused, a subsequent assignment of the inventor's interests is valid, and upon a new application a patent may be issued vesting the title in the assignee.² But when the application for a patent has been finally rejected and abandoned, the rights conferred by the inventor upon his assignees become extinguished, and if thereafter the heirs of the inventor obtain letters-patent by a special act of Congress, the interest in the invention and monopoly reside in them to the exclusion of the assignees.³

⁴ That the assignment of an imperfect invention, with all its future improvements, is an assignment of the perfected result, and the assignee is the equitable owner of the patent when issued, see *Littlefield v. Perry* (1874), 21 Wall. 205 ; 7 O. G. 964.

That an assignment of a patent with future improvements is valid and vests an equitable interest in the improvements when made, which the court may follow with decree for legal title, see *Aspinwall Mfg. Co. v. Gill* (1887), 40 O. G. 1133 ; 32 Fed. Rep. 697.

That on an agreement to assign a future patent, the right to an assignment becomes absolute when the patent issues, see *Satterthwait v. Marshall* (1872), 4 Del. Ch. 337.

That a contract to assign will be specifically enforced, see *Hapgood v. Rosenstock* (1885), 23 Blatch. 95 ; 23 Fed. Rep. 86 ; *Ex parte Edison* (1875), 7 O. G. 423 ; and § 411 and notes, *ante*, and § 1228 and notes, *post*.

§ 772. ¹ That an assignment pending an application is not an assignment of a lawsuit, see *Gay v. Cornell* (1849), 1 Blatch. 506.

² That an assignment of an invention before patent is valid, although a patent had been refused to the applicant before the assignment was made, see *Gay v. Cornell* (1849), 1 Blatch. 506.

That where an assignment had been made of an improvement pending an application for a patent, and the application being rejected a new application is filed and granted, the patent enures to the benefit of the assignee, see *Littlefield v. Perry* (1874), 21 Wall. 205 ; 7 O. G. 964.

³ That when the inventor makes an assignment of his invention before a patent is granted, and the patent being refused on his application the application is abandoned, and his rights and all those derived from him are lapsed, and after his death his heirs obtain a patent by special act of Congress, their patent

§ 773. Effect of Assignment, how Determined: Its Construction.

The extent of the interest created in the assignee by an assignment depends in part upon the interest owned by the assignor, and in part upon the terms of the conveyance. An assignor cannot transfer what he does not himself possess. A sole patentee can assign the entire interest in the patented invention, but the owner of an undivided interest can convey only that undivided interest, and the owner of an interest which has been limited by previous grants or by irrevocable licenses, can give no title except to the residuary or reversionary rights that still remain in him.¹ Hence, however broad may be the words of the conveyance, they operate upon the patented invention only within the scope of the rights vested in the assignor at the date of the assignment. The assignee must take his interest subject to all previous lawful conveyances and to the restrictions originally imposed upon his assignor. Within these limits the interest transferred by the assignment is measured by the terms of the conveyance.² These are to be so construed as to effect the intention of the parties, but cannot be varied by parol evidence, except in cases of mutual mistake.³ If more than one instrument enters into the transaction, as where the equitable title created by an

is not subject to the old assignment, see *Fire Extinguisher Co. v. Graham* (1883), 16 Fed. Rep. 543; 24 O. G. 793.

§ 773. ¹ That an assignee's rights cannot be greater than those of his assignor, see *Gottfried v. Miller* (1881), 10 Fed. Rep. 471.

That it will never be presumed that a grantor intends to grant what he has no right to grant, or that the grantee expects to receive what is already his, see *Day v. Cary* (1859), 1 Fisher, 424.

That where an assignor has any right at all to convey, his grant of all his rights will not be intended as attempting to include rights previously transferred by him, see *Turnbull v. Weir Plow Co.* (1874), 6 Bissell, 225; 7 O. G. 173; 1 Bann. & A. 544.

² That the rights of the assignee are

governed by the assignment, see *Hendrie v. Sayles* (1878), 98 U. S. 546.

³ That a grant should be construed to cover whatever is necessary to render it effective, see *Hamilton v. Kingsbury* (1878), 15 Blatch. 64; 14 O. G. 448.

That an assignment of an interest in an invention is a contract, and is to be construed so as to effect the intention of the parties, see *Nicholson Pavement Co. v. Jenkins* (1872), 14 Wall. 452; 5 Fisher, 491; 1 O. G. 465.

That parol evidence cannot vary an assignment unless there has been a mutual mistake, see *Knowlton Platform & Car Coupling Co. v. Cook* (1879), 70 Me. 143; *Hammond v. Pratt* (1879), 16 O. G. 1235; *Ruggles v. Eddy* (1872), 5 Fisher, 581; 10 Blatch. 52.

assignment before patent is protected by the subsequent conveyance of the legal title, both are to be interpreted together in ascertaining the extent of the interest assigned.⁴

§ 774. **Assignment, its Implied Warranty of Title.**

The terms of the conveyance are important, not only as a measure of the interest assigned but as an indication of the liability of the assignor upon his implied warranty of title. As will be seen hereafter, the assignment imports a covenant that the assignor has a good right to convey the interest therein described; and whenever this interest exceeds the interest which he could actually convey the assignee has an appropriate remedy for the breach of warranty.¹ Hence the significance of the interpretation put by the courts upon the language of the instrument in two classes of cases; one where it purports to convey the entire interest in the patented invention; the other where it is construed to cover only such interest as the assignor may himself possess.

§ 775. **Assignment of "All Rights" in the Patented Invention Warrants a Perfect Title.**

An assignment of all rights to the patented invention, in whatever language such rights may be described, transfers or attempts to transfer the entire interest covered by the patent. By it the assignor asserts himself to be the sole owner of the patented invention, free from all incumbrances created by any prior transfer. From it, if this assertion of the assignor be true, the assignee derives an exclusive title to the invention and to the monopoly; if not true, such ownership as the assignor possessed is vested in him together with a right of action on the implied warranty, or at his option the transfer may be treated as inoperative and void. Thus an assignment

⁴ That where an assignment has been duly recorded, and a supplementary assignment is not recorded, both are to be construed together, see *Littlefield v. Perry* (1874), 21 Wall. 205; 7 O. G. 964.

That titles to patents are not to be overthrown on soluble doubts, see *Blandy v. Griffith* (1869), 3 Fisher, 609.

That in case of doubt the practical construction given to the contract by the acts of the parties may control, see *Topliff v. Topliff* (1887), 122 U. S. 121; 40 O. G. 115.

§ 774. ¹ See §§ 783, 1232, and notes, *post*.

of "all the right" to the patented invention, or of the "exclusive right to make and sell" throughout the United States for the whole term of the patent, or with any equivalent words of description, purports to convey the entire interest in the patented invention,¹ and is justified only when the assignor has the unqualified ownership of all the rights created or protected by the patent.

§ 776. Assignment of "All My Rights" in the Patented Invention Implies no Warranty of Title.

An assignment of all the rights of the assignor in the patented invention, on the other hand, contains no implied averment as to the nature or scope of the interest conveyed.¹ Such an assignment will operate upon any ownership which may be vested in the assignor, and will transfer it to the assignee subject to any previous conveyances or contracts which the assignor or his predecessors may have made, whether these have created legal or equitable rights, and whether or not they are recorded.² An assignee under this form of con-

§ 775. ¹ In *Turnbull v. Weir Plow Co.* (1880), 9 Bissell, 334, Drummond, J.: (336) "Where a man assigns all the right which was conveyed to him by letters-patent, the meaning is that the assignment takes with it everything that the letters-patent conveyed. It is certainly different from an assignment which declares merely that he assigns all the interest which he, at the time he makes the assignment, has in the letters-patent, provided, as in this case, he had previously assigned a part of the interest which he had to another person." 23 O. G. 91 (91); 14 Fed. Rep. 108 (110); 5 Bann. & A. 288 (290).

That the grant of "an exclusive right to make and sell" the invention "in the United States for the whole term of the patent" carries the entire interest in the invention, see *Pickhardt v. Packard* (1884), 23 Blatch. 23; 30 O. G. 179; 22 Fed. Rep. 530; *Nellis v. Pennock Mfg. Co.* (1882), 13 Fed. Rep. 451; 22 O. G. 1131; 15 Phila. 493.

That whether the form of a conveyance is that of an assignment or a license, if it transfers all rights under the patent it is an assignment, and the transferee may sue in his own name, see *Siebert Cylinder Oil Cup Co. v. Beggs* (1887), 32 Fed. Rep. 790.

§ 776. ¹ That a conveyance of all my right, title, and interest does not import a warranty, see *Turnbull v. Weir Plow Co.* (1874), 7 O. G. 173; 6 Bissell, 225; 1 Bann. & A. 544.

That an assignment of "all my right" purports to cover only the right he then has, see *Turnbull v. Weir Plow Co.* (1880), 23 O. G. 91; 9 Bissell, 334; 5 Bann. & A. 288; 14 Fed. Rep. 108.

That a conveyance of the right, title, and interest in a patent "as fully as the same would have been enjoyed by me but for this assignment," is a mere quitclaim without warranty, see *Gilmore v. Aiken* (1875), 118 Mass. 94.

² That a conveyance of "all my right, title, and interest in and to" a

voynance is put upon his guard and is chargeable with notice of all facts which he might have ascertained by inquiring of the prior owners of the patented invention, or of any person claiming a right under the patent.³ Where an assignment of this character has once been made, every one who derives his title through it is presumed to have received his ownership with the same knowledge of existing interests in others which is imputed to the original assignee, and one transferring such rights to another is not bound by any suppression of the truth by future owners or by their failure to disclose the actual condition of the title.⁴

§ 777. Assignment Transfers only the Invention Specifically Assigned.

The assignment of a patented invention operates only upon the invention covered by the patent. Other inventions owned by the same assignor, though related to the one assigned as modifications or improvements, and though essential to the practical employment of the one assigned, are not transferred by the conveyance.¹ Even when the assignment confers in

patent, though properly recorded, does not affect a territorial right previously conveyed, even if the prior conveyance is not recorded, see *Turnbull v. Weir Plow Co.* (1880), 23 O. G. 91; 9 Bissell, 334; 5 Bann. & A. 288; 14 Fed. Rep. 108; *Turnbull v. Weir Plow Co.* (1874), 6 Bissell, 225; 7 O. G. 173; 1 Bann. & A. 544.

³ That the expression "right, title, and interest," in an assignment from a person holding under the patentee, is enough to put the assignee on inquiry and to charge him with notice of what he could have found out from the first grantor, see *Hamilton v. Kingsbury* (1880), 17 O. G. 847; 4 Fed. Rep. 428; 17 Blatch. 460.

That where an assignment refers to an invention as in use, such reference is an express notice to the assignee of such use, and of the claim of the licensee of the right to use, see *Prime v. Brandon*

Mfg. Co. (1879), 16 Blatch. 453; 4 Bann. & A. 379.

⁴ That an assignor of his "right, title, and interest" only is not bound by any suppression of truth on the part of his assignees, nor by their failure to disclose the true state of the title, see *Hamilton v. Kingsbury* (1880), 4 Fed. Rep. 428; 17 O. G. 847; 17 Blatch. 460.

See further as to implied warranty, §§ 783, 794, 1232, and notes, *post*.

§ 777. ¹ That an assignment of one invention does not carry an interest in a different one, see *Puetz v. Bransford* (1887), 39 O. G. 1427; 31 Fed. Rep. 458.

That the assignment of all right, title, and interest in and to an improvement, conveys no interest in the original invention, see *Leach v. Dresser* (1879), 69 Me. 129.

That a conveyance under a specific

express terms upon the assignee a right to future improvements on the invention, it cannot affect an independent invention; nor can a general conveyance of the interest of the assignor in all his patents previously obtained create a title in the assignee to a subsequent improvement upon any one of the assigned inventions.² The invention transferred by the assignment to the assignee also remains in him distinct from any other invention which he may acquire. The meeting in a single person of the ownership of several patented inventions does not unite the inventions, nor confer upon their owner any rights which could not have been asserted by the several owners of the different patents.³ Thus where the elements

patent confers no right to use improvements which have been invented since the date of such patent, although they were in existence at the date of the conveyance, see *American Hide & Leather Splitting & Dressing Machine Co. v. American Tool & Machine Co.* (1870), 4 Fisher, 284; *Holmes*, 503.

That the word "invention," in a contract for the assignment of a patent therein recited includes only the invention described in the patent and its renewals, not any other improvements, though the invention would be worthless without them, see *United Nickel Co. v. American Nickel Plating Works* (1878), 4 Bann. & A. 74.

² That an assignment of a patent with the right to the improvements to be made does not cover distinct inventions, see *Stebbins Hydraulic Elevator Mfg. Co. v. Stebbins* (1880), 17 O. G. 1348; 4 Fed. Rep. 445.

That an assignment of the assignor's interest in all patents previously obtained does not carry a subsequent invention of an improvement in one of these, see *Hammond v. Pratt* (1879), 16 O. G. 1235.

That where an agreement was made to sell two inventions, one only of which was patented, and the conveyance was duly made of the patent, and

afterwards the other was patented, the conveyance was held to cover only the first patent, see *Warren v. Cole* (1867), 15 Mich. 265.

³ In *Washburn & Moen Mfg. Co. v. Griesche* (1883), 5 McCrary, 246, Treat, J. : (249) "When, through several assignments, an individual becomes the owner of several distinct patents he can have no greater rights than his assignors respectively. He cannot claim that as no one of the assigned patents is specifically infringed, yet, if they are all considered, and some element of one is imported into another, and thus by patchwork a really new combination, unpatented, can be formed, therefore the defendant, who uses none of these patents, must be held to infringe. To infringe what? No existing patent. To illustrate: If A has a patent and B has a patent, and C infringes neither; and if A assigns his patent to D, and B does likewise, does C, by force of those assignments, become an infringer, when he infringes neither? 3 Fisher, 536; 16 Pet. 336; 15 Wall. 187; 1 Black, 427; id. 78; 2 Fisher, 89. In these, as in some other cases recently argued, there seemed to be an unexpressed, yet implied thought, that the assignment of different patents to a common assignee gave to the latter greater

of a combination are separately patented the assignee of all these patents does not become thereby the owner of the combination, nor can he use the elements combined without a license under the patent for the combination. Nor can the assignee of several patents lap one upon the other, and in this manner cover features of the invention which the patents in the hands of separate owners would not protect.

§ 778. Assignment Transfers only the Monopoly Created by American Patents: Its Effect on Foreign Patents.

But while the operation of an assignment is thus uniformly limited to the invention covered by the patent, the scope of the monopoly conveyed is not invariable. An inventor may secure for his invention one monopoly under his original American patent, another dependent on the first under each re-issue, a third still dependent on the first, but more distinct from it than a re-issue, under an extension, and others under foreign patents. In connection with the invention, he may assign any one or several of these concurrent or successive monopolies, and which will pass under a given conveyance depends upon the terms of the assignment and the presumptions of law. That an assignment of the invention carries one of these monopolies is evident, since the possession of prohibitory powers is essential to the effective ownership of the entire interest or any undivided part of the entire interest in a patented invention. Hence an assignment before patent creates an equitable title in the assignee to the original term of the future American patent, and if in due form and properly recorded it vests in him the legal title also when the patent is actually granted. Re-issues, being dependent on and superseding the original patent, likewise pass by such assignment unless the assignee prefers to hold his monopoly as created by the original patent.¹ An assignment during

rights than the respective patents conferred on their patentees; so that the assignee claiming under both could, by lapping one over the other, or incorporating parts of one into the other, obtain a right, unpatented, which neither of the assignors could separately maintain.

No such doctrine can be accepted. Each patent must rest on its own merits alone. *Munson v. Gilbert & Barker Mfg. Co.*, 3 Bann. & A. 595." 16 Fed. Rep. 669 (671).

§ 778. ¹ That as far as an assignment of a patent is concerned, the re-

the original term has the same effect on the monopoly arising from the original or re-issued patent, the legal title thereto always vesting in the assignee. The monopolies created by foreign patents, having no legal existence in the United States and being controlled entirely as to their operation and assignment by foreign laws, are not affected by any transfer of the patented invention, or of the invention before patent, which can be recognized and sustained in this country as the conveyance of a monopoly. For this reason an assignment of an invention, whether before or after the issue of an American patent, does not transfer the monopoly created by a foreign patent, nor does the existence of a foreign patent at the date of the assignment preclude the assignee from claiming title to the monopoly arising under the patent granted by the United States.² An express provision in such assignment transferring foreign patents would at best be but a contract which equity could enforce against the assignor by compelling him to execute such instruments as, under the foreign law, would operate as a conveyance of the monopoly within the country for which it was granted.

§ 779. Effect of Assignment upon an Extension.

It being certain that in every case an assignment operates upon the original term of the American patent and upon its re-issues, and that it never operates upon a foreign patent except by virtue of the laws of the country where the patent is in force, the only doubt which can arise in reference to the effect of an assignment upon the monopoly relates to an extension. An extension, when allowed by law, is intended for the benefit of the inventor.¹ It is permitted to him only on the

issue is part of the original patent and is covered by the assignment, see *Littlefield v. Perry* (1874), 21 Wall. 205; 7 O. G. 964.

That an assignee may accept or reject a re-issue as he pleases, see *Littlefield v. Perry* (1874), 21 Wall. 205; 7 O. G. 964.

² That the sale of the "invention" and all patents, present or future, while it is patented only under a foreign pat-

ent, carries not only that patent but subsequent American patents, see *Emmons v. Sladdin* (1875), 2 Bann. & A. 199; 9 O. G. 352.

§ 779. ¹ That an extension is for the benefit of the inventor, see *Ex parte Baker* (1872), 1 O. G. 632; *Case v. Redfield* (1849), 4 McLean, 526; 2 Robb, 741.

That no extension will be granted if the assignees are to reap the entire

ground that his inventive skill has not received a sufficient reward during the original term, and that this insufficiency is not due to his own fault or neglect.² It was not provided as a recompense to the assignees for the devotion of their capital or their business energies to the development of the invention and the distribution of its practical results among the public.³ Thus an extension can be obtained by the inventor alone, if living, or by his administrator or executor after his death.⁴ At the same time, the possibility of an extension adds to the value of the invention even before the original patent has been issued; and if he then is able to transfer it, and obtain a higher price on that account, he indirectly receives the recompense which the extension was intended to bestow. Hence the law recognizes his right to transfer this monopoly as well as any other,⁵ only requiring that, as a simple assignment of the invention is satisfied by the passage of the original term, an instrument which is to operate upon the extension must expressly and unequivocally include it.⁶ The presumption as to any given assignment is that it does not refer to the extension; and therefore, if its words can be construed to relate only to the original term and the re-issues, the assignment will be limited to these monopolies. Thus an assignment of all the assignor's right, title, and interest "during the term for which a patent may be granted;" or a conveyance of "all the patents which the grantor now has, or has in contemplation to obtain;" or a transfer of "all my right and title to the patent and the invention thereby secured;" or the assignment before patent of all the rights "I

benefit, see *Ex parte Munger* (1873), 3 O. G. 323; *Ex parte Baker* (1872), 1 O. G. 632.

See also § 836 and notes, *post*.

² See Sec. 18, act of 1836.

³ That the extension of a patent does not enure to the benefit of an assignee of the original term, see *Wilson v. Rousseau* (1846), 4 How. 646; 2 Robb, 372.

⁴ See Sec. 18, act of 1836; also *Woodworth v. Wilson* (1846), 4 How. 712; 2 Robb, 473; *Woodworth v. Sherman* (1844), 3 Story, 171; 2 Robb, 257.

⁵ See § 770 and cases cited, *ante*.

⁶ That the assignment of a patent during the original term, or before the patent issues, does not carry the extension unless there are express words to that effect, see *Hendrie v. Sayles* (1878), 98 U. S. 546; *Gibson v. Cook* (1850), 2 Blatch. 144; *Case v. Redfield* (1849), 4 McLean, 526; 2 Robb, 741; *Phelps v. Comstock* (1848), 4 McLean, 353; *Brooks v. Bicknell* (1845), 4 McLean, 64; *Woodworth v. Sherman* (1844), 3 Story, 171; 2 Robb, 257.

now have, or by letters-patent should be entitled to have," to the invention "to the full extent to which the same could be enjoyed by me but for this assignment," and providing for the issue of the patent to the assignee "as the owner of the whole right and title" to the invention; or a conveyance of "the patent" or of the "invention" after the patent has been granted,—have all alike been held to operate upon the original term and the re-issues only, for want of words which necessarily included the extension.⁷ On the other hand it has been said that an assignment before patent of "the invention" without any restrictions, or an assignment of "the invention and of all rights that may from time to time be

⁷ That a conveyance, during the original term, of all right, title, and interest during "the term for which letters-patent are or may be granted" does not carry an extension, see *Gear v. Grosvenor* (1873), 3 O. G. 380; *Holmes*, 215; 6 *Fisher*, 314.

That an assignment of the "right, title, and interest" in letters-patent about to be issued does not carry an extension, see *Johnson v. Wilcox & Gibbs Sewing Mach. Co.* (1886), 23 *Blatch.* 531; 27 *Fed. Rep.* 689.

That the grant of all patents which the grantor "now has or has in contemplation to obtain," does not carry an extension, see *Wetherell v. Passaic Zinc Co.* (1872), 2 O. G. 471; 6 *Fisher*, 50; 9 *Phila.* 385.

That an assignment by the patentee of all his right and title to the patent and to the invention thereby secured does not cover the extension, see *Waterman v. Wallace* (1875), 13 *Blatch.* 128; 2 *Bann. & A.* 126.

That an assignment, before a patent is granted, of all the right "I now have or by letters-patent would be entitled to have" in the invention, "to the full extent to which the same could be enjoyed by me but for this assignment," and providing for the issue of the patent to the assignee, "as the owner of the whole right and title"

to the invention, does not cover an extension, for want of words showing an intention to convey a future interest, see *Mowry v. Grand St. & Newtown R. R. Co.* (1872), 10 *Blatch.* 89; 5 *Fisher*, 586.

That an assignment of the "patent" does not carry the extension, see *Ex parte Holmes* (1873), 4 O. G. 581.

That the assignment of an "invention" after a patent issues is the grant only of the current term, see *Waterman v. Wallace* (1875), 13 *Blatch.* 128; 2 *Bann. & A.* 126.

That an assignment of the "invention" does not carry the extension, unless expressly so stated, see *Ex parte Holmes* (1873), 4 O. G. 581.

That the "term for which letters-patent may be granted" in the *habendum* is to be construed by the rest of the deed, and usually includes nothing except re-issues, see *Jenkins v. Nicholson Pavement Co.* (1870), 4 *Fisher*, 201; 1 *Abbott*, 567.

That a contract by the patentee in 1829 that his assignee shall have the benefit of all renewals, covers only re-issues, and not extensions, in the hands of the administrator, extensions being unknown to the law at the date of the contract, see *Wilson v. Rousseau* (1846), 4 *How.* 646; 2 *Robb*, 372.

secured," or of "the invention to the full end of the term for which a patent may be granted," or of "all patents and renewals" or of "the invention as now secured by letters-patent," and "to the full end of the term for which letters-patent are or may be granted," or a conveyance by the owner of the right to an extension of "all my rights" in the invention, — transferred the patentee's rights to the monopoly under the extension, and imposed on him the obligation to obtain the extension, if possible, and by a proper instrument convey it to his assignee.⁸ These illustrations show how comprehensive the language of an assignment may be, and yet not operate upon the extension; and also that no special form of words is necessary in order to convey it. In all cases the question is one of intention; and the interpretation put upon the instrument in this respect must be governed by its entire provisions, and by the circumstances of the contracting parties and the object they endeavored to effect. The assignee is presumed to know what rights to an extension may eventually vest in the assignor, and how such an extension would affect his own use and enjoyment of the invention; and he must either protect himself by the insertion of such provisions into the assignment as will secure to him the monopoly under the extension, as well as under the original patent, or abide by the presumption of the law that the right to the extension remains in the inventor.⁹

⁸ That the assignment of an "invention" without any restrictions carries all future patents for it, see *Emmons v. Sladdin* (1875), 2 Bann. & A. 199; 9 O. G. 352.

That a conveyance of an "invention" and "of all rights that may from time to time be secured" carries an extension, see *Railroad Co. v. Trimble* (1870), 10 Wall. 367.

That an assignment of the "invention" "to the full end of the term for which a patent may be granted" covers an extension, see *Nicholson Pavement Co. v. Jenkins* (1872), 14 Wall. 452; 1 O. G. 465; 5 Fisher, 491.

That an assignment of patents and

renewals carries extensions, see *Union Mfg. Co. v. Lounsbury* (1864), 42 Barb. 125; *Goodyear v. Cary* (1859), 4 Blatch. 271; *Wilson v. Turner* (1845), Taney, 278.

That an assignment of "the invention as secured by letters-patent" and "to the full end of the term for which letters-patent are or may be granted" carries the extension also, see *Ruggles v. Eddy* (1872), 5 Fisher, 581; 10 Blatch. 52.

That where an assignor owns a right to the extension, his conveyance of "all his right," etc., will carry the extension, see *Ex parte Mason* (1872), 1 O. G. 357.

⁹ In *Brooks v. Bicknell* (1845), 4

§ 780. Single Assignment may Transfer Several Patented Inventions.

An assignment by the owner of several patents may include one or more or all of them, as the parties may desire; though, to avoid confusion on the records, a separate conveyance for each patent is desirable. When such an instrument describes each patent by its date and number, the subject-matter of the assignment is evident. A general assignment of all such patents as the assignor "has in his own right" is, however, valid, and will transfer all patents of which he is the apparent owner, or part-owner, though not those which he holds in trust for others.¹

McLean, 64, *per Curiam*: (67) "The assignment transferred only the interest expressed on its face. No right, beyond the term named in the original patent, was conveyed by the assignment, unless so specified. But it is said that the assignee had ground to expect, when the patent expired, that he, in common with others, would have a right to use it; and that to deny him this right would be unjust. When he purchased the patent, in whole or part, he knew, or at least must be presumed to have known, that the patent could be renewed by Congress, and as a prudent man, he should have provided for such a contingency, in his contract of assignment, and what, under a renewal, would be a just provision in behalf of the assignee. For the time of the patent, he has not only had the right to use the machine, but to sell the invention to others. Now, no hardship results to the assignee from the renewal, unless he has a machine in operation which is necessarily suspended by the extension of the patent. The assignee could not claim, on any supposed ground of hardship, anything beyond the use of the machine or machines he may have in operation at the time of the renewal of the patent. But, under the

construction claimed for the assignee, he not only takes the use of the machine, if the assignment was a general one, but the entire beneficial interest in the renewed patent. Such a construction is in direct opposition to the declared intention of the act."

That where a patentee agrees to sell a right under an extension, and the buyer pays part of the purchase-money, but refuses to pay the rest, this does not, *ipso facto*, cancel the contract, since it is part executed, though a court of equity would decree cancellation of it in terms, see *Gibson v. Barnard* (1848), 1 Blatch. 388.

See further as to the assignment of an extension, §§ 412, 770, and notes, *ante*, and § 844 and notes, *post*.

§ 780. ¹ That the grant of such patents only as the grantor "has in his own right" does not include such as he holds for the benefit of others, but does include those in which he has only a part interest, see *Wetherell v. Passaic Zinc Co.* (1872), 2 O. G. 471; 6 Fisher, 50; 9 Phila. 385.

That a trade-mark used to designate patented articles is assignable with the patent, see *Julian v. Hoosier Drill Co.* (1881), 78 Ind. 408.

§ 781. Assignment of Patented Invention Does not Transfer Rights of Action for Past Infringements.

An assignment carries no right to sue for past infringements, unless so expressed.¹ These are injuries against the former owners of the patent, for which they have their remedy. Like other choses in action, the right to pursue this remedy can be transferred to the assignees of the invention, as well as to any other parties; but it is not embraced in the ownership either of the invention or the monopoly, and hence requires distinct words of conveyance. The assignment of an expired patent, however, being of no effect as an alienation of a patented invention for want of any existing subject-matter, may take effect upon those rights of action which alone remain, and be valid as a power of attorney to enforce them.² A conveyance *pendente lite* does not affect the litigation; but the judgment binds the parties to the assignment, according to the nature of the interests involved.³

§ 782. Effect of Assignment upon Existing Licenses and Powers of Attorney.

An assignment of the entire interest of the assignor in a patented invention revokes all his revocable licenses and terminates all his previous powers of attorney, unless the as-

§ 781. ¹ That an assignment of a patent does not cover claims for past infringements, unless so expressed, see *Kaolatype Engraving Co. v. Hoke* (1887), 30 Fed. Rep. 444; 39 O. G. 589; *May v. Juneau Co.* (1887), 30 Fed. Rep. 241; 41 O. G. 578; *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.* (1883), 21 Blatch. 519; 25 O. G. 1076; 18 Fed. Rep. 638; *Merriam v. Smith* (1882), 11 Fed. Rep. 588.

That an assignment of a patent by an administrator under order of court does not carry the right of action for past infringements, see *May v. Juneau Co.* (1887), 41 O. G. 578; 30 Fed. Rep. 241.

That the assignment of all "right, title, interest, claims, and demands

whatsoever which the estate has in, to, by, under, and through" letters-patent, carries rights of action for past infringements, see *May v. County of Logan* (1887), 30 Fed. Rep. 250; 41 O. G. 1387.

See further as to assignment of rights of action, §§ 790, 943, and notes, *post*.

² That the assignment of an expired patent may be good as a power of attorney to collect damages for past infringements, but not otherwise, see *Bell v. McCallough* (1858), 1 Bend, 194; 1 Fisher, 380.

³ That a conveyance *pendente lite* does not affect the litigation, see *Campbell v. James* (1880), 18 O. G. 1111; 18 Blatch. 92; 2 Fed. Rep. 338.

signed by continuing to recognize them as still in force estops himself from denying their validity.¹ The assignment of an undivided part of the entire interest creates a joint ownership in the invention and the monopoly, the proportion of each co-owner being determined by the provisions of the assignment. The relation sustained by these co-owners toward each other, and the rights of each as to the enjoyment of the patented invention, will be considered in a separate section.²

§ 783. Assignment for Valuable Consideration Implies a Warranty of Title, and a Right to Assign: Express Warranties.

From the assignment of a patented invention for a valuable consideration a warranty of title to it, and of a right to assign it according to the terms of the assignment, is implied by law.¹ This warranty grows out of the sale itself, not out

§ 782. ¹ That the conveyance of a patent revokes all revocable licenses, see *Shaw v. Colwell Lead Co.* (1882), 20 Blatch. 417; 11 Fed. Rep. 711.

That where a patent and all future improvements are assigned to one person, and subsequently an agreement is made by the assignor with another not to interfere with his manufacture, and after this an improvement is made and patented and assigned to the first assignee, the latter may enforce this new patent against the promisee under the agreement, see *Troy Iron & Nail Factory v. Corning* (1852), 14 How. 193.

That where the patentee sells to a corporation, and having obtained a re-assignment for the purpose of procuring an extension secures his extension and secretly licenses to others before he assigns back to the corporation, it is a fraud upon the corporation and the licensee acquires no rights, see *Consolidated Fruit Jar Co. v. Mason* (1877), 7 Daly, 64.

That an assignee of an interest in a patent, after a license is granted and while it is running, cannot compel the

licensee to account to him separately for his share of the royalties, see *Bergmann v. Macmillan* (1881), L. R. 17 Ch. D. 423.

That the sale of a patent terminates all previous powers of attorney, see *Labaree v. Peoria, Pekin, & Jacksonville R. R. Co.* (1877), 3 Bann. & A. 180.

That assignees of a patent who allow a power of attorney to remain and permit others to act on it may be bound by it, see *Labaree v. Peoria, Pekin, & Jacksonville R. R. Co.* (1877), 3 Bann. & A. 180.

That where an entire invention is assigned before the application and the attorney has received his power from the inventor alone, the power must be ratified by the assignee, or a new attorney must be appointed, see *Ex parte Ackerman* (1880), 17 O. G. 1036.

² See §§ 795-799, and notes, *post*.

§ 783. ¹ That in the sale of a patent there is always an implied warranty of title, see *Faulks v. Kamp* (1880), 3 Fed. Rep. 898; 17 C. G. 851; 17 Blatch. 432; 5 Bann. & A. 73; *Sher-*

of the instrument by which the conveyance is effected.² It draws after it any subsequently acquired title of the assignor which may be necessary to make his former transfer valid, and confers upon the assignee a right to damages wherever the interest actually vested in him by the assignment is less than that which it purports to convey.³ Express covenants of warranty may also be inserted in the assignment. These bind the assignor according to their terms, and may wholly or in part supersede the implied warranty.⁴ From a conveyance of all the assignor's right, title, and interest in the invention no warranty of title is implied. Such a conveyance passes the rights then vested in the alienor, whatever they may be, but imposes no obligation upon him, either on account

man *v.* Champlain Transportation Co. (1858), 31 Vt. 162.

That the sale of a patent right not only implies a warranty of title to it but a right to sell it, see *Faulks v. Kamp* (1880), 17 O. G. 851; 3 Fed. Rep. 898; 17 Blatch. 432; 5 Bann. & A. 73.

² That the warranty of title grows out of the sale itself, not out of the form of the conveyance, see *Faulks v. Kamp* (1880), 3 Fed. Rep. 898; 17 O. G. 851; 17 Blatch. 432; 5 Bann. & A. 73.

³ That the warranty implied in the sale of a patent right draws after it any after acquired title of the vendor which may be necessary to make the sale effective, see *Faulks v. Kamp* (1880), 3 Fed. Rep. 898; 17 O. G. 851; 17 Blatch. 432; 5 Bann. & A. 73.

That the assignee may recover damages for the breach of warranty, see §§ 1229-1232, and notes, *post*.

⁴ That there is no implied warranty in the sale of a patent that the patent is valid, see *Hiatt v. Twomey* (1836), 1 Dev. & Bat. Eq. (N. C.) 315.

That in the sale of a patent it is doubtful whether there is any implied warranty of validity where all is done in good faith, and both parties are assignees and are equally ignorant and

there is no fraud, see *Johnson v. Wilimantic Linen Co.* (1866), 33 Conn. 436.

That the conveyance of such inventions "as I have a patent right for" does not warrant that the vendor has a valid patent right, see *Bull v. Pratt* (1815), 1 Conn. 342.

That a subscriber for a share in a patent right, paying nothing and signing only as an inducement to lead others to subscribe, does not warrant to them the validity of the patent or the value of the invention, but they run their own risks, see *Lane v. Smith* (1878), 68 Me. 178.

That an agreement to protect the sales of the vendee from suits for infringements on other patents is a warranty that the article does not infringe other patents, see *Croninger v. Paige* (1880), 48 Wis. 229.

That a covenant of warranty is valueless when the property warranted does not exist, see *Bliss v. Negus* (1811), 8 Mass. 46.

That if the instrument conveying the patent contains no warranty, the vendee cannot set up a parol warranty, see *Joliffe v. Collius* (1855), 21 Mo. 338.

of a defect in his existing title or in respect to any title he may subsequently acquire.⁵

§ 784. Assignment to be Recorded : Record Constructive Notice.

For the protection of all persons subsequently becoming interested in the patented invention, the law requires that an assignment shall be recorded in the Patent Office within three months after the date of its execution.¹ During these three months the subsequent alienee must protect himself by such investigation as he is able to make, and runs his own risk of a defective title through the timely recording of a prior assignment.² But after three months without record the prior conveyance becomes invalid as against his later transfer, except in cases where he has actual notice of its existence.³ The record of the title to a patented invention, as it appears in the Patent Office, is thus conclusive in favor of all *bona fide* purchasers of any interest in the invention who have no other knowledge of the state of the title than that which the record furnishes, and against all unrecorded assignees whose title dates more than three months before the subsequent title is acquired.⁴ But such a record is not necessary to

⁵ See § 776 and notes, *ante*.

§ 784. ¹ Sec. 4898, Rev. Stat. "An assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent Office within three months from the date thereof."

See also *Turnbull v. Weir Plow Co.* (1874), 6 Bissell, 225; 1 Bann. & A. 544; 7 O. G. 173; *Gibson v. Cook* (1850), 2 Blatch. 144.

² In *Gibson v. Cook* (1850), 2 Blatch. 144, Nelson, J.: (148) "In order to guard against an outstanding title of over three months' duration, the purchaser need only look to the records of the Patent Office. Within that period he must protect himself in the best way he can, as an unrecorded prior assignment would prevail; but it must be an assignment in writing, that may be recorded within the time limited."

³ That an assignment is not valid against innocent parties, unless recorded, see *Boyd v. McAlpin* (1844), 3 McLean, 427; 2 Robb, 277; *Higgins v. Strong* (1836), 4 Blackf. (Ind.) 182.

That the law requiring a record of assignments, etc., is for the protection of *bona fide* purchasers without actual notice, see *Turnbull v. Weir Plow Co.* (1874), 6 Bissell, 225; 7 O. G. 173; 1 Bann. & A. 544.

That an assignment duly recorded protects the assignee in all his rights as against a subsequent assignee, see *Aspinwall Mfg. Co. v. Gill* (1887), 32 Fed. Rep. 697.

That actual notice to a subsequent purchaser is equivalent to record, see *Peck v. Bacon* (1847), 18 Conn. 377; and cases cited in note 5, *post*.

⁴ That the record of the patent and its assignments in the Patent Office is notice to all the world, and every one

render an assignment valid as between the assignor and those claiming under him, or between the assignee and any person having actual notice.⁶ The record, though made after

is chargeable with such knowledge as the search of the records would convey, see *National Car Brake Shoe Co. v. Terre Haute Car & Mfg. Co.* (1884), 28 O. G. 1007; 19 Fed. Rep. 514; *Newell v. West* (1875), 13 Blatch. 114; 8 O. G. 598; 9 O. G. 1110; 2 Bann. & A. 113.

That the assignee of a patent may rely on the record title, see *Campbell v. James* (1880), 18 Blatch. 92; 18 O. G. 1111; 2 Fed. Rep. 338; *Secombe v. Campbell* (1880), 2 Fed. Rep. 357; 18 Blatch. 108.

That the title of an assignee of record, derived from an assignor of more than six months ownership, cannot be attacked on the ground of fraud in the assignor, see *Racine Seeder Co. v. Joliet Wire Check Rower Co.* (1886), 27 Fed. Rep. 367; 37 O. G. 452.

That an assignment must be recorded before the assignee can sue on the patent, see *Wyeth v. Stone* (1840), 1 Story, 273; 2 Robb, 23.

That the Commissioner must be governed by the record title to the patent and cannot regard mere equitable claims, see *Ex parte Edison* (1875), 7 O. G. 423.

⁶ In *Perry v. Corning* (1870), 7 Blatch. 195, Woodruff, J.: (201) "It is sufficient to say that as against a purchaser in good faith, for value, without notice of any prior assignment, an assignment not recorded within the time limited in the act is not valid, and will not affect his rights acquired from the patentee before such record is made; and that, on the other hand, the instrument, though not recorded, is a perfectly valid instrument, and effectual according to its purport, as against the assignor and all others except third persons who, in good faith, for value, without notice, become pur-

chasers or acquire rights or interests in or under the patent."

In *Pitts v. Whitman* (1843), 2 Story, 609, Story, J.: (615) "Now, it is observable that there are no words in this enactment which declare that the assignment, if not recorded, shall be utterly void; and the question, therefore, is whether it is to be construed as indispensable to the validity of an assignment that it should be recorded within the three months, as a *sine qua non*, or whether the statute is merely directory for the protection of purchasers. Upon the best reflection which I have been able to bestow upon the subject, my opinion is that the latter is the true interpretation and object of the provision." 2 Robb, 189 (196).

Further, that an unrecorded assignment is valid between the parties, see *Horne v. Chatham* (1885), 64 Tex. 36; *Maurice v. Devo* (1883), 23 W. Va. 247; *Turnbull v. Weir Plow Co.* (1874), 7 O. G. 173; 6 Bissell, 225; 1 Bann. & A. 544; *Moore v. Bare* (1860), 11 Iowa, 198; *Sone v. Palmer* (1859), 28 Mo. 539; *Black v. Stone* (1858), 33 Ala. 327; *Hildreth v. Turner* (1855) 17 Ill. 184; *McKernan v. Hite* (1855), 6 Ind. 428; *Louden v. Burt* (1853), 4 Ind. 566; *Case v. Redfield* (1849), 4 McLean, 526; 2 Robb, 741; *Peck v. Bacon* (1847), 18 Conn. 377.

That an assignment though not recorded is good, except against creditors and subsequent *bona fide* purchasers, see *Holden v. Curtis* (1819), 2 N. H. 61.

That one who knows of a prior unrecorded assignment cannot be a *bona fide* purchaser, see *Ashcroft v. Walworth* (1872), 2 O. G. 546; *Holmes*, 152; 5 *Fisher*, 528.

That an assignment though unre-

three months have elapsed, affords constructive notice to all persons acquiring interests in the invention subsequently to the date of record.⁰

§ 785. Record of Unrecordable Instrument not Constructive Notice.

The law provides for the recording of three instruments only: an assignment before patent when the patent is to issue to the assignee, either alone or jointly with the inventor; an assignment after patent; and a grant.¹ The record of no other instrument than these affords constructive notice, although if thus brought to the knowledge of any person it may become as to him individually an actual notice of whatever rights the instrument purports to convey.² Thus an

recorded is good against all who have actual notice, see *Maurice v. Devo* (1883), 23 W. Va. 247; *Ashcroft v. Walworth* (1872), 5 Fisher, 528; *Holmes*, 152; 2 O. G. 546; *Continental Windmill Co. v. Empire Windmill Co.* (1871), 4 Fisher, 428; 8 Blatch. 295.

That it has been doubted whether actual notice of an unrecorded grant would bind subsequent assignees, see *Perry v. Corning* (1870), 7 Blatch. 195, and cases there cited.

That a prior unrecorded assignment is good against subsequent assignees without value, see *Saxton v. Aultman* (1864), 15 Ohio St. 471.

⁰ That the rule requiring an assignment to be recorded within three months is directory only, the record being good between the parties whenever it is made, see *Brooks v. Byam* (1843), 2 Story, 525; 2 Robb, 161.

That the record of an assignment is notice to subsequent purchasers, see *Case v. Redfield* (1849), 4 McLean, 526; 2 Robb, 741.

§ 785. ¹ That under the act of 1836 only an assignment of the whole or a part of the entire interest in an existing patent, or a grant of a territorial inter-

est, could be recorded, see Sec. 11, 1836, and *Brooks v. Byam* (1843), 2 Story, 525; 2 Robb, 161.

That under the act of 1870 and the Revised Statutes an assignment before patent may also be recorded, see Sec. 33, 1870, and Sec. 4895, Rev. Stat.

That Sec. 4895, Rev. Stat., does not provide for recording assignments of unpatented inventions, unless the patent is to issue to the assignee, and if recorded, such record is not notice to any one, see *Wright v. Randel* (1881), 21 O. G. 493; 19 Blatch. 495; 8 Fed. Rep. 591.

That the conveyance of a right to use within a limited territory need not be recorded, see *Stevens v. Head* (1837), 9 Vt. 174.

That under Sec. 5046, Rev. Stat. an assignment by the bankrupt court to the assignee need not be recorded in the Patent Office, see *Prime v. Brandon Mfg. Co.* (1879), 16 Blatch. 453; 4 Bann. & A. 379.

² That the record of an instrument which the law does not require to be recorded is not constructive notice of anything to any person, see *Wright v. Randel* (1881), 19 Blatch. 495; 8 Fed. Rep. 591; 21 O. G. 493; *Hamilton v.*

assignment before patent, unaccompanied by a request that the patent issue to the assignee, although recorded in due season, cannot prevail over a subsequent assignment with such request to a *bona fide* assignee for value, but the latter will receive the patent and can enforce it against the former.³ The record of an assignment of a right of action under a patent, for the same reason, is not constructive notice to the party against whom such action lies.⁴

§ 786. Relation of Legal and Equitable Titles Arising from Assignments.

Through the operation of these rules concerning the record of assignments, as well as by the other methods before noticed, the legal and equitable titles to a patentable invention may become separated from each other and vest in different owners, or an equitable title as against certain individuals may be created in one party while both the legal and equitable titles, as against all the world, may reside in another. Where, for example, an inventor assigns his invention before the granting of a patent, and then procures the issue of a patent in his own name, the assignment not containing a request for it to issue to the assignee, the legal title

Kingsbury (1879), 17 Blatch. 264 ; 17 O. G. 147.

That an agreement to assign a patent is not a recordable instrument, and if recorded does not amount to notice, see *N. Y. Paper Bag Mach. Co. v. Union Paper Bag Mach. Co.* (1887), 32 Fed. Rep. 788.

The record of a recordable instrument is constructive notice to all persons, whether cognizant of the record or not. But a person, having actual knowledge that any instrument is on record is put on inquiry as to all facts which the instrument suggests and which a reasonable search might ascertain, whether or not the instrument is in itself properly recordable. Thus that where some papers which the law does not require to be recorded are recorded while others are not, a party who acts

upon those recorded, in ignorance of the latter, is still bound by them as if also known, being put on inquiry by those recorded, see *Hamilton v. Kingsbury* (1879), 17 Blatch. 264 ; 17 O. G. 147.

³ That an unrecorded assignment, or an assignment before patent not requesting the issue of the patent to the assignee though put on record, cannot avail against a subsequent *bona fide* legal title to the patent, and such subsequent assignee may have the patent issued to him and hold it against the former, see *Wright v. Randel* (1881), 19 Blatch. 495 ; 8 Fed. Rep. 591 ; 21 O. G. 493.

⁴ That an assignment of a right of action need not be recorded, see *Gear v. Fitch* (1878), 16 O. G. 1231 ; 3 Bann. & A. 573.

vests in the inventor and the equitable title in the assignee.¹ Or where a party, having knowledge of the existence of a prior unrecorded assignment, after the time limited for recording it takes an assignment to himself and places it on record, he holds the legal title to the patented invention though the equitable title belongs to the former alienee.² In these cases, and in all others where the legal and equitable titles are severed from each other, chancery will regard the holder of the legal title as a trustee for the equitable owner, and compel him to execute such conveyances and perform such other acts as equity may require.³ But where a legal and equitable title meet in the same person, these will prevail over all other merely equitable titles unless their equity is

§ 786. ¹ That an assignment of the patent privilege, before the patent issues, is a contract to assign the patent when issued, and creates an equitable title to the patent in the assignee although the patent issues to the inventor, see *Aspinwall Mfg. Co. v. Gill* (1887), 40 O. G. 1133; *United States Stamping Co. v. Jewett* (1880), 7 Fed. Rep. 869; 18 Blatch. 469; 18 O. G. 1529; *Hammend v. Pratt* (1880), 16 O. G. 1235; *Littlefield v. Perry* (1875), 21 Wall. 205; 7 O. G. 964; *Newell v. West* (1875), 13 Blatch. 114; 8 O. G. 598; 9 O. G. 1110; 2 Bann. & A. 113; *Troy Iron & Nail Co. v. Corning* (1852), 14 How. 193; *Gayler v. Wilder* (1850), 10 How. 477.

That where a patent issues to an inventor after its assignment to another with a request that it issue to the assignee, the legal title vests in the assignee, upon his recording of the assignment, see *United States Stamping Co. v. Jewett* (1880), 7 Fed. Rep. 869; 18 Blatch. 469; 18 O. G. 1529; and other cases cited in § 769, notes 4 and 5, *ante*.

² That an assignee of record, taking his assignment with notice of prior unrecorded conveyances, acquires at most the legal title only, while the equitable title resides in the former assignees, see

Maurice v. Devo (1883), 23 W. Va. 247; *Ashcroft v. Walworth* (1872), 5 Fisher, 528; 2 O. G. 546; *Holmes*, 152; *Perry v. Corning* (1870), 7 Blatch. 195; and other cases cited in § 784, notes 3 and 5, *ante*.

³ That chancery will compel the holder of the legal title to do whatever may be required to protect the interests of the owner of the equitable title, see *Hapgood v. Rosenstock* (1885), 23 Blatch. 95; 23 Fed. Rep. 86; and cases cited in § 769, note 6, *ante*, and § 1228 and notes, *post*.

That where the absolute owner of a patent conveys it to joint trustees, with full discretionary powers, they cannot act otherwise than jointly, and their sole contracts are void, see *Wescott v. Wayne Agricultural Works* (1882), 11 Fed. Rep. 298.

That contract right may be protected in equity by enjoining the patentee from violating it, even though a specific performance cannot be decreed, see *Goddard v. Wilde* (1883), 17 Fed. Rep. 845.

That the sale of the invention, and the patent or extension to be thereafter obtained for it, with covenants of quiet enjoyment, gives an equitable interest in the patents so obtained, and the

superior to his.⁴ Thus when an assignment before patent, unaccompanied by a request that the patent issue to the assignee, is followed by another assignment to a *bona fide* assignee for value containing such request, which being duly recorded secures the patent to the later assignee, the legal title vests in him by the issue of the patent, and the equities being equal he can hold the patented invention against the equitable title of the former assignee.⁵ Or where, during the time limited for placing an assignment upon record, another *bona fide* purchaser obtains a title which he could enforce in chancery against his assignor, the due recording of the previous assignment enables the assignee in whom the legal and the equitable titles both inhere to vindicate them against any claim that may be set up by the later alienee.⁶ The legal title is shown by the patent itself, as granted and assigned by proper instruments duly recorded.⁷ Equitable titles may

patentee will be a trustee for the vendee, see *Emmons v. Sladdin* (1875), 9 O. G. 352; 2 Bann. & A. 199.

⁴ That the legal title to a patent will prevail over the equitable, unless the legal owner had notice of the equities, see *Davis Wagon Wheel Co. v. Davis Wagon Co.* (1884), 20 Fed. Rep. 699; 22 Blatch. 221; and cases cited in § 769, note 5, *ante*.

That notice to individual stockholders of an outstanding equitable title is not notice to the corporation, see *Davis Wagon Wheel Co. v. Davis Wagon Co.* (1884), 22 Blatch. 221; 20 Fed. Rep. 699.

⁵ That an assignment before patent with request that the patent issue to the assignee, if recorded, gives superior title to that of prior assignees of a prior patent, with contract to assign all future inventions of which this is one, provided the second assignment is *bona fide* and without notice, see *Wright v. Randel* (1881), 8 Fed. Rep. 591; 19 Blatch. 495; 21 O. G. 493.

That a subsequent *bona fide* purchase for value prevails over any mere

contract to sell a future term, see *Gibson v. Cooke* (1850), 2 Blatch. 144; and cases cited in § 769, note 5, *ante*.

That where an inventor assigns a patent with the interest in a new invention made by him, and afterward assigns the new invention to others and requests the patent to issue to them, which latter assignment is recorded and the patent so issued, these latter assignees may hold the new invention against the former assignee, see *Wright v. Randel* (1881), 21 O. G. 493; 19 Blatch. 495; 8 Fed. Rep. 591.

⁶ That an assignee, recording his assignment within the period prescribed by law, prevails over all intervening assignees, whether with or without notice of his assignment, see *Gibson v. Cook* (1850), 2 Blatch. 144.

⁷ That the legal title to a patent is shown by the patent as granted and assigned, whatever equitable rights any mere contracts may create, see *Graham v. McCormick* (1880), 5 Bann. & A. 244; 10 Bissell, 39; 21 O. G. 1533; 11 Fed. Rep. 859.

That title by grant of letters-patent

rest upon contracts to convey, which are unrecordable, or upon recordable conveyances where record has been unlawfully delayed.⁸ The parties having power in all cases to secure their rights by making proper conveyances and recording them in compliance with the law, the hardship which results from the extinguishment of merely equitable ownerships by those in which the legal and the equitable titles both unite must be attributed to their own negligence, rather than to the legal doctrine by which these respective rights are regulated and preserved.

§ 787. Assignor Estopped to Deny Validity of Patent or Title of Assignee.

The assignor of a patented invention is estopped from denying the validity of the patent or his own title to the interest transferred.¹ He cannot become the owner of an older patent

is title of record, see *Ex parte Osgood* (1885), 33 O. G. 1265.

That an assignment in trust gives the assignee a legal title, see *Campbell v. James* (1879), 17 Blatch. 42; 18 O. G. 979; 4 Bann. & A. 456.

⁸ That a contract to assign creates only an equitable interest, see *Gibson v. Cooke* (1850), 2 Blatch. 144; *Park v. Little* (1813), 3 Wash. 196; 1 Robt. 17; and cases cited in § 769, note 5, and § 771, note 4, *ante*.

That an equitable title may rest on unrecorded conveyances, see note 2, *ante*.

§ 787. ¹ That an assignor is estopped to deny the validity of the patent, see *American Paper Barrel Co. v. Laraway* (1886), 28 Fed. Rep. 141; 37 O. G. 674; *Underwood v. Warren* (1884), 21 Fed. Rep. 573; *Time Telegraph Co. v. Carey* (1884), 22 Blatch. 34; 26 O. G. 826; *Consolidated Middlings Purifier Co. v. Guilder* (1881), 9 Fed. Rep. 155; 3 McCrary, 186; *Faulks v. Kamp* (1880), 5 Bann. & A. 73; 17 O. G. 851; 17 Blatch. 432; 3 Fed. Rep. 898; *Onderdonk v. Fanning* (1880), 4 Fed. Rep. 148. See § 1021 and notes, *post*.

That parties subsequently becoming interested with the assignee are bound by the same estoppel, see *Time Telegraph Co. v. Carey* (1884), 22 Blatch. 34; 26 O. G. 826.

That an assignor is estopped to deny his own right to convey the patent, see *Faulks v. Kamp* (1880), 17 O. G. 851; 5 Bann. & A. 73; 17 Blatch. 432; 3 Fed. Rep. 898; *Ex parte Edison* (1875), 7 O. G. 423.

That a patentee is not estopped to deny the validity of his patent as against an assignee of his own trustee in bankruptcy, see *Cropper v. Smith* (1881), L. R. 26 Ch. D. 700; 10 App. Cas. 249.

That the estoppel operates against the assignor in favor of the assignee though the patent be invalid or the title void as against all the world beside, see *Curran v. Birdsall* (1883), 20 Fed. Rep. 835; 27 O. G. 1319.

That where a member of an infringing firm was formerly a part-owner of the patent, he is estopped from denying its validity unless he conveyed his interest to the plaintiff without considera-

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for the same invention and hold it against his assignee, nor can he practise the invention contrary to the provisions of his assignment, and when sued for infringement set up in his defence the invalidity of the patent or his own inability to convey it.² On the contrary, if the patent be in fact invalid, and the assignor obtains a valid patent for the same invention, the valid patent enures to the benefit of the assignee, except where his assignment covered only the then existing rights of the assignor.³ In the same manner the assignee is estopped

tion, see *Parker v. McKee* (1885), 32 O. G. 137.

That a plaintiff cannot deny the existence of a company through which he derived title, see *Bogart v. Hinds* (1885), 33 O. G. 1268.

That a patentee is estopped from denying the validity of the patent or its re-issues in a suit against him by his assignee, though the re-issues were granted after the assignment, and the assignee ought to have known that they were void, see *Burdsall v. Curran* (1887), 42 O. G. 1167; 31 Fed. Rep. 918.

That an applicant is estopped to deny his deed of assignment, see *Ex parte Edison* (1875), 7 O. G. 428.

² That a patentee having sold his patent cannot buy in an older patent and thus defeat his assignee's rights, even if the older patent be manifestly superior to his, see *Rumsey v. Buck* (1884), 20 Fed. Rep. 697; *Curran v. Burdsall* (1883), 27 O. G. 1319; 20 Fed. Rep. 835.

That where an assignor is co-owner of an older and superior patent, the assignee of the junior patent becomes the licensee of the other co-owners, and these must look to the assignor for their compensation, see *Curran v. Burdsall* (1883), 27 O. G. 1319; 20 Fed. Rep. 835.

That where an assignor agreed to stop making the invention and paid a license fee to the assignee for the privilege of selling what he had on hand, he cannot deny the validity of

the patent in a suit against him by the assignee for infringement by making and selling after the assignment under new letters-patent, see *Consolidated Middlings Purifier Co. v. Guildler* (1881), 9 Fed. Rep. 155; 8 McCrary, 186.

That a party who clothes another with the legal title to a patent, and confers upon the assignee the power to determine who shall take its benefits, is estopped to complain of fraud on the ground that another is not allowed to share in it, see *Racine Seeder Co. v. Joliet Wire Check Rower Co.* (1886), 27 Fed. Rep. 367; 37 O. G. 452.

See as to infringements by assignors § 914 and notes, *post*.

³ That where the grantor of a patent afterwards acquires a patent for the same invention, the latter enures to the benefit of his grantee, see *Faulks v. Kamp* (1880), 5 Bann. & A. 73; 17 Blatch. 432; 17 O. G. 851; 3 Fed. Rep. 898.

That if the title of the vendor is invalid at the time of the sale, a title afterwards acquired by him will enure to the benefit of the vendee, see *Sherman v. Champlain Transportation Co.* (1858), 31 Vt. 162.

That where one of two joint-patentees obtains a sole patent for the same invention, after the assignment of the joint patent, the sole patent vests in the assignees, see *Kohler v. Kohler* (1888), 43 O. G. 247.

That where an assignor grants to

from denying the validity of the patent, and of the title conferred upon him by the assignor, if he has taken and still enjoys the benefits of the assignment.⁴ Where by the terms of the assignment he becomes liable to the assignor for royalties on sales or for a share in the profits made by him from the use of the invention he cannot, in an action of account brought by the assignor for their recovery, defend upon the ground that the invention was unpatentable, or the patent void, or the assignor without a title which he could convey.⁵ Nor can he purchase an outstanding claim against the assignor and hold it as a set-off against the amount due according to the terms of his assignment.⁶ But where an assignee, on discovering the defects in the patent or the title, repudiates the assignment and relinquishes its benefits, the estoppel is no longer operative upon him.⁷

one person, and afterwards to another without warranty, and then again becomes the owner of the rights of the first grantee, the second grant becomes effective by estoppel, see *Littlefield v. Perry* (1874), 21 Wall. 205 ; 7 O. G. 964.

That a title may be acquired by estoppel against an inventor who permits third parties to deal with his invention as if it were their own, see *National Feather Duster Co. v. Hibbard* (1881), 11 Bissell, 76 ; 21 O. G. 635 ; 9 Fed. Rep. 558.

That an estoppel *in pais* cannot turn into a first and original inventor one who is not so, but can merely divert the patent from the inventor to an equitable assignee or defeat it altogether, see *Swift v. Rochow* (1880), 17 O. G. 450.

See further as to the estoppel of the assignor §§ 981, 1046, and notes, *post*.

⁴ That an assignee of a patent who has derived profits under it is estopped from denying its validity in an action for an account, see *Swift v. Rochow* (1880), 17 O. G. 450.

See also §§ 1238, 1239, and notes, *post*.

⁵ That an assignee cannot defend against a claim for royalties on the ground of fraud in the assignor, if he has received all the benefits of the assignment, see *Shaw v. Soule* (1884), 20 Fed. Rep. 790.

That an assignee manufacturing on terms cannot deny the validity of the patent when called to an account, see *Kinsman v. Parkhurst* (1855), 18 How. 289.

⁶ That an assignee cannot purchase of a third person a claim against the patentee and set it up against him on an account rendered in pursuance of an agreement to manufacture, see *Kinsman v. Parkhurst* (1855), 18 How. 289.

⁷ That a recital in a conditional contract of assignment that "the vendor is the owner of the patent," is not an estoppel on the purchaser, if the contract is rescinded before it takes effect, see *Swift v. Rochow* (1880), 17 O. G. 450.

See further as to the general doctrine of estoppel upon assignees and licensees, §§ 820, 1238, 1239, 1251, 1252, and notes, *post*.

§ 788. Assignments upon Condition: Reversionary Interests of Assignor.

An assignment may be made upon condition, or for a term less than the entire duration of the patent, and thus reversionary interests may be created in the assignor.¹ These interests he can protect according to their nature, enforcing the conditions and maintaining actions, legal or equitable, as the case requires.² After the termination of his interest in the invention, whether by forfeiture for breach of condition or by lapse of time, the assignee can neither license others to practise it, nor in any other manner limit the rights now vested in the assignor.³

§ 788. ¹ That unless an assignment is unconditional the assignor has rights which he can protect, see *Cook v. Bidwell* (1881), 20 O. G. 1083; 8 Fed. Rep. 452.

That as long as the conditions of a conditional assignment are not fulfilled, the assignor has a reversionary interest, see *Otis Bros. Mfg. Co. v. Crane Bros. Mfg. Co.* (1886), 27 Fed. Rep. 550.

That an assignment for a term of years leaves a reversionary interest in the assignor, which he can protect, see *Still v. Reading* (1881), 20 O. G. 1025; 9 Fed. Rep. 40; 4 Woods, 345; *Cook v. Bidwell* (1879), 20 O. G. 1083; 8 Fed. Rep. 452.

That whether an assignment on condition subsequent has been defeated is a question for the courts, not for the Patent Office, see *Hammond v. Pratt* (1880), 16 O. G. 1235.

² That where a patent is sold with a condition of reconveyance, the condition may be enforced, see *Andrews v. Fielding* (1884), 20 Fed. Rep. 123.

That where the assignee of a patent fails to carry out the purpose for which it has been assigned to him, and the contract provides for a reverting of the patent in such case to the assignor, it will so revert, see *Buckley v. Sawyer Mfg. Co.* (1881), 7 Fed. Rep. 358; 2 McCrary, 350.

That any person taking title from

a conditional assignee with notice of the conditions is bound by them, see *Werderman v. Société Générale d'Électricité* (1881), L. R. 19 Ch. D. 246.

That where the inventor agrees with a capitalist to develop an invention, and each party is to use due diligence, and the patent is to revert to the inventor if the capitalist is in fault, no reverter will be decreed if both are in fault, and the inventor has been remunerated, see *Buckley v. Sawyer Mfg. Co.* (1881), 2 McCrary, 350; 7 Fed. Rep. 358.

That where the owner of a patent, having assigned the exclusive right to make and sell, excepting the right to sell in a certain place, and reserving to himself the personal right to make and sell anywhere, and having transferred to the assignee the right to sue infringers and take the proceeds of the suits, afterwards sells the patent to one who knows of this assignment and its terms, the assignee can enjoin the vendee from making and selling, except in the particular place excepted, see *Haygood v. Rosenstock* (1885), 23 Blatch. 95; 23 Fed. Rep. 86.

³ That after an assignment has been forfeited by breach of condition, the assignee can grant nothing either by way of license or otherwise, see *Abbett v. Zusi* (1879), 5 Bann. & A. 38.

§ 789. Assignees: when Bound by Prior Acts of Assignors.

The privity which exists between the assignor of a patented invention and his assignees renders them subject to the legal consequences of all his prior acts of which they have actual or constructive notice or of which such notice is presumed.¹ They are concluded, equally with himself, by judgments rendered against him before the assignment, and receive their interests subject to all the equities of which they have knowledge.² If their title accrues pending an interference, they are bound by its results to the same extent that the assignor would have been had the assignment not been made.³ But private conduct or admissions of the assignor, of which his assignees could have obtained no information or were not bound to make inquiry, do not thus affect them.⁴ Acts subsequent to the assignment cannot prejudice their rights.

§ 789. ¹ That an assignee takes the patent subject to all the legal consequences of the inventor's prior acts, see *Worley v. Tobacco Co.* (1881), 104 U. S. 340; 21 O. G. 559; *McClurg v. Kingsland* (1843), 1 How. 202; 2 Robb, 105.

That an assignee of the interest of another assignee takes no more than his grantor had, and is chargeable with notice of what he might have learned if he had inquired of the original grantor, as against a later assignee of the original grantor, see *Hamilton v. Kingsbury* (1880), 17 Blatch. 460; 17 O. G. 847; 4 Fed. Rep. 428.

² That the assignee of a patent is concluded by a decree against his assignor, see *Pennington v. Hunt* (1884), 20 Fed. Rep. 195; and §§ 983, 1017, 1048, and notes, *post*.

That an assignee takes subject to the assignor's disclaimers, and other acts working an estoppel, see *Blades v. Band, McNally, & Co.* (1886), 27 Fed. Rep. 93; 37 O. G. 99.

That where an assignee assigns his rights, his assignee is bound by all the equities of which he has knowledge, see

Kinsman v. Parkhurst (1855), 18 How. 289.

³ That a purchaser who buys an interest in an invention during an interference is bound by the rule of *caveat emptor*, see *Ex parte Mason* (1872), 2 O. G. 274.

That under Sec. 58, act of 1870, an assignee is not estopped by the patentee's statement in an interference proceeding as to the date of his invention, see *Union Paper Bag Mach. Co. v. Crane* (1874), 1 Bann. & A. 494; 6 O. G. 801; *Holmes*, 429.

That a concession as to priority does not affect prior assignees, see *Hammond v. Pratt* (1880), 16 O. G. 1235.

That the rights of an assignee against a rival inventor are the same as those of his assignor, see *Gay v. Cornell* (1849), 1 Blatch. 506.

⁴ That an assignee for valuable consideration is not bound by a prior unrecorded equitable claim of which he had no notice, see *Campbell v. James* (1880), 18 Blatch. 92; 18 O. G. 1111; 2 Fed. Rep. 338.

That whether assignees without notice are estopped by the conduct of the

§ 790. Assignment of Right of Action for Past Infringements.

The right to sue for past infringements may be assigned in connection with an assignment of the patent, like any other chose in action, and the remedy can be enforced in law or equity by the assignee.¹ Such an assignment may be made after a suit has been commenced, in which case the defendant must be notified thereof before proceeding further in the cause.² No especial form is required for such assignment. An irrevocable power of attorney to collect the claims, or an instrument purporting to assign the patented invention, but executed after the patent has expired, are regarded as sufficient for this purpose.³ Such an assignment is not legally recordable.⁴

inventor, *quere*, see *Sprague v. Adriance* (1877), 3 Bann. & A. 124; 14 O. G. 308.

That a purchaser, pending a suit to which he is a party, takes subject to the equities of the other parties to the suit, see *Kearney v. Lehigh Valley R. R. Co.* (1886), 27 Fed. Rep. 699.

§ 790. ¹ That the right to sue for the infringement of a patent is assignable, see *Shaw v. Colwell Lead Co.* (1882), 11 Fed. Rep. 711; 20 Blatch. 417; *Hamilton v. Rollins* (1877), 5 Dillon, 495; 3 Bann. & A. 157.

That the assignment of a share in the proceeds of suits for infringements creates no interest in the invention or the monopoly, see *Tilghman v. Proctor* (1888), 125 U. S. 136; 43 O. G. 628.

That a right of action for infringement survives to personal representatives and may be sued on or assigned by them, and the assignee may sue thereon in his own name if the local law permits, see *May v. County of Logan* (1887), 30 Fed. Rep. 250; 41 O. G. 1387.

That an assignment by an administrator of all rights under or through an expired patent carries claims for past infringements, see *May v. Saginaw Co.* (1887), 32 Fed. Rep. 629.

That a sale of patents by an admin-

istrator under order of court for a nominal sum does not carry a right to sue for past infringements, see *May v. Juneau Co.* (1887), 30 Fed. Rep. 241; 41 O. G. 578.

That an assignment of a claim for the use of an invention is not an assignment of the patent, see *Campbell v. James* (1880), 18 Blatch. 92; 18 O. G. 1111; 2 Fed. Rep. 338.

That an assignee of claims for past infringements takes subject to all equities, see *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.* (1883), 21 Blatch. 519; 25 O. G. 1076; 18 Fed. Rep. 638.

² That when a right of action is assigned after a suit is brought, the defendant should be notified of it, see *Gear v. Fitch* (1878), 3 Bann. & A. 573; 16 O. G. 1231.

³ That an assignment of an expired patent can take effect only as an assignment of claims for past infringements, see *May v. Saginaw Co.* (1887), 32 Fed. Rep. 629.

That the assignment of an expired patent may operate as a power of attorney to sue for and collect damages for past infringements, see *Bell v. McCullough* (1858), 1 Bond, 194; 1 Fisher, 380.

⁴ That an assignment of the right

§ 791. Grant Defined: Distinguished from Assignment.

The grant of a patented invention differs from an assignment only as to the territorial limits within which it operates. It differs from a license as to the nature of the rights conveyed. The grantee has the exclusive interest both in the invention and in the monopoly, within the prescribed limits, and may maintain an action in his own name for an infringement of the patent within his territory. A licensee has either a non-exclusive interest or an interest in less than all the rights embraced in the invention, and no interest in the monopoly which he can make effective by a suit at law in his own name. To distinguish, therefore, an assignment from a grant it is only necessary to determine whether the conveyance is of force throughout the entire United States or is confined to a particular locality.¹ It matters not whether the restrictions are in positive or negative terms. An instrument transferring all the rights secured by the patent, except as to a certain town or county, is as true a grant as if the area lying outside of such town or county were specifically described.²

§ 792. Grant Distinguished from License.

To distinguish a grant from a license, regard must be paid to the nature of the interest conveyed. The interest must be

to maintain suits need not be recorded, see *Gear v. Fitch* (1878), 16 O. G. 1231; 3 Bann. & A. 573.

See further as to an assignment of a claim for past infringements, § 781 and notes, *ante*, and § 943 and notes, *post*.

§ 791. ¹ See § 763, note 1, *ante*.

² That the transfer of the entire interest in the invention within specified territory is a grant, see *Potter v. Holland* (1858), 4 Blatch. 206; 1 Fisher, 327; *Ritter v. Serrell* (1852), 2 Blatch. 379.

That the transfer of all the patentee's interest in a given territory is a grant, see *Perry v. Corning* (1870), 7 Blatch. 195.

That an assignment of all rights

"except certain counties already sold" is valid and certain, since evidence may show what counties have been sold, see *Washburn & Moen Mfg. Co. v. Haish* (1880), 19 O. G. 173; 10 Bissell, 65; 4 Fed. Rep. 900.

That the grant of a State-right "except 14 counties," with an agreement to furnish a list of such counties, leaves the grantee free to select them until the list is furnished, see *Pryor v. Coulter* (1830), 1 Bailey (S. C.), 517.

That when a territorial assignee sells his "right to use and sell" as mentioned in the patent, it carries his entire rights, see *Burdell v. Denig* (1865), 2 Fisher, 588.

entire within the prescribed area, and exclusive.¹ A transfer of the right to make or use or sell, or of the exclusive right to make or use or sell, does not convey the entire interest; the grant must operate on all three of these rights, and be exclusive as to all; and a transfer which does not thus operate is a mere license. But these rights need not be particularly described in the conveyance, if it manifests an evident intention of the grantor to transfer them. An alienation of all the rights mentioned in the patent is an assignment or a grant according to the territorial limits fixed by the conveyance.²

§ 793. Grants upon Condition.

A grant, like an assignment, may be conditional or temporary. It may also be limited as to the extent of its enjoyment. The grant of an exclusive right to make and use and sell a certain number of the patented devices within the prescribed territory, and of the exclusive use of the invention within such territory, is a valid grant, conferring upon the grantee the sole interest in the invention and monopoly in that area, and yet restricting him in its enjoyment to the number of the articles described.¹ Limits may also be placed to his mode

§ 792. ¹ In *Littlefield v. Perry* (1874), 21 Wall. 205; 7 O. G. 964, the Supreme Court seem to recognize the grant of an undivided interest within a certain territory as valid and proper. The statute on which the power to transfer the monopoly depends, however, makes no provision for the conveyance of any rights within a specified area unless such rights are exclusive. Sec. 4898, Rev. Stat.: "The patentee . . . may in like manner grant and convey an exclusive right under his patent to . . . any specified part of the United States." See also *Potter v. Holland* (1858), 4 Blatch. 206; 1 Fisher, 327; *Gayler v. Wilder* (1850), 10 How. 477. A non-exclusive right must, therefore, be an interest in the invention as distinguished from the monopoly, — that

is, a mere license, unless a grant of an undivided interest could be construed as making the grantee and grantor co-grantees, in whom the entire and exclusive sectional interest resided.

² That an assignment of all the patentee's right, title, and interest within certain territory is the grant of an exclusive right, see *Perry v. Corning* (1870), 7 Blatch. 195; *Burdell v. Denig* (1865), 2 Fisher, 588.

That an exclusive right for a term of years to use the invention in a given territory, and to use and sell the product of such use, is a mere license, not a grant, see *Oliver, Finnie & Co. v. Rumford Chemical Works* (1883), 109 U. S. 75; 25 O. G. 784.

§ 793. ¹ That the grant of an exclusive right to make, use, and sell a cer-

of using the invention, or to the sale of it or of its products outside of his territory; the conveyance is still a grant unless the enjoyment thus denied to the grantee is reserved to the grantor or vested in some other alienee.² His right is no less exclusive for being limited in exercise, provided it resides in him alone. But in the absence of such restrictions the grantee may enjoy the rights to make and use and sell within his district as fully as the patentee could have done, and the products which arise out of his practice of the invention may be used by his vendees in any portion of the United States.³

tain number of the patented devices within a certain territory, and of the exclusive use of the patent in such territory, vests an exclusive territorial interest in the grantee, see *Ritter v. Serrell* (1852), 2 Blatch. 379.

² That a grant of specific territory may be limited as to the mode of use and yet be valid, see *Dorsey Revolving Harvester Rake Co. v. Bradley Mfg. Co.* (1874), 12 Blatch. 202; 1 Bann. & A. 330.

³ That an assignee of a territorial right, without restrictions, may sell the patented device to be used anywhere, see *Hatch v. Hall* (1884), 30 O. G. 1096; 22 Fed. Rep. 438; *McKay v. Wooster* (1873), 2 Sawyer, 373; 6 Fisher, 375; 3 O. G. 441.

That such an assignee cannot sell the device to have it sold again or used in the course of trade outside his territory, see *Hatch v. Adams* (1884), 22 Fed. Rep. 434; 29 O. G. 776.

See also §§ 824, 914, and notes, *post*.

That where the patentee grants a territorial right to make, use, and sell without limiting the use by the vendee, the vendee of the grantee may use the invention anywhere without reference to other grants of the patentee, see *Adams v. Burke* (1873), 17 Wall. 453; 33 O. G. 114.

That a grantee cannot make outside his own territory, for use outside it, see *American Paper Barrel Co. v. Laraway* (1886), 28 Fed. Rep. 141; 37 O. G. 674.

That an assignment, by the assignee of an exclusive right to make and use the invention within a given territory, exhausts his own interests within that territory, and he has no right to make up the invention and put it into the market, to be used after the patent expires, contrary to the rights of the patentee on the extension, see *Union Paper Bag Mach. Co. v. Nixon* (1876), 9 O. G. 691; 2 Bann. & A. 244; 1 Flippin, 491.

That the assignor of a territorial right cannot sell the device in that territory or to be used in that territory, see *Union Paper Bag Mach. Co. v. Nixon* (1876), 2 Bann. & A. 244; 9 O. G. 691; 1 Flippin, 491.

That the reservation by an assignor of the right to use the invention in one of several assigned States does not affect the assignee's rights in the other States, see *Hobbie v. Smith* (1886), 27 Fed. Rep. 656.

That an agreement that the grantee only should manufacture is not void as being in restraint of trade, see *Kinsman v. Parkhurst* (1855), 18 How. 289.

§ 794. Form of Grant: Implied Warranties: Estoppels.

A grant, like an assignment, must be in writing and duly signed by the grantor.¹ It must also be recorded within the same period in order to avail against subsequent *bona fide* assignees and grantees for value.² It imports a warranty of title, and gives rise to the same estoppel and the same privities of interest and obligation as an assignment.³ Having in view the essential difference between them, the rules which have been stated as regulating and applying to the one form of conveyance may be predicated, *mutatis mutandis*, of the other.

SECTION II.

OF THE TRANSFER OF LETTERS-PATENT: JOINT-OWNERS.

§ 795. Property of Joint-Owners in the Patented Invention.

By the assignment of an undivided interest in a patented invention, the alienor and alienee become joint-owners both of the invention and the monopoly. On account of the peculiar nature of this species of property, the relations of such joint-owners toward each other present questions of difficulty, not all of which can be considered as yet fully settled. Property in an invention, as well as property in a monopoly, is incorporeal. It is incapable alike of physical partition, and of united physical possession. The subordinate rights embraced in the invention may indeed be separated, and be

§ 794. ¹ Sec. 4898, Rev. Stat.

² Sec. 4898, Rev. Stat. See also § 784 and notes, *ante*.

That a conveyance of "all my right, title, and interest in and to" a patent, though recorded, does not affect territorial rights previously conveyed by the grantor, but not recorded, see *Turnbull v. Weir Plow Co.* (1880), 14 Fed. Rep. 108; 9 Bissell, 334; 23 O. G. 91; 5 Bann. & A. 288.

³ That an assignment of "all our right, title, and interest" in certain

territory "to the full end of the term," etc., is not a mere release, but implies that a patent has been issued in due form, and if this is not true the price is not recoverable, see *Shepherd v. Jenkins* (1881), 73 Mo. 510.

That if a grantee avails himself of the grant, he cannot, in a suit for royalties on goods sold, deny that the patentee is the true inventor, unless he has been evicted, see *Birdsall v. Perrigo* (1865), 5 Blatch. 251.

hold by different owners, but the monopoly is indivisible, and whether it resides in many individuals, or in one alone, must be of the same character and limits. When, therefore, a patented invention, which includes both the invention and the monopoly, vests in two or more persons their relations to each other as co-owners must follow one of three rules: either (1) each owner must individually possess all the subordinate rights embraced in the invention together with the entire and indivisible monopoly; or (2) he must individually possess the rights embraced in the invention while the monopoly resides entire and indivisible in all the owners collectively; or (3) the rights embraced in the invention as well as the monopoly must vest indivisibly in all the owners as a single person. The first rule might be pronounced untenable upon its face had not the courts, ignoring the fact that the right to suspend prohibitory powers is as true a part of the monopoly as is the right to enforce them, already held with tolerable uniformity that each joint-owner may, at his pleasure, abrogate the monopoly both as against himself and his co-owners, — a position which assumes that the monopoly is indivisibly and entirely his to destroy, if not to exercise. The second rule, and probably the correct one, has as yet received no formal recognition except, perhaps, indirectly in cases where one joint-owner has been held liable to his co-owners for an infringement of their common patent. The third rule has been repeatedly discarded by the courts, and it may be accepted as an established doctrine that whatever may be their relation to the monopoly such joint-owners are not co-partners, nor collective owners of the invention, but that their interests therein are distinct, each being independent of the others, though subject to the limitations imposed upon its disposition and enjoyment by the monopoly conferred on his co-owners.¹

§ 795. ¹ In *Pitts v. Hall* (1854), 3 Blatch. 201, Hall, J. : (206) "In the case of joint-patentees, where no agreement of co-partnership exists, the relation of co-partners certainly does not result from their connection as joint-patentees; and, when one joint-owner

of a patent transfers his undivided interest to a stranger, the assignee does not become the partner of his co-proprietor. In both cases the parties interested in the patent are simply joint-owners, or tenants in common, of the rights and property secured by the

§ 796. Reciprocal Rights and Duties of Joint Owners in reference to the Enjoyment of the Patented Invention.

According to the second rule the monopoly resides in the co-owners collectively, and can neither be abrogated nor

patent; and their rights, powers, and duties, as respects each other, must be substantially those of the joint-owners of a chattel. Part owners of goods and chattels are either joint-owners or tenants in common, each having a distinct or at least, an independent, although an undivided, interest in the property. Neither can transfer or dispose of the whole property; nor can one act for the other in relation thereto, but merely for his own share, and to the extent of his own several right and interest; and at common law the one had no action of account against the other for his share of the profits derived from the common property. (Story on Partnership, § 89.) A personal chattel vested in several different proprietors cannot possibly be enjoyed advantageously by all, without a common consent and agreement among them. To regulate their enjoyment in case of disagreement is one of the hardest tasks of legislation, and it is not without wisdom that the law of England and of this country, in general, declines to interfere in their disputes, leaving it to themselves either to enjoy their common property by agreement or to suffer it to remain unenjoyed or to perish by their dissension, as the best method of forcing them to a common consent for their common benefit. (Abbott on Shipping, 98.) It is well settled that a destruction or sale of the joint property by one of the part owners, authorizes his co-proprietor to maintain trover for the conversion. (2 Kent's Comm., 8th ed., 351, note.) But on such a sale only the right of the party who makes the sale passes to the purchaser; and the purchaser becomes a tenant in

common with the owner of the remaining interest, unless and until the latter confirms the sale, or recovers the value of his share from the wrong-doer. The principles of these doctrines are, it strikes me, applicable to the case of the joint-ownership of patent rights. The grant of the exclusive right to make, use, and vend to others to be used, is to the patentees jointly and not to either severally. The right, the property secured by the patent, may be granted to others by license or assignment, or by the sale of machines by the patentees jointly; and a license or assignment or sale of a machine by them is a transfer, *pro tanto*, of the property secured by the patent. One joint-owner can legally grant, assign, license, or sell only in respect to his own share or right. He cannot sell and give a good title to his co-owner's right, for the same reason that one joint-owner of a chattel cannot transfer the share of his co-proprietor. And if he appropriates any portion of the exclusive right or common property to his separate use or benefit, by either the use or the sale of the patented machine, he does what is, in principle, the same as the conversion, by destruction or sale, of the joint property by a tenant in common, which authorizes his co-tenant to maintain trover."

That joint-owners of a patented invention are tenants in common, see *Dunham v. Indianapolis & St. Louis R. R. Co.* (1876), 7 Bissell, 223; 2 Bann. & A. 327; *De Witt v. Elmira Nobles Mfg. Co.* (1875), 5 Hun, 301.

That there is no true analogy between patent rights and any other property, and co-owners are not like tenants in

suspended without the consent of all, while each joint-owner individually possesses the subordinate rights embraced in the invention. This rule at once preserves the harmony of the law in reference to the nature and ownership of a monopoly, protects the exclusive privilege conferred by the patent upon all the patentees, and permits to each owner as wide a latitude in the enjoyment of the invention as is consistent with the rights of his co-owners. Under it each may himself practise the invention without accountability to them, and may convey his entire interest in the patented invention to another individual; since the exercise of such powers does not interfere with the enjoyment of their equal privileges by the other owners, nor with that security from competition which the patent is intended to afford. But it forbids an assignment of the interest of one joint-owner to several assignees, or the grant of licenses to make, or use, or sell the patented invention, because by multiplying the number of those persons who can practise the invention without disturbance from the exercise of the monopoly, the value of the patented invention to the other owners may be sensibly diminished and perhaps destroyed. In the few cases hitherto decided the courts, by partially adopting the first rule, have indeed recognized this power as inherent in each owner of the patented invention. They have held that his right to alienate his own interest to others is unlimited in respect to the number of his transferees; that by such transfer the entire monopoly is abrogated or suspended so that his assignees and licensees cannot be interfered with by the other owners of the prohibitory powers; and that, at most, he is accountable to them for their proportion of the purchase-money or license-fees which he may have received.¹ It is obvious that under this rule the other own-

common of lands, or ways, or tolls, or personal property, see *Vose v. Singer* (1862), 4 Allen, 226.

That a joint interest in a patent does not make the owners partners, see *Parkhurst v. Kinsman* (1849), 1 Blatch. 488.

That there may be any number of joint-owners, and each will be independent of the others, and not a co-partner, see *Vose v. Singer* (1862), 4 Allen, 226.

That the issue of a patent to one of two joint-owners of an invention enures to the benefit of both, see *Vetter v. Lentzinger* (1871), 31 Iowa, 182.

§.796. ¹ In *Dunham v. Indianapolis & St. Louis R. R. Co.* (1876), 7 Bissell, 223, Drummond, J.: (223) "The material point is, who is to answer, if any one, to the other patentees for the use of the part which does not belong to

ors do not obtain adequate protection. Those who desire to use their property by practising the invention are at the

them, when a joint-owner uses the improvement, or makes a contract with another person for its use. What is the position of patentees with reference to their right to use the thing patented? The patentees are tenants in common of the right. One of them has no superiority of right over the others. One of them can manufacture and use the article patented without the consent of the others; that is, each has the same right, although one may own a greater share of the thing patented than the others. The grant was, in this case, to the three to use and vend the improved car-brake shoes, and while it is clear that one of the patentees cannot grant what does not belong to him, and if he gives a license or makes a contract for the use of the thing patented, he can only grant that which he has himself, and not the rights of the other patentees, still he can clothe his grantee or his licensee with the same right that he has himself, namely, the right to sell or use the thing patented. And it seems to me the better rule is to hold, if there is a liability at all, that where a party owning less than the whole of a thing patented, makes a grant or a license, he shall be answerable to the others, rather than that the other patentees shall look to the grantee or licensee. There were three cases particularly referred to on the argument. One was the case of *Pitts v. Hall*, 3 Blatchford, 201, decided by Judge Hall, of the Northern District of New York. He seems to hold that if one joint-owner of a patent uses or sells his right without the authority of his co-owner, he is liable to an action by such co-owner for an infringement of the patent; and the conclusion, perhaps, to be drawn from his decision is that if the party to whom he sells uses the thing

patented, an action could be maintained and an injunction issued against the grantee or licensee of the co-owner. Judge Curtis, in the case of *Clum v. Brewer*, 2 Curtis, Circuit Court, 506, seems to hold, and I think that is the true rule upon the subject, that where one of the joint-patentees uses or sells the thing patented, or any portion of it, the others cannot sue him as for an infringement of the patent. The most that can be claimed is that if one uses or sells it to the detriment of the others, he may be held responsible. For example, if he obtains more than his share of the profits from the use of the article, or in issuing licenses he obtains more than his share of the license money, he possibly may be held responsible by the other joint-patentees; but Judge Curtis, in that case, held that an injunction should not issue against the use, by one of the joint-patentees, of the thing patented, and the principle decided by him is that one tenant in common of letters-patent has the same right as the others to make, use, and sell the thing patented, and a licensee under one tenant in common cannot be enjoined on a bill by another tenant in common. A case has been decided in England bearing on this question, *Mathers v. Green*, 1 Law Reports, Chancery Appeals, 29, and the opinion is given by Lord Chancellor Cranworth. That was a case of letters-patent granted to three individuals. The Chancellor says: 'The right conferred is a right to exclude all the world other than the grantees from using the invention. But there is no exclusion in the letters-patent of any one of the patentees. The inability of any one of the patentees to use the invention, if any such inability exists, must be sought elsewhere than in the letters-patent. But there is

mercy of those whose profit is derived from selling rights or granting licenses to others; and as each owner may fix

no principle, in the absence of contract, which can prevent any persons not prohibited by statute from using any invention whatever. Is there any implied contract where two or more persons jointly obtain letters-patent, that no one of them shall use the invention without the consent of the others, or, if he does, that he shall use it for their joint benefit? I can discover no principle for such a doctrine. It would enable one of two patentees either to prevent the use of the invention altogether, or else to compel the other patentee to risk his skill and capital in the use of the invention on the terms of being accountable for half the profit, if profit should be made, without being able to call on his co-patentee for contribution if there should be loss.' Now while this is the principle announced by the Chancellor, it perhaps should be with this qualification, — that if one of the patentees obtains more than his share of the profits, he might be held liable under certain circumstances to the others. Certainly I do not wish to be understood as affirming that there is never such liability. Of course we must take into consideration any risk which he may run, any outlay of money which he may make in the manufacture or sale of the article; but if, looking at it upon equitable principles, he has obtained more than his share of the profits arising from the thing patented, either in the use or sale of it, or of licenses, it seems to me he might in certain cases be held accountable to the other joint patentees." 2 Bann. & A. 327 (328).

See also *Clum v. Brewer* (1855), 2 Curtis, 506.

That one co-owner cannot be obliged to account to the other for the mere use of the invention or for profits arising

from its use, see *Fraser v. Gates* (1885), 118 Ill. 99; *Gates v. Fraser* (1881), 9 Bradwell (Ill.), 624.

That a surviving partner who uses a patent belonging to the late firm, against the objection of the representative of the deceased partner, is liable to account to such representative for one half the profits resulting from such use, see *Freeman v. Freeman* (1886), 142 Mass. 98.

That a part owner may be accountable to his co-owners for a share of the profits obtained by him from using the invention or selling rights, see *Aspinwall Mfg. Co. v. Gill* (1887), 40 O. G. 1133; 32 Fed. Rep. 697.

That whether one co-owner can compel another to account for one half the license fees, etc., received by him is doubtful, see *Gates v. Fraser* (1881), 9 Bradwell (Ill.), 624.

That each co-owner of a patent may use the right without the concurrence of the others and license at will, see *Washburn & Moen Mfg. Co. v. Chicago Galvanized Wire Fence Co.* (1884), 109 Ill. 71.

That a license by one co-owner is good against all, and their remedy is by account against him, see *De Witt v. Elmira Nobles Mfg. Co.* (1876), 66 N. Y. 459.

That one joint-owner cannot compel another to account for a share of his profits from a sale of the patented articles, see *Vose v. Singer* (1862), 4 Allen, 226.

That where one of several joint-patentees assigns to a third party, the estoppel against him operates as a license to the third party, and the other patentees must look to the assignor for an account, see *Curran v. Burdsall* (1883), 27 O. G. 1319; 20 Fed. Rep. 835.

his own price on the rights or licenses he grants, his liability to account to his co-owners for their share affords them no security of proper compensation. This rule seems to have been reached by treating property in a patented invention as analogous to property in a personal chattel, and endeavoring to apply to one the principles which govern the ownership of the other. If the sole property in a patented invention consisted in the right to practise it, some remote analogy to property in a personal chattel might exist. But the actual value of the property in a patented invention resides in the monopoly, by virtue of which its owners can not only prevent the use of a single personal chattel but of all others which are substantially identical with it in character. The right to practise the invention cannot be conferred without affecting these prohibitory powers, and no rule which ignores them, and permits the transfer of the invention without reference to its effect on them, can meet the requirements of the case. The second rule is far more just, and more in accordance with the nature of the subject, and in closer analogy to the rules applied to the joint-ownership of certain incorporeal rights to which those of the co-owners of a patented invention bear the nearest but by no means a perfect resemblance. It restricts the power of alienation on the part of a joint-owner within such limits as prevents an increase in the burden placed upon the common property of all, permitting him to enjoy his interest himself or to convey it to another single owner, whether an individual, a co-partnership, or a corporation, but not allowing him to multiply the number of those who are relieved from the monopoly without the consent of his co-owners. This rule also has its hardship, since it compels the joint-owner to practise the invention, or to sell his interest to a single purchaser or to such a group of purchasers as are acceptable to his co-owners, or to remain without the enjoyment of his property; but it is a rule conservative, not destructive, of the value of the patented invention as a whole, and entails on him no greater disadvantage than now rests upon the joint proprietors of a common, or a wharfing privilege, or any other incorporeal right, an increase in the number of whose occupants is forbidden by the law unless

it be with the express or implied permission of all the existing owners.²

§ 797. Joint-Owners cannot Practise Infringing Inventions.

Although the courts have recognized the right of one joint-owner to multiply indefinitely the number of those who can lawfully practise the patented invention without reference to

² Although no exact similitude exists between a patent privilege and any other property, yet the resemblance which it bears to a common of pasture is sufficient to suggest a possible solution of the present question. Both the patent privilege and the common of pasture are to be exercised within definite territory by specified means of enjoyment, and with a limited and determinable amount of profit. In both, the appropriation to himself, by one owner, of more than his just share of such profit is an unjust invasion of the rights of the others, whether, in the one case, by the introduction of an excessive number of commonable beasts, or, in the other, by distributing the patent privilege to an increased number of proprietors or licensees. Any assignment of either right which does not impose a greater burden on the common property, and any use of either by the owner which does not curtail its proper use by his co-owners, is fair and equitable although the ultimate result to him may far exceed any advantage which his co-owners may actually attain. Now the law finds no difficulty in regulating the rights and duties of commoners of pasture. It recognizes the fact that the profit is limited in amount and, therefore, prevents its distribution among a greater number of cattle than the owners have the right to introduce. But it does not measure the keenness of their appetites, nor the capacity of their stomachs, nor the benefit derived by one owner over another on account of his choicer breed of animals or the higher value to him of the food obtained. So far as analogy may be taken as a guide at all in such cases, does not this suggest that the joint-owners of a patent privilege enjoy all the rights to which they are entitled, as against each other, when each is allowed to practise the invention without accountability to his co-owners for any benefit which his superior skill or larger capital may enable him to realize, and to assign his interest to one other person, natural or artificial, for what price he pleases, with the same power to use and to assign; but that, as in the case of a commoner, he should not be allowed to introduce into the common property a greater number of those agencies by which its profits are to be absorbed, to the inevitable diminution of the advantage which his co-owners would otherwise have rightfully enjoyed? This suggestion, based on the nature of the property in the invention, takes no notice of the injury done to one owner of a patent by another when the latter prevents the former from exercising the prohibitory powers of the monopoly in his own defence, as under the present rules of law often occurs. But under this suggestion, that injury would also be avoided, since each owner could still enforce his rights against every person except the co-owner or the single individual to whom his interests had been assigned.

its effect on his co-owners, it has been held that neither a joint-owner nor his alienees can lawfully practise an infringing invention.¹ This limitation may appear inconsistent with

§ 707. ¹ In *Herring v. Gas Consumers' Association* (1878), 3 McCrary, 206, Treat, J. : (206) "The direct question presented is whether an infringer of a patent can escape liability for his infringement because he is a joint-owner of the original patent upon which the infringement occurs. The cases cited do not reach the precise point raised by the bill. It is evident that if a stranger was guilty of the infringement he would be compelled to respond in damages. Can a part-owner infringe the common patent and escape all liability? If he can, it is obvious that, however small his aliquot part, he can make the enjoyment of the patent valueless to his joint-owner. He has, by virtue of the joint-ownership, a right to use the patent, but he has no right, more than a stranger, to infringe the same. If there is an infringement, the right of recovery is in the party wronged. All the joint-owners should ordinarily be parties plaintiff, but if the wrong-doer is one who is guilty to the damage of the other joint-owner, the other should not be left remediless. As to such infringement they are strangers. All the joint-owners are on the record, and the amount of the recovery determines their respective interests. The infringer cannot escape the consequences of his wrong to his joint-owner by averring that he was by his infringement injuring not his joint-owner alone, but himself also. In other words, he cannot, *under cover* of his interest in the common patent, shield every wrong-doer who may infringe that patent. He can, as to the other part owners, by infringing, become liable to them for the wrong done. The amount of recovery will be in proportion to their respective interests. Were this not so, the door would be

open to the grossest frauds by one joint-owner against all other joint-owners. The case of *Pitts v. Hall*, 3 Blatchf. 204, and the comments thereon in *Curtis, Pat. § 108 et seq.*, do not cover this case. The question there discussed pertains to the use by one joint-owner of the common property. The difficulties in maintaining an action for an infringement against a joint-owner who merely uses the common patent may be insurmountable. As to that no opinion is expressed. In this case an entirely new and distinct proposition is presented, viz. : one of the several joint-owners is not using the common patent, but an infringing patent. His defence is that inasmuch as he had a right to use the original patent without question from his joint-owners, under the decision in *Pitts v. Hall, supra*, he has a right also to use any infringing patents, on the ground that his right to use the original being vested in him, his use of other and infringing patents did not cause any wrong or injury to himself as joint-owner. In other words, the defendant contends that as one joint-owner he could use the common patent without being liable to account to the other joint-owners; that he could not be sued as an infringer for using what he had a right to use by virtue of his proprietary interest; and, therefore, if he used an infringing device, he was only injuring himself in what he had a proprietary right to forbid. This would be correct if no interest except his own were involved, for a man may do what he pleases with his own, and "*volenti non fit injuria*" would be, *a fortiori*, applicable in such a case. If a stranger were using the infringing patent, this action would unquestionably lie against him; and the question before us is

the latitude allowed him under the preceding rule, but it is sound in principle. The powers included in his ownership of the invention are only such as can be exercised within the scope of the patent, by making, using, or selling the invention therein described and claimed; and his ownership of the monopoly, which exists only for the protection of his interest in the invention, does not entitle him to perform acts which would be an infringement in a stranger, unless they are the precise acts involved in the practice of the patented invention. The use by him of an infringing art or instrument is neither the practice of the patented invention nor the employment of prohibitory powers in its defence. It is an act entirely outside of the enjoyment of his rights as the owner either of the invention or of the monopoly. Acts of the same character on the part of licensees are equally beyond the privileges conferred upon them by their license, and are not affected by the estoppel which prevents the enforcement of the monopoly against their practice of the patented invention.² Joint-owners and their licensees are, therefore, as to such acts of infringement regarded as strangers to the patented invention, and are liable in damages to the other owners according to the proportion of their respective interests therein.

§ 798. Reciprocal Relations of Joint-Owners Variable by Contract: Their Relations to Third Parties.

While these general rules govern the relations of joint-owners in the absence of any special contract between them,

whether it will lie against a joint-owner, or, in the language of the bill, whether he, under cover of his joint ownership, can infringe and escape liability. So far as he acts outside of his interests or rights or powers as a joint-owner, there is no adequate reason for treating him, *quoad hoc*, otherwise, than as a stranger. If this be not so, then one joint-owner may destroy, without remedy, the rights of the other joint-owners." 21 O. G. 203 (203); 3 Bann. & A. 253 (254); 9 Fed. Rep. 556 (556).

That one joint-owner can enjoin an-

other in certain cases, see *Duke v. Graham* (1884), 19 Fed. Rep. 647.

That one co-owner is not estopped from denying the validity of the patent as against the others, see *Marston v. Swett* (1875), 4 Hun, 153; 6 Thomp. & C. 534.

² That a licensee is liable for infringement if he uses any other invention substantially identical with the one covered by his license, see *Miller's Falls Co. v. Ives* (1877), 14 O. G. 203; 14 Blatch. 169; 2 Bann. & A. 574.

they are nevertheless at liberty to regulate their reciprocal rights according to their own desires.¹ They may unite their interests more closely by additional agreements, or one may deprive himself of a portion of his rights in favor of the others. In reference to third parties, however, all the joint-owners of the patented invention are regarded as a single proprietor. Infringement by a stranger violates the right of all in whom the property in the patented invention vests, and all must join in action; to redress the wrong; the damages which they recover being apportioned among them according to their individual but undivided interests in the patented invention.²

§ 798. ¹ That joint-owners of a patent may subdivide it at pleasure, see *Vose v. Singer* (1862), 4 Allen, 226.

That an agreement of co-owners to account, if observed by them for a time, is not within the Statute of Frauds where the contract has been fulfilled on one side by the transfer of the interest in the patent, and might have been fully executed on the other within the year, see *Fraser v. Gates* (1885), 118 Ill. 99.

That an agreement of co-owners to account to each other is a continuing agreement, and enures to the benefit of a bankrupt owner who purchases the interest from his assignee in bankruptcy, see *Fraser v. Gates* (1885), 118 Ill. 99.

That an agreement to account to each other does not make the co-owners partners, see *Fraser v. Gates* (1885), 118 Ill. 99.

That joint-owners of a patent who are also partners are bound to account to each other for the use of the invention, see *Freeman v. Freeman* (1884), 136 Mass. 260.

That co-owners, being also co-partners, may hold each other to account for royalties and prices received for the invention, see *Burr v. De La Vergne* (1886), 102 N. Y. 415.

That owners not named as licensors in the license are entitled to their share of the royalties, if they were partners with the nominal licensor when the license was granted, see *Rogers v. Relesner* (1887), 41 O. G. 351; 30 Fed. Rep. 525.

That an agreement between a patentee and an improver of the patented device to take out a new joint patent makes them, in equity, joint-owners of the improved invention, and each can restrain the other from using it except for their joint benefit, see *Duke v. Graham* (1884), 19 Fed. Rep. 647.

That where the patentee and the inventor of an improvement re-issue the original patent for the improved device in their joint names, each can restrain the other from using the patent except for their joint benefit, see *Duke v. Graham* (1884), 19 Fed. Rep. 647.

² That a suit for infringement against a stranger should be brought in the names of all the joint-owners, and the damages recovered be distributed among them according to their respective interests in the patented invention, see *Herring v. Gas Consumers' Association* (1878), 3 McCrary, 206; 21 O. G. 203; 3 Bann. & A. 253; 9 Fed. Rep. 556, and cases cited under §§ 937-945, 1070, 1098-1102, *post*.

§ 799. Joint Grantees.

Joint grantees occupy toward each other in respect to their limited territorial ownership the same relations which subsist between the joint-owners of the entire interest for the whole United States. Within their local boundaries the complete property in the invention and the monopoly is vested in them as co-owners, and each may practise the invention, dispose of his own interest, or license others in the same manner as a joint assignee. Their several rights may be increased, diminished, or changed in character by mutual agreements, and in enforcing them against infringers they act as a collective body, in whom the indivisible monopoly resides. Owners of different territorial interests may similarly combine their privileges, or enter into contracts with each other whereby their rights, as otherwise defined by law, are variously modified.¹

SECTION III.

OF THE TRANSFER OF LETTERS-PATENT: EXECUTORS AND ADMINISTRATORS.¹

§ 800. Property of Decedent in Patented Inventions Vested by Federal Statutes in his Executor or Administrator.

Upon the death of any owner of a patented invention his interest vests immediately in his executor or administrator, by virtue of the statutes of the United States.² The title of

§ 799. ¹ That owners of different territorial rights do not mingle their rights by appointing a common attorney to convey, see *May v. Chaffee*, (1871), 5 Fisher, 160; 2 Dillon, 385.

That two assignees of different territory may appoint an agent to manage for both, and may thus restrict themselves in perpetuity from doing anything to injure each other, see *Ladd v. Mills* (1884), 20 Fed. Rep. 792; 22 Blatch. 242.

§ 800. ¹ For a discussion of this subject, in another connection, see §§ 404-406, and notes, *ante*.

² That the interest of the owner of a patented invention vests, upon his death, in his executor or administrator, see *Shaw Relief Valve Co. v. New Bedford* (1884), 19 Fed. Rep. 753; 28 O. G. 283; *Bradley v. Dull* (1884), 19 Fed. Rep. 913; 27 O. G. 625.

That the executor or administrator in whom the patent vests is the one

the administrator or executor is not derived from the local laws of the State in which he was appointed, or in which the property is situated, though his official character may be determined by such laws.³ His title rests upon the acts of Congress which control alike the nature of his ownership and the extent of his authority and obligations.⁴

§ 801. Nature of the Property of an Executor or Administrator in the Patented Inventions of his Decedent.

The property in a patented invention in the hands of an executor or administrator is not personal property belonging to the decedent's estate, nor assets liable to the claims of creditors or of distributees. It is a franchise which he holds, not in his official capacity under the probate laws, but in a different and special capacity under the Patent Laws.¹ It does not enter into his dealings with the estate as such, nor is he accountable for it to the personal representatives of the deceased. Though he is often said to be a trustee, in whom the patented invention vests for the benefit of the owner's

appointed at the domicile of the deceased owner, see *Hodge v. North Missouri R. R. Co.* (1869), 4 Fisher, 161; 1 Dillon, 104.

That the executor or administrator owns the entire interest of his decedent in every part of the United States, see *Hodge v. North Missouri R. R. Co.* (1869), 4 Fisher, 161; 1 Dillon, 104.

That where an inventor dies before application the executor or administrator must apply for the patent; and where he dies pending application the executor or administrator must receive the patent, see *Rice v. Burt* (1879), 16 O. G. 1050.

That where the inventor dies, pending the application, the executor or administrator may file a new application, but the rights of third parties cannot be affected thereby, see *Ex parte Smith* (1888), 43 O. G. 505; *Rice v. Burt* (1879), 16 O. G. 1050.

³ That an administrator's title to

a patent is not derived from the State law but from the United States law, and there is no necessity for local State administration, in order to enable him to sue anywhere, see *Goodyear v. Hullihan* (1867), 3 Fisher, 251; 2 Hughes, 492.

That the official character of an administrator is not a question for the United States Courts, see *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.* (1874), 6 O. G. 34; 1 Bann. & A. 177.

⁴ That State laws cannot limit the powers of administrators under the Patent Laws of the United States, see *Brooks v. Jenkins* (1844), 3 McLean, 432.

§ 801. ¹ That a patent in the administrator's hands is not personalty belonging to the decedent's estate, but is a franchise held in trust for the heirs, see *Goodyear v. Hullihan* (1867), 3 Fisher, 251; 2 Hughes, 492.

heirs or devisees,² he is not a true trustee having a legal title to the property, but a mere instrument of the law, charged to perform certain duties in the interest of those to whom the patented invention properly belongs.³

§ 802. Relations of the Executor or Administrator to the Heirs and Devisees of the Decedent in reference to those Patented Inventions.

The title of an executor or administrator to a patented invention is identical with that of his decedent, so far as the Patent Office, the courts, and third parties are concerned. As between him and the heirs of the former owner, or the devisees on whom the will may have conferred the ownership of the invention, the property vests in them, though managed and controlled by him. In procuring letters-patent or a re-issue or an extension, in prosecuting actions for infringement or other wrongs against the property, in making contracts and assignments, and in granting licenses, he acts as if he were the independent owner of the patented invention, although accountable in equity to those in whom the beneficial interest in the invention legally resides.¹

² That a patent granted to an administrator is held by him in trust for the heirs, but the patent need not so state, see *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.* (1874), 1 Bann. & A. 177 ; 6 O. G. 34.

That where an inventor dies leaving a will devising the invention, and the executor obtains a patent, he holds it in trust for the devisees by implication of law, see *Stimpson v. Rogers, Smith & Co.* (1859), 4 Blatch. 333.

³ In *Wintermute v. Redington* (1856), 1 Fisher, 239, Willson, J. : (241) "Administrators of an estate are not, properly speaking, trustees in whom is vested the legal title. The law clothes

them with certain powers, by which they are enabled to transmit the legal title of property. They are mere instruments of the law, and the effect is given to their acts upon the same principle that title to property is transferred by the official act of a sheriff or marshal."

§ 802. ¹ That an executor or administrator can assign a patent and give a good title thereto, see *Donoughe v. Hubbard* (1886), 35 O. G. 1561 ; 27 Fed. Rep. 742 ; *Bradley v. Dull* (1884), 27 O. G. 625 ; 19 Fed. Rep. 913.

That it is not necessary that all the executors or administrators should join in the assignment, see *Wintermute v. Redington* (1856), 1 Fisher, 239.

SECTION IV.

OF THE TRANSFER OF LETTERS-PATENT: JUDICIAL SALES.¹

§ 803. Patented Inventions not Subject to Execution nor to any Ordinary Method of Appropriation for the Benefit of Creditors.

The general principle that all the property of a debtor is liable for his debts applies to the property in a patented invention.² No reason exists, either in the nature of the property or in the meritorious acts of which it is considered a reward, that should exempt it from the claims of creditors.³ But in enforcing such claims several difficulties arise. The property is incorporeal, and therefore cannot be seized and appropriated to the satisfaction of a judgment by any of the methods known to the common law.⁴ It is also universal, not local, and therefore cannot be directly reached, to any considerable extent, by any process issuing out of courts of local jurisdiction.⁵ It is transferable, under the Patent Law of the

§ 803. ¹ For a discussion of this subject in part, see § 766 and notes, *ante*.

² That a patent is liable for the debts of the patentee, see *Shaw Relief Valve Co. v. New Bedford* (1884), 19 Fed. Rep. 753; 28 O. G. 233.

³ That property does not become "exempt from attachment" by its intrinsic nature, but by the provisions of positive law, see *In re Keach* (1884), 14 R. I. 571.

⁴ That a patent privilege cannot be seized and sold on execution, see *Carver v. Peck* (1881), 131 Mass. 291; *Pacific Bank v. Robinson* (1881), 57 Cal. 520; *Stevens v. Gladding* (1854), 17 How. 447; *Stephens v. Cady* (1852), 14 How. 528.

⁵ In *Stevens v. Gladding* (1854), 17 How. 447, Curtis, J. : (451) "There would certainly be great difficulty in

assenting to the proposition that patent and copyrights, held under the laws of the United States, are subject to seizure and sale on execution. Not to repeat what is said on this subject in 14 How. 531, it may be added that these incorporeal rights do not exist in any particular State or district; they are co-extensive with the United States. There is nothing in any act of Congress, or in the nature of the rights themselves, to give them locality anywhere, so as to subject them to the process of courts having jurisdiction limited by the lines of States and districts. That an execution out of the court of common pleas for the county of Bristol, in the State of Massachusetts, can be levied on an incorporeal right subsisting in Rhode Island, or New York, will hardly be pretended. That by the levy of such an execution, the entire right

United States, only by the patentee or his alienee or personal representatives, and therefore cannot be decreed by any court to vest in any person without the required conveyance from its actual owner.⁶ For these reasons patented inventions were for a long time regarded as practically exempt from the ordinary liability for the debts of their owners, though methods are now adopted by which they are with great facility made subject to the claims of creditors.⁷

§ 804. Patented Inventions Subjected to the Claims of Creditors only through some Form of Assignment by their True Owner.

These methods are in form or in effect assignments by the owner of the patented invention. Only by a grant can incorporeal property be transferred from one person to another. Only by a grant from some authority, having a jurisdiction over the property which is as universal as the property itself, could any beneficial transfer be accomplished. Only by a grant from the real owner of the patented invention can the requirements of the Patent Law concerning transfers be fulfilled. Hence any method which effects such transfer must be a conveyance by the lawful owner or its equivalent. Such is not the case with the judgment or order of any court or the act of any officer. In the absence of a statute of the United States to that effect, neither an adjudication in bankruptcy nor the voluntary assignment of the owner could put the property in the patented invention at the disposal of the court or assignee, unless the one was followed, and the other accompanied, by an actual transfer of the patented invention in the mode provided by the Patent Law.¹ Thus all the

could be divided, and so much of it as might be exercised within the county of Bristol sold, would be a position subject to much difficulty."

See also *Carver v. Peck* (1881), 131 Mass. 291.

⁶ See §§ 765, 766, and notes, *ante*.

⁷ In *Carver v. Peck* (1881), 131 Mass. 291, Gray, J. : (292) "The incorporeal and intangible right of an inventor or an author in a patent or a

copyright cannot be taken on execution at law; and a general assignment of his property under a bankrupt or insolvent act will either by its own force pass this right to the assignee in bankruptcy or insolvency, or will at least entitle the latter by proper proceedings to compel the debtor to convey it to him for the benefit of creditors."

See also § 805 and notes, *post*.

§ 804. ¹ That an assignment by an in-

methods that might be devised are reducible in substance to one, — a voluntary or compulsory transfer by the owner of the patented invention.

§ 805. **Owner of Patented Invention may be Compelled by a Court of Equity to Assign it for the Benefit of Creditors.**

That courts of equity, acting in aid of courts of law, have the authority to compel the owner of a patented invention to assign it to a trustee or receiver, to be sold for the satisfaction of his judgment-debts, seems now to be decided.¹ This method

solvent to his trustee of all his property, not exempted by law, does not carry a patent, see *Campbell v. James* (1880), 18 Blatch. 92; 5 Bann. & A. 354; 18 O. G. 1111; 2 Fed. Rep. 338.

That the title to a patent does not vest in a receiver, see *Dick v. Struthers* (1885), 25 Fed. Rep. 103; 34 O. G. 131.

That neither the assignee in insolvency nor a receiver can assign or pass title to a patent except by a written instrument, signed by the owner of the patent and duly recorded, see *Gordon v. Anthony* (1879), 16 O. G. 1135; 16 Blatch. 234; 4 Bann. & A. 248.

That an assignment made by a judge of Probate under a State insolvent law, does not transfer the title to a patent, but an instrument of assignment must be executed by the owner, see *Ashcroft v. Walworth* (1872), 2 O. G. 546; *Holmes*, 152; 5 *Fisher*, 523.

That a receiver may convey the equitable title, though unable, without the concurrence of the real owner, to transfer the legal title, see *Adams v. Howard* (1884), 23 Blatch. 27; 22 Fed. Rep. 656.

§ 805. ¹ In *Pacific Bank v. Robinson* (1881), 20 O. G. 1314, McKee, J. : (1814) "The question is, has a court of equity power to compel its assignment and sale for the benefit of judgment creditors? In 1852 Mr. Justice Nelson, in *Stephens v. Cady* (14 How.

528), held that a copyright to print and publish maps of the State of New Hampshire could be reached by a creditor's bill and applied to the payment of debts of the owner of the copyright, under a decree compelling a transfer in conformity with the provisions of the act of Congress. That, however, was mere *obiter*, because the decision of the question was not necessarily involved in the case. And afterward, in 1854, in the case of *Stephens v. Gladding* (17 How. 447), which was a branch of the case of *Stephens v. Cady*, Mr. Justice Curtis declined to pass upon the question, because neither the copyright nor any interest in it had been attempted to be sold. But in 1875 the supreme court of New York, in the case of *Barnes v. Morgan* (3 Hun, 703), took up the *dictum* of Mr. Justice Nelson in *Stephens v. Cady* and approved of it as a sustainable legal proposition. An order had been made at special term, directing the defendant in the case to deliver to a receiver, appointed under supplementary proceedings, certain patents and models appertaining thereto. From the order defendant appealed to the supreme court. Assignability of the patents by the voluntary act of the owner under the act of Congress which created them was conceded, and according to the authority of *Hesse v. Stevenson* (3 B. & P. 577), *Nias v. Adamson* (3 B. & Ald. 225), and *Coles v. Barrow*

satisfies all the requirements of the law. Where the owner refuses to execute the necessary conveyances or is incapable of

(4 Taunt. 764), it had been established that patent rights of a bankrupt pass by act and operation of law to his assignees in bankruptcy for the benefit of creditors. In *Hesse v. Stevenson*, Lord Alvanley, in delivering the opinion of the court, used this language: 'It is said that although by the assignment every right and interest, and every right of action, as well as right of possession and possibility of interest, is taken out of the bankrupt and vested in the assignees, yet that the fruits of a man's own invention do not pass. It is true that the schemes which a man may have in his own head before he obtains his certificate, or the fruits which he makes of such schemes, do not pass, nor could the assignees require him to assign them over, provided he does not carry his schemes into effect until after he has obtained his certificate; but if he avails himself of his knowledge and skill, and thereby acquires a beneficial interest, which may be the subject of assignment, I cannot frame to myself an argument why that interest should not pass in the same manner as any other property acquired by his personal industry.' Patent rights being, therefore, assignable by the voluntary act of the owner and by act and operation of law, it followed that a court of equity could compel the defendant to assign them to a receiver, to be sold and applied to the satisfaction of judgments against him, and the supreme court affirmed the order of the special term. 'If,' said the court, 'the use of a monopoly which such a grant confers is not sufficiently productive in the hands of the inventor to pay his debts, the privilege bestowed, being a right of property as declared by Chief Justice Taney, should be transferred to the person designated by law

and sold for the benefit of the creditor. It would be a marvellous, if not unjust, perpetuation of the ideal if an inventor, having obtained a patent, thus divulging his secret and at the same time acquiring a property in it for practicable purposes, should be permitted to hold it unused against his creditors until, either by compromise or the lapse of time, his obligations should be discharged, and this, too, although it might be one which, by assignment or upon manufacture of the thing invented, would readily yield enough to pay all existing liabilities.'" 57 Cal. 520 (523).

In *Ashcroft v. Walworth* (1872), 2 O. G. 546, Shepley, J. : (547) "It might have been competent for the court under the insolvent law to have compelled the debtor to execute such an instrument in writing as, in accordance with the provisions of the Patent Act, would have been effectual to transfer the title in the patent to the assignee. If a right in a patent were such property as did not come within the exceptions of the insolvent law as property not liable to attachment, or if it is of such a nature that it is subject to the operation of State insolvent laws, this would seem to have been the only proper and effectual mode to have made it available for the benefit of the creditors. Without such a conveyance as the statute of the United States contemplates, we do not think the assignee acquires any legal title to any interest the debtor may have in any letters-patent. To invest the assignee with the legal title the court must compel a transfer in conformity with the requirements of the Patent Act." Holmes, 152 (154); 5 Fisher, 528 (530).

That the receiver of an insolvent is entitled to his patents, and the court

doing so, it has been held that the court of equity, in order to effectuate its own decree, may appoint a trustee to make the assignment in the name and on behalf of the recalcitrant or incapacitated owner, and that this conveyance is equivalent to one executed by himself.² Whether a State insolvent court could exercise the former power over the owner of a patented invention depends on the authority conferred upon it by the local law. The latter power, whose existence in any court is still open to question, must be derived expressly or impliedly from the laws of the United States.

SECTION V.

OF THE TRANSFER OF LETTERS-PATENT: LICENSES.

§ 806. License Defined: Distinguished from Assignment and Grant.

Any conveyance of an interest in a patented invention, which cannot operate as an assignment or a grant, is a

may order the debtor to assign them to him, see *In re Keach* (1884), 14 R. I. 571; *Carver v. Peck* (1881), 131 Mass. 291.

That a patent may be reached by a creditor's bill, see *Gillett v. Bate* (1881), 86 N. Y. 87; 10 Abb. N. C. 88.

That a patent may be subjected to the debts of the patentee by a creditor's bill, even against a fraudulent assignee, and where the citizenship of the parties is different the Federal courts have jurisdiction, see *Gerrell v. Dickson* (1886), 26 Fed. Rep. 454.

That a patent is assigned by the operation of law upon the bankruptcy of the owner, and though it cannot be seized on execution, it can be reached by a creditor's bill and by proceedings supplementary to execution, see *Barnes v. Morgan* (1875), 3 Hun, 703; 6 Thomp. & C. 105.

That the want of novelty or utility is no defence to a creditor's bill against

the patentee or a fraudulent assignee, see *Gillett v. Bate* (1881), 86 N. Y. 87; 10 Abb. N. C. 88.

That unpatented inventions cannot be reached by a creditor's bill, see *Gillett v. Bate* (1881), 86 N. Y. 87; 10 Abb. N. C. 88.

That an incomplete and experimental invention cannot be reached by a creditor's bill, see *Ryan v. Lee* (1882), 14 Mo. App. 599.

² That a court of equity may direct the sale of an inventor's interest in his patent to satisfy a judgment against him, and will require the patentee to assign as provided in Sec. 4898, Rev. Stat., and, if he refuses, will appoint a trustee to make the assignment, see *Murray v. Ager* (1881), 20 O. G. 1311; 1 Mackey, 87.

That a patent right cannot be reached by a creditor's bill under Gen. Stat. Mass. c. 113, § 2, cl. 11, see *Carver v. Peck* (1881), 131 Mass. 291.

license.¹ A license is distinguished from these other forms of transferring letters-patent by the single characteristic that an assignment and a grant transfer the monopoly as well as the invention, while a license transfers only the invention and does not affect the monopoly otherwise than by estopping the licensor from exercising its prohibitory powers in derogation of the privileges conferred by him upon the licensee.² Whether a given conveyance carries both the monopoly and the invention is usually determined by the language in which it describes the transferred interest in the invention, such instrument rarely mentioning the monopoly or treating it as the subject-matter of the alienation. Hence if the interest in the invention which the conveyance purports to transfer is one to which the law annexes the monopoly, the instrument is a grant or an assignment; and, on the contrary, if this interest is such that its alienation leaves the monopoly still residing, in contemplation of law, in the alienor, the conveyance is a mere license. This contract of license is governed and defined by State law, as distinguished from statutory Patent Law, and is subject to the incidents which attach to all agreements.³

§ 806. ¹ That anything less than a grant or an assignment is a license, see *Potter v. Holland* (1858), 1 Fisher, 327; 4 Blatch. 206.

² In *Sanford v. Messer* (1872), 2 O. G. 470, Shepley, J. : (471) "Any assignment which does not convey to the assignee the entire and unqualified monopoly which the patentee holds in the territory specified, or an undivided interest in the entire monopoly, is a mere license." 5 Fisher, 411 (412); Holmes, 149 (150).

See also *Theberath v. Celluloid Mfg. Co.* (1880), 3 Fed. Rep. 143; 5 Bann. & A. 577.

That while an assignment and grant convey the monopoly, a license merely waives the monopoly as to the licensee, see *Howe v. Wooldredge* (1866), 12 Allen, 18; *Buss v. Putney* (1859), 38 N. H. 44.

That the sole matter conveyed in a license is the right not to be sued, see *Hawks v. Swett* (1875), 4 Hun, 146; 6 Thomp. & C. 529.

That a license may be granted before the patent issues, see *Kelly v. Porter* (1883), 8 Sawyer, 482; 17 Fed. Rep. 519.

³ That licenses are governed by State laws, see *State of Missouri v. Bell Telephone Co.* (1885), 23 Fed. Rep. 539.

That the Federal courts may determine, in an infringement case, whether there is an outstanding license or not, see *Hammacher v. Wilson* (1886), 26 Fed. Rep. 239; 36 O. G. 233.

That a common carrier, though licensed by a patentee to carry on business with one customer only, may be compelled to carry it on with all, see *State of Missouri v. Bell Telephone Co.* (1885), 23 Fed. Rep. 539.

That a license under an expired pat-

§ 807. The Invention, not the Monopoly, Transferred by a License.

It is a necessary consequence of the indivisibility of the monopoly that nothing less than the conveyance of the entire interest in the invention, or of an undivided part of such entire interest, can operate upon it as a transfer. Though the subordinate rights in the invention are separable and may be aliened at the pleasure of its owner, the monopoly cannot be subdivided to correspond with them and be transferred with them to independent owners. The monopoly remains in him on whom the issue of the letters-patent conferred it, until he transfers to another person all the rights for whose vindication the monopoly was created, or makes that other person a joint-owner with himself. As long, therefore, as any interest resides in him to which the monopoly must attach, the interests which he conveys to others, unless they thereby become jointly interested with himself, are interests in the invention merely, not affecting the monopoly; and however extensive in its terms the instrument transferring them may be, it still leaves the monopoly in him.¹ The only alienation which can carry the monopoly is that of the exclusive right, or of an undivided interest in the exclusive right, to practise the invention, including the exclusive right to make, the exclusive right to use, and the exclusive right to sell the patented invention.²

§ 808. Any Transfer of less than the Entire Interest in the Patented Invention, or an undivided part of such Entire Interest, is a License.

Judged by this test every conveyance which does not transfer the exclusive right, or an undivided interest in the exclusive right, to practise the invention is a license.¹ All

ent, among others, is no evidence of fraud, since all parties are chargeable with notice as to the term of patents, see *Pope Mfg. Co. v. Owsley* (1886), 27 Fed. Rep. 100; 37 O. G. 781.

That a license taken to avoid a suit is not taken under duress or fraud, see *Pope Mfg. Co. v. Owsley* (1886), 27

Fed. Rep. 100; 37 O. G. 781; *McKay v. Jackman* (1883), 17 Fed. Rep. 641.

§ 807. See §§ 753-758, and notes, *ante*, for a more extended discussion of these principles.

² See § 763 and notes, *ante*.

§ 808. ¹ That any grant which does not convey either an undivided interest

alienations of the right to make, or the right to use, or the right to sell, or of the right to make and use, or of the right to make and use and sell, are merely licenses.² All transfers of the exclusive right to use, or of the exclusive right to make and use, or of the exclusive right to use and sell, are also simple licenses.³ Conveyances of the exclusive right to use in a certain manner, or of the exclusive right to make and use and sell in a particular form or for a particular purpose, are only licenses.⁴ But an instrument conferring the exclu-

or an exclusive local interest, is a mere license, see *Nelson v. McMann* (1879), 16 Blatch. 139; 4 Bann. & A. 203; 16 O. G. 761.

That any grant less than an exclusive right within a given territory, is a mere license, see *Sanford v. Messer* (1872), 2 O. G. 470; 5 Fisher, 411; *Holmes*, 149; *Farrington v. Gregory* (1870), 4 Fisher, 221; *Gayler v. Wilder* (1850), 10 How. 477.

² That the grant of a right to use and sell only, but not to make, is a mere license, see *Sanford v. Messer* (1872), 2 O. G. 470; 5 Fisher, 411; *Holmes*, 149.

That a grant "to use and sell" in a given territory is a mere license, see *Farrington v. Gregory* (1870), 4 Fisher, 221.

That an agreement that the promisee may make and sell in a given territory, is a mere license, see *Gayler v. Wilder* (1850), 10 How. 477.

That an agreement by the patentee not to sue or disturb one who uses the invention is only a license, not affecting the patent right, see *Bull v. Pratt* (1815), 1 Conn. 342.

That a conveyance of the power to sell, use, and grant to others the right to use the patented device within certain territory for a certain period, is not a mere power of attorney, but a contract vesting rights in the grantee, see *Burdell v. Denig* (1875), 92 U. S. 716.

That the contract of a workman to

give his employer the benefit of his inventions is a license, not a grant, see *Whiting v. Graves* (1878), 13 O. G. 455; 8 Bann. & A. 222.

That an agreement between conflicting patentees for a common use of their patents, and the mutual defence of their rights, is not an assignment, but a mere license to each to use the inventions of the other, see *Aultman v. Holley* (1873), 5 O. G. 3.

That the conveyance of a right to canvass for and sell the patented article as an agent, conveys no interest in the monopoly, and may be oral, see *Springfield v. Drake* (1876), 58 N. H. 19.

³ That an exclusive territorial right to use and sell, but not make, is a mere license, see *Hill v. Whitcomb* (1874), 5 O. G. 430; *Holmes*, 317; 1 Bann. & A. 34; *Sanford v. Messer* (1872), 5 Fisher, 411; 2 O. G. 470; *Holmes*, 149.

That the grant of the sole right to sell the patented article within certain territory does not carry any part of the patent right, but is a mere license, the grantor still owning the entire patent, see *Ingalls v. Tice* (1882), 14 Fed. Rep. 297; 22 O. G. 2160.

That an irrevocable and exclusive power to act as "sole agent" for making and selling, to retain his commission, and pay the balance to the principal, is not an assignment but a mere license, see *Kempton v. Bray* (1868), 99 Mass. 350.

⁴ That the grant of an exclusive

sive right to make and sell carries the entire invention, since the exclusive right conferred gives to the alienee complete dominion over the use also, and thus transferring the monopoly becomes either an assignment or a grant.⁵ These limitations of the interest transferred may appear either in the description of the interest itself, or in the reservation of rights to the alior, or may be implied from the remaining portions of the contract. The conveyance of the entire interest in the patented invention, reserving to the alior a right to make it, or a right to sell it, even though not exclusive, vests in the alienee only an independent partial interest and makes him a mere licensee.⁶ The transfer of the entire in-

right to make and sell one form of the invention is a mere license, see *Nellis v. Pennock Mfg. Co.* (1882), 22 O. G. 1131 ; 13 Fed. Rep. 451.

That the grant of a right to use for a specific purpose is a mere license, see *Bogart v. Hinds* (1885), 33 O. G. 1268 ; 25 Fed. Rep. 484.

That the grant of the exclusive use of an invention for a certain purpose in a certain territory, and for a certain time, is a mere license, see *Oliver v. Rumford Chemical Works* (1883), 109 U. S. 75 ; 25 O. G. 784.

That a right to make, use, and sell for a particular purpose, in specified places, is only a license, see *Gamewell Fire Alarm Telegraph Co. v. Brooklyn* (1882), 14 Fed. Rep. 255 ; 22 O. G. 1978.

That an exclusive license to make or use for special purposes is not an assignment, see *Dorsey Revolving Harvester Rake Co. v. Bradley Mfg. Co.* (1874), 12 Blatch. 202 ; 1 Bann. & A. 330.

⁵ That the conveyance of the exclusive right to make and sell carries the right to use, see *Nellis v. Pennock Mfg. Co.* (1882), 22 O. G. 1131 ; 13 Fed. Rep. 451 ; *Turnbull v. Weir Plow Co.* (1880), 23 O. G. 91 ; 9 Bissell, 334 ; 5 Bann. & A. 288 ; 14 Fed. Rep. 108.

That a non-exclusive right to make and sell is a mere license, see *Dorsey Revolving Harvester Rake Co. v. Bradley Mfg. Co.* (1874), 12 Blatch. 202 ; 1 Bann. & A. 330 ; *Hussey v. Whitely* (1860), 1 Bond, 407 ; 2 Fisher, 120.

That the purchaser of an exclusive privilege of making and selling acquires an interest in the franchise secured by the patent, see *Mitchell v. Hawley* (1873), 16 Wall. 544 ; 3 O. G. 241 ; 6 Fisher, 331.

That an assignment of the exclusive right to make, use, and sell, and to vend to others to use and sell, carries the entire interest, although the right to sell the privilege of making is not mentioned, and not reserved to the assignors, see *Pickhardt v. Packard* (1884), 23 Blatch. 23 ; 30 O. G. 179 ; 22 Fed. Rep. 530.

That the grant of an "exclusive right to make and sell" the invention "in the United States for the whole term" of the patent, is an assignment of the whole patent and there is no right left in the assignor, see *Nellis v. Pennock Mfg. Co.* (1882), 13 Fed. Rep. 451 ; 22 O. G. 1131.

⁶ That any reservation of a right in the grantor renders the grant a license, not an assignment, see *Hussey v. Whitely* (1860), 1 Bond, 407 ; 2 Fisher, 120.

That a grant, reserving the right of

terest with a reservation of the right to use, however, gives to the alienee an absolute control over the patented invention, because without a making and a selling there can be no use, and hence such a conveyance is regarded as an assignment coupled with a license to the alienor to use the patented invention whenever, through the exercise of his rights by the alienee, the former may be able to procure it.⁷ The covenants embraced in the instrument may similarly determine whether the conveyance is an assignment or a license. When they impose such obligations on the parties as can exist only while the monopoly remains in the alienor, the granting clause and the description must be regarded as relating to the invention alone, and the instrument itself construed to be a license. A covenant on the part of the alienor to protect the alienee by prosecuting infringers, for example, indicates that in whatever terms the interest transferred may be described, the prohibitory powers are still in the alienor, that the interest conveyed is, therefore, less than the entire interest or an undivided part thereof, and that the transfer operates only as a license.⁸

making to the grantor, is only a license, see *Hamilton v. Kingsbury* (1880), 4 Fed. Rep. 428; 17 Blatch. 460; 17 O. G. 847; 5 Bann. & A. 157; *Sanford v. Messer* (1872), Holmes, 149; 2 O. G. 470; 5 Fisher, 411.

That a grant reserving to the grantor certain uses of the invention is a mere license, see *Ex parte Paine* (1878), 13 O. G. 408.

That an assignment of the entire interest in the patent, within a certain territory, but reserving to the assignor the right to sell devices of his own making, is a mere license, see *Hussey v. Whitely* (1860), 2 Fisher, 120; 1 Bond, 407.

⁷ That the conveyance of all rights in the invention within certain territory, except the right to use the patented device for a certain specific purpose, is a grant of the invention to the assignee, and a special license back to the assignor, see *Littlefield v. Perry* (1874), 21 Wall. 205; 7 O. G. 964.

That a patentee who sells all his interest in the patent, reserving a right to certain specified uses of the invention, is no longer an owner but a mere licensee under his assignee, see *Frankfort Whiskey Process Co. v. Pepper* (1885), 26 Fed. Rep. 336.

That a contract for an exclusive right to make, construct, and use in a given State, and to sell to others to be used, but reserving to the grantor the right to sell devices of his own make in the State, though neither an assignment nor a grant, is more than a mere license and is assignable, and vests a fixed right in the purchaser, see *Pitts v. Jameson* (1853), 15 Barb. 310.

⁸ That the presence in the instrument of a covenant binding the grantor to protect the grantee by suit, etc., shows that the instrument is a mere license, see *Theberath v. Celluloid Mfg. Co.* (1880), 5 Bann. & A. 577; 3 Fed. Rep. 143.

§ 809. License may be either Express or Implied: Express Licenses.

A license may consist in an express agreement between the owner of the patented invention and the licensee, or it may be implied from circumstances. An express license may be oral or in writing, and when in writing it may take any form that can be legally interpreted as a conveyance of those interests which a license is sufficient to transfer.¹ Thus, if an instrument attempting to convey the entire interest in the patented invention, or an undivided portion of it, is insufficient for that purpose, it may still be valid as a license.² A contract for such conveyance, or an agreement to bestow a license, when accepted and acted on by the proposed licensee, has the same effect.³ A compromise of litigated claims in which each party abandons all his rights to interfere with or restrain the other, or one by which the contending parties league together for the common enjoyment and common defence of their respective inventions, are other forms which this mode of conveyance may assume, and which are equally valid with licenses of greater definiteness of expression, provided the intention of the parties to transfer the proper interests can be clearly ascertained.⁴ The scope of an implied

§ 809. ¹ That a license need not be written, see *Buss v. Putney* (1859), 38 N. H. 44; *Potter v. Holland* (1858), 4 Blatch. 206; 1 Fisher, 327.

² That a contract for any part of the patent right may be good as a license, see *Gayler v. Wilder* (1850), 10 How. 477.

That an optional contract to purchase a patent does not operate as a license to the vendee's licensees to make an infringing article during the option, see *Iowa Barb Steel Wire Co. v. Southern Barbed Wire Co.* (1887), 30 Fed. Rep. 615; 40 O. G. 578.

³ That an agreement to license, if acted on, becomes an actual license according to the intent of the parties, see *Magic Ruffle Co. v. Elm City Co.* (1875), 13 Blatch. 151; 2 Bann. & A. 152; 8 O. G. 773.

⁴ That where the parties to a suit compromise it by an agreement allowing each party to do what he pleased, without regard to their conflicting claims, it is a license, see *Troy Iron & Nail Factory v. Corning* (1849), 1 Blatch. 467.

That an agreement, in settling a suit, that the defendant has infringed and has paid for it, is no license for the future, see *Pickering v. Phillips* (1876), 4 Clifford, 383; 2 Bann. & A. 417; 10 O. G. 420.

That where a written license is found in the hands of the licensee, a person who claims that it was delivered as an escrow must prove it, see *Mellon v. Delaware, Lackawanna, & Western R. R. Co.* (1882), 21 O. G. 1616.

license is determined by the circumstances out of which it has arisen.⁶

§ 810. Express Licenses may Cover one or more of the Rights Embraced in the Invention.

A license may relate to any or to all of the subordinate rights embraced in the invention. These rights are in their nature independent of each other, and can be exercised either separately or together, and can vest in different persons or in a single individual. It is optional with the owner of the patented invention to divide them, and to confer upon one licensee the right to make, upon another the right to use, and upon another the right to sell, or to bestow the three, or any two of them, on the same licensee.¹ To which and to how many of these rights a given license relates depends upon its terms, interpreted by the intention of the parties as shown by all the circumstances of the case.

§ 811. Express Licenses: License to Make.

A license to make confers upon the licensee the right to construct the article which is described and claimed in the letters-patent. If conferred alone, it gives the licensee no right to use or sell the article when constructed, and hence is generally coupled expressly with one or the other of these additional rights, as in licenses to make and use, or to make and sell.¹ Where the express words of the license embrace only the right to make, and the other rights are necessary to enable

⁶ That the scope of an implied license is ascertained from the circumstances, see *Montross v. Mabie* (1887), 41 O. G. 931; 30 Fed. Rep. 234.

§ 810. ¹ In *Steam Cutter Co. v. Sheldon* (1872), 10 Blatch. 1, Woodruff, J. : (8) "True, the patent granted to an inventor confers upon him the right to make, to use, and to vend to others to be used; and it is possible for him, in granting to others a share in his exclusive right, to limit the privilege granted, as he may see fit, and it is, therefore, possible for him to keep these

privileges distinct, if he can find persons willing to pay for one without the right to enjoy either of the others. Each case, however, must be judged of as well by the terms of the grant of privilege, as, also, by the situation of the parties or the circumstances under which they act." 5 Fisher, 477 (484).

See also *Porter Needle Co. v. National Needle Co.* (1883), 17 Fed. Rep. 536.

§ 811. ¹ That the right to make is distinct from the right to use, see *Bicknell v. Todd* (1851), 5 McLean, 236.

the licensee to derive any advantage from the license, the presumption that the licensor intended that the right conveyed should be beneficial to the licensee controls the interpretation of the license, and extends it to include the right to use or sell, rather than permit it to be practically void. Thus a license to make the invention, conferred upon a licensee in whose business the thing made is ordinarily employed, carries by implication a right to use it when constructed. A similar license to a manufacturer of articles for sale, who has no use for this particular article when made, authorizes him to sell as well as make it.² The scope of the license is governed by the same presumption. A license to make an article which is covered by several patents, all owned by the same licensor, is a license under each of these patents, to whatever extent the making of the invention may require.³

§ 812. Express Licenses: License to Use.

A license to use varies in signification according to the nature of the invention to which it relates. When the invention is an art a license to use it is a license to practise the invention, and confers a right to do whatever the specification of the patent may prescribe or suggest, no other form of license being appropriate to this class of inventions. When the invention is an instrument, however, a license to use bestows merely the right to employ the completed article for practical purposes, but not the right to make it nor to sell it.¹

² In *Steam Cutter Co. v. Sheldon* (1872), 10 Blatch. 1, Woodruff, J. : (8) "If a party engaged exclusively in the construction of machines of various kinds, for sale to others, were to receive a license to manufacture a patented machine, for a consideration presently paid to the patentee, a construction which would deny him all opportunity to make the privilege of any value, forbidding his sale of the machines when manufactured, should be very clearly imported by the license, or the court would hold that the parties meant that he should derive some benefit from the license, and not be left thereafter

wholly dependent on the will of the patentee." 5 Fisher, 477 (484).

³ That a general grant of the right to make the patented device, by the owner of two patents which cover the making, confers the right under both patents, see *Day v. Stellman* (1859), 1 Fisher, 487.

That a license under a foreign patent does not authorize the licensee to make the articles abroad for sale here, see *Société Anonyme v. Tilghman's Patent Sand Blast Co.* (1883), L. R. 25 Ch. D. 1.

§ 812. ¹ In *Steam Cutter Co. v. Sheldon* (1872), 10 Blatch. 1, Wood-

In the absence of express restrictions in the license, this right of use is unlimited as to place, quantity and method, and may be continued during the term for which the patent has been granted, although the use must be confined to the precise invention covered by the patent of the licensor.² Express restrictions as to place, time, quantity or mode of use, are binding on the licensee and render all use contrary to such restrictions an infringement of the patent. A license to use within a certain district only, or at a certain shop, or on a certain line of railway, gives no authority to the licensee or his vendees to employ the invention in another district, or at a different shop, or on a new or an extended line of railway.³ A license to use a specified number of the patented

ruff, J. : (8) "On the other hand, when the patentee, having made machines, sells one with the right to use the same, his grant may, with propriety, be limited to the particular machine sold ; and it is also clear that such a sale would (unless limited in terms, or by special circumstances), import the right to use, although not so expressed. So, a sale of a patented invention to a dealer, not for use but for sale to others, would carry with it the right, in the ultimate purchaser, to use the machine sold. Limitations in respect to territorial limits, extent of use, and the like, may be, and in general are, provided by express terms or stipulations." 5 Fisher, 477 (484).

² That a license does not authorize the use of any other invention than the one described in the license, though invented by the same licensee, see Miller's Falls Co. v. Ives (1877), 14 O. G. 203 ; 14 Blatch. 169 ; 2 Bann. & A. 574.

That the sale of an invention, the use of which involves the use of a process patented by the same grantor, is a license to use the process, see Downton v. Yaeger Milling Co. (1879), 17 O. G. 906 ; 1 McCrary, 26 ; 5 Bann. & A. 112 ; 1 Fed. Rep. 199.

That the sale of a machine with right to use a patented article therewith gives a license to use the article, but is not an assignment and need not be in writing, see Buss v. Putney (1859), 38 N. H. 44.

³ In Dorsey Revolving Harvester Rake Co. v. Bradley Mfg. Co. (1874), 12 Blatch. 202, Woodruff, J. : (204) "The right to make and vend, and the right to use, are completely severable ; and, while a grant of the right to make and sell to others might be deemed to imply the right in the purchasers to use the thing purchased, a patentee may restrict the use. The patent as effectually secures to him a monopoly of the right to use as it does of the right to make. The patentee or his assignee may, therefore, give the exclusive right to make and sell for use within certain territory ; and such a restriction would be entitled to enforcement." 1 Bann. & A. 330 (332).

That a license to use within a certain district confers no rights beyond the limits of that district, see Chambers v. Smith (1870), 5 Fisher, 12 ; Woodworth v. Cook (1850), 2 Blatch. 151.

That a right to use in one place only makes a user in any other place an infringement, but such infringement does

articles, or to use the patented process for the production of a certain quantity of its results, does not empower the licensee to use a greater number or produce a greater quantity, even though he is willing to pay the licensor additional royalties or license-fees in proportion to the increase of his use of the invention.⁴ A license to use for a given purpose only, or in

not revoke the right to use in the place specified, see *Steam Cutter Co. v. Sheldon* (1872), 10 Blatch. 1; 5 Fisher, 477.

That a machine licensed to be used in certain territory cannot be used elsewhere by other purchasers, and a demand by an agent for royalties properly due cannot ratify its improper use, see *Wicke v. Kleinknecht* (1874), 1 Bann. & A. 608; 7 O. G. 1098.

That the purchaser of a machine from one who has a right to use, and to sell to others to be used, only in a certain territory, has no right to use it elsewhere, and if he does, is liable for royalties to the patentee, see *Burke v. Partridge* (1878), 58 N. H. 9.

That a license to manufacture "at their shop," in a place described, is not transferable, see *Searls v. Bouton* (1881), 21 O. G. 1784; 20 Blatch. 426; 12 Fed. Rep. 140.

That a license to one to use "at his own establishment" does not cover a use at a shop owned by himself and others, see *Rubber Co. v. Goodyear* (1869), 9 Wall. 788.

That the sale of certain buildings and machinery with the right to use certain patented processes, gives no license to use the processes elsewhere, see *Wetherell v. Passaic Zinc Co.* (1872), 2 O. G. 471; 9 Phila. 385; 6 Fisher, 50.

That a personal license to use a patented device in one certain shop does not forbid its being made elsewhere, see *Wood v. Wells, Crittenden & Co.* (1873), 6 Fisher, 382.

That a license to a railway company

to use a patented device on their road extends no farther than the road was built and used by it at the time the license was given, the use on roads built or leased afterwards not being protected, see *Emigh v. Chicago, Burlington, & Quincy R. R. Co.* (1863), 1 Bissell, 400; 2 Fisher, 387.

That a license to use the invention on a railroad fifty-eight miles long does not confer the right to use it on a new road owned by the same licensee, see *Emigh v. Chicago, Burlington, & Quincy R. R. Co.* (1863), 2 Fisher, 387; 1 Bissell, 400.

That a license to use a device on a certain railroad does not carry the right to use the device on the cars of the licensee over whatever railroad they may be run, see *Hodge v. Hudson River Railroad Co.* (1868), 6 Blatch. 85; 3 Fisher, 410.

That a railroad company, running its cars on another railroad, is not operating said road within the meaning of a license granted "to the operator" of such road, see *Hodge v. Hudson River Railroad Co.* (1868), 6 Blatch. 85; 3 Fisher, 410.

That a license to use the patented device "on any road now or hereafter owned," etc., covers its use on all machines on such roads, see *Matthew v. Pennsylvania R. R. Co.* (1881), 8 Fed. Rep. 45.

⁴ That a license based on the pre-payment of a specific sum for each machine used, will not permit the use of other machines unless paid for in the same manner, see *Wooster v. Seidenberg*

a particular manner, or for a period less than the duration of the patent, binds the licensee with equal strictness, and makes him liable as an infringer for any excess of use beyond what is distinctly conferred upon him.⁵ In licenses to use the law often implies the grant of other powers which in the case in question are essential to the enjoyment of the right to use.⁶ A license to use a specific article carries the right to repair it as long as its identity remains.⁷ A license to use a certain number of articles bestows the right to keep the number in use complete, by purchasing, or if necessary by making, new ones as the old are worn out or destroyed.⁸

§ 813. Express Licenses: License to Sell.

A license to sell confers the right to vend the patented article. Being comparatively valueless without the right to

(1875), 10 O. G. 244 ; 13 Blatch. 88 ; 2 Bann. & A. 91.

That the tender of an agreed price per machine for machines used beyond the scope of the license does not cure an infringement consisting in the use of such machines, see *Steam Cutter Co. v. Sheldon* (1872), 10 Blatch. 1 ; 5 Fisher, 477.

⁵ That a license to use only upon specified conditions confines the use to such conditions, see *Woodworth v. Cook* (1850), 2 Blatch. 151.

That the words "licensed to use once only," if stamped on an invention, is notice that it is used under such a license and that the license expires on its first use, see *American Cotton Tie Supply Co. v. Bullard* (1877), 17 O. G. 389 ; 17 Blatch. 160 ; 4 Bann. & A. 520. *Contra*: *American Cotton Tie Supply Co. v. Simmons* (1878), 13 O. G. 967 ; 3 Bann. & A. 320.

That a license granted for a certain period to a person, but not to "his assigns," will expire at his death, see *Oliver v. Rumford Chemical Works* (1883), 109 U. S. 75 ; 25 O. G. 784.

⁶ That a license to one man and "his legal representatives" of the "full and

exclusive right to use and to sell to be used," reserving to the assignor the right to make "for himself and his representatives," gives to the licensee the right to make the invention, since without it the license would be valueless, see *Hamilton v. Kingsbury* (1878), 15 Blatch. 64 ; 14 O. G. 448 ; 3 Bann. & A. 346.

That an exclusive license to a person and his assigns to make and use includes a right to sell without express words to that effect, see *Bellas v. Hays* (1819), 5 S. & R. 427.

⁷ That a gratuitous universal license to use machines confers the right to use them until they are used up, see *Wooster v. Sidenberg* (1875), 13 Blatch. 88 ; 2 Bann. & A. 91 ; 10 O. G. 244.

That a license "to use to the extent of one machine" includes the right to make for such use and to repair indefinitely, see *Steam Cutter Co. v. Sheldon* (1872), 10 Blatch. 1 ; 5 Fisher, 477.

⁸ That the grant of a right "to use any number of" the patented devices, carries the right to make them and have them made, see *Steam Stone Cutter Co. v. Shortsleeves* (1879), 16 Blatch. 381 ; 4 Bann. & A. 364.

produce the articles to be sold, it is usually coupled with a license to make. Whether granted alone, or in connection with the right to construct the invention, it may be restricted as to time, place, and quantity, and by such restrictions the licensee is bound as rigidly as in the case of a license to use. In this, as in all other instances where a license covers two or more rights, the restrictions may apply only to one right, or in the same or different degrees to each of the rights conveyed. A license to make and sell may thus limit only the place and time of making, leaving the maker to find his market when and where he can; or it may confine his sales within a given territory, and fix no boundaries to the act of manufacture. Provisions in the license may, to the same extent, curtail the rights of purchasers of the patented article from the licensee, by limiting his power to sell it except for use within a specified area or for a certain purpose.¹ When a license to practise an art is joined with an unrestricted license to sell its product, the latter license is superfluous unless the product also is a patented invention; but if the license to sell is limited as to time or place or purpose it may operate as a

§ 815. ¹ In *Dorsey Revolving Harvester Rake Co. v. Bradley Mfg. Co.* (1874), 12 Blatch. 202, Woodruff, J.: (207) "Does the right to make and sell carry with it the right to use? If, by implication, the right to use is incident to, or implied in, the right to make and sell, does not the limitation of the right to make and sell to specific territorial limits, operate with equal strictness upon the right of use which is incidental thereto or is so implied? Is the incident broader in its scope than the principal grant? If it be true, as claimed, that when one who has the whole right in the invention, to make, sell, and use (either for the whole or a part of the United States), sells a machine, it passes from under the dominion of the patent, and may be used anywhere, does that follow when a mere licensee to make and sell within specified limits sells the patented inven-

tion to another? Does the cautiously guarded decision of the Supreme Court in *Adams v. Burke* (17 Wallace, 453), carefully limited to the precise case then under consideration, reasonably import an affirmative to the last question? Especially may one having a license to make and sell within a limited territory only deliberately contract to supply the patented invention for use in other territory, provided his manufacture and his actual negotiation of sales are within the privileged limits, and may he practically avail himself of the markets of the whole country?" 1 Bann. & A. 330 (335).

That the assignee of a territorial right to make, use, and sell a machine may sell the product of the machine anywhere, as the territorial restriction relates to the machine only, see *Simpson v. Wilson* (1846), 4 How. 709; 2 Robb, 469.

condition governing the enjoyment of the former license, and confining the use of the art to the production of such results as can lawfully be sold.² A license to sell, or to use and sell, may embrace by implication the right to make, when, under all the circumstances of the case, the rights expressly granted would otherwise be unavailable to the licensee.³

§ 814. **Express Licenses: Exclusive or Non-Exclusive.**

Licenses may be exclusive or non-exclusive. An exclusive license confers upon the licensee the sole right to make, use, or sell the invention within the area or for the purposes described.¹ A non-exclusive license confers this right upon him in common with the licensor, and with all other persons upon whom the licensor may see fit to bestow it. The nature of the right in either case is the same; its value alone being

² In *Boyd v. Brown* (1843), 3 McLean, 295, *per Curiam*: (296) "There can be no doubt that the original patentee, in selling rights for counties or States, might, by a special covenant, prohibit the assignee from vending the article beyond the limits of his own exclusive right. But in such a case the remedy would be on the contract, and not under the Patent Law. For that law protects the thing patented, and not the product. The exclusive right to make and use the instruments for the construction of this bedstead in Hamilton County is what the law secures, under his assignment, to the complainant. Any one violates this right who either makes, uses, or sells these instruments within the above limits. But the bedstead, which is the product, so soon as it is sold, mingles with the common mass of property, and is only subject to the general laws of property." 2 Robb, 203 (205).

³ That a license to use and sell carries the right to make, if without it the expressed privilege cannot be reasonably enjoyed, see *Hamilton v. Kingsbury* (1878), 15 Blatch. 64; 14 O. G. 448; 3 Bann. & A. 346.

That the right to make and sell includes the right to use, see *Turnbull v. Weir Plow Co.* (1880), 14 Fed. Rep. 108; 9 Bissell, 334; 5 Bann. & A. 288; 23 O. G. 91; also § 808 and notes, *ante*.

§ 814. ¹ That a covenant in a license not to give the same right to any other is equivalent to an exclusive right in the licensee, see *Day v. Cary* (1859), 1 Fisher, 424.

That the contract of a workman to give his employer the exclusive benefit of his inventions is an exclusive license during the life of the patent, see *Wilkins v. Spafford* (1878), 13 O. G. 675; 3 Bann. & A. 274.

That a licensor granting an exclusive territorial license excludes himself and all others from using any device, though different in name, which is substantially the same, see *Ferree v. Smith* (1877), 29 La. Ann. 811.

That an exclusive license, with an agreement to assign after the license expires, is without consideration if the patent is void, such a license conveying no rights which the licensee did not already have, see *Harlow v. Putnam* (1878), 124 Mass. 553.

affected by its confinement to himself or its indefinite distribution to others. To this statement there is apparently a single exception, — an exclusive license to make and use and sell operating upon the monopoly as well as the invention and vesting both in the licensee, while a non-exclusive license of the same extent merely conveys the rights in the invention.² But the exception is apparent only, — such an exclusive license being in reality, though not in form, an assignment or a grant, according to the territory to which it relates.

§ 815. **Express Licenses: By whom Granted: Caveat Emptor.**

Any owner of a patented invention may issue licenses within the limits of his own right, in any form and to any extent which he may deem expedient. A patentee or assignee, whether sole or joint, may license for the whole or for any part of the United States. A grantee can license only within the territory covered by his ownership of the invention. A license issued by one joint-owner is valid by estoppel against the other owners, though contrary to their will, whatever remedy they have under the present law being in an account for their share of the license-fee from the licensor.¹ But no part-owner can grant an exclusive license, or in any other manner restrict the licensing powers of the other owners of the patent.² As between the licensee and licensor the doctrine of *caveat emptor* is rigidly applied.³ The rights of

² In *Mitchell v. Hawley* (1872), 16 Wall. 544, Clifford, J. : (548) "Purchasers of the exclusive privilege of making or vending the patented machine hold the whole or a portion of the franchise which the patent secures, depending upon the nature of the conveyance." 3 O. G. 241 (242); 6 Fisher, 331 (333).

See also *Pickhardt v. Packard* (1884), 23 Blatch. 23; 30 O. G. 179; 22 Fed. Rep. 530; *Nellis v. Pennock Mfg. Co.* (1882), 13 Fed. Rep. 451; 22 O. G. 1131; *Farrington v. Gregory* (1870), 4 Fisher, 221; and § 808, note 5, *ante*.

§ 815. ¹ That a license by one joint-owner is valid, see *Washburn & Moen*

Mfg. Co. v. Chicago Galvanized Wire Fence Co. (1884), 109 Ill. 71; *Curran v. Burdsall* (1883), 20 Fed. Rep. 835; 27 O. G. 1319; *Dunham v. Indianapolis & St. Louis R. R. Co.* (1876), 7 Bissell, 223; 2 Bann. & A. 327; *De Witt v. Elmira Nobles Mfg. Co.* (1876), 66 N. Y. 459; *Clum v. Brewer* (1855), 2 Curtis, 506; and § 796 and notes, *ante*.

² See cases cited in note 1, and § 796 and notes, *ante*.

³ That the doctrine of *caveat emptor* obliges the licensee to ascertain whether the licensor has a good title, see *Abbett v. Zusi* (1879), 5 Bann. & A. 38.

the licensee can never exceed those of his licensor, and it is his duty to ascertain, before he purchases his rights, whether the licensor is able to convey the interest he proposes to bestow.⁴ No previous conveyance, whether assignment, grant, or license, can be affected by the one which he receives, and thus he takes his right subject to all the limitations these may impose upon him.⁵

§ 816. Duration of Express License: Effect of its Termination.

Unless otherwise agreed, an express license expires at the end of the original term of the patent.¹ No one but the patentee, or an assignee or grantee to whom the patentee has conveyed the extended term, can authorize the practice of the invention under the extension; and a license even by these is never presumed to cover the extended term unless such an intention clearly and unequivocally appears upon the face of the license itself.² A license for the "whole term for which let-

⁴ That the rights of a licensee cannot be broader than those of his licensor, see *Waterman v. Wallace* (1875), 13 Blatch. 128; 2 Bann. & A. 126.

⁵ That an assignee, having assigned all his interest in the patent, cannot confer any right on a subsequent purchaser to use the invention, either during the present or an extended term, see *Union Paper Bag Mach. Co. v. Nixon* (1876), 1 Flippin, 491; 2 Bann. & A. 244; 9 O. G. 691.

§ 816. ¹ That a license to practise an invention expires with the patent on which it is based, see *Wetherell v. Passaic Zinc Co.* (1872), 6 Fisher, 50; 2 O. G. 471; 9 Phila. 335; *Mitchell v. Hawley* (1872), 16 Wall. 544; 3 O. G. 241; 6 Fisher, 331; *England v. Thompson* (1869), 3 Clifford, 271.

That an exclusive license expires when the term of the patent ends, see *Union Paper Bag Mach. Co. v. Nixon* (1882), 105 U. S. 766; 21 O. G. 1275.

That a grant to make and use within certain territory for the term of the patent expires with the original term,

and does not remain under an extension, see *Wood v. Michigan Southern & Northern Indiana R. R. Co.* (1868), 3 Fisher, 464; 2 Bissell, 62.

That a sub-license to practise an invention expires with the term of the patent, see *Hawley v. Mitchell* (1871), 4 Fisher, 388; 1 O. G. 306; Holmes, 42.

That an express license to use an invention expires with the original patent, see *Union Paper Bag Mach. Co. v. Nixon* (1881), 105 U. S. 766; 21 O. G. 1275; *Wooster v. Sidenberg* (1876), 10 O. G. 244; 13 Blatch. 88; 2 Bann. & A. 91; *Mitchell v. Hawley* (1872), 16 Wall. 544; 3 O. G. 241; 6 Fisher, 331.

² That the license is presumed to cover only the original term of the patent, and one who claims that it covers the extended term must prove it, see *Hodge v. Hudson River Railroad Co.* (1868), 6 Blatch. 85; 3 Fisher, 410.

That a license may be made to endure under an extension, and the royalty will be collectible, see *Union Mfg. Co. v. Lounsbury* (1869), 41 N. Y. 363.

That a license to endure till all pat-

ters-patent are or may be granted," or under "any letters-patent granted by the United States," does not satisfy the requirements of this rule, and will be operative only during the original term.³ The effect of the termination of the license

outs now or hereafter to be granted for the invention expire is good, and will run until the expiration of the latest patent, see *McKay v. Mace* (1884), 23 Fed. Rep. 76.

That after an extension by act of Congress the licensee stands on his original title, not on the act of Congress granting the extension, such act not conferring rights but merely protecting them, see *Union Mfg. Co. v. Lounsbury* (1869), 41 N. Y. 363.

That one who takes a license under an extension thereby admits that he has no existing rights which he did not then set up, and is estopped from asserting them against the patentee, see *Wooster v. Taylor* (1874), 12 Blatch. 384; 1 Bann. & A. 594; 8 O. G. 644.

³ In *Hodge v. Hudson River Railroad Co.* (1868), 6 Blatch. 85, Blatchford, J.: (89) "The presumption of law in regard to every license under a patent is that the parties deal in regard only to the term existing when the license is given, unless an express provision is inserted looking to a further interest. (*Wilson v. Rousseau*, 4 How. 646, 685, 686). Unless there be such a stipulation, showing that the parties contemplated an extension, the court is bound to construe the instrument, in each and all of its provisions, as relating to the then existing term only. (*Gibson v. Cook*, 2 Blatchf. C. C. R. 144, 146.) The language of the license in the present case is very different from the language of the instrument in the case of *Phelps v. Comstock* (4 McLean, 353). In that case the language was 'to the full end of the term or terms for which letters-patent are or may be granted for said improvements.' The court held that that lan-

guage embraced any subsequent extension of the patent. So, also, in *Case v. Redfield* (4 McLean, 526), where the court held that the language of the instrument embraced an extension, the language was 'all the right, title, and interest . . . in said invention and improvement, as secured . . . by said letters-patent, for the whole of the United States, . . . for which letters-patent were or may be granted for said improvements.' In *Clum v. Brewer*, (2 Curtis, C. C. R. 506, 508), where the court held that the parties intended to cover an interest in any extension, the language was 'one undivided fourth part of my said invention, and of all my rights and property therein, secured by my said caveat or otherwise, that I have or may have from any letters-patent for the same, granted by the Government of the United States and within the limits thereof.' In *Pitts v. Hall* (3 Blatchf. C. C. R. 201), where the court held that there was no doubt that the parties intended by the language used to refer to and provide for an extension, the language to that effect was clear and unambiguous. In all four of the cases referred to, the instrument under consideration was one purporting to convey, by assignment or grant, an interest in the invention patented, and an interest in the entire right granted by the existing patent to make and use and vend to others to be used the invention patented. As Mr. Justice Curtis says, in *Clum v. Brewer* (p. 521), 'where the invention is the subject sold it would be natural to expect to find, in the instrument of sale, something showing an intention that the purchaser should be interested, not merely in the original letters-patent, but in any ex-

upon the privileges of the licensee, however, differs according to the right which forms the subject-matter of the license, and the class to which the patented invention properly belongs. If the invention is an instrument a license to make it, or to sell it, expires with the original term of the patent, and no further manufacture or sale will be lawful without a license under the extension.⁴ But a license to make and use, or a license to use a particular instrument manufactured under the patent and duly sold to the licensee, remains in force, so far as the use is concerned, until the instrument made or purchased is worn out and can no longer be repaired without destroying its identity.⁵ A license to use a certain number

tension thereof, securing the exclusive right to the same invention which was the subject of the sale.' In the present case neither the invention, nor any interest in it, nor any interest in the entire right covered by the patent was granted, but merely a license to use the invention, and to construct brakes containing it for such use on certain cars, on a certain railroad; and such license is to continue during *the term* for which *said* letters-patent are or may be granted. *The term* for which *said* letters-patent — that is, the letters-patent granted October 2d, 1849, and re-issued March 1st, 1853 — were granted, or might be granted, was a term ending October 2d, 1863. It is impossible, on any fair construction of the language, and in view of the adjudged cases, to hold that the license was intended by the parties to cover an extended term of the patent." 3 Fisher, 410 (414).

See also *Wetherell v. Passaic Zinc Co.* (1872), 6 Fisher, 50; 2 O. G. 471; 9 Phila. 385.

⁴ That a license to make or to sell, or to make and sell, a patented article expires with the original patent unless otherwise provided in the license, see *Mitchell v. Hawley* (1872), 16 Wall. 544; 3 O. G. 241; 6 Fisher, 331; *Wood v. Michigan Southern R. R. Co.* (1868), 2 Bissell, 62; 3 Fisher, 464.

That a license to make, use, and sell runs for the term of the patent, see *Birdsell v. Shaliol* (1884), 112 U. S. 485; 30 O. G. 261.

⁵ In *Mitchell v. Hawley* (1872), 16 Wall. 544, Clifford, J. : (548) "Purchasers of the exclusive privilege of making or vending the patented machine hold the whole or a portion of the franchise which the patent secures, depending upon the nature of the conveyance; and of course the interest which the purchaser acquires terminates at the time limited for its continuance by the law which created the franchise, unless it is expressly stipulated to the contrary. But the purchaser of the implement or machine for the purpose of using it in the ordinary pursuits of life stands on different grounds, as he does not acquire any right to construct another machine either for his own use or to be vended to another for any purpose. Complete title to the implement or machine purchased becomes vested in the vendee by the sale and purchase; but he acquires no portion of the franchise, as the machine when it rightfully passes from the patentee to the purchaser, ceases to be within the limits of the monopoly." 3 O. G. 241 (242); 6 Fisher, 331 (333).

In *Wetherell v. Passaic Zinc Co.* (1872), 2 O. G. 471, McKennan, J. :

of patented instruments in like manner confers upon the licensee the right to keep that number in employment during

(474) "A broad distinction is thus indicated between the use of an invention and the use of a patented machine. While the right to the use of the invention expires with the end of the term of the original patent, the right to the continued use of the machine which embodies it is protected. The law did not intend to revive an assignment or grant which expired with the term of the original patent, but to protect a species of tangible property, sold by the patentee, the value of which depended chiefly upon the owner's right to use it, and which, without some saving provision, would fall within the grasp of the exclusive rights vested in the patentee by the extension. It was manifestly, then, something less than the entire right to use the invention which the act contemplated. What that is is clearly stated in the opinion of the court, not as a dictum of the judge who delivered it, but as an exposition of the meaning of the act, which was necessary to a decision of the cause. 'The thing patented' is the subject of the use, and the court say, where these words are employed in the act in connection simply with the right to use, they refer only to the patented machine, and not to the invention. This, then, is an authoritative definition of their significance in the clause in question, and they must therefore be taken to mean a specific machine, and, in connection with the other words of the clause, to confer a right to use *it*, 'nothing more.' And it has since been held that this right is restricted to the mere use, and does not cover the reconstruction of the machine. It necessarily follows that this saving clause is applicable only to inventions which are susceptible of embodiment in a substantial and tangible form, and not to those which consist

in a formula for producing prescribed results, and when those results are obtained there is an end of the thing patented, and which, as often as it is employed in practice, involves the renewed use or reproduction of the entire invention." 3 Fisher, 50 (58); 9 Phila. 385 (389).

In *Hawley v. Mitchell* (1871), 1 O. G. 306, Shepley, J. : (307) "No words of limitation, however clearly expressed, confining an assignee's right to the original term, will have any effect to deprive the assignee or his assigns of the right to use, during the extended term of the patent, machines lawfully constructed and used by them during the original term. But this right applies only to machines which have passed outside of the monopoly by a lawful sale of the whole monopoly in the particular machine during the original term." Holmes, 42 (44); 4 Fisher, 388 (390).

In *Wood v. Michigan Southern & Northern Indiana R. R. Co.* (1868), 2 Bissell, 62, McDonald, J. : (65) "To every assignee or grantee of a patent holding the right, at the expiration of the first term of it, to use the thing patented, this section of the act plainly gives the same right to use it during the term of the renewal of the patent, exactly to the extent to which he had the right to use it under the first term of the patent. And it is clear that he may not only use it, but repair it for use till it is worn out. So the Supreme Court has decided. On the contrary, it is equally clear that this section does not authorize the assignee or grantee either to sell or to manufacture for sale the thing patented; for the terms of the section only embrace 'assignees and grantees of the right to use.' . . . (67) The same doctrine was adhered to in

the original term, to replace them with others as they become unserviceable, and to use those actually on hand when the patent expires until they are no longer capable of use.⁶ A general license to use the invention, having no reference to particular instruments or to a specific number of the patented articles, and not granted in connection with an unrestricted sale of

Wilson v. Simpson, 9 How. 109. And Mr. Justice Wayne, in delivering the opinion of the court in that case, said that the decision in *Wilson v. Rousseau* 'does not permit an assignee of the first term of a patent, after its renewal and extension, to make other machines.' The subsequent cases of *Bloomer v. McQuewan*, 14 How. 539; *Chaffee v. The Boston Belting Co.*, 22 How. 217; *Bloomer v. Millinger*, 1 Wallace, 340, -- all recognize and approve the same doctrine. The doctrine established in all these cases is that an assignee of a patent holding, at the expiration of the first term, a right during that term to make and use the thing patented, may during the time of its subsequent extension, continue to use it, and even repair it for use; but that he cannot make it for use, or for any other purpose. It is true that in the cases in the Supreme Court referred to, there was a remarkable diversity of opinion among the judges. But that diversity had no reference to anything favorable to the defence in this case. It seems to have arisen solely from an opinion, on the part of the minority of the judges, that the assignee of a patent for its first term had no right even to use the thing patented after the expiration of that term, unless the assignment, by its terms, gave him that right. And this circumstance may well admonish us not to extend this right to the thing patented." 3 Fisher, 464 (468).

See also *Union Paper Bag Mach. Co. v. Nixon* (1882), 105 U. S. 766; 21 O. G. 1275; *Eunson v. Dodge* (1873),

18 Wall. 414; 5 O. G. 95; *Brooks v. Bicknell* (1845), 4 McLean, 64.

That the right to use includes the right to repair and to purchase new when the old are worn out, see *Bicknell v. Todd* (1851), 5 McLean, 236.

That a right to use subsists with the same limitations as to place, etc., after an extension as before, see *Day v. Union India Rubber Co.* (1856), 3 Blatch. 488.

That the owners of an extension and their grantees take their title subject to the rights of the existing owners of the patented devices, see *Union Paper Bag Mach. Co. v. Nixon* (1882), 105 U. S. 766; 21 O. G. 1275.

That a licensee is neither an assignee nor a grantee, under Sec. 4928, Rev. Stat., but must be a purchaser of the patented article or be protected by some agreement of sale lawfully made by the owner of the patent, see *Wooster v. Sidenberg* (1875), 10 O. G. 244; 13 Blatch 88; 2 Bann. & A. 91.

That where an agent of the patentee, for a valuable consideration, licenses another to construct a device embodying the invention, the patentee has no right to the device, but the licensee may use the invention in connection with such device even under an extension, see *Black v. Hubbard* (1877), 3 Bann. & A. 39; 12 O. G. 842.

⁶ That a license to use one device is a license to make one for use and to use it until it is worn out, and to supply its place with another and so on, till the patent expires, and then to use the one at that time in use until it is also worn out, see *Woodworth v. Curtis* (1847), 2 W. & M. 524; 2 Robb, 603.

the patented article, on the contrary, expires with the patent.⁷ If the invention is an art, a license to use it is a license to practise the invention as a whole, and in analogy with the preceding rules should also terminate with the original patent.⁸ But it has been held that such a license granted by the patentee, or by an assignee to whom the extension has already been conveyed, continues during the extended term and authorizes the licensee not only to employ the process but to procure new apparatus for its use after the extension.⁹ These various rights the licensee will waive if he takes a new license from the owners of the extended term.¹⁰ A license to a specific person ceases at his death.¹¹

§ 817. **Express License not Recordable.**

A license is not such a conveyance of an interest in the patented invention as to affect its ownership, and hence is not required to be recorded.¹ All subsequent purchasers

⁷ That a general license to use expires with the patent, see *Union Paper Bag Mach. Co. v. Nixon* (1882), 105 U. S. 766; 21 O. G. 1275; *Wooster v. Sidenberg* (1875), 10 O. G. 244; 13 Blatch. 88; 2 Bann. & A. 91.

⁸ That the grant of a right to use a process, even though coupled with the sale of apparatus suitable for use in that process, does not convey the right to use the process during an extension, see *Wetherell v. Passaic Zinc Co.* (1872), 2 O. G. 471; 9 Phila. 385; 6 Fisher, 50.

⁹ That the right to practise a patented process, if derived from the patentee himself, continues during an extension, even against an assignee of the extended term, and even though the licensee makes new apparatus to do it with after the extension, see *Day v. Union India Rubber Co.* (1856), 3 Blatch. 488.

¹⁰ That where a licensee has articles in use at the expiration of the patent, and has the right to use them during the extension and until they are used

up, but takes a new license under the extension and forfeits it, his old license cannot avail him even as to these articles, see *Wooster v. Taylor* (1874), 12 Blatch. 384; 1 Bann. & A. 594; 8 O. G. 644.

¹¹ That a personal license granted for a certain period will expire at the death of the licensee unless also granted to his assigns, see *Oliver v. Rumford Chemical Works* (1883), 109 U. S. 75; 25 O. G. 784.

That under a personal and unassignable license to make and sell, the articles on hand at the death of the licensee may be sold by his representatives, see *Montross v. Mabie* (1887), 30 Fed. Rep. 234; 41 O. G. 931.

§ 817. ¹ That a license need not be recorded, see *Hamilton v. Kingsbury* (1879), 17 Blatch. 264; 17 O. G. 147; 4 Bann. & A. 615; *Chambers v. Smith* (1870), 5 Fisher, 12; *Farrington v. Gregory* (1870), 4 Fisher, 221; *Brooks v. Byam* (1843), 2 Story, 525; 2 Robb, 161.

take their titles subject to the rights of existing irrevocable licensees, as assignees of other property receive it subject to the obligations imposed upon it by the contracts of its previous owners.² The value of the patented invention to the vendee may be impaired by such outstanding licenses, but of this he must inform himself at his own risk as best he may. The record of a license, not being legally required, is not constructive notice to any person or for any purpose.³

§ 818. Express Licenses: How Construed.

A license is construed by the courts according to the intention of the parties, as manifested by the language they employ.¹ If the license is in writing all previous parol agreements covering the same subject-matter are merged in the written instrument, and oral evidence is not admissible to expand, contract, or vary its provisions.² When several licenses or other contracts constitute together one transaction, all are to be considered in the interpretation of each, as if they were a single instrument.³ The scope of any license, if general in its terms, is to be limited by the patent on which it is based; and where the conduct of the parties and their dealings with each other have given a practical construction to the conveyance, not inconsistent with its letter, this also is regarded in determining its meaning.⁴ A license conferred before the is-

² That an irrevocable license is good without record against subsequent purchasers of the patent, see *Farrington v. Gregory* (1870), 4 Fisher, 221.

³ That the record of a license is not constructive notice, see *Chambers v. Smith* (1870), 5 Fisher, 12.

§ 818. ¹ That a license is to be construed by the intent of the parties, see *Wetherell v. Passaic Zinc Co.* (1872), 2 O. G. 471; 9 Phila. 385; 6 Fisher, 50.

That in enforcing a license the courts will follow the contract, not the moral conditions outside it, see *Ex parte Fuller* (1874), 5 O. G. 643.

² That a parol agreement, made before a written license, is merged in the

license, see *Evory v. Candee* (1879), 17 Blatch. 200; 4 Bann. & A. 545.

That oral evidence is not admissible to explain a written license, but the parties must stand by it as made, see *Troy Iron & Nail Factory v. Corning* (1849), 1 Blatch. 467.

³ That several contracts for sale and license, made between the same parties on the same day, may all be construed together, see *Hammond v. Mason & Hamlin Organ Co.* (1875), 92 U. S. 724.

⁴ That a license is limited in scope by the patent on which it is based, see *Stuart v. Shantz* (1872), 6 Fisher, 35; 2 O. G. 524.

That a license to use the invention

sue of the patent must be construed as applying to the actual invention patented, however this may differ from the one described and claimed in the original application.⁵

§ 819. Reciprocal Rights and Duties of Licensors and Licensees.

The reciprocal rights and duties of licensors and licensees are determined by the express provisions of the license, and by implication of law from the relation which exists between them. If the licensee fulfils the conditions of the license, he is entitled to enjoy the privileges therein conferred upon him without interference from the licensor, and to be protected by the licensor against the violation of his rights by others.¹ Corresponding to this right of the licensee is the duty of the

covered by one Claim of a patent gives no right to use the inventions covered by its other Claims, see *United Nickel Co. v. California Electrical Works* (1885), 25 Fed. Rep. 475.

That the practical construction given to a license by the act of the parties is of great weight, see *Rubber Co. v. Goodyear* (1869), 9 Wall. 788.

⁵ That a license given pending an application for a patent covers the patent as granted, however it may differ from the original application, see *Kelly v. Porter* (1883), 17 Fed. Rep. 519 ; 8 Sawyer, 482.

§ 819. ¹ In *Cohn v. National Rubber Co.* (1878), 3 Bann. & A. 568, Clifford, J. : (568) "Inventors whose inventions are secured by valid letters-patent have the exclusive right, for the period allowed by law, to make, use, and vend the thing patented ; and by virtue of that right they may assign the patent, or license others to practise the invention. Persons duly licensed by the owner of the patent may make, use, and vend the patented product, within the terms and conditions of their license, without hindrance or interruption by the patentee, if they themselves comply with those terms and conditions." 15 O. G. 829 (829).

That a licensee, acting within his license, is not an infringer, see *Kelly v. Porter* (1883), 8 Sawyer, 482 ; 17 Fed. Rep. 519.

That a licensee cannot extend his license by acting beyond its terms, even where the conduct of his licensor is hostile, see *Aspinwall Mfg. Co. v. Gill* (1887), 40 O. G. 1133 ; 32 Fed. Rep. 697.

That a licensee, authorized to sell materials to be used in a patented process to the licensees of such process, becomes an infringer if he sells the materials for use to others known by him not to be licensees, see *Willis v. McCullen* (1886), 38 O. G. 1017 ; 29 Fed. Rep. 641.

That a license does not free the licensee from liability when he infringes a different patent not owned by the licensor, see *Stuart v. Shantz* (1872), 6 Fisher, 35 ; 2 O. G. 524.

That a licensee may deny that his acts are infringements even though his contract forbids him to deny it, see *White v. Lee* (1882), 23 O. G. 1621 ; 14 Fed. Rep. 789.

That a licensee is bound by his license though he neglects to read it before signing or accepting it, see *McKay v. Jackman* (1883), 17 Fed. Rep. 641.

licensor not to permit others to use gratuitously the privilege for whose enjoyment the licensee is compelled to pay, and to prosecute infringers whenever their wrongful acts become injurious to the licensee.² If the license is granted upon con-

² In *Goodyear v. Housinger* (1867), 2 Bissoll, 1, Drummond, J. : (8) "It was unfair, and is always unfair, to those who are licensed to use the particular article or method, under letters-patent, to allow others to use what the licensees have thus purchased. It is true that this conduct may be explained. There may be circumstances such as would not warrant any inference against the patentee, from such conduct; as, for instance, if the patentee were unable to prosecute the parties thus infringing the patents; or, if circumstances were such as to indicate that there was no acquiescence, expressed or implied, in the violation; or, as appears in this case, that there was a suit pending in one of the circuit courts of the United States, where the right under the patent was to be tested. That would constitute a reason why the patentee, or those claiming under him, should not involve themselves in great expense while there might be a question as to the validity of the patent." 3 Fisher, 147 (153).

That an exclusive license implies no warranty against infringers, see *Baker v. Mason* (1854), 3 R. I. 45.

That a licensor fulfils his agreement to prosecute infringers if he stops the infringement in any way, see *Foster v. Goldschmidt* (1884), 22 Blatch. 287; 21 Fed. Rep. 70; 28 O. G. 915.

That a licensor covenanting to sue infringers, not to license others, and to use diligence in securing the licensee's rights, is not bound to protect the licensee against those who claim under adverse patents, nor does he warrant against them, nor is he estopped to deny the validity of the patent in an action against him for not suing, or for

licensing others, see *Jackson v. Allen* (1876), 120 Mass. 64.

That a patentee, after granting an exclusive license for the term of the patent and agreeing to assign the extended term, cannot contract with third parties against the interests of his licensee, see *Adams v. Bridgewater Iron Co.* (1886), 26 Fed. Rep. 324; 34 O. G. 1045.

That a new license, granted to others in violation of the rights of an existing licensee, makes the licensor liable for all damage resulting, see *Pitts v. Jameson* (1853), 15 Barb. 310.

That an agreement by the licensor not to license any other person is broken by every concession, by suit or otherwise, which operates as a recognition of the rights of others to make and use, whether they are later patentees or not, see *Jackson v. Allen* (1876), 120 Mass. 64.

That where a licensor agrees that royalties shall be reduced if subsequent licenses are granted to others upon lower terms, the licensee cannot insist on the reduction unless he accepts the other burdens imposed upon the later licensees, see *Foster v. Goldschmidt* (1884), 22 Blatch. 287; 21 Fed. Rep. 70; 28 O. G. 915.

That a licensor will not be enjoined from suing for his license fees on the ground that he charges the plaintiffs more than he agreed to, their relief being at law, but he may be enjoined from declaring the license void and thus causing damage to the plaintiffs, see *Baker Mfg. Co. v. Washburn & Moen Mfg. Co.* (1883), 18 Fed. Rep. 172; 5 McCrary, 504.

That suing out and serving an injunction is a breach of the licensor's contract,

dition precedent, the condition must be performed before the privileges described can vest in the licensee, and any premature exercise of them will be an infringement of the patent, and render the licensee liable to an injunction.³ Pending the license, a violation of its concurrent conditions by the licensee suspends his privileges, and subjects him to an action for a breach of contract.⁴ If he persists in using them after he has, either by words or conduct, repudiated his license, he may be sued as an infringer, and cannot plead his license as a defence.⁵ When the license is not made irrevocable by its terms, or paid for by a gross sum in advance, the licensor may recall it on condition broken;⁶ but an unconditional license, limited

see *Sullings v. Goodyear Dental Vulcanite Co.* (1877), 36 Mich. 313.

That a license may be annulled on account of fraudulent representations of the licensor as to the salability of the invention, see *Hull v. Fields* (1882), 76 Va. 594.

³ In *Goodyear v. Congress Rubber Co.*, (1856), 3 Blatch. 449, Ingersoll, J. : (455) "When a license is granted to any one to use a patent in the manufacture of goods, which license is accompanied with an obligation, in favor of the patentee, on the part of the one to whom it is granted, to do or not to do a particular thing, and which obligation is the consideration upon which the license is granted, he upon whom the obligation rests must perform it, and, if he will not perform it, an injunction will be granted to restrain him from any further right to use the patent under the license."

⁴ That a licensee, violating the provisions of his license, may be sued on the contract or for infringement, and if the suit is on the contract the damages are the damages from the infringement, see *Magic Ruffle Co. v. Elm City Co.* (1875), 8 O. G. 773 ; 13 Blatch. 151 ; 2 Bann. & A. 152.

⁵ In *Cohn v. National Rubber Co.* (1878), 3 Bann. & A. 568, Clifford, J. :

(571) "Licensees, if they fulfil the stipulations of their licenses, are entitled to practise the invention within the terms and conditions of the instrument, to the extent of the authority conferred without question or impediment by the owner of the patent. Doubt upon that subject cannot be entertained ; but if they refuse to perform on their part, and repudiate the license, they may be treated by the owner of the patent, at his election, as infringers. He may have his remedy by suit upon the license, in case they have repudiated the license, or he may elect to treat them in future as infringers of his exclusive rights under the patent. Being infringers, they cannot set up the license in defence of a suit, any more than if they had never possessed any such authority." 15 O. G. 829 (830).

See also *Moody v. Taber* (1874), Holmes, 325 ; 5 O. G. 273 ; 1 Bann. & A. 41 ; *Brooks v. Stolley* (1845), 3 McLean, 523 ; 2 Robb, 281.

That a purchaser from a repudiating licensee, with notice, will be an infringer, see *Moody v. Taber* (1874), 1 Bann. & A. 41 ; 5 O. G. 273 ; Holmes, 325.

⁶ That where a license is conditional a breach of the condition will avoid the license at the option of the licensor, see

in duration by the life of the patent, is irrevocable.⁷ The surrender of a license by one of several joint-licensees does not affect the privileges of the others.⁸

§ 820. Licensee under Express License: When Estopped to Deny Validity of the Patent.

A licensee, having accepted a license, and while exercising under its protection the rights therein conferred, is estopped from denying the validity of the patent in any suit in which such exercise of his license privileges is the basis of the controversy.¹ In the absence of express provisions in the license

Woodworth v. Cook (1850), 2 Blatch. 151.

That where a license is avoided for breach of condition both parties are remitted to their original rights, and the licensee may defend against the patent, as if there were no license, see *Woodworth v. Cook* (1850), 2 Blatch. 151.

⁷ That a license, unlimited as to time and not conditioned otherwise than on the grant of the patent, is irrevocable, see *Kelly v. Porter* (1883), 8 Sawyer, 482; 17 Fed. Rep. 519.

⁸ That the surrender of a license by a part of the licensees does not avoid it as to the others, see *Theberath v. Celluloid Mfg. Co.* (1880), 3 Fed. Rep. 143; 5 Bann. & A. 577.

§ 820. ¹ That an assignor taking a license under his assignee is estopped to deny the validity of the patent, see *Consolidated Middlings Purifier Co. v. Guilder* (1881), 3 McCrary, 186; 9 Fed. Rep. 155.

That a licensee who has enjoyed without disturbance the benefit of a patent cannot dispute its validity in a suit for compensation, see *Deane v. Hodge* (1886), 35 Minn. 146.

That an exclusive licensee, not evicted, and benefiting by the license, cannot impeach the patent on a suit for royalties, see *Rogers v. Reissner* (1887), 41 O. G. 351; 30 Fed. Rep. 525; *McKay v. Jackman* (1883), 17

Fed. Rep. 641; *White v. Lee* (1882), 14 Fed. Rep. 789; 23 O. G. 1621.

That a defendant in a suit brought to recover license fees, payable according to the quantity made, cannot deny the validity of the patent unless fraud has been practised upon him, for having had the benefit he must pay for it, see *Wilder v. Adams* (1846), 2 W. & M. 329.

That a purchaser from the licensee is not estopped to deny the validity of the patent, in a suit for infringement, see *Baltimore Car Wheel Co. v. North Baltimore Passenger R. R. Co.* (1884), 21 Fed. Rep. 47.

That a licensee is not necessarily estopped by his license, nor prevented from making any defence that any other defendant could, see *Burr v. Duryee* (1862), 2 Fisher, 275.

That a licensee, while claiming under the license, is estopped to deny the validity of the patent, see *Brown v. Lapham* (1886), 23 Blatch. 475; 27 Fed. Rep. 77; 37 O. G. 676; *Baltimore Car Wheel Co. v. North Baltimore Passenger Ry. Co.* (1884), 21 Fed. Rep. 47.

That a licensee cannot deny the consideration of his license after long delay and the enjoyment of all its benefits, see *Davis v. Gray* (1867), 17 Ohio St. 330.

That a licensee sued for license fees may deny the originality of the inven-

to the contrary, however, he may repudiate the license, cease to claim its protection, and as to his future exercise of the privileges described therein defend himself upon the ground that the patent is invalid.² After such a repudiation of the license he may also dispute the validity of the patent in actions against him for license fees for the past making or use of the invention, but not for royalties on completed sales.³ When the license in its terms admits the validity of the patent, and provides that no act of either party shall impair the effect of this admission, the licensee cannot, at any time during the period for which the license was granted, attack the patent in his own defence.⁴ Neither an offer to take a

tion unless the license estops him, see *Morse Arms Mfg. Co. v. U. S.* (1880), 16 Ct. of Cl. 296.

That although a patent may not be good for all its claims, a licensee taking its benefits cannot set up its invalidity in a suit against him for royalties, see *Milligan v. Lalancé & Grosjean Mfg. Co.* (1884), 21 Fed. Rep. 570 ; 29 O. G. 367.

² That a licensee cannot repudiate his contract without notice to his licensor, see *Marsh v. Dodge* (1875), 4 Hun, 278.

That where a licensee has the right to terminate the license on a three months notice, and notifies the licensor of his present intention to terminate it after three months, this is sufficient notice, see *Wilde v. Smith* (1879), 8 Daly, 196.

That a licensee, having repudiated his license with the knowledge of the licensor, may dispute the validity of the patent, see *Brown v. Lapham* (1886), 23 Blatch. 475 ; 27 Fed. Rep. 77 ; 37 O. G. 676 ; *White v. Lee* (1880), 3 Fed. Rep. 222 ; 5 Bann. & A. 572.

That if the licensor repudiates the license, the licensee is not estopped thereby, see *Baltimore Car Wheel Co. v. North Baltimore Passenger Ry. Co.* (1884), 21 Fed. Rep. 47.

³ For the cases in which a licensee

can or cannot dispute the validity of the patent in actions for license-fees and royalties due before his repudiation, see §§ 1251, 1252, and notes, *post*.

⁴ That a licensee is estopped to deny the validity of the patent, while the license is in force, if the license so provides, see *Pope Mfg. Co. v. Owsley* (1886), 27 Fed. Rep. 100 ; 37 O. G. 781 ; *Magic Ruffle Co. v. Elm City Co.* (1875), 13 Blatch. 151 ; 8 O. G. 773 ; 2 Bann. & A. 152.

That if a licensee binds himself not to deny the validity of the patent, his only defence is that he keeps within his license, see *Pope Mfg. Co. v. Owsley* (1886), 27 Fed. Rep. 100 ; 37 O. G. 781.

That a license is not affected by judgments in favor of third parties against the validity of the patent, if the licensee agreed not to dispute it, see *Pope Mfg. Co. v. Owsley* (1886), 27 Fed. Rep. 100 ; 37 O. G. 781.

That where a license admits that the patent was lawfully granted, and provides that the revocation shall not impair the effect of this admission, the licensee is estopped to deny the validity of the patent, see *Evory v. Candee* (1879), 17 Blatch. 200 ; 4 Bann. & A. 545.

That a licensee under a license ad-

license, nor an expired license under which the defendant no longer claims, works such an estoppel.⁵ A licensee stamping articles answering to the description given in the patent with the name and date of the patent thereby admits that they were made under the protection of his license, and as to these is estopped from disputing the validity of the patent or his own obligations to the licensor.⁶

§ 821. Express License: Consideration Therefor: Royalties.

The consideration for the license, moving from the licensee to the licensor, may be money or any other object or obligation, as the parties may agree. Where the consideration is in money, it may be payable in a gross sum either in advance or at any other specified time, or it may be payable in periodical instalments, or in amounts determined by the extent to

mitting the validity of the patent, and binding him to defend it, is estopped to deny the patent and must pay royalties while he uses the invention, see *Washburn & Moen Mfg. Co. v. Cincinnati Barbed Wire Fence Co.* (1884), 22 Fed. Rep. 712.

That an agreement not to set up the invalidity of the patent as a defence, except under special circumstances, will be enforced, see *Ball v. Murry* (1848), 10 Pa. St. 111.

That a covenant by the licensee as to the mode of using the invention does not estop him to deny the validity of the patent when sued thereon, see *Bliss v. Negus* (1811), 8 Mass. 46.

That an agreement not to deny the validity of the patent will prevail, whatever the invalidity may consist in, see *Heilner v. Battin* (1856), 27 Pa. St. 517.

That taking a license for a definite period does not operate as an admission of validity after that period, nor work an estoppel, see *Rich v. Atwater* (1844), 16 Conn. 409.

That a licensee is not estopped in equity from denying the validity of the

patent on an infringement suit, unless the license expressly estops him, see *National Mfg. Co. v. Meyers* (1881), 7 Fed. Rep. 355.

⁵ That an offer to take a license does not estop the offerer from denying the validity of the patent, see *Evans v. Eaton* (1816), Peters, C. C. 322; 1 Robb, 68.

That an expired license is no bar to the denial of the validity of the patent, see *Blatherwick v. Carey* (1881), 10 Bissell, 494; 9 Fed. Rep. 202.

That one who was formerly a licensee and also claimed to own the patent is now estopped to deny its validity, see *Burr v. Kimbark* (1886), 28 Fed. Rep. 574; 37 O. G. 1480.

⁶ That when licensees stamp articles with the name and date of the patent they admit that the articles were made under the patent, see *Jones v. Vankirk* (1865), 2 Fisher, 586.

For a review of the cases concerning estoppel of licensee, see *Morse Arms Mfg. Co. v. U. S.* (1880), 16 Ct. of Cl. 296; and §§ 1250-1252, and notes, *post*.

which the licensee has practised the invention.¹ When the license is paid for by a gross sum in advance, it is not revocable by the licensor unless expressly so provided; but if by periodical license-fees or royalties, the question of its revocability is not affected by their payment.² A licensee remains liable for his license-fees or royalties until evicted by the licensor, although it is the duty of the licensor, unless otherwise agreed, to demand them and not wait for the licensee to pay them.³ A failure to make the stipulated payments

§ 821. ¹ That a licensee acting within his license is liable only for the royalty agreed on, see *Kelly v. Porter* (1883), 17 Fed. Rep. 519; 8 Sawyer, 482.

That a licensee is liable for royalties while he takes the benefit of any of the patents covered by his license, see *Pope Mfg. Co. v. Owsley* (1886), 27 Fed. Rep. 100; 37 O. G. 781.

That on a license to practise the invention, as distinguished from selling, the royalty is not collectible if the patent is worthless, see *Jenkins v. Abbotts* (1874), 54 N. H. 447.

That a licensee is liable for royalties on a patent apparently valid, until the patent is rescinded, or revoked, or notice is given to the licensor that no more royalties will be paid, see *Marston v. Swett* (1880), 82 N. Y. 526.

That after a patent has been annulled and priority awarded to another, no more royalties can be recovered, see *Marston v. Swett* (1880), 82 N. Y. 526.

That an agreement to pay a certain royalty on every article made on the patented machine, is not an agreement to run the machine to its utmost capacity, see *Newell v. Wheeler* (1867), 36 N. Y. 244.

That an agreement in a license to pay a certain royalty for each of a certain number of devices is not an agreement to make and pay for the whole number, see *Babcock v. Northern Pac.*

R. Co. (1886), 26 Fed. Rep. 756; 36 O. G. 942.

That an agreement to pay royalties to a certain amount within a specified time, and the other accruing royalties within a year, obliges the licensee to pay the amount absolutely, and whatever other royalties may accrue within the year, see *Babcock v. Northern Pac. R. Co.* (1886), 26 Fed. Rep. 756; 36 O. G. 942.

That where royalties are made payable quarterly on the first days of January, April, July, and October, and the license is dated and executed January 7th, the first royalty becomes payable April 1st, see *Dare v. Boylston* (1880), 6 Fed. Rep. 493; 18 Blatch. 548; 19 O. G. 725.

That a right to royalties is property, and is insurable like other property, and its owner has an insurable interest in the factory where the articles are made, see *National Filtering Oil Co. v. Citizens Insurance Co.* (1885), 34 Hun, 556.

² That a license fully paid for in advance, and not upon condition, is irrevocable, see *Wood v. Wells, Crittenden & Co.* (1873), 6 Fisher, 382.

³ That royalties must be paid unless there has been an eviction, see *McKay v. Jackman* (1883), 17 Fed. Rep. 641; *White v. Lee* (1882), 14 Fed. Rep. 789; 23 O. G. 1621.

That it is the duty of a licensor to demand the license fee if he has no other agreement, and not wait for the

renders the licensee liable to an action at law to recover them, and to a proceeding in equity for the rescission of the license, but does not authorize the licensor to treat the license as already forfeited, and prosecute the licensee for an infringement.⁴

§ 822. Express License: How Forfeited.

It was formerly held that any breach of condition by the licensee, even the non-payment of royalties or license-fees, forfeited his license and made him an infringer of the patent.¹ This doctrine is in harmony with the nature of a license, which is not merely the conveyance to the licensee of an interest in the invention, but also an agreement not to exercise against him the prohibitory powers created by the patent, provided he fulfils the obligations which he has assumed. His failure to fulfil these obligations ought, therefore, to remove the restraint imposed upon the licensor by the agreement and enable him at once to enforce his monopoly against the offending licensee. Two practical difficulties, however, attend the application of this doctrine: one, that it permits the licensor to inflict the extreme penalty, of his own motion, for every trifling violation of his contract by the licensee; the other, that in suits for infringement, when a license is set up as a defence and its forfeiture alleged, a multiplicity of issues may arise, not involving the actual merits of the cause and preventing ultimate justice to the parties. To avoid the first of these difficulties, the doctrine has been modified by the courts so far as to require an ex-

licensee to pay it, see *Dare v. Boylston* (1880), 6 Fed. Rep. 493; 18 Blatch. 548; 19 O. G. 725.

⁴ See § 822 and notes, *post*.

That an agreement by parol with a licensee that if he becomes satisfied that the patent is void he need pay no royalties is no defence to a suit for license fees, under a written license, see *Evory v. Candee* (1879), 17 Blatch. 200; 4 Bann. & A. 545.

That where the defendant claims under a license and sustains his claim,

a decree may be made against him for overdue license fees, see *McKay v. Jackman* (1882), 20 Blatch. 466; 22 O. G. 85; 12 Fed. Rep. 615.

§ 822. ¹ That a license paid for by notes, and forfeitable for non-payment, is forfeited by the failure to pay the first note, see *Woodworth v. Weed* (1846), 1 Blatch. 165.

That a conditional license is avoidable at the option of the licensor for breach of condition, see *Woodworth v. Cook* (1850), 2 Blatch. 151.

press stipulation to that effect in the license in order for a mere breach of condition to work a forfeiture.² To overcome the second, later decisions hold that licenses containing express stipulations for their forfeiture are not *ipso facto* forfeited upon condition broken, but remain operative and pleadable until rescinded by a court of equity.³ The remo-

² That a breach of the covenant in a license does not work a forfeiture *per se*, unless it is so expressly agreed, see Consolidated Middlings Purifier Co. v. Wolf (1886), 37 O. G. 567; 28 Fed. Rep. 814; White v. Lee (1880), 5 Bann. & A. 572; 3 Fed. Rep. 222.

That a license to make and sell, not limited on its face, cannot be terminated by the licensee, without the consent of the licensor, see Starling v. St. Paul Plow Works (1887), 29 Fed. Rep. 790.

That a license may be conditioned to become void if the patent is infringed, see Wood v. Wells, Crittenden, & Co. (1873), 6 Fisher, 382.

For the construction of a special contract as to revocation of license, see Weed v. Draper (1870), 104 Mass. 28; Weed v. Draper (1868), 99 Mass. 53.

That an agreement, in a license that the license may be declared forfeited if the licensee fails to pay the royalties is valid and enforceable, see Hammacher v. Wilson (1886), 26 Fed. Rep. 239; 36 O. G. 233.

³ In White v. Lee (1880), 3 Fed. Rep. 222, Lowell, J. : (224) "No court of equity will say that a plaintiff, even if he have an election to put an end to a contract in a certain way, shall assume it to be ended without following that method, and proceed accordingly. This contract still exists until one party or the other, or both, bring it to an end. It cannot be treated as ended, as a legal consequence of a failure to pay the royalties. To this effect are the authorities, even before the late and controlling case of Hartwell v. Tilghman, 99 U. S. 547. See Wilson v. Sanford, 10

How. 99; Hartshorn v. Day, 19 How. 211; Goodyear v. Union R. Co., 4 Blatchf. 63; Blanchard v. Sprague, 1 Cliff. 288; Merserole v. Union Paper Collar Co. 6 Blatchf. 356-7." 5 Bann. & A. 572 (574).

That a license "conditioned to be void," etc., may be annulled in equity, see Adams v. Meyrose (1881), 7 Fed. Rep. 208; 2 McCrary, 360.

That a contract to give an exclusive right to sell on payment of royalties is not revocable on failure to pay, without a proceeding in equity, see Burdell v. Denig (1865), 2 Fisher, 588.

That a license is not avoided by the failure of the licensee to comply with its terms, even though it contains an express condition to that effect, and the licensee cannot be treated in equity as an infringer, though the license so declares, until the license has been judicially annulled, see Adams v. Meyrose (1881), 2 McCrary, 360; 7 Fed. Rep. 208; Hartell v. Tilghman (1878), 99 U. S. 547.

That written notice of his default must be served on the licensee in order to terminate his license, when the license so provides, see White v. Lee (1880), 3 Fed. Rep. 222; 5 Bann. & A. 572.

That a notice that the license "will be revoked" is not a notice of revocation, see Pope Mfg. Co. v. Owsley (1886), 27 Fed. Rep. 100; 37 O. G. 781.

That the contract is not dissolved *ipso facto* when the licensor forbids the licensee to further use the invention, see Union Mfg. Co. v. Lounsbury (1864), 42 Barb. 125.

dies now open to the licensor against a licensee who still claims under the license, but fails to perform his obligations, are a suit upon the contract for the damages sustained, or a bill in equity for the rescission of the license, followed by a suit for the infringement of the patent.⁴ In determining the questions presented by a bill in equity for the rescission of a license, the court is guided by the ordinary principles which govern its decisions in other cases. Thus where the breach complained of is the non-payment of money at the time fixed in the license, the license will not be rescinded if payment has been subsequently tendered or complete justice can be done by a judgment for the amount already due.⁵

⁴ That where the licensee exceeds his rights he breaks his contract and infringes the patent both, see *Pope Mfg. Co. v. Owsley* (1886), 27 Fed. Rep. 100; 37 O. G. 781; *Magic Ruffle Co. v. Elm City Co.* (1875), 8 O. G. 773; 13 Blatch. 151; 2 Bann. & A. 152.

That when a license has been terminated by due notice the licensee becomes an infringer as to all subsequent acts, see *Hammacher v. Wilson* (1886), 26 Fed. Rep. 239; 36 O. G. 233.

⁵ In *White v. Lee* (1880), 5 Bann. & A. 572, Lowell, J. : (573) "The theory of the bill is that any failure by the licensee to pay the royalties, or to render an account, avoids the license immediately at the election of the licensor. A license is often compared to a lease of land, and many decisions follow this analogy. Now, so far is equity from decreeing the forfeiture of a lease for a breach of covenant, that it often interferes to prevent a forfeiture which would exist at law. I know of no case in which a mere failure to pay money, or keep some engagement of that nature, has been held a good cause for asking a court of equity either to declare a forfeiture, or to proceed as if one had been incurred. In some few patent cases, beginning with *Brooks v. Stolley*,

8 McLean, 523, it has been held that a patentee enjoyed the unusual privilege of treating a breach of covenant as if it, of itself, worked a forfeiture. No doubt the parties may agree that such an effect shall follow; and this will account for some of the decisions. The others of this sort are overruled by *Hartell v. Tilghman*, 99 U. S. 547." 3 Fed. Rep. 222 (223).

That failure to pay royalties at the date agreed upon is not *ipso facto* a forfeiture of the license, even though the license so provides, see *Dare v. Boylston* (1880), 6 Fed. Rep. 493; 18 Blatch. 548; 19 O. G. 725.

That a licensor who fails in his duties will not be aided by equity against his licensee, see *Foster v. Goldschmidt* (1884), 22 Blatch. 287; 21 Fed. Rep. 70; 28 O. G. 915.

That a provision for avoiding a license for non-payment of royalties is only a means of securing payment and is cured by tender after pay-day, see *Dare v. Boylston* (1880), 18 Blatch. 548; 6 Fed. Rep. 493; 19 O. G. 725.

That where an exclusive licensee fails to pay as he agrees and the patentee thereupon grants an exclusive license to another, who has notice of the prior license, the first licensee may at any time tender what is due and assert his

Nor will infringement by the licensee, by means of wrongful acts outside the limits of his license, be ground for a rescission, unless his conduct is so hostile to the patent as to amount to a denial of its claims.⁶ But a non-payment of royalties or license-fees, coupled with an abandonment of the privileges of the license and working other injuries to the licensor than the mere detention of money due, or arising from circumstances which indicate that future royalties and license-fees will likewise be unpaid, and any other breach of condition which under the agreement of the parties, interpreted according to the rules of equity, should operate as a forfeiture of the privileges conferred upon the licensee, are grounds upon which equity will annul the license, and restore the parties to their original rights, — the licensor to his right to maintain an action for infringement, and the licensee to his right to defend against it by denying the validity of the patent or the title of the licensor.⁷ The foregoing modifications have no application to cases where the licensee has openly repudiated his license, either by words or conduct. Such repudiation is more than a mere ground of forfeiture.⁸

rights as against the second licensee, see *Dare v. Boylston* (1880), 19 O. G. 725; 18 Blatch. 548; 6 Fed. Rep. 493.

That where the patentee revokes one license and then licenses another party who has notice of the first license, the second licensee is chargeable with notice that the first licensee still claims that his license is good, see *Dare v. Boylston* (1880), 18 Blatch. 548; 19 O. G. 725; 6 Fed. Rep. 493.

That if a royalty is based on the number of articles sold, and the licensee ceases to make and sell, he abandons his license, and the licensor may then license other parties, see *Pitts v. Jameson* (1853), 15 Barb. 310.

⁶ That the infringement of a patent by a licensee does not forfeit his license, unless his conduct is so hostile toward the patent as to amount to a repudiation of his rights as a licensee under

it, see *Wood v. Wells, Crittenden & Co.* (1873), 6 Fisher, 382.

That the use of the same machine as the invention of another than the licensor revokes the license to that extent, see *Steam Cutter Co. v. Sheldon* (1872), 10 Blatch. 1; 5 Fisher, 477.

⁷ That a license is forfeited by non-payment of royalties and disclaimer of licensor's rights, see *Bell v. McCullough* (1858), 1 Fisher, 380; 1 Bond, 194.

⁸ In *White v. Lee* (1880), 3 Fed. Rep. 222, Lowell, J.: (224) "It is true, as the plaintiffs contend, that if a licensee has renounced the license he may, on the one hand, defend against the agreement and set up the invalidity of the patent; and, on the other, may be treated as an infringer. *Moody v. Taber*, 1 Holmes, 325; *Cohn v. National Rubber Co.*, 15 O. G. 829." 5 Bann. & A. 572 (574).

It severs the relations between the licensee and licensor, and from that time forward authorizes the latter to treat all acts of the former, within the scope of the patent, as infringements, and estops the former from pleading his license in any suit for such acts of infringement that may be brought against him by the licensor.

§ 823. **Express License: When Transferable.**

Whether or not a license is transferable depends on the intention of the parties. There is nothing in the nature of a license, considered as the conveyance of an interest in the invention or as a release from the monopoly, which precludes its alienation as long as this does not extend the privileges thereby conferred. Clearly a licensee, unless receiving express authority to that effect, would have no right to multiply his privileges by sub-licenses, and thus increase the number of the individuals who could lawfully practise the invention. His authority to divide his rights, and to apportion them to others, must be measured by the circumstances of each case, and be so limited that the sum of all the rights distributed shall be no greater than his own. In view of the abuses likely to arise from the practical exercise of such powers of alienation, and the difficulties attending any attempt to vindicate the rights of the licensor, the courts have held that a license is not assignable unless it affirmatively appears that such was the intention of the parties.¹ Even where the license

§ 823. ¹ In *Dorsey Revolving Harvester Rake Co. v. Bradley Mfg. Co.* (1874), 12 Blatch. 202, Woodruff, J. : (208) "Whether a license is or is not assignable is to be determined, not merely by the term 'license,' but by an inquiry into the fair meaning and intention of the parties; and it may be affected not only by the words of license, but by the nature of the transaction, the consideration paid, and other circumstances showing that an assignable right was conferred." 1 Bann. & A. 330 (336).

That licenses are generally personal, not assignable, see *Adams v. Howard*

(1884), 23 Blatch. 27; 22 Fed. Rep. 656.

That a license to use is personal and not assignable, see *Eclipse Windmill Co. v. Woodmanse Windmill Co.* (1885), 24 Fed. Rep. 650; 32 O. G. 1605.

That a license to make and use is personal and does not pass to the receiver of the licensed firm, see *Curran v. Craig* (1884), 22 Fed. Rep. 101.

That a "shop right" license is personal, not assignable, and is available only in the manner stipulated, see *Gibbs v. Hoefner* (1884), 22 Blatch. 36; 19 Fed. Rep. 323.

That a personal license is not assign-

is granted to the licensee "and his assigns," the force of the latter phrase is qualified or neutralized if the rights conferred upon the licensee himself are evidently not transferable.² A license to use "in the licensee's own business," or "at his shop," is personal only and cannot be assigned.³ But a license to use to a certain quantity on payment of a gross sum is *prima facie* alienable, since it can make no difference to the licensor by whom the quantity is used.⁴ A license to a partnership is not affected by a change of members in the firm, unless the license otherwise provides, and when such license is limited in number or amount it will enure to the benefit of each member of the firm, after the dissolution, if the limits named are not exceeded.⁵ Assignees of a license

able, see *Racine Seeder Co. v. Joliet Wire Check Rower Co.* (1886), 27 Fed. Rep. 367; 37 O. G. 452.

That a license to use for a special purpose is not transferable unless so expressed, not even passing to the licensee's administrator, see *Oliver v. Rumford Chemical Works* (1883), 109 U. S. 75; 25 O. G. 784.

That a license cannot be apportioned out to others by the licensee, see *Consolidated Fruit Jar Co. v. Whitney* (1874), 1 Bann. & A. 356.

That the exclusive right to supply the licensor with articles to be made on the patented machine, under a "personal" license, does not authorize the licensee to arrange with others for their manufacture and supply, and if the licensee cannot manufacture personally the license ceases, see *Houghton v. Rowley* (1874), 9 Phila. 288.

That where an exclusive right is granted to a licensee it vests at his death in his personal representatives so far as to enable them to finish up and dispose of the devices on hand, and then ceases, see *Pitts v. Jameson* (1853), 15 Barb. 310.

That a license to use an invention may be subjected in equity to the claim of a judgment in favor of the licensor,

see *Matthews v. Green* (1884), 19 Fed. Rep. 649.

² That the word "assigns" in the license is not conclusive, if the subject-matter is not transferable, see *Brooks v. Byam* (1843), 2 Story, 525; 2 Robb, 161.

³ That a license to use in "his own proper business" to a certain amount yearly is not transferable, see *Putnam v. Hollender* (1881), 6 Fed. Rep. 882; 19 Blatch. 48; 19 O. G. 1423.

That a license to use the patented invention at the licensee's shop, and to associate others with him in such use, is not assignable, see *Gibbs v. Hoefner* (1884), 19 Fed. Rep. 323; 22 Blatch. 36; *Searls v. Bouton* (1882), 21 O. G. 1784; 20 Blatch. 426; 12 Fed. Rep. 140; *Rubber Co. v. Goodyear* (1869), 9 Wall. 788.

⁴ That a license to use the invention to a certain extent on payment of a gross sum is *prima facie* assignable, see *Belding v. Turner* (1871), 8 Blatch. 321; 4 Fisher, 446.

⁵ That a license to a partnership is good, if paid for in advance, though one member of the firm retires and new members are admitted, unless the contrary is expressed, see *Belding v. Turner* (1871), 8 Blatch. 321; 4 Fisher, 446.

That where a firm is licensee a change

take it subject to all the obligations and conditions imposed upon the original licensee, and run their own risk of his right to transfer it.⁶ An unauthorized transfer may be ratified by the acceptance of the royalties or license-fees from the assignee after notice of the assignment.⁷

§ 824. Implied Licenses: License to Use Implied in Favor of Purchaser at any Lawful Sale of a Patented Article.

There are certain cases in which the law implies a license from the dealings of the parties with each other, or from the

in partners does not affect its duties or rights as such licensee, but the retiring partner is merely a surety for the royalties, and if he has to pay them he is entitled to be repaid by the firm, see *Sizer v. Ray* (1881), 87 N. Y. 220.

That a license granted to a firm and limited only as to the quantity to be made confers a right upon the remaining member of the firm after its dissolution, see *Belding v. Turner* (1871), 4 Fisher, 446 ; 8 Blatch. 321.

That a license to A., B. & C., "constituting the firm of A., B. & Co., and their executors, administrators, and assigns," is a license to A., B. & C., not to the firm, and the receiver of the firm has no right in it, but each party can assign his interest in it separately, see *Adams v. Howard* (1884), 23 Blatch. 27 ; 22 Fed. Rep. 656.

That a license to a partnership cannot be transferred to a corporation composed of the same persons, see *Locke v. Lane* (1888), 35 Fed. Rep. 289.

That the receiver of a bankrupt corporation, carrying on its business of making patented articles under a license by order of the court, cannot be interfered with by a new licensee without contempt of court, see *In re Woven Tape Skirt Co.* (1877), 12 Hun, 111.

⁶ That the purchaser of a licensee's right must take his own risks as to the vendor's right to sell, see *Chambers v. Smith* (1870), 5 Fisher, 12.

That licenses bind, as to terms, etc., all the assignees of the licensee, whether recorded or not, see *Hamilton v. Kingsbury* (1879), 17 O. G. 147 ; 17 Blatch. 264 ; 4 Baun. & A. 615.

That an assignment of a license on an annual royalty resembles the assignment of a lease, and follows the same rules, see *Wilde v. Smith* (1879), 8 Daly, 196.

That it is doubtful whether the same privity exists between the assignee of a license and the licensor as between the assignee of a lessee and the lessor, see *Wilde v. Smith* (1879), 8 Daly, 196.

That in a suit by a retiring partner, as surety for royalties which he has paid, the attitude of the firm toward the patentee is of no consequence, and judgment against the surety is conclusive against the firm, nor is it material whether the firm made a profit or not by their sales, see *Sizer v. Ray* (1881), 87 N. Y. 220.

⁷ That an assignment contrary to the terms of a license is validated by the acceptance of the royalty from the assignee, unless the licensor shows the contrary, see *Wilde v. Smith* (1879), 8 Daly, 196 ; *Bloomer v. Gilpin* (1859), 4 Fisher, 50.

That a notice by the licensor to the assignee that the royalty is due, and demanding payment, shows that the licensor knows of the assignment, see *Wilde v. Smith* (1879), 8 Daly, 196.

relations which subsist between them. The most frequent and important of these cases arises when a patented article is sold by any one who has a right to sell it. From such a sale the law implies a license to the purchaser, and to every subsequent owner of the article, to use it as long as its identity can be preserved.¹ This implied license rests upon the principle that the owner of the patented invention, having once received his recompense for releasing the article from the monopoly, either in its price directly paid to him or in the license-fee which he collects from its vendor, he can thereafter neither limit nor demand compensation for its use,² but

§ 824. ¹ That an absolute lawful sale of a patented device carries both the right to use it and the ownership of the device itself, see *Porter Needle Co. v. National Needle Co.* (1883), 17 Fed. Rep. 536.

That a patentee may sever the ownership of a patented article from the right to use it, if he chooses, see *Porter Needle Co. v. National Needle Co.* (1883), 17 Fed. Rep. 536.

That a machine may be sold without the right to use it, and the purchaser does not then acquire by the sale a right to use, see *Rodgers v. Torrant* (1880), 43 Mich. 113; *Wortendyke v. White* (1875), 2 Bann. & A. 25; *Wilson v. Stolley* (1847), 4 McLean, 273.

That where an inventor submits his invention to the United States for adoption and use, no presumption of a gratuitous license arises, but a license is implied at a reasonable royalty, see *McKeever v. United States* (1878), 14 Ct. of Cl. 396; 23 O. G. 1525.

That the sending of persons to buy of a suspected infringer after injunction is no consent, and raises no implied license, see *Knowles v. Peck* (1875), 42 Conn. 386.

That the capture of an article by an American vessel gives no right to use it as against the patentee, see *Opinions Atty. Gen.* (1820), 5 Op. At. Gen. 725.

That the use by the defendant, without interference, for years, is no evidence to show a right in his vendors, see *Baldwin v. Sibley* (1858), 1 Clifford, 150.

² In *Adams v. Burke* (1873), 17 Wall. 453, Miller, J. : (456) "But, in the essential nature of things, when the patentee, or the person having his rights, sells a machine or instrument whose sole value is in its use, he receives the consideration for its use, and he parts with the right to restrict that use. The article, in the language of the court, passes without the limit of the monopoly. That is to say, the patentee or his assignee, having in the act of sale received all the royalty or consideration which he claims for the use of his invention in that particular machine or instrument, it is open to the use of the purchaser, without further restriction on account of the monopoly of the patentees. If this principle be sound as to a machine or instrument whose use may be continued for a number of years, and may extend beyond the existence of the patent as limited at the time of the sale, and into the period of a renewal or extension, it must be much more applicable to an instrument or product of patented manufacture which perishes in the first use of it, or which, by that first use, becomes in-

by the sale delivers it from all the restrictions of the patent and makes it common property like any other personal estate.³ To have that effect, however, the sale must be a lawful and an unconditional sale. The sale is lawful when the vendor is the patentee himself, or some one to whom he has conveyed the right to sell without conditions, or some one upon whom such right to sell has been conferred by law.⁴

capable of further use, and of no further value." 5 O. G. 118 (119).

In *Goodyear v. Beverly Rubber Co.* (1859), 1 Clifford, 348, Clifford, J. : (354) "Patentees may grant an interest in the patent, or they may license another to manufacture the product produced by their process, and authorize him to sell the same in the market. Whether the inventor in any given case has a patent for the article manufactured, or only for the product or the material of which it is composed, the unconditional sale of the manufactured article carries with it the absolute dominion over the material as well as over the manufactured article. Having manufactured the material and sold it for a satisfactory compensation, whether as material or in the form of a manufactured article, the patentee, so far as that quantity of the product of his invention is concerned, has enjoyed all the rights secured to him by his letters-patent; and the manufactured article, and the material of which it is composed, go to the purchaser for a valuable consideration, discharged of all the rights of the patentee previously attached to it, or impressed upon it, by the act of Congress under which the patent was granted."

³ In *Howe v. Wooldredge* (1366), 12 Allen, 18, Gray, J. : (22) "When a single machine, made under a patent, has been sold, either by the patentee or by his assignee or licensee, acting within the authority conferred by an assignment or license, the machine thus sold is no longer subject to the franchise or

monopoly, but may be freely used or resold by the purchaser during the term of the patent, without making himself or any subsequent purchaser liable to the patentee, or his assignee or licensee, for any use which may be made of the machine."

In *Goodyear v. Beverly Rubber Co.* (1859), 1 Clifford, 348, Clifford, J. : (356) "By virtue of the contract of sale and the unconditional delivery of the manufactured article, it passes outside of the monopoly, and is no longer under the peculiar protection granted to patented rights. Whenever a valid sale of the patented article is thus made, it then becomes the private property of the purchaser, and is no longer protected by the laws of the United States, but by the laws of the State in which it is situated."

That the patented article, thus lawfully sold, is no longer under the monopoly, see also *Holliday v. Matheson* (1885), 24 Fed. Rep. 185; 31 O. G. 1444; 23 Blatch. 239; *Detweiler v. Voegel* (1881), 8 Fed. Rep. 600; 19 Blatch. 482; *American Cotton Tie Co. v. Simons* (1878), 3 Bann. & A. 320; 18 O. G. 967; *Mitchell v. Hawley* (1872), 16 Wall. 544; 6 Fisher, 331; 3 O. G. 241; *Adams v. Burke* (1871), 1 O. G. 282; Holmes, 40; 4 Fisher, 392.

⁴ That a purchaser from the patentee himself has an implied license to use, see *Detweiler v. Voegel* (1881), 8 Fed. Rep. 600; 19 Blatch. 482; *Black v. Hubbard* (1877), 12 O. G. 842; 3 Bann. & A. 39.

That where an American patentee

Thus an assignee whether sole or joint, a grantee selling within his own territory,⁶ and a licensee whose right to

sells the patented article abroad without restrictions, the purchaser can use and sell it in the United States, see *Holliday v. Matheson* (1885), 24 Fed. Rep. 185; 81 O. G. 1444; 23 Blatch. 239.

That if a factory and machinery are sold with the acquiescence of the patentee of the machines, and without notice to the buyer, he may use them, see *Detweiler v. Voego* (1881), 8 Fed. Rep. 600; 19 Blatch. 482.

⁶ In *McKay v. Wooster* (1873), 3 O. G. 441, Sawyer, J.: (443) "At the date of the assignment to Billings the patentees were still the holders of the entire interest under the patent. Had they at that time, at Chicago, sold one of the patented articles in question without restriction or condition, that undoubtedly would have been a lawful sale without restriction or condition; and the article so sold would have been taken out of the monopoly, and the purchaser, or any one deriving title through him, would have been entitled to use it till worn out in any part of the United States. The patentee himself could not, by a subsequent assignment of his patent, have limited the right of the purchaser already vested. The vendor being at that time entitled to the whole monopoly for the entire jurisdiction of the United States, it was competent for him to wholly emancipate the article sold by taking the entire royalty for the use in any part of the territory. And a sale without restriction or limitation would work such emancipation. In such case any party subsequently purchasing the right to any specific portion of territory would take that right subject to the use of the machine so sold at any point within the territory purchased. What the patentees could do with respect to one machine, they

could do as to any number of machines in existence or to be brought into existence. What they could do themselves they could by contract authorize or convey the right to any other party to do. As the patentees themselves could *lawfully sell* these patented articles at Chicago *without restriction or condition*, so as to authorize the purchasers, or those claiming under them, to use the machines anywhere in the United States, they could convey the right to Billings to lawfully do the same. This authority to emancipate from the monopoly by an unrestricted sale was a part of their 'right, title, and interest in the invention secured by the patent,' that could be exercised and enjoyed at Chicago or other place east of the Rocky Mountains as well as elsewhere. The assignment to Billings is in the broadest terms. It is of 'all the right, title, and interest which the said John L. and George W. Stevens had in and to the said letters-patent, and the invention as secured to them by said letters-patent, and all their rights, liberties, privileges, and franchises which they had or might acquire by or under said letters-patent,' 'for, to, and in all the States and Territories of the United States east of the Rocky Mountains.' There is no limitation of the power to vend within the territory. The patentees could lawfully make without restriction or condition, could use without restriction or condition, or could *vend without restriction or condition*, anywhere within the specified territory; and all their rights they conveyed to Billings *without restriction or condition*, who thereupon stepped into the shoes of the patentees as to the territory sold. Had they intended to limit the right of vending 'to vending to be used' by the purchasers within the territory sold only, they should at least

sell is unrestricted by limitations as to the use of the thing

have so specified the intention, and by some apt words restricted the right of use in the deed of assignment. This unrestricted assignment of the right to vend put it in the power of Billings to lawfully vend the patented article within his territory without restriction or condition, and thereby wholly emancipate from the monopoly the article so sold. The complainant subsequently purchased his territory, and, whatever the terms of his grant, he could of course obtain only what was left of the franchise or monopoly. As the patentees, after their sale to Billings, could not object to sales by him without restrictions or conditions, their subsequent assignee cannot object. The latter's right is subject to the right of Billings and those who have lawfully purchased without restriction or condition from him." 6 Fisher, 375 (380); 2 Sawyer, 273 (379).

So far as the foregoing opinion proceeds on the assumption that the grant of all a patentee's "right, title, and interest" in the invention, within a given territory, transfers the right to license others to use, without the territory, the invention sold by the grantee within the territory, it is manifestly unsound. The error arises from confounding the *personal* right of the patentee with his *territorial* right. The patentee's territorial right consists in the right to make within the territory, to use within the territory, to sell within the territory, and to grant or license others to make, use, or sell within the territory. His personal right consists in the right he has as the owner of the whole monopoly, wherever he may be, to grant or license others to make, use, or sell, in any territory whatsoever, except that already covered by grants or exclusive licenses to other parties. The power of a patentee in Chicago to grant a license

to use in California is not a part of his territorial right in Chicago, but of his territorial right in California, and resides in him in Chicago only as a part of his personal right. This personal right is limited as to the area over which it may be exercised by his successive territorial transfers, but it never passes from him to any other person unless by an entire or partial assignment of all the interest remaining in him. Were this not so the first grantee of any territory, however small, would obtain the personal right of the patentee, and could license anywhere within the United States; and since his right in his own territory is exclusive of the patentee, the most important interest under the patent would vest in him, rendering the remaining interests of little security and value. Moreover, if the interest of the patentee "within the territory" includes his power to confer the right to use the invention everywhere, it must also embrace the power to confer the right to make and sell everywhere, and thus transfer the complete monopoly to the grantee, irrespective of any territorial boundaries, which is contrary to the fundamental idea of a grant of territory. Logically and consistently, only the patentee, and he only while he has as yet bestowed no exclusive rights on any person, can transfer the right to use the invention everywhere; and after such exclusive rights have been conferred, only he and his assignees can create rights co-extensive with the area uncovered by previous exclusive interests. Neither a grantee nor a licensee of specific territory possesses this authority, nor can they vest in any vendee of the articles made or sold under their grants or licenses any right to use outside the territory covered by their several conveyances. If the doctrine that a purchaser from a grantee has the

sold⁶ have, equally with the patentee, the power to transfer such a title to the purchaser as will draw after it a license to use the article as long as it exists, and to sell it to others with the same right to use. Thus, also, a sheriff, levying an execution on the assets of the patentee, or on the assets of another person with the patentee's consent, may sell the patented article if embraced among such assets, and the same license will attach thereto as if the sale had been made by the patentee.⁷ The sale must furthermore be un-

right to use the purchased article outside the vendor's territory has any legal basis, it is in the rule that public policy requires that such a right must be recognized as against all parties interested in the patent, in order to avoid the public inconvenience which the enforcement of their logical and otherwise inevitable rights would occasion. So broad a rule as this has never been sanctioned by any series of decisions, although in a few cases it has been advanced in justification of the judgment actually rendered. See the remainder of this note, and § 826, note 2, *post*.

Further, that a lawful sale by a grantee within his own territory frees the article sold from the monopoly throughout the United States, see *Hobbie v. Smith* (1886), 27 Fed. Rep. 656; *Adams v. Burke* (1873), 17 Wall. 453; 5 O. G. 118; *Hawley v. Mitchell* (1871), 4 Fisher, 388; 1 O. G. 306; *Holmes*, 42; *Adams v. Burke* (1871), *Holmes*, 40; 4 Fisher, 392; 1 O. G. 282.

⁶ In *Birdsell v. Shaliol* (1884), 112 U. S. 485, Gray, J.: (487) "A license from the patentee to make, use, and sell machines gives the licensee the right to do so, within the scope of the license, throughout the term of the patent; and has the same effect upon machines sold by the licensee, under authority of his license, that a sale by the patentee has upon machines sold by himself, of wholly releasing them from the monopoly, and discharging all claim

of the patentee for their use by anybody; because such is the effect of the patentee's voluntary act of licensing or selling, in consideration of the sum paid him for the license or sale." 30 O. G. 261 (262).

That a license to a maker, with a covenant not to sue his vendees, works an implied license to them, see *Colgate v. Western Electric Mfg. Co.* (1886), 28 Fed. Rep. 146; 37 O. G. 893.

That a purchaser of the patented articles from a licensee whom he knows to have forfeited his license may be sued in spite of such license, see *Moody v. Taber* (1874), *Holmes*, 325; 5 O. G. 273; 1 Bann. & A. 41.

⁷ In *Wilder v. Kent* (1883), 15 Fed. Rep. 217, Acheson, J.: (218) "We are therefore called upon to decide what rights a purchaser at sheriff's sale takes in a patented machine belonging to and sold as the property of the owner of the patent, — the defendant in the execution. The learned counsel agree that the question has never been judicially determined; and upon diligent search no case has been found involving the precise point now presented for decision. In *Sawin v. Guild*, 1 Gall. 485; 1 Robb, 47, the sheriff, upon an execution against the patentee, levied on and sold the 'materials' of several of the completed patented machines, and such sale was held to be no infringement of the patent right. 'He sold,' said Mr. Justice Story, 'the ma-

conditional. Not only may the patentee impose conditions, limiting the use of the patented article, upon his grantees

terials as such, to be applied by the purchaser as he should by law have a right to apply them. The purchaser must therefore act at his own peril, but in no respect can the officer be responsible for his conduct.' The specific ruling in *Chambers v. Smith*, 5 Fisher, 12, was that a purchaser at a marshal's sale of a patented machine was an infringer in operating it outside of the district to which its use was limited by the license granted to the defendant in the execution. The position taken by the plaintiff's counsel is that when the owner of a patent who does not manufacture for sale makes a machine for his own use only, and such patented machine is sold at a forced sale by the sheriff, the right to use it does not pass with it, but only the ownership of the materials of which the machine is constructed. To sustain this proposition reliance is placed upon the cases of *Stephens v. Cady*, 14 How. 528, and *Stevens v. Gladding*, 17 How. 477, in which it was held that the seizure and sale of the copperplate of a copyrighted map, under an execution against the owner of the copyright and plate, did not carry with it the right to print and publish the map. But the reason assigned for this is, that the copyright—the exclusive and intangible right to multiply copies of the original work—does not inhere in, and has no necessary connection with, the plate, which is the mere instrument for producing the copies. The copyright and the plate are wholly distinct and disconnected subjects of property, each capable of being owned and transferred independent of the other (*id.*), and therefore a judicial sale of the one does not carry any title to the other. But the lawful sale of a patented machine takes it out of the monopoly, either

altogether or *pro tanto*, according to the nature of the contract. The purchaser of a machine from the patentee acquires no right in the patent itself, and needs none to enable him to enjoy his acquisition. By implication he is invested with a license to use that particular machine, and, in the absence of express stipulation to the contrary, such license passes with the machine to successive owners as an incident of proprietorship. That such is the law in case of a voluntary sale of a patented machine by the patentee is incontrovertible. But wherefore should the rights of the sheriff's vendee, under an execution against the patentee, be less than those of a purchaser directly from the patentee? The rule is that the purchaser at a sheriff's sale succeeds to the beneficial rights of the defendant in the execution to the property sold. *Chambers v. Smith*, *supra*. But why should an exception be made where the subject-matter of sale is a patented machine? To deny to the sheriff's vendee the right to use such machine would in effect prevent its sale upon an execution at law as an operative apparatus, and practically withdraw it from the reach of the owner's execution creditors. The mischievous consequences to such creditors to which the doctrine contended for would lead (now that patented machinery has come into almost universal use) can hardly be estimated. The plaintiff's position is untenable. It is very true that the patent-right itself, being incorporeal and resting exclusively upon statutory grant, cannot be levied on at law, and is available to creditors only by proceedings in a court of equity. *Ager v. Murray*, 105 U. S. 126. But a patented machine is susceptible of manual seizure, and the unrestricted sale thereof does not involve

and express licensees, but any person having the right to sell may at the time of sale restrict the use of his vendee within specific boundaries of time or place or method, and these will then become the measure of the implied license arising from the sale.⁸ But when the sale is unconditional, as is the case in ordinary sales by authorized vendors in open market, the implied license gives to the purchaser and his vendees the unrestricted right to use the article unless such use infringes some other patent than the one by which the article itself has been protected.⁹

the transfer of any interest in the patent. The conclusion, therefore, is, that whatever right to use the patented machine a defendant in an execution may have passes with the machine when sold by the sheriff to his vendee." 23 O. G. 881 (832).

That where the owner of a patent consents to the sale of the patented invention under an execution, the purchaser has an implied license, see *Detweiler v. Voegel* (1881), 19 Blatch. 482; 8 Fed. Rep. 600.

That a foreclosure sale of a patented device, to which the patentee is a party, frees the device from the monopoly, see *Detweiler v. Voegel* (1881), 8 Fed. Rep. 600; 19 Blatch. 482.

⁸ In *Dorsey Revolving Harvester Rake Co. v. Bradley Mfg. Co.* (1874), 12 Blatch. 202, Woodruff, J.: (204) "I have no doubt of the right of a patentee to grant the right to make and sell the patented invention within specified territory, and to make that right exclusive in the grantee, and yet limit the use of the thing so made and sold within specified limits." 1 Bann. & A. 330 (332).

That a patentee may sell a patented article with restrictions as to its use, and these will bind the vendee, see *Holliday v. Matheson* (1885), 31 O. G. 1444; 24 Fed. Rep. 185; 23 Blatch. 239.

⁹ In *American Cotton Tie Co. v. Simmons* (1878), 3 Bann. & A. 320, Shepley, J.: (321) "The company clearly had the right, in selling a patented article, to put a restriction on its use or sale, and to convey only a restricted title, or to license only a restricted use, and the purchaser under such a restricted title could not convey a greater or better title than he had himself. The law upon this subject was fully stated in *Hawley v. Mitchell*, 1 Holmes, 42, and affirmed in the Supreme Court of the United States, 16 Wall. 544. But when the proprietor of a patented article sells it for the purpose of allowing it to be used in the ordinary pursuits of life, and to pass into the market of the country as an ordinary article of commerce, and subject to unrestricted purchase and sale, he waives his right to affix conditions or restrictions to its use or sale, and consents that, after one sale and the payment of one royalty, it shall pass out of the limits of the monopoly." 13 O. G. 967 (968).

That the unconditional sale of a patented article confers the whole title to it upon the vendee, and impliedly warrants full ownership in the vendor and a good title everywhere, though the sale were made abroad, see *Holliday v. Matheson* (1884), 30 O. G. 452.

§ 825. **Implied License: License to Use not Implied from Sale unless the Invention Sold and the Invention Used are Identical.**

The sale from which this universal license is implied must, moreover, be a sale of the precise article covered by the patent. A purchaser of the materials of which an article consists, or of the elements of which it is combined, obtains thereby no right to make and use the article, or to unite the elements and employ them in the combination, although the vendor is the owner of the patent in which the combination or the article is claimed. To this rule there is one exception. The sale of any object which can be used only in constructing a patented article, or in practising a patented art, is presumed to have been intended both by the buyer and seller, for that specific use; and when the seller is the owner of the patent for the article or art, his act of sale confers a license on the purchaser to employ the object for that purpose.¹ In order that the license may be implied in other cases the licensed article must be the subject-matter of the sale. Though the article has once been lawfully sold, if it is broken up and ceases to exist in its entirety, a purchaser of its severed parts obtains no right to reconstruct and use it.² But it is not im-

§ 825. ¹ In *Roosevelt v. Western Electric Co.* (1884), 20 Fed. Rep. 724, Wallace, J.: (724) "The purchase of a patented article from the patentee or owner of the patent confers upon the buyer the right to use the article to the same extent as though it were not the subject of a patent; but the sale does not import the permission of the vendor that it may be used in a way that will violate his exclusive property in another invention. Where the article is of such peculiar characteristics that it cannot be dealt in as a trade commodity, and cannot be used practically at all, unless as a part of another patented article of the vendors, it would be preposterous to suppose that the parties did not contemplate its use in that way. It would be against good conscience to allow an injunction to a vendor under

such circumstances. He would be estopped from asserting a right which the purchaser must have understood him to waive." 28 O. G. 812 (812).

That the purchaser of a machine covered by one patent does not, by using it, infringe a patent owned by the same party for a process which consists in the use of the machine, see *Downton v. Yaeger Milling Co.* (1879), 17 O. G. 906; 5 Bann. & A. 112; 1 McCrary, 26.

That the sale of a machine, in which needles covered by a different patent of the same patentee are used, carries a license to use those needles until they are used up, but not to replace them, see *Aiken v. Manchester Print Works* (1865), 2 Clifford, 435.

² That where an old licensed machine is broken up and sold at auction,

portant under what name the article is made the subject of the sale. The sale of the complete article by one who owns a patent for the materials of which it is composed, or of a combination by the patentee of its essential elements, carries a license to employ the materials in the article, or the elements in combination, and to use them, thus united or combined, without restriction.³

§ 826. **Implied License: Right to Use Unlimited as to Time, Territory, Method, and Quantity.**

This implied license of the purchaser and his vendees includes the right to use and the right to repair and the right to sell. His right to use is unlimited in duration. It continues not only during the original term of the patent, like the right under an express license, but unlike the right under an express license it subsists during an extension, even though such extension be conferred by special act of Congress.¹ It is

the purchaser has no right to use it, see *Wortendyke v. White* (1875), 2 Bann. & A. 25.

³ That the license extends to the materials of which the article sold is composed, see *Goodyear v. Beverly Rubber Co.* (1859), 1 Clifford, 348; cited in § 824, note 2, *ante*.

§ 826. ¹ In *Adams v. Burke* (1873), 17 Wall. 453, Miller, J. : (455) "We have repeatedly held that where a person had purchased a patented machine of the patentee or his assignee, this purchase carried with it the right to the use of that machine so long as it was capable of use, and that the expiration and renewal of the patent, whether in favor of the original patentee or of his assignee, did not affect this right. The true ground on which these decisions rest is that the sale by a person who has the full right to make, sell, and use such a machine carries with it the right to the use of that machine to the full extent to which it can be used in point of time." 5 O. G. 118 (119).

In *Mitchell v. Hawley* (1872), 18

Wall. 544, Clifford, J. : (546) "Patentees acquire by their letters-patent the exclusive right to make and use their patented inventions and to vend the same to others to be used for the period of time specified in the patent, but when they have made one or more of the things patented, and have vended the same to others to be used, they have parted to that extent with their exclusive right, as they are never entitled to but one royalty for a patented machine; and consequently a patentee, when he has himself constructed a machine and sold it without any conditions, or authorized another to construct, sell, and deliver it, or to construct and use and operate it, without any conditions, and the consideration has been paid to him for the thing patented, the rule is well established that the patentee must be understood to have parted to that extent with all his exclusive right, and that he ceases to have any interest whatever in the patented machine so sold and delivered or authorized to be constructed and oper-

also unlimited in place. The purchaser may use the article anywhere, whether within or without the territory covered by

ated. Where such circumstances appear, the owner of the machine, whether he built it or purchased it, if he has also acquired the right to use and operate it during the lifetime of the patent, may continue to use it until it is worn out, in spite of any and every extension subsequently obtained by the patentee or his assigns." 3 O. G. 241 (242); 6 Fisher, 331 (332).

In *Blanchard v. Whitney* (1855), 3 Blatch. 307, Nelson, J.: (309) "As I have already said, it would be a very forced and unreasonable construction of the transaction, to limit the duration of the use to the then existing term of the patent, in the absence of any express provision to that effect, inasmuch as the limitation of that term in no way operated necessarily as a restriction upon the title of the patentee and manufacturer. He could convey the right to an unlimited use. When the plaintiff built the machine now sought to be enjoined by him, he had a right to use it as long as it should last, for all coming time. This right he had irrespective of the patent. As the inventor and builder of the machine, he had this right to such use, without a patent. The patent secured to him the exclusive right to all machines made like it, and deprived all others of the right to make or use the same, without his consent, for a certain period of time. But the right to use the machine in question for all coming time was in the plaintiff, without the patent. The right which the plaintiff had to the machine in question, he conveyed to the defendant. He conveyed his whole right to it—his whole right to the use of it. And, as his whole right was a right to use it for all coming time, he conveyed to the defendant his right to that extent. By his voluntary act, his whole right to

use the machine in question became vested in the defendant; and the act of Congress of 1847, which authorizes the renewal and continuance of the plaintiff's patent to his use, does not purport to take away, neither could it take away, any right vested in the defendant, or any one else, by the voluntary act of the plaintiff."

Further, that such license to use continues during an extension, unless expressly restricted to the current term of the patent, see *Union Paper Bag Mach. Co. v. Nixon* (1876), 2 Bann. & A. 244; 1 Flippin, 491; 9 O. G. 691; *Wooster v. Sidenberg* (1875), 10 O. G. 244; 2 Bann. & A. 91; 13 Blatch. 88; *Hawley v. Mitchell* (1871), 4 Fisher, 388; *Holmes*, 42; 1 O. G. 306; *Adams v. Burke* (1871), 4 Fisher, 392; *Holmes*, 40; 1 O. G. 282; *Farrington v. Commissioners of Detroit* (1870), 4 Fisher, 216; *Farrington v. Gregory* (1870), 4 Fisher, 221; *Hodge v. Hudson River R. R. Co.* (1868), 3 Fisher, 410; 6 Blatch. 85; *Wood v. Michigan Southern & Northern Indiana R. R. Co.* (1868), 3 Fisher, 464; 2 Bissell, 62; *Bloomer v. Millinger* (1863), 1 Wall. 340; *Goodyear v. Beverly Rubber Co.* (1859), 1 Clifford, 348; *Day v. Union India Rubber Co.* (1856), 3 Blatch. 488; *Bloomer v. McQuewan* (1852), 14 How. 539; *Wilson v. Rousseau* (1846), 4 How. 646; 2 Robb, 372; *Simpson v. Wilson* (1846), 4 How. 709; 2 Robb, 469.

That the right of the purchaser of a patented device to use it during an extension is the same though the extension be granted by a special act of Congress, see *Bloomer v. McQuewan* (1852), 14 How. 539.

That the purchaser of a patented device may use it under a re-issue, see *Simpson v. Wilson* (1846), 4 How. 709; 2 Robb,

his vendor's grant or license, except perhaps within a district owned by a grantee whose title is anterior to that of his vendor.² It is likewise unlimited in method. Of whatever use the article is capable he may avail himself, even although the right to apply the patented articles to a special purpose has previously been granted to a different licensee.³ It is, finally, unlimited in quantity. The article vests in him as its absolute owner, and all the benefit which he can derive from its employment he is entitled to enjoy.

469; *Wilson v. Turner* (1846), 4 How. 712; 2 Robb, 467.

² As to the right of a purchaser from a grantee to use anywhere, see remarks on *McKay v. Wooster*, in § 824, note 5, *ante*.

That the purchaser from a territorial grantee or licensee, may use the article anywhere, except perhaps when the vendor's right is restricted to sales for use within such territory, see *Hobbie v. Smith* (1886), 27 Fed. Rep. 656; *Adams v. Burke* (1873), 17 Wall. 453; 5 O. G. 118; *McKay v. Wooster* (1873), 2 Sawyer, 373; 6 Fisher, 375; 3 O. G. 441; *May v. Chaffee* (1871), 2 Dillon, 385; 5 Fisher, 160; *Hawley v. Mitchell* (1871), 1 O. G. 306; 4 Fisher, 388; Holmes, 42; *Adams v. Burke* (1871), 4 Fisher, 392; Holmes, 40; 1 O. G. 282; *Jenkins v. Greenwald* (1857), 1 Bond, 126; 2 Fisher, 37.

That the purchaser of a patented article from a grantee may use it anywhere, and the sale is lawful though the grantee knows that it will be used outside his territory, see *Hobbie v. Smith* (1886), 27 Fed. Rep. 656.

That the purchaser of the patented device from an assignee of a territorial right to use and sell in that territory may use the device in any place in spite of other territorial assignments, see *Adams v. Burke* (1873), 17 Wall. 453; 5 O. G. 118.

That where a patented article is sold by the grantee of an entire territorial interest, the purchaser may use it anywhere, except perhaps in territory as-

signed prior to the assignment to his vendor, see *McKay v. Wooster* (1873), 3 O. G. 441; 6 Fisher, 375; 2 Sawyer, 373.

That no limitation in the assignment of his interest to a territorial assignee, will deprive a purchaser of the patented device from him of the right to use it always, see *Hawley v. Mitchell* (1871), 1 O. G. 306; 4 Fisher, 388; Holmes, 42.

That a limitation in a license as to the place and time of use of the patented devices made and sold by such licensee will bind his vendees, see *Hawley v. Mitchell* (1871), 1 O. G. 306; 4 Fisher, 388; Holmes, 42.

That a sale of the device by the patentee in a foreign country, without restrictions, confers a right to use it anywhere, see *Holliday v. Matheson* (1885), 24 Fed. Rep. 185; 31 O. G. 1444; 23 Blatch. 239; *Holliday v. Matheson* (1884), 30 O. G. 452.

³ That the lawful vendee of a patented article may use it in any mode of which it is capable, see *McKay v. Wooster* (1873), 3 O. G. 441; 6 Fisher, 375; 2 Sawyer, 373; *Adams v. Burke* (1871), 4 Fisher, 392; Holmes, 40; 1 O. G. 282.

That the purchaser of a patented device from an assignee of the right to make it may use it for any purpose, though the right to use it for a special purpose has been granted to a different assignee, see *Metropolitan Washing Machine Co. v. Earle* (1861), 2 Fisher, 203; 3 Wall. Jr. 320.

§ 827. Implied License: License to Use does not Embrace the Right to Make, nor to Sell as Matter of Traffic.

The right of the purchaser to repair the article does not embrace the right to make a new one nor to reconstruct the old.¹ He may replace its worn-out parts or elements with others, even when these are of the essence of the invention.² He may remove the effects of accident or wear and tear. He may add to it such improvements as he is able to procure. But when its original materials disappear, the article which he purchased ceases to exist, and with it the implied license to repair and use it.³ The power to sell the specific article

§ 827. ¹ In *Mitchell v. Hawley* (1872), 16 Wall. 544, Clifford, J.: (548) "But the purchaser of the implement or machine for the purpose of using it in the ordinary pursuits of life stands on different grounds, as he does not acquire any right to construct another machine either for his own use or to be vended to another for any purpose." 3 O. G. 241 (242); 6 Fisher, 331 (333).

That the purchaser of a patented device from the patentee may use it till it is worn out, but has no right to make another like it, see *Union Metallic Cartridge Co. v. United States Cartridge Co.* (1877), 2 Bann. & A. 593; 11 O. G. 1113.

That a license implied from the purchase of a patented invention does not attach to it when rebuilt, see *Gottfried v. Phillip Best Brewing Co.* (1879), 17 O. G. 675; 5 Bann. & A. 4.

That where the use of an invention destroys it, there is no implied license to reconstruct as there is to repair it, see *American Cotton Tie Co. v. Simmons* (1882), 106 U. S. 89; 22 O. G. 1976.

² In *Mitchell v. Hawley* (1872), 16 Wall. 544, Clifford, J.: (548) "Sales of the kind may be made by the patentee with or without conditions, as in other cases; but where the

sale is absolute, and without any conditions, the rule is well settled that the purchaser may continue to use the implement or machine purchased until it is worn out, or he may repair it or improve upon it as he pleases, in the same manner as if dealing with property of any other kind." 3 O. G. 241 (242); 6 Fisher, 331 (333).

That the lawful sale of a patented machine confers the right to replace worn-out parts, though these are the essence of the invention, see *Farrington v. Water Commissioners of Detroit* (1870), 4 Fisher, 216.

That the purchaser of a machine has an implied license to replace old parts as long as the identity of the machine remains, see *Gottfried v. Conrad Seipp Brewing Co.* (1881), 10 Bissell, 368; 8 Fed. Rep. 322.

That the right to repair continues during an extension, see *Hodge v. Hudson River R. R. Co.* (1868), 3 Fisher, 410; 6 Blatch. 85; *Wood v. Michigan Southern & Northern Indiana R. R. Co.* (1868), 3 Fisher, 464; 2 Bissell, 62.

³ In *Wilson v. Simpson* (1850), 9 How. 109, Wayne, J.: (122) "But the questions which were argued by counsel, — when repairs destroy identity and encroach upon invention, or when the thing patented ceases to exist, so as to exclude the repair or

thus purchased for use is also unrestricted, but does not extend to sales made in the ordinary course of trade.⁴

replacement of any one part of its combination, in connection with the rest of it, not requiring repair or to be replaced, — are before the court upon the evidence in the record. We admit, for such is the rule in *Wilson v. Rousseau*, 4 Howard, that when the material of the combination ceases to exist, in whatever way that may occur, the right to renew it depends upon the right to make the invention. If the right to make does not exist, there is no right to rebuild the combination. But it does not follow, when one of the elements of the combination has become so much worn as to be inoperative, or has been broken, that the machine no longer exists for restoration to its original use by the owner who has bought its use. When the wearing or injury is partial then repair is restoration, and not reconstruction. Illustrations of this will occur to any one, from the frequent repairs of many machines for agricultural purposes; also from the repair and replacement of broken or worn-out parts of larger and more complex combinations for manufactures. In either case repairing partial injuries, whether they occur from accident or from wear and tear, is only refitting a machine for use; and it is no more than that, though it shall be a replacement of an essential part of a combination. It is the use of the whole of that which a purchaser buys when the patentee sells to him a machine; and when he repairs the damages which may be done to it, it is no more than the exercise of that right of care which every one may use to give duration to that which he owns, or has a right to use as a whole. This foundation of the right to repair and replace, and its application to the point we are consider-

ing, will be found in the answers which every one will give to two inquiries. The right to repair and replace in such a case is either in the patentee or in him who has bought the machine. Has the patentee a more equitable right to force the disuse of the machine entirely, on account of the inoperativeness of a part of it, than the purchaser has to repair who has, in the whole of it, a right of use? And what harm is done to the patentee in the use of his right of invention, when the repair and replacement of a partial injury are confined to the machine which the purchaser has bought?"

⁴ In *Goodyear v. Beverly Rubber Co.* (1859), 1 Clifford, 348, Clifford, J: (356) "Suppose it to be an implement or machine, he may devise it or sell it, and if it be composed of various parts, he may break it up and use the materials for any other lawful purpose. Second purchasers acquire the same rights as the seller had, and may do with the article or its materials whatever the first purchaser could have lawfully done if he had not parted with the title."

That the purchaser of patented articles from a territorial grantee has no implied license to sell them outside such territory, as a matter of trade, though he may use them anywhere, see *Hatch v. Adams* (1884), 22 Fed. Rep. 434; 29 O. G. 776.

That the licensee of a grantee can sell within the territory to those who use the article outside the territory, but cannot himself sell outside the territory nor furnish the articles to others to be sold in the trade outside the territory, see *Hatch v. Hall* (1887), 30 Fed. Rep. 613; 40 O. G. 1342.

§ 828. Implied License: License to Use not Restricted by Unknown Prior Agreements of Licensor.

The purchaser of a patented article runs his own risk of his vendor's right to sell.¹ But if his vendor has received this right, the vendee is not bound by any previous covenants between the vendor and third parties of which he has no notice at the time of sale, nor can he be affected by any subsequent conveyance of the vendor.² Even an act of Congress cannot interfere with his enjoyment of the property which the sale has vested in him and which he now holds, not under the statutes of the United States, but under the common law that governs the usual contracts of vendors and vendees.³

§ 828. ¹ That the purchaser of a patented article runs the risk of the vendor's right to sell, see *Mitchell v. Hawley* (1872), 16 Wall. 544; 3 O. G. 241; 6 Fisher, 331.

² That covenants between patentees and their licensees do not follow the patented device into the hands of *bona fide* purchasers without notice, see *Metropolitan Washing Machine Co. v. Earle* (1861), 2 Fisher, 203; 3 Wall. Jr. 320.

That a licensee of a right to use the patented material for a certain article cannot hold as infringers those who purchase the article of licensed makers or sellers, and use the material for a different purpose, they having an implied license so to use it, see *Metropolitan Washing Mach. Co. v. Earle* (1861), 2 Fisher, 203; 3 Wall. Jr. 320.

That a recognition by the licensor of the rights of adverse patentees is binding on his prior licensees, see *Jackson v. Allen* (1876), 120 Mass. 64.

³ In *Bloomer v. McQuewan* (1852), 14 How. 539, Taney, C. J. : (552) "The fair inference from all of these special laws is this, that Congress has constantly recognized the rights of those who purchase for use a patented implement or machine; that in these various

special laws the patentee and purchasers of different inventions were intended to be placed on the same ground; and that the relative rights of both parties under the extension, by special act of Congress, were intended to be the same as they were when the extension was granted under the general law of 1836. It would seem that in some cases the attention of the legislature was more particularly called to the subject, and the rights of the purchaser recognized and cautiously guarded. And when the provision is omitted, the just presumption is that Congress legislated on the principle decided by this court in *Evans v. Eaton*, and regarded the special law as ingrafted on the general one, and subject to all of its restrictions and provisions, except only as to the time the patent should endure. Time is the only thing upon which they legislate. And any other construction would make the legislation of Congress on these various special laws inconsistent with itself, and impute to it the intention of dealing out a different measure of justice to purchasers of different kinds of implements and machines; protecting some of them, and disregarding the equal and just claims of others. And if such could be the interpretation of this law, the power of

§ 829. **Implied License: License to Use Implied in favor of Innocent Purchaser at Unlawful Sale, if Vendor afterwards Acquires an Interest in the Patented Invention.**

Another case of implied license, similar and collateral to the last, arises where a vendor, having no right to sell the patented article at the time of the purchase, afterwards acquires an interest in the patent by which a present right to sell is vested in him. Under these circumstances, the title of the former purchaser to the patented article becomes valid by estoppel, and from thenceforward his right to use it is complete against his vendor, and all subsequent vendees.¹ The acquisition by the vendee of an interest in the patent has the same effect upon a previous unlawful sale, and renders it thereafter operative both on the article, and on the right to its enjoyment.²

§ 830. **Implied License: License to Use Implied in favor of Purchaser at Unlawful Sale if Vendor afterwards Compensates the Owner of the Patent for the Infringing Sale.**

A third case, also collateral to the first, occurs where a vendor, who had no right to sell the article, is sued for the

Congress to pass it would be open to serious objections. For it can hardly be maintained that Congress could lawfully deprive a citizen of the use of his property, after he had purchased the absolute and unlimited right from the inventor, and when that property was no longer held under the protection and control of the general government, but under the protection of the State, and on that account subject to State taxation. The 5th amendment to the Constitution of the United States declares that no person shall be deprived of life, liberty, or property, without due process of law. The right to construct and use these planing machines had been purchased and paid for without any limitation as to the time for which they were to be used. They were the property of the respondents. Their only value consists in their use. And a special act of Congress passed after-

wards, depriving the appellees of the right to use them, certainly could not be regarded as due process of law."

§ 829. ¹ That where a person unlawfully sells a patented device, and afterwards acquires an interest in the patent, he is estopped from denying the right of his vendee to use the device till it is used up, see *Gottfried v. Miller* (1882), 104 U. S. 521 ; 21 O. G. 711.

That whether the other owners of the patent are also estopped, *quere*, see *Gottfried v. Miller* (1882), 104 U. S. 521 ; 21 O. G. 711.

² That where the purchaser of a patented article, from one who had no right to sell it, afterward obtains an assignment of the territorial right, his purchase of the invention becomes lawful, and he may use the article even during an extension, see *Eunson v. Dodge* (1873), 13 Wall. 414 ; 5 O. G. 95.

infringement by the owner of the patented invention, and satisfies the judgment which has been obtained against him. Here, if the owner of the patent receives his compensation by license-fees or royalties, or makes and sells the articles for public use, the damages which he recovers are the substitute for the license-fees which are his due, or for the profits he would have obtained if he himself had sold the article instead of the vendor. Thus by the satisfaction of his judgment he has already once received his lawful recompense for the release of this particular article from the monopoly, and estopped himself from claiming that the title of the purchaser is void. The purchaser, therefore, may retain the article as his rightful property, and use it and repair it as freely as if he had procured it from the patentee.¹ But where the owner of

§ 830. ¹ In *Allis v. Stowell* (1883), 16 Fed. Rep. 783, Dyer, J. : (787) " 'The recovery of profits and damages from the manufacturers of an infringing machine debars the patentee from recovering from a user for the use of the same machine,' where the user purchased the machine from the infringing manufacturers. *Booth v. Seevers*, 19 O. G. 1140, and cases there cited. These adjudications indicate the law to be that where a patentee recovers from an infringing manufacturer full damages and profits on account of the infringement, the purchaser from such manufacturer, who is a user of the machine, will be protected in such use against a suit for infringement, as he would be if he were a licensee from the patentee. But this could only be held on a clear showing that the purchaser was using the same patented machine or instrument as that involved in the suit between the patentee and the infringing manufacturer, and that the user was a vendee of such manufacturer; and under the authorities it would seem that to effect such a result it must further appear that the patentee's claim to profits and damages against the manufacturer has been actually paid and satisfied."

In *Steam Stone Cutter Co. v. Windsor Mfg. Co.* (1879), 17 Blatch. 24, Wheeler, J. : (31) " If the avails of the sales are claimed and taken, the right to the thing sold must be parted with; *solutio pretii emptionis loco habetur.* (2 Kent's Comm. 387.) It will be like taking judgment and satisfaction for the conversion of property, which always operates 'so that the defendant hath now the same property therein as the original plaintiff had, and this against all the world.' (*Adams v. Broughton*, Andr., 19, Strange, 1078.) And this relates back to the time of the conversion. (Addison on Torts, Wood's ed., 544; 6 Hen. VII., fols. 8, 9, pl. 4; Shep. Touch. 227; *Barrett v. Brandão*, 6 Man. & Gr. 640, note.) The sales must be adopted by the orator upon the very terms upon which the defendant made them, and as much right to the inventions must follow as if the sales had been made by the orator instead of by the defendant. It may be that this right will not follow until satisfaction is made; but whether it will or not is not now material. The question now is, how much the orator is entitled to recover by way of satisfaction; and this

the patent receives his compensation through his own use of the article, and neither licenses nor makes for sale to others,

is to be arrived at on the ground that satisfaction will be made. If not made, the defendant will not suffer unjustly by having it reckoned as if it would be. It follows, necessarily, that the defendant will be under no liability over to the purchasers after satisfaction, and that nothing should be deducted here on that account." 4 Bann. & A. 445 (451).

In *Perrigo v. Spaulding* (1876), 13 Blatch. 389, Johnson, J. : (391) "It seems to be well established that, when a patentee gets his remuneration by patent or license fees, a recovery of the license or patent fee from an infringer, and its payment, authorizes him to use the particular articles for which such recovery has been had. On the other hand, when a patentee chooses to use his invention himself, and find his remuneration in the sale of the products of its use, and to prevent others from using his invention, it is his right, and then a recovery for profits and damages will be limited to the profits and damages up to the time of the recovery. Such a recovery will not carry with it any right to the further use by the infringer of the invention. (*Suffolk Co. v. Hayden*, 3 Wall. 315 ; *Spaulding v. Page*, 4 Fisher's Pat. Cases, 641, 645, 646.) But where the patentee sells his patented instrument or machine for use by others, finding his remuneration in the profit of the sale of the manufactured machine or instrument, it is obvious that his interest is promoted by increasing the sale and that into his profit enters the value of the patented invention over and above the cost of manufacture and the ordinary fair profit of the manufacture. Even if no patent or license fee is fixed, the value thereof, as a profit, enters into the selling price, and, if not capable

of exact ascertainment, may, nevertheless be approximated to by estimation, when necessary. When the patentee sells, he receives this profit, and thus obtains full compensation for the article sold and for the right to use it while it lasts. When, for an infringement, he obtains both the profits and damages, he will be presumed to have obtained a full compensation for all the injury he has sustained, and to be placed in as good a position as if he had made and sold the article himself. Such is, I think, the presumption between parties thus situated, and if any different rule is sought to be applied in any particular case, it should appear that a recovery has not been sought or obtained for the whole gains of the manufacture as well as for all the damages sustained. (*Spaulding v. Page*, before cited ; *The Gilbert & Barker Manufacturing Co. v. Bussing*, 12 Blatchf. C. C. R. 426.) When a patentee manufactures and sells his patented article for use, the right to use passes by the sale. If an infringer manufactures and sells, he must account for and pay the profits, which are to be calculated upon the principle that the gain by the appropriation of the patentee's invention is their measure. If there are damages sustained and proved by the plaintiff, beyond the profits made by the infringer, these also may be recovered. But, when a full recovery and satisfaction from one party has been had, the patentee has obtained all that the law gives him, and the particular article or machine, if it be a machine, becomes, in effect, licensed by the patentee, and may be used so long as it lasts, free from any further claim by the patentee." 2 Bann. & A. 348 (350) ; 12 O. G. 352 (353).

In *Spaulding v. Page* (1871), 4 Fish-

his recovery of damages is a more recompense for injuries inflicted by the infringer upon his exclusive use. The payment of such damages is not the payment of a license-fee, nor of the profit on the article unlawfully sold. It leaves the article still under the monopoly, and any future use will be as truly an infringement as the past has been.² From the

er, 641, Sawyer, J. : (649) "Where a patentee does not use the patented machine himself, nor establish a patent fee, but manufactures the patented article, and sells at fixed prices, seeking his compensation in the profits of the manufacture and sale at such fixed prices, and another party infringes the patent by making and selling the patented article, and where the patentee sues the party so infringing, and claims to recover, and does recover, the full amount of profits which he himself would have obtained on said articles had he manufactured and sold them at his ordinary prices, by such claim and recovery he adopts the sale made by the party infringing, and the right to use the specific articles so sold, and for which the recovery has been had, vests in the purchaser." 1 Sawyer, 702 (709).

See also *Steam Stone Cutter Co. v. Sheldons* (1884), 21 Fed. Rep. 875 ; 22 Blatch. 484 ; *Booth v. SeEVERS* (1881), 19 O. G. 1140 ; *Gilbert & Barker Mfg. Co. v. Bussing* (1875), 12 Blatch. 426 ; 1 Bann. & A. 621 ; 8 O. G. 144.

That a conversion ratified may be regarded as a sale for purposes of royalty, see *Wilder v. Adams* (1860), 16 Gray, 478.

That a mere judgment against an infringing seller, without satisfaction does not confer an implied license on the purchaser, see *Tuttle v. Matthews* (1886), 28 Fed. Rep. 98 ; 36 O. G. 694 ; *Fisher v. Consolidated Amador Mine* (1885), 25 Fed. Rep. 201 ; 11 Sawyer, 190 ; *Birdsell v. Shaliol* (1884), 112 U. S. 485 ; 30 O. G. 261 ; *Gilbert & Barker*

Mfg. Co. v. Bussing (1875), 8 O. G. 144 ; 12 Blatch. 426 ; 1 Bann. & A. 621.

That when the judgment against an infringing seller is satisfied, the buyer has an implied license to use, see *Steam Stone Cutter Co. v. Sheldon* (1884), 22 Blatch. 484 ; 21 Fed. Rep. 875 ; *Gilbert & Barker Mfg. Co. v. Bussing* (1875), 8 O. G. 144 ; 12 Blatch. 426 ; 1 Bann. & A. 621.

That where a sale by an infringing vendor is ratified by his agreement with the patentee, the purchaser has an implied license to use and sell the device, see *Alabastine Co. v. Richardson* (1886), 26 Fed. Rep. 620 ; 35 O. G. 1225.

That the settlement of the vendor with the patentee for past infringements does not protect vendees subsequently purchasing, see *Matthews v. Spangenberg* (1882), 23 O. G. 92 ; 20 Blatch. 482 ; 19 Fed. Rep. 823.

That on an agreement to pay royalties on each article made by the licensee, royalties are due on articles made by infringers of the licensee's rights if he has received payment for the future use of such articles from the infringing makers, as if he himself had made them, see *Porter v. Standard Measuring Mach. Co.* (1886), 142 Mass. 191.

² See citation from *Perrigo v. Spaulding* (1876), 13 Blatch. 389, in note 1, *ante*.

That where no satisfaction has been made to the patentee, the purchaser from an infringing maker can be enjoined, for he cannot use the device without the consent of the patentee, see *Gilbert & Barker Mfg. Co. v. Buss-*

recovery and payment of mere nominal damages, in either case, no license is implied.³

§ 831. Implied License : License to Use Implied from Permission to Make before an Application for a Patent.

Another case in which a license is implied from the dealings of the parties with each other arises when, before his application for a patent, the inventor sells the article which is to be protected by the patent, or knowingly permits another to construct it, without a contract limiting the extent or method of its use. The purchaser or maker in this case obtains the right, by implication, to use or sell the specific article after the patent has been granted, with the same freedom from restrictions as if he had bought it from the patentee during the existence of the patent.¹

§ 832. Implied License : License to Use Inventions of Workmen Sometimes Implied in favor of Employer.

The principal case in which a license is implied from the relations of the parties occurs where an employee, during the period of his employment, makes an invention in the line of his employer's business. An employer, simply as such, has

ing (1875), 8 O. G. 144 ; 12 Blatch. 426 ; 1 Bann. & A. 621.

³ In *Blake v. Greenwood Cemetery* (1883), 16 Fed. Rep. 676, Benedict, J. : (677) "In this action the validity of the plaintiff's patent is not disputed, nor is it denied that the machine used by the defendant infringes upon that patent. But it is contended by the defendant that the recovery by the plaintiff of the sum of one dollar in the former suit, and the tender of that sum to him by the maker of the machine, is a bar to any recovery in this action against the user of the machine. To sustain this plea would be to hold that a decree for nominal damages recovered by a patentee against the manufacturer of infringing machines operates as a license to the manufacturer, and

also to his vendees, as to all existing infringing machines made by such manufacturer. The law is not so understood. The infringement by the manufacturer and the infringement by the user of an infringing machine, are separate trespasses, and judgment because of one is no bar to an action for the other. To create a bar there must be satisfaction, and nominal damages is not satisfaction." 25 O. G. 89 (90) ; 21 Blatch. 222 (223).

§ 831. ¹ See Sec. 4899, Rev. Stat.

That under this act a person making or buying an invention, before the application for a patent, has a right to use or sell only that specific thing, see *Brickill v. City of New York* (1879), 18 O. G. 463 ; 18 Blatch. 273 ; 5 Bann. & A. 544 ; 7 Fed. Rep. 479.

no right to the inventions of his employee.¹ If he contracts for his employee's inventive skill, and pays him for its exercise in his behalf, he may thereby become the equitable owner of the inventions which result, and be entitled to an assignment of the patents when they are obtained.² If their agreement is that the employer shall have the benefit, or the exclusive benefit, of the inventions of the employee, this is an express license to the employer to practise the inventions, but leaves their ownership in the inventor.³ But where, without any express agreement to that effect, an employee uses the time and tools of the employer in making an invention, and then applies it practically in the employer's business, the law implies a license to the employer to continue his enjoyment of the invention, even after the relations between himself and the inventor have been dissolved.⁴ The duration of

§ 832. ¹ That an employer, as such, has no right to the inventions of his employee, see *Hall v. Johnson* (1883), 23 O. G. 2411; *Hapgood v. Hewitt* (1882), 11 Bissell, 184; 11 Fed. Rep. 422; 21 O. G. 1786; *Damon v. Eastwick* (1882), 14 Fed. Rep. 40; 22 O. G. 1709; *Whiting v. Graves* (1878), 13 O. G. 455; 3 Bann. & A. 222; and § 414, and notes, *ante*.

² That an employer may become the equitable owner of his employee's inventions through a definite prior contract between them, see *Joliet Mfg. Co. v. Dice* (1883), 105 Ill. 649; *Continental Windmill Co. v. Empire Windmill Co.* (1871), 8 Blatch. 295; 4 Fisher, 428; *Appleton v. Bacon* (1862), 2 Black, 699; and § 414 and notes, *ante*.

That where an employee assigned his invention to his employer, who patented it, and under it the employee made devices for his employer as and for the one patented, he cannot claim after leaving the employ that such devices were not the ones patented, and if he makes them himself he is an infringer, see *Time Telegraph Co. v. Himmer* (1884), 19 Fed. Rep. 322; 26 O. G. 826; 22 Blatch. 34.

³ That a contract for the exclusive right to an employee's inventive skill for a specific period carries the exclusive license to use all inventions made during that period, under all patents and extensions, and also a license to use all inventions previously patented, but first made available during that period, see *Wilkins v. Spafford* (1878), 3 Bann. & A. 274; 13 O. G. 675.

⁴ In *Wade v. Metcalf* (1883), 16 Fed. Rep. 130, Lowell, J. : (131) "This section of the statute, which first appeared in the law of 1839, § 7 (5 St. 354), has been usually applied to the case of employer and workman. If the workman, by using the tools and time and money of his employer with his consent, makes an invention and applies it in his employer's business, the employer may continue to use it. If the improvement is a process, it has been held that the employer may continue to practise the process for the whole period of the patent. *McClurg v. Kingsland*, 1 How. 202; *Chabot v. American Button-hole, &c., Co.*, 6 Fisher, 71. But if the invention pertains to a machine, it is understood that only the specific machine or machines which have been so

his license in such cases depends upon the nature of the invention. If it is an art he may practise it until the origi-

made are licensed. *Pierson v. Eagle Screw Co.*, 3 Story, 402; *Brickill v. Mayor, &c.*, of New York, 7 Fed. Rep. 470."

Further, that where a workman makes an invention at the expense of his employer, and applies the invention practically in the employer's business, the employer has an implied license to use it after the relation ceases, see *Jencks v. Langdon Mills* (1886), 27 Fed. Rep. 622; 36 O. G. 347; *Bensley v. Northwestern Horse Nail Co.* (1886), 26 Fed. Rep. 250; 36 O. G. 689; *Barry v. Crane Bros. Mfg. Co.* (1884), 22 Fed. Rep. 396; *Slemmer's Appeal* (1868), 58 Pa. St. 155.

That an employer, merely as such, has no right in the inventions of his employee, unless it be a naked license to use or sell the invention in his ordinary business, see *Hapgood v. Hewitt* (1882), 21 O. G. 1786; 11 Fed. Rep. 422; 11 Bissell, 184.

That where an inventor, using the tools and time of his employer, makes an invention under an agreement that the employer should have his invention for a certain sum, and uses it in the employer's business, the invention belongs to the employer as against subsequent assignees of the inventor, or at least the employer has an implied license to use it, see *Continental Windmill Co. v. Empire Windmill Co.* (1871), 8 Blatch. 295; 4 Fisher, 428.

That where an employee incorporates his inventions into machines belonging to his employers, it gives the employers an implied license to use the inventions in such machines after the employment ceases, see *Chabot v. American Button-hole and Overseaming Co.* (1872), 6 Fisher, 71.

That where an employee makes his experiments at the expense and in the

factory of his employer, and has his wages increased as a result of his success, and having perfected his invention permits the employer to use it without claiming any pay, this operates as an implied license to the employer to continue its use, see *McClurg v. Kingeland* (1843), 1 How. 202; 2 Robb, 105.

That where an employee is hired to invent, and does so, and puts his invention into use in his employer's business, the latter has a right to use the particular device till it is worn out, but acquires no rights in the patent itself, see *Whiting v. Graves* (1878), 3 Bann. & A. 222; 13 O. G. 455.

That where an employee constructs his invention for the use of his employer, and uses it until he applies for a patent, the employer has a right to use it until it is worn out, see *Magoun v. New England Glass Co.* (1877), 3 Bann. & A. 114; 14 O. G. 1.

That an inventor and employee, having supervised and directed the building of his machine for his employer, a license in favor of the latter to use it as long as it lasts is implied, see *American Tube Works v. Bridgewater Iron Co.* (1886), 26 Fed. Rep. 334; 34 O. G. 1047.

That if an employee puts his invention into his employer's use without the consent of the employer and without any agreement for compensation, and the invention develops in the employer's use into a practical condition at his expense, he has an implied gratuitous license to use it as long as it lasts, see *Barry v. Crane Bros. Mfg. Co.* (1884), 22 Fed. Rep. 396.

That use by an inventor in his employer's business of a new design, without express contract, gives the employer an implied license to continue the use

nal term of the patent has expired.⁵ If it is an article he may use it until it is worn out, and repair it as long as its identity can be retained.⁶ His license, however, is not transferable like that of a purchaser of a patented article.⁷ Arising out of the relations between himself and his employee it is personal in its character, and cannot be applied to the benefit or protection of any other users of the patented invention. A corporation, whether municipal or private, has the same right to the enjoyment of the inventions of its employes as is possessed by individual employers.⁸

§ 833. Implied License: License to Use Inventions of Co-partner sometimes Implied in favor of the Firm.

From the relations between a partnership and its members a similar license is implied. If one co-partner makes an invention at the cost of the firm, and applies it to their common benefit, the right to use it becomes vested in the partnership, and is not affected by the retirement of the inventor from the firm.¹ Upon the dissolution of the partnership this license

of the design until the patent expires, whether or not the employment continues, see *Herman v. Herman* (1886), 29 Fed. Rep. 92; 37 O. G. 892.

That if a workman uses his invention in his masters' employment without claiming it against them, they may have an implied license to use it, see *Hall v. Johnson* (1883), 23 O. G. 2411.

⁵ See *Wade v. Metcalf*, cited in note 4, *ante*.

⁶ See *Wade v. Metcalf*, cited in note 4, *ante*.

⁷ That the implied license of an employer is personal, not assignable, see *Hapgood v. Hewitt* (1886), 119 U. S. 226; 37 O. G. 1247; *Hapgood v. Hewitt* (1882), 11 Fed. Rep. 422; 21 O. G. 1786; 11 Bissell, 184.

⁸ That where the employee of a city invents a device, and uses it on machines belonging to the city before his application for a patent, a license to the city to continue its use on such machines,

until the devices used are used up, is implied, see *Brickill v. Mayor of New York* (1880), 18 Blatch. 273; 5 Bann. & A. 544; 18 O. G. 463; 7 Fed. Rep. 479.

§ 833. ¹ In *Wade v. Metcalf* (1883), 16 Fed. Rep. 130, Lowell, J.: (132) "The plaintiff contends that this law only applies to employers and employed. But there is no such limitation in the statute. When the plaintiff, as a member of the firm, and at the joint expense, made and altered these machines, and permitted their use by the firm, how does he escape the statute by being himself one of the firm? The law was applied without hesitation to a case of this kind in *Slemmer's Appeal*, 58 Pa. St. 155. Again, the plaintiff contends that if the statute has any application, it only grants a limited and personal license to a certain legal individual called a firm, which ends when the firm ends. But the section in question describes in

terminates; though where the patented invention is an article, and several having been constructed at the firm's expense are at its dissolution distributed among its members, each has the right to use the article conveyed to him, as if the partnership were still in being.² A license of the same character arises in favor of a corporation, one of whose members is the owner of a patented invention, if he knowingly permits its employment in their business, and receives his proportion of the benefit to be derived therefrom.³

§ 834. **Implied License: Licenses Arising by Estoppel: Implied Licenses, how Construed.**

Besides these special cases, which are of definite character and frequent occurrence, an implied license may arise out of any circumstances which operate as an estoppel on the owner of the patent to prevent him from denying the rights claimed by the apparent licensee.¹ Such circumstances must, however,

unmistakable language a complete and perpetual release of the specific articles from the monopoly."

That under circumstances like the above a license is implied in favor of each member of the firm, see *Wade v. Metcalf* (1883), 16 Fed. Rep. 130.

² That where one partner invents a device and permits the firm to use it, this is no implied license to a member of the firm to increase the number used after the firm is dissolved, although the firm paid the expense of procuring the patent, if the firm received from it a benefit greater than the expense, see *Keller v. Stolzenbach* (1884), 20 Fed. Rep. 47; 27 O. G. 209.

That where one member of a firm patented a design and used it in the firm's business, an implied license arose to use the design till the firm dissolved, and after dissolution to sell, by receiver or otherwise, all existing devices embodying such design, see *Montross v. Mabie* (1887), 30 Fed. Rep. 234; 41 O. G. 931.

That a firm, dealing with one of its

members as if it were a licensee, is licensee until the firm can close up its business, and if a receiver is necessary for that purpose, he will be a licensee, see *Montross v. Mabie* (1887), 41 O. G. 931; 30 Fed. Rep. 234.

That articles made under an implied license to a firm may be sold by any one of the partners after dissolution for the benefit of the firm, see *Montross v. Mabie* (1887), 41 O. G. 931; 30 Fed. Rep. 234.

That articles used by a firm under an implied license from one of its members, and afterwards distributed among the partners at the dissolution of the firm, may be used by them in like manner, see *Wade v. Metcalf* (1883), 16 Fed. Rep. 130.

³ That where the members of a corporation own patents, and permit the corporation to use the patented devices without objection, a license will be implied, see *Detweiler v. Voegel* (1881), 19 Blatch. 482; 8 Fed. Rep. 600.

§ 834. ¹ That a license may arise by estoppel, see *Gear v. Grosvenor* (1873),

be unequivocal and fulfil the ordinary requisites of an estoppel *in pais*. An acquiescence in known infringements does not authorize their continuance, nor does a judgment for past infringements license the infringer to practise the invention in the future.² An unmolested use during a defective patent affords no presumption of a license under the re-issue.³ But any conduct by which the owner of the patent induces the person who employs the invention to place himself in a situation where he must suffer injury unless his right to practise the invention is conceded will be regarded as implying such a right, and as estopping the owner of the patent from asserting his prohibitory powers in its defeat. An implied license is construed primarily according to the legal rules under which it arises out of the circumstances or relations of the parties; and subject to these rules, by the evident intention of the licensor and licensee.⁴

6 Fisher, 314; Holmes, 215; 3 O. G. (1862), 4 Fisher, 86; Earle v. Sawyer 380; Reutgen v. Kanowrs (1804), 1 (1825), 4 Mason, 1; 1 Robb, 490. Wash. 168; 1 Robb, 1.

² That a license is not implied from the mere failure of the patentee to sue for infringements, see City of Concord v. Norton (1883), 16 Fed. Rep. 477; McWilliams Mfg. Co. v. Blundell (1882), 11 Fed. Rep. 419; 22 O. G. 177.

That no license is implied from a judgment for damages for past infringement, see Hayden v. Suffolk Mfg. Co.

³ That a use under a defective patent does not imply a license to use under a renewed patent, see McWilliams Mfg. Co. v. Blundell (1882), 11 Fed. Rep. 419; 22 O. G. 177.

⁴ That an implied license is construed according to the circumstances of the case and the evident intention of the parties, see Montross v. Mabie (1887), 41 O. G. 931; 30 Fed. Rep. 234.

CHAPTER VI.

OF THE EXTENSION OF LETTERS-PATENT.

§ 835. Extension of Letters-Patent: Origin and History of Extensions.

FROM the earliest history of Patent Law the fact has been recognized that through various causes an inventor may fail to obtain an adequate recompense for his inventive skill during the original term of his patent, and that justice to him and a due regard to the public interest may thus sometimes require an extension of his monopoly in the invention. The ancient crown grants were on this account frequently renewed after the expiration of their original terms, and though for a long period after the statute of James I. no such increase of the patent privilege was permitted by the laws of England, yet with the development of industrial enterprise in the first quarter of this century the importance of additional protection to the inventor became so apparent that Parliament in 1835 expressly provided means for extending letters-patent, at first for seven and then for fourteen years. In this country the propriety of such extensions in special cases has always been conceded, — the principal variations in our law relating to the tribunal in which the authority to grant extensions should reside. Prior to the act of 1836 this power was lodged in Congress, by whom alone the original term of the monopoly could be prolonged. In 1836 jurisdiction over the renewal as well as the first issue of letters-patent was conferred upon the Patent Office, subject to numerous restrictions as to the grounds of renewal and the duration of the extended term. In 1861 this jurisdiction over extensions was withdrawn as to all patents granted after the passage of that act, and Congress thus became the only source from which an increase of the monopoly created by future patents could

be obtained.¹ This is the present state of the law, — the Patent Office having authority to renew a patent issued before March 2, 1861, and acting as an examining and advisory tribunal concerning the extension of later patents when the existence of the conditions precedent to such extension is submitted to its judgment by a special act of Congress. Occasions for the exercise of its former power cannot now arise; and an exposition of the current law upon this subject might therefore leave unnoticed those peculiar doctrines which apply only to extensions granted by the Office when having general jurisdiction under provisions similar to those of 1836. Inasmuch, however, as Congress may at any time restore this jurisdiction, and when restoring it will probably preserve unchanged the leading characteristics which it previously possessed, this aspect of the law will also be considered in connection with the rules now practically in force.

§ 836. Extension: to Whom Granted.

As the sole object of an extension is to furnish to an inventor an additional opportunity to secure the recompense which he has hitherto failed to obtain, so no extension will be granted unless the inventor is to enjoy at least a substantial portion of its benefits.¹ It is not necessary that the legal title to the extended patent should vest permanently in him, for he may already have contracted to convey this to another; but even here the consideration for the transfer must be reasonable in amount or the purpose of the extension will fail, and the extension itself will consequently be refused.²

§ 835. ¹ That under Sec. 16, act of 1861, no future patents can be extended, see *De Florez v. Reynolds* (1880), 17 O. G. 503; 8 Fed. Rep. 434; 5 Bann. & A. 140; 17 Blatch. 436.

§ 836. ¹ That an extension is for the benefit of the inventor, see *Case v. Redfield* (1849), 4 McLean, 526; 2 Robb, 741.

That no extension will be granted unless the inventor is to profit by it, see *Ex parte Baker* (1872), 1 O. G. 632.

That when the patentee is to receive but five per cent of the benefits of the

extension it will be refused, see *Ex parte Peberdy* (1872), 2 O. G. 644.

² That an extension may be granted to an inventor who owns an interest in the patent, see *Ex parte Woodman* (1872), 1 O. G. 550.

That the patentee's interest in the extension may be equitable only, see *Gear v. Grosvenor* (1873), 3 O. G. 380; 6 Fisher, 314; Holmes, 215.

That a patent will not be extended where the assignees are to reap the entire benefit, see *Ex parte Munger* (1873), 3 O. G. 323.

Where there has been no contract to assign the extension the inventor will be presumed to have the beneficial interest therein, and the other conditions for its allowance being present he will receive it unaffected by his assignment of the original term or by any warrant of attorney which he may have previously made.³ Where assignees of the original patent have re-issued it without his concurrence, his extension may be based either on the original or the re-issued patent, but if he has consented to the re-issue the extension of the latter is alone permitted.⁴ The precise relation of the inventor to the patent must appear upon the face of his application for its extension, and if less than the whole future benefit is to be enjoyed by him, the proportion which he will receive must be specifically stated.⁵ A joint patent will not be extended unless all the joint inventors desire it, though the application of one may be ratified by the subsequent application of the others.⁶ The executor or administrator of a deceased inventor may apply for and obtain an extension in his own name, and will thereafter hold it in trust for the heirs or devisees of the inventor, or for such assignees as have already paid or have agreed to pay a valuable and reasonable consideration for its enjoyment.⁷

³ That there is no presumption that the assignee of the original term is interested in the extension, see *Goodyear v. Hullihen* (1867), 3 Fisher, 251; 2 Hughes, 492.

That an inventor may obtain an extension, though he may have given to another an irrevocable power of attorney, see *Ex parte Cox* (1872), 2 O. G. 491.

⁴ That an original patent may be extended to the patentee, though a re-issue has been obtained by an assignee, see *Ex parte Low* (1872), 1 O. G. 203; *Crompton v. Belknap Mills* (1869), 3 Fisher, 536.

That where an assigned patent has been re-issued to the assignee, and he has assigned half his interest therein to the inventor, the inventor cannot have an extension of the original, see *Ex parte Dickinson* (1873), 3 O. G. 91.

That no extension of the original patent can be granted after a re-issue, if the patentee consented to the re-issue, only the re-issue being extendible, see *Ex parte Packer* (1872), 2 O. G. 31.

⁵ That where the applicant for an extension has parted with any portion of his interest in the invention, the application must clearly show what interest he has left, see *Ex parte Lee* (1872), 1 O. G. 435.

⁶ That a joint patent will not be extended unless both patentees desire it, see *Ex parte Wickersham* (1873), 4 O. G. 155.

That one of two joint inventors may apply for an extension, if the other ratifies his act by applying also, see *Ex parte Beadle* (1872), 1 O. G. 434.

⁷ That an administrator may have an extension, and when granted will

§ 837. Extension : Conditions of Grant.

An inventor is entitled to an extension only when the recompense received by him during the original term of his patent is not commensurate with the benefit conferred by his inventive act upon the public. Whether or not the recompense has been in due proportion to the benefit depends upon the practical value of the invention in the arts, and the actual profit derived from it by the inventor under the original monopoly. The value of the invention must be demonstrated, either by experience or by the nature of the process or the instrument itself, and not rest in conjecture or on the mere assertions of the inventor.¹ If improvements have been made upon it since the issue of the original patent, its value must be due to the invention as first patented, and not solely to the subsequent improvements.² The sufficiency of the remuneration already obtained by the inventor is a special question of fact in each case, and cannot be measured by any general rules.³ Where the invention is of great industrial value the

hold it as trustee for the heirs of the inventor, and not for assignees, though the entire patent were assigned, see *Wilson v. Rousseau* (1846), 4 How. 646; 2 Robb, 372; *Brooks v. Jenkins* (1844), 3 McLean, 432; 1 Fisher, 41; *Brooks v. Jenkins* (1843), 3 McLean, 250; 2 Robb, 118.

§ 837. ¹ That no extension will be granted unless the value of the invention is proved, see *Ex parte Lockwood* (1873), 3 O. G. 439; *Ex parte Marston*, (1872), 1 O. G. 608.

That the value of the invention is not to be guessed at, but to be proved from experience, see *Ex parte Dick* (1872), 2 O. G. 147.

That an extension may be allowed though the invention is not yet in use, if it is of apparent value, and due diligence has been used, see *Ex parte Winans* (1872), 2 O. G. 440.

That an extension will not be granted on the mere allegation of the applicant that the invention is exceedingly useful,

but its utility must be proved, see *Ex parte Mathews* (1872), 1 O. G. 405; *Ex parte Falkenburg* (1872), 2 O. G. 3.

That a patent will not be extended when the invention is in little demand, or has gone out of use, see *Ex parte Behr* (1873), 3 O. G. 292.

That a contract to purchase the extension for \$2,000 shows the value of it, see *Ex parte Slemmons* (1874), 6 O. G. 575.

² That a patent will not be extended if the chief value of the invention resides in the improvements since made, see *Ex parte Roots* (1874), 6 O. G. 391.

That on an application for an extension the value of the invention to the public must be shown, and if improvements have been made, the value shown must be that of the original, separate from the improvements, see *Ex parte Haseltine* (1875), 8 O. G. 45.

³ That the sufficiency of the remuneration received is a special question of fact in each case, see *Ex parte Voel-*

enjoyment of large profits is not inconsistent with inadequacy of recompense; and, on the other hand, a small reward is ample when the advantage bestowed upon the public is of limited amount or short duration.⁴ If the failure of proper compensation has resulted from the negligence of the inventor, as by continued acquiescence in infringements or unreasonable delay in amending a defective patent,⁵ or if from sources not yet made available he will secure a profit proportioned to his merit, no reason exists for an extension and the application will therefore be denied.⁶

§ 838. Extension Must be for the Same Invention as Original.

As an extension is not a new patent, but a mere prolongation of the term of an original patent, it is obvious that it cannot embrace a different invention from the one claimed in and protected by the patent whose term it prolongs.¹ An inventor seeking this addition to his monopoly must base his application upon that precise form and scope of the monopoly which exists at the time when the extension, if granted, would

ter (1877), 12 O. G. 393; *Ex parte* Watterman (1872), 2 O. G. 247; *Ex parte* Dick (1872), 2 O. G. 147.

That want of proper remuneration must be affirmatively proved, see *Ex parte* Falkenburg (1872), 2 O. G. 3.

⁴ That an extension will be granted where the invention is of great value, although large profits have been already realized, see *Ex parte* Sturtevant (1873), 5 O. G. 2.

That less than \$5,000 is not sufficient remuneration in some cases, see *Ex parte* Lewis (1873), 3 O. G. 92.

⁵ That to acquiesce in the acts of infringers for ten years is negligence in attempting to secure remuneration, see *Ex parte* Lyman (1872), 2 O. G. 705.

That where an inventor has been deprived of his proper remuneration through infringements, and has pursued his legal remedies, he has exercised due diligence in securing his reward, see *Ex parte* Blandy (1872), 2 O. G. 174.

That no extension will be allowed if the failure of remuneration has arisen from the neglect to obtain a re-issue, see *Ex parte* Emmert (1872), 1 O. G. 90.

That when the patent has always been in the hands of assignees, the failure to apply for a necessary re-issue will not prevent the inventor from obtaining a renewal, see *Ex parte* Emmert (1872), 1 O. G. 90.

⁶ That an extension should be refused if the damages probably recoverable for past infringements will give recompense enough, see *Ex parte* Arnold (1874), 5 O. G. 553.

§ 838. ¹ That an extension is presumed to be for the same invention as the original, see *La Baw v. Hawkins* (1874), 6 O. G. 724; 1 Bann. & A. 428.

That an extension cannot cover a new invention or one not embraced in the original patent, see *Union Metallic Cartridge Co. v. United States Cartridge Co.* (1884), 112 U. S. 624; 30 O. G. 771.

take effect. He is not permitted to introduce new elements into the invention, nor discard others which he has previously treated as essential; nor can he select subordinate parts of the invention which separately considered may be of great value and yet hitherto have returned him little profit.² He must take an extension of the patent as it stands, or not at all; and though, if defective, it may still be amended by a re-issue or disclaimer, he cannot use the extension as a method of curing its defects.³ Where the patent has been re-issued during the original term with his consent, the re-issued patent, not the original, is the subject of extension, and if this contains new matter no extension will be conceded until the new matter has been disclaimed.⁴ The identity of the original invention being preserved, the number of successive or divisional re-issues which have been allowed is unimportant. The extension rests upon the last re-issue in which the inventor has concurred, and in the event of a divisional re-issue each division may be separately prolonged.⁵ Nor does it affect the inventor's rights that his original patent was limited by the duration of a prior foreign patent,—its term, whenever expiring, being capable of extension if justice and the public interest will be thereby promoted.⁶

² That an extension will not be allowed on an unimportant part of the invention, see *Ex parte* Collender (1873), 2 O. G. 727.

³ That an extension will not be granted to cure an insufficient specification, not remedied by a re-issue during the original term, see *Ex parte* Morse (1874), 6 O. G. 296.

⁴ That a re-issue containing new matter cannot be extended until the new matter is disclaimed, see *Ex parte* Allen (1872), 2 O. G. 89.

That a re-issue will not be extended if its claims are broader than the real invention, see *Ex parte* Sexton (1873), 3 O. G. 409; *Ex parte* Lyman (1872), 2 O. G. 705.

⁵ That the concurrence of the inventor in a re-issue makes the re-issue alone extendible, see *Ex parte* Packer (1872), 2 O. G. 31.

That each re-issue may be separately extended, see *Wheeler v. McCormick* (1873), 6 Fisher, 551; 11 Blatch. 334; 4 O. G. 692.

⁶ That an extension under the act of 1836 might be granted for patents limited by the terms of foreign patents, see *New American File Co. v. Nicholson File Co.* (1881), 8 Fed. Rep. 816; 20 O. G. 524.

That where, after a foreign patent had been issued, an American patent was granted, and the foreign patent expired before the American patent was extended, the extension was still valid, see *Tilghman v. Mitchell* (1871), 9 Blatch. 18; 4 Fisher, 615.

That under Sec. 4887, Rev. Stat., the extension of the foreign patent does not extend the American patent, see *Reissner v. Sharp* (1879), 16 Blatch. 383, 4 Bann. & A. 366; 16 O. G. 355.

§ 839. Extension of Invalid Patent not Permitted.

The extension of an invalid patent is manifestly unjust and improper, whether the invalidity is due to the nature of its subject-matter or to incurable defects in the instrument itself. Upon an application for a prolongation of the monopoly this entire question may be examined, and if it is apparent that the patent ought not to have been originally granted it will not be renewed.¹ Thus if it does not describe and claim a true invention, but covers simply a force, or function, or result; or if the invention which it claims was destitute of patentable novelty or utility, or had been abandoned; or if the original patent was obtained by fraud; or if it fails to disclose the invention to the public and cannot be amended, — in these and similar cases, where the grant may be at any time defeated, a continuance of the unlawful and unsustainable monopoly will not be attempted.² In determining this question, however, the presumption is in favor of the validity of the original patent, and this presumption is so far increased, if the patent has been upheld in the courts, that without new evidence the private opinion of the tribunal having jurisdiction over the allowance of the extension cannot prevail

§ 839. ¹ That on an application for an extension the Commissioner may consider the novelty and utility and scope of the invention, see *Ex parte Lyman* (1872), 2 O. G. 705; *Swift v. Whisen* (1867), 2 Bond, 115; 3 Fisher, 343.

² That no extension will be allowed where the patent does not embrace an invention, see *Ex parte Sabbaton* (1872), 2 O. G. 703.

That an extension will not be allowed where the patent covers a function merely, see *Ex parte Sexton* (1873), 3 O. G. 409.

That a patent for a result will not be extended, see *Ex parte Dick* (1872), 2 O. G. 147.

That an extension ought not to be allowed if the original invention was not new, see *Ex parte Arnold* (1874), 5 O. G. 553; *Ex parte Carrè* (1873), 4 O. G. 180; *Ex parte Stewart* (1873), 4 O. G. 665.

That no extension will be allowed where the original patent claims a device that was old when the patent was granted, unless such device is disclaimed, see *Ex parte Lewis* (1873), 3 O. G. 92.

That an extension ought scarcely to be allowed after a free public use for years, see *Ex parte Arnold* (1874), 5 O. G. 553.

That fraud in obtaining an extension will be a fatal objection to the patent, see *Goodyear v. Providence Rubber Co.* (1864), 2 Clifford, 351; 2 Fisher, 499.

That an extension will not be allowed when an invention is kept secret from the public, see *Ex parte Collender* (1873), 2 O. G. 727.

That an extension will be allowed, though the patent is defective, if it can be cured by a re-issue, see *Ex parte Mayall* (1873), 4 O. G. 582.

against it.³ An extension in the face of opposition strengthens this presumption, and in its turn may be urged in favor of the patent in the courts.⁴

§ 840. Extension: Procedure in Cases over which the Patent Office had Original Jurisdiction.

In cases of extension over which the Patent Office had original jurisdiction proceedings were commenced by filing a written application not more than six months, nor less than ninety days, before the expiration of the patent.¹ Upon receipt of the application the Commissioner caused notice to be given to persons interested adversely to the extension by publication in Washington and elsewhere, for at least sixty days before the hearing on the application,² and also instituted an examination in the ordinary method into the patentability of the invention. At the time appointed in the published notice

³ That if the patent has been sustained by the courts, and no new evidence against it is offered on the hearing for an extension, it will be regarded as valid, see *Ex parte Putnam* (1873), 3 O. G. 240; *Ex parte Blandy* (1872), 2 O. G. 174; *Ex parte Cox* (1872), 2 O. G. 491; *Ex parte Blake* (1872), 1 O. G. 605.

That personal doubts of the Commissioner as to validity yield to the judgments of the courts, see *Ex parte Putnam* (1873), 3 O. G. 240.

That a patent for a combination whose elements do not co-operate may be extended, if the courts have upheld the combination as a true and patentable one, see *Ex parte Lewis* (1873), 3 O. G. 92.

That no extension should be allowed when the original invention was not new, even though the courts, in the absence of certain evidence now at hand, have sustained it, see *Ex parte Lawson* (1873), 3 O. G. 150.

⁴ That an extension strengthens the presumption of novelty and utility, see *Whitney v. Mowry* (1867), 2 Bond, 45; 3 Fisher, 157.

§ 840. ¹ That the ninety days under Sec. 12, act March 2, 1861, begin with the day on which the application for an extension is filed, see *Johnson v. McCullough* (1870), 4 Fisher, 170.

That an application for an extension being filed February 15, and the patent expiring the 15th of May, the application was filed within ninety days before the expiration of the patent, see *Johnson v. Onion* (1877), 3 Hughes, 290.

That the jurisdiction of the Commissioner over an extension begins on the filing of the petition, and all subsequent steps are subject to his control, see *Gear v. Grosvenor* (1873), Holmes, 215; 6 Fisher, 314; 3 O. G. 380.

² That the publication sixty days previous to the hearing may begin on the first day of the sixty, see *Gear v. Grosvenor* (1873), 3 O. G. 380; 6 Fisher, 314; Holmes, 215.

That a notice of an application to extend the original is sufficient notice of an application to extend the re-issue, see *Crompton v. Belknap Mills* (1869), 3 Fisher, 536.

the interested parties were heard with their evidence upon all points involved in the controversy, and if the Commissioner was satisfied that the patentee, without his fault, had failed to secure a reasonable remuneration for his labor and expense, and that justice and the public good required a prolongation of the monopoly, he entered a certificate upon the patent renewing it for seven years after the close of the original term.³ This certificate being recorded in the Office gave the same effect to the patent as if it had at first been issued for the term of twenty-one years.⁴

§ 841. Extension: Procedure in Cases Referred to the Patent Office by Congress.

Applications for the extension of patents issued since March 2, 1861, must be made to Congress. Such applications may be directly granted or denied without further action, or may be granted subject to the decision of the Commissioner of Patents upon the merits of the application. In the latter cases the proceedings in the Patent Office, except as to the time and mode of their inception, closely resemble those arising under the former law. An application must be filed in the Office based upon the special act of Congress, a certified copy of which must accompany the application, and the applicant must at the same time furnish a statement under oath of the ascertained value of the invention, and of his receipts and expenditures on its account,

³ That a patent will be extended if there is no opposition, and the Commissioner is satisfied as to diligence and merit, see *Ex parte Robbins* (1873), 3 O. G. 292.

That an extension may be allowed though the Commissioner has doubts as to the patentability of the invention, see *Ex parte Lockwood* (1873), 3 O. G. 439.

That, although priority is in dispute, an extension may be allowed upon *ex parte* proofs with a disclaimer of the disputed Claims, see *Ex parte Nishwitz* (1872), 1 O. G. 141.

That a patent will not be extended where the same invention is covered by a previous patent to the same grantee, see *Ex parte Latta* (1873), 3 O. G. 349.

⁴ That the effect of an extension is to make the patent a patent for the old and new terms, see *Gibson v. Harris* (1846), 1 Blatch. 167.

That an extension vests an absolute and complete title in the patentee though the surrender and re-issue of the original was by another, see *Potter v. Empire Sewing Machine Co.* (1868), 3 Fisher, 474.

giving such facts and data in reference thereto as will enable the Commissioner to form an exact judgment concerning his real profits.¹ Any ambiguity or concealment in this statement is suspicious, and if it is unavoidably defective the reasons for the defect must appear. Upon this application four questions arise: the original patentability of the invention; its value to the public; the sufficiency of the remuneration already received by the inventor; and the effect of an extension upon the public interest. On the first point, in uncontested cases, no evidence is necessary. On the second, the testimony of disinterested persons must, if possible, be presented, and with such definiteness as to enable the Commissioner to estimate the industrial importance of the device or process covered by the patent. On the third point, it must be shown by sufficient proof that the inventor has employed all reasonable means to make his monopoly productive, and that without his fault he has failed to obtain a fair recompense for the time, ingenuity, and expense bestowed on the invention, and on its introduction into use.³ The conclusions of the Commissioner on the fourth point are drawn from the facts disclosed by the preceding inquiries, and from his general knowledge of the condition of the art. The rules of evidence governing this investigation are those established by the

§ 841. ¹ That the applicant for an extension must file an account showing facts and not mere opinions, see *Ex parte Lee* (1872), 1 O. G. 435.

That on an application for an extension, the account of receipts and expenditures need not give every item, but must give data enough for a clear judgment as to remuneration, see *Ex parte Wilson* (1872), 1 O. G. 185.

That on an application for an extension, the real gains received from the patented invention should be stated, although they are derived only from a part interest in the invention, see *Ex parte Miller* (1872), 1 O. G. 431.

That an account of profits taken on an extension hearing must include all profits received under foreign patents

for the invention, see *In re Newton's Patent* (1884), L. R. 9 App. Cas. 592; *In re Adair's Patent* (1881), L. R. 6 App. Cas. 176.

That where an application for an extension withholds particulars as to remuneration it is suspicious, see *Ex parte Wilson* (1872), 1 O. G. 185.

That the expenses of introducing into use may properly be set off against receipts in estimating value and remuneration, see *Ex parte Dick* (1872), 2 O. G. 147.

² That a patentee may be estopped by neglect from asserting his rights under the extension, see *Goodyear v. Honsinger* (1867), 2 Bissell, 1; 3 Fisher, 147.

Office for other cases in which exterior proof may be required.³ Any person may oppose an extension by serving notice of his opposition, and his reasons therefor, upon the applicant or his attorney, at least ten days before the day fixed for the closing of the evidence, and after such notice will be treated as an adverse party, and entitled to participate in all future proceedings, to offer testimony against the matters asserted by the applicant, and to be heard in argument. After the evidence has closed, the application is referred to the proper examiner for his determination of the patentability of the invention, and upon his report and the proof and arguments of the parties the Commissioner bases his decision, by which the extension is awarded or the application is dismissed.

§ 842. **Extension: Decision of Patent Office Final.**

In cases within the original jurisdiction of the Patent Office the decision of the Commissioner allowing an extension was final upon all matters necessarily involved in his judicial action.¹ If lawful on its face the extension could not be collaterally attacked for fraud or other irregularity, though the patent as extended was still open to all defences which could have been set up against it during the original term.²

³ That in extension cases the usual rules of evidence apply, see *Ex parte Lewis* (1873), 3 O. G. 92.

§ 842. ¹ That the decision of the Commissioner as to an extension is final, see *New American File Co. v. Nicholson File Co.* (1881), 20 O. G. 524; 8 Fed. Rep. 816; *U. S. Rifle & Cartridge Co. v. Whitney Arms Co.* (1877), 14 Blatch. 94; 2 Bann. & A. 493; 11 O. G. 373; *Ex parte Sexton* (1876), 9 O. G. 251; *Gear v. Grosvenor* (1873), Holmes, 215; 6 Fisher, 314; 3 O. G. 380; *Tilghman v. Mitchell* (1871), 4 Fisher, 615; 9 Blatch. 18; *Whitney v. Mowry* (1870), 4 Fisher, 207; *Jordan v. Dobson* (1870), 4 Fisher, 232; 2 Abbott, 393; 7 Phila. 533; *American Wood Paper Co. v. Glens Falls Paper Co.* (1870), 4 Fisher, 324; 8 Blatch. 513; *Crompton v. Belknap*

Mills (1869), 3 Fisher, 536; *Goodyear v. Providence Rubber Co.* (1864), 2 Fisher, 499; 2 Clifford, 351; *Clum v. Brewer* (1855), 2 Curtis, 506; *Colt v. Young* (1852), 2 Blatch. 471.

² That an extension is a judicial act of the Commissioner, and cannot be collaterally impeached, see *Dorsey Harvester Rake Co. v. Marsh* (1873), 6 Fisher, 387; *American Wood Paper Co. v. Glens Falls Paper Co.* (1870), 8 Blatch. 513; 4 Fisher, 324; *Rubber Co. v. Goodyear* (1869), 9 Wall. 788.

That if an extension is regular on its face it cannot be attacked by the defendant in an infringement suit for fraud or irregularity, see *Tilghman v. Mitchell* (1871), 9 Blatch. 18; 4 Fisher, 615.

That extended letters-patent are not impeachable for fraud in a collateral

§ 843. Extension: Effect on Rights of Assignees, etc.

The rights of assignees under an extension are protected but not defined by the express provisions of the statutes. An extension does not purport to vary the contract relations between the inventor and other parties. Like the original monopoly it is property which may be transferred or enjoyed in every manner consistent with its nature, and rights under it may be created and enforced to the same extent as during the original term. Conveyances of the extension made before it is allowed, licenses so granted as to continue while the monopoly endures, and implied licenses to use the patented article free from the dominion of the monopoly, take effect under the extension, and are governed by the terms of the express or implied contracts in which they originate.¹ The inventor cannot make use of his extension to curtail any of these vested rights. An assignee of the original term, though having no interest in the extension, may nevertheless employ the patented devices which he has on hand at the expiration of the patent, until they are no longer capable of use. Grantees of territorial interests in the patent, and purchasers of the patented instruments at a lawful and unrestricted sale, enjoy a similar privilege. The owner of the extension is bound by the acts of the former owners of the patent in reference to these parties, and cannot prejudice their legal rights by any exercise of his prohibitory powers.²

suit, see *Gear v. Grosvenor* (1873), Holmes, 215; 6 *Fisher*, 314; 3 O. G. 380.

That the decision of the Commissioner allowing an extension has great weight, but not on the question of infringement, see *Evarts v. Ford* (1873), 5 O. G. 58.

§ 843. ¹ That the right to use the invention during an extension depends on the right to use during the original term, see *Union Paper Bag Mach. Co. v. Nixon* (1876), 9 O. G. 691; 1 *Flippin*, 491; 2 *Bann. & A.* 244.

That the act concerning extensions

avails assignees as well as patentees, according to the nature of their contracts, see *Wilson v. Turner* (1845), Taney, 278.

That an extension of the patent does not relieve a licensee from the duty of paying royalties, see *Union Mfg. Co. v. Lounsbury* (1869), 41 N. Y. 363; *Union Mfg. Co. v. Lounsbury* (1864), 42 Barb. 125.

² That the owners under an extension are bound by the acts of the patentee under the original patent, see *Goodyear v. Honsinger* (1867), 2 *Bissell*, 1; 3 *Fisher*, 147.

§ 844. Extension: Assignment of.

An extension may be assigned by the inventor even before the original patent is granted, though such an assignment is operative only as a contract until the extension is allowed, and then takes effect by vesting the title in the assignee.¹ No transfer made prior to or during the original term passes the extension, unless the language of the conveyance expressly embraces it, — the presumption being that the assignees of a patent are owners only of the monopoly created by the primary grant.² A contract to assign an extension may be specifically enforced in equity, and where an inventor having made such a contract dies before the extension can be procured, his executor or administrator may apply for and obtain it in trust for the true and equitable owner.³

§ 844. ¹ That an extension may be assigned before it is granted, see *Ex parte Holmes* (1873), 4 O. G. 581; *Nicholson Pavement Co. v. Jenkins* (1872), 14 Wall. 452; 5 Fisher, 491; 1 O. G. 465; *Clum v. Brewer* (1855), 2 Curtis, 506.

That an extension may be assigned before the original patent is granted, see *Ex parte Holmes* (1873), 4 O. G. 581.

That an extension cannot be conveyed before it is granted, though it may be contracted for, see *Day v. Candee* (1853), 3 Fisher, 9.

That an agreement for the sale of an extension is good, see *Pitts v. Hall* (1854), 3 Blatch. 201.

That an assignment of an extension before it is granted operates from the date of the extension, and the legal title vests in the assignee, see *Gear v. Grosvenor* (1873), Holmes, 215; 6 Fisher, 314; 3 O. G. 380.

That an agreement to assign an extension when obtained makes the assignee the equitable owner of it when

it is obtained, see *Aiken v. Dolan* (1867), 3 Fisher, 197.

² That an assignment of an "invention" before the patent, and requesting that the patent issue to the assignee, does not cover the extension, see *Mowry v. Grand Street & Newtown R. R. Co.* (1872), 5 Fisher, 586; 10 Blatch. 89.

That an assignment of an interest in the invention and letters-patent pending the original term, does not carry an extension, unless it is so expressly stated, see *Jenkins v. Nicholson Pavement Co.* (1870), 4 Fisher, 201; 1 Abb. 567. See also §§ 412, 770, 779, and notes, *ante*.

³ That where a patentee, having agreed to convey an extension yet to be obtained, dies, his executor or administrator will take the extension in trust for, and may assign it to, the promisee, and the record of such assignment is notice to all concerned, see *Nowell v. West* (1876), 9 O. G. 1110; 8 O. G. 598; 2 Bann. & A. 113; 13 Blatch. 114.

§ 845. Extension under Special Acts of Congress.

Congress may extend a patent by special act in favor of the inventor or his heirs at any time before or after the expiration of the original term.¹ When such an extension is obtained, in addition to an extension under the original jurisdiction of the Patent Office, both are valid and the former is enjoyable after the termination of the latter.² As these extensions are entirely within the discretion of Congress, it may make such regulations as it pleases concerning the rights of assignees, though it cannot vary the relations which have been established by prior contracts between the inventor and other parties.³ Under an extension by special act, assignees have no privileges other than those arising out of contract, unless the act expressly confers them.⁴ All special acts of this character are considered as engrafted on the general law, and are interpreted in accordance with its permanent provisions.⁵

§ 845. ¹ That an extension may be granted by special act of Congress, see *Bloomer v. Stolley* (1850), 5 McLean, 158.

That an extension may be granted by special act of Congress after the original has expired, see *Jordan v. Dobson* (1870), 2 Abbott, 398; 7 Phila. 533; 4 Fisher, 232.

That where an extension is granted by a special act of Congress, the certificate need not recite all the provisions of the act, see *Agawam Co. v. Jordan* (1868), 7 Wall. 583.

² That an extension granted by the Patent Office and one allowed by Congress are entirely distinct, and one will take effect after the other, see *Woodworth v. Edwards* (1847), 3 W. & M. 120.

³ That Congress, in the special act

of extension, may regulate the rights of assignees, see *Blanchard Gun Stock Turning Co. v. Warner* (1845), 1 Blatch. 258.

That special acts authorizing extensions do not vary the rights of parties *inter sese*, see *Prime v. Brandon Mfg. Co.* (1879), 16 Blatch. 453; 4 Bann. & A. 379.

That special acts of extension cannot affect rights under prior contracts, see *Bloomer v. McQuewan* (1852), 14 How. 539.

⁴ That assignees have no rights under an extension by special act of Congress, unless it is so expressly provided in the act, see *Gibson v. Gifford* (1850), 1 Blatch. 529.

⁵ See as to this point, and the text of this paragraph in general, §§ 46, 47, and notes, *ante*.

END OF VOL. II.

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THE LAW OF PATENTS.

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THE

LAW OF PATENTS

FOR

USEFUL INVENTIONS.

BY

Allen

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IN THREE VOLUMES.

VOL. III.

Felix qui potuit rerum cognoscere causas. — VIRG. Georg. II. 490.

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of Owners of Patented Inventions Liberally Construed
and Applied.**

THE various rights created by the exercise of inventive skill, by the grant of letters-patent, and by the contract relations entered into between patentees and other parties, are subject to invasion by numerous wrongs, differing widely in their character and in the nature and application of the remedies by which they are redressed. The law aims to afford complete protection to those from whom the public receive such signal benefits as are conferred upon them by inventors; and where, from the intrinsic difficulties of the case, adequate protection cannot be secured, it endeavors to compensate them fully for the injuries they have sustained. In this department of remedial justice, therefore, is the liberal spirit of our modern jurisprudence toward inventors especially displayed. Not only are their rights clearly and minutely defined and each variety of wrong against them met by an appropriate remedy, but in administering these remedies the courts are uniformly governed by the principle that an inventor, having performed his part of his agreement with the public, is entitled to a perfect

vindication of his rights and to an exhaustive satisfaction for his wrongs. The operation of this principle is particularly apparent in the adjustment of protective measures to actual or threatened injuries, in the flexibility with which the rules of practice are adapted to the exigencies of each individual controversy, in the weight given to the presumptions in favor of the inventor, and in the methods by which damages are ascertained; but every detail of procedure is characterized by the same leaning toward the inventor and against those by whom his rights have been infringed. In that discussion of these various wrongs and remedies, which is to form this concluding portion of our treatise, it will be necessary to consider separately the rights arising from the exercise of inventive skill alone, the rights created by the grant of letters-patent, and the rights resulting from contracts between the owner of the patent and third persons, with the wrongs by which each is invaded, and the remedies by which those wrongs may be redressed.

§ 847. Protection of the Rights of an Inventor in his Unpatented Invention.

By the performance of an inventive act the inventor acquires a property in the invention which he thus creates, irrespective of its future protection by a patent. This property vests in him by the law of nature, and by the same law may be divested in any manner which places it in the possession of the public. Before the establishment of patent systems the knowledge of the public was equivalent to the possession of the public, and an inventor could retain the property in his invention only while he preserved his secret. Under the Patent Law he can disclose the nature and the mode of use of his invention without surrendering it until his patent has expired; and under our American law he can use it publicly for a certain period before applying for a patent without the risk of thereby forfeiting his exclusive rights. The property which thus vests in him by the law of nature, enlarged in its enjoyment by the provisions of our Patent Law, is recognized as entitled to the same protection as any other form of property; and whether attacked by force or

fraud his rights therein are vindicated by the courts, and the wrongs committed against them are adequately redressed.

§ 348. Protection of the Rights of an Inventor in his Patented Invention.

The issue of a patent confers on the inventor additional rights of extraordinary scope and value. Not only is he now empowered to use his invention in public, and to permit others to use it, without abandoning his own dominion over it, but he is clothed with an authority whereby he can prohibit the enjoyment of the invention to all persons whomsoever, even although they are original inventors like himself. The monopoly created by his patent prevails over all the rights which later inventors of the same invention would otherwise acquire by the exercise of their inventive skill, and renders their use of their own inventions, whether openly or in secret, equally an infringement of his rights as if they were mere imitators of his results. The patentee, under a valid patent, thus owns the invention as his exclusive property, whose value is capable of being lessened or destroyed by any act which impairs its commercial importance, or converts the proceeds of its enjoyment into other channels; and for any such injury, of whatever character, the law provides a remedy as ample and efficient as it is in the nature of human jurisprudence to afford.

§ 349. Protection of the Contract Rights of the Inventor and his Transferees.

An invention, whether patented or unpatented, being, like other property, subject to conveyance by its owner in such interests and upon such terms as he may deem expedient, various relations may arise between him and his transferees, to each of which attach certain rights and obligations, susceptible of violation in numerous modes and requiring protection and vindication according to the nature of the injuries threatened or received. These relations are divisible into two groups, — one characterized by a conveyance which transfers the monopoly as well as the invention, and embracing assignors and assignees and grantors and grantees; the other by a conveyance which operates upon the invention alone, leav-

ing the monopoly unaffected in the hands of its former owner except by an estoppel in favor of the transferee, and includes all such parties as are known by the general names of licensors and licensees. The rights and duties of the different members of each of these two groups are so far similar that they may be properly treated together with reference to the wrongs by which they are invaded and the remedies applied for their redress.

§ 850. Protection of the Contract Rights of Assignors and Assignees.

The rights of the assignor against the assignee and of the grantor against the grantee are few and simple. The principal one is the right to recover the price which the assignee or grantee has agreed to pay for the interests transferred to him. The others grow out of special stipulations contained in the conveyance, or from the general law which limits the enjoyment of the transferee to the precise privileges conferred upon him by the owner of the invention. The rights of the assignee against the assignor, and similarly of the grantee against the grantor, are more numerous and complex. He has a right to the transfer to him of the invention and the patent according to the terms of the contract made between them. Upon a total failure of the consideration moving toward him he has a right to recover back the purchase-money which he has already paid. If the conveyance contains covenants of warranty he is entitled to their fulfilment, or to damages for their breach, as well as that of the implied warranty of title which enters into all transfers of property. He has a right also to good faith and fair dealing on the part of his grantor or assignor, and to a remedy for any fraud that may be practised upon him.

§ 851. Protection of the Contract Rights of Licensors and Licensees.

The rights of the licensor against the licensee resemble those of assignors against their assignees. He is entitled to the license fee or royalties which the licensee agrees to pay for the enjoyment of his privilege, and to the compliance of

the licensee with those restrictions which the license or the law itself imposes on him. The licensee, under certain circumstances, has a right to repudiate the license and to recover back the license-fees which he has paid. He has a right to be defended by the licensor against infringers whose practice of the invention is injurious to his interests. He acquires rights also under the covenants in his license, whether express or implied, and to the estoppel by virtue of which he is protected against an assertion of the monopoly by the licensor in derogation of the privilege that his license has conferred. For a violation of any of these rights, and for any fraud or imposition of which the licensor is guilty in obtaining his submission to the patent, he has his remedy in an appropriate and effective form.

§ 852. General Division of the Subject of Wrongs and Remedies.

This outline of the rights connected with inventions indicates the topics to which a discussion of wrongs and remedies must relate and the order in which they must be pursued. Hence we shall consider in the following pages : —

- I. Wrongs against the owners of unpatented inventions.
- II. Wrongs against patentees.
- III. Wrongs between contracting parties.

And in connection with each class of wrongs the remedies provided by the law for their redress.

§ 853. Remedies for Certain Wrongs Afforded by Federal Courts: for Other Wrongs by State Courts: this Distinction Preliminary.

Before entering upon this discussion a collateral topic, affecting to a certain extent the details of each of these main topics, must, however, be examined. In the United States every person resides under two different governments, and is subject to two different systems of jurisprudence. His rights are protected by two distinct bodies of law, and his wrongs are redressed in the courts of two independent sovereignties. In reference to every group of wrongs and remedies the question, therefore, arises whether the wrongs invade the rights

protected by the State or by the Federal law, and whether the remedies are to be applied by the Federal or by the local courts. This question is particularly important in connection with the rights in patented inventions, since some of these rights depend upon the laws of the United States, and others on the laws of individual States; and thus in instituting any action for a violation of these rights it must be first determined whether the cause is one of State or Federal jurisdiction. To avoid the discussion of this question in connection with each wrong and its remedy, the entire subject will be here considered in a preliminary chapter.

CHAPTER I.

OF THE JURISDICTION OF THE FEDERAL AND STATE COURTS OVER
ACTIONS WHICH RELATE TO PATENTED INVENTIONS.§ 854. **Federal Jurisdiction where Parties are Citizens of Different States : this Jurisdiction not Exclusive.**

Courts derive their jurisdiction over actions either from the residence of the parties or from the subject-matter of the controversy. The Federal courts having no jurisdiction other than that conferred upon them by the Acts of Congress in pursuance of the Constitution, the State courts retain sole cognizance of all actions not thus specifically placed under the jurisdiction of the Federal courts. Jurisdiction has been bestowed upon the Federal courts in certain cases, on the ground of the residence of the parties, if the plaintiff and defendant are citizens of different States. In such cases the nature of the subject-matter of the controversy is of no importance.¹ The rules which determine whether jurisdiction on this ground exists, being common to all wrongs and remedies, will not be here discussed, the reader having access to them in works particularly devoted to that subject. In the following examination of the other ground of jurisdiction it will be assumed that the citizenship of the parties to the controversy is the same.

§ 855. **Federal Jurisdiction Exclusive over all Cases Arising under the Patent Laws.**

Jurisdiction, on the ground of subject-matter, has been vested in the Federal courts over all cases arising under the

§ 854. ¹ That where the parties on one side of the controversy differ in citizenship from the parties on the other side, the Federal courts have jurisdiction, see *Campbell v. James* (1880), 18 O.G. 1111; 2 Fed. Rep. 338; 18 Blatch. 92; 5 Bann. & A. 354.

Patent Laws.¹ This jurisdiction is exclusive, and hence no suit arising under the Patent Laws, whatever may be the residence of the parties, can fall within the cognizance of any local court.² In any given case, therefore, the jurisdictional question is determined as soon as it is ascertained whether or not the case itself is included in the class above described. The line which divides this class from all that lie outside it is now clearly defined, both upon principle and by the concurrent decisions of the State and Federal courts.

§ 856. Cases Arising under the Patent Laws are Cases Affecting the Monopoly Created by such Laws.

The purpose and effect of the Patent Laws is to create and preserve a monopoly in the patented invention in favor of the patentee. They are not concerned with the invention as dis-

§ 855. ¹ That the Federal courts have exclusive jurisdiction over all cases arising under the Patent Laws, see *Willis v. McCollin* (1886), 38 O. G. 1017; *Brown v. Texas Cactus Hedge Co.* (1885), 64 Tex. 396; *Page v. Dickerson* (1871), 28 Wis. 694; *Slemmer's Appeal* (1868), 58 Pa. St. 155.

That under the act of 1819 the jurisdiction of the Federal courts was not exclusive, see *Burrall v. Jewett* (1830), 2 Paige (N. Y.) 134; qualified by *Gibson v. Woodworth*, 8 Paige (N. Y.), 132.

² That the Federal courts have exclusive jurisdiction over any controversy as to the patent right without regard to the citizenship of the parties, see *Duke v. Graham* (1884), 19 Fed. Rep. 647; *Campbell v. James* (1880), 18 O. G. 1111; 2 Fed. Rep. 338; 18 Blatch. 92; 5 Bann. & A. 354; *Allen v. Blunt* (1849), 1 Blatch. 480.

That where the subject-matter confers jurisdiction any issue as to citizenship is immaterial, see *Fischer v. Neil* (1881), 6 Fed. Rep. 89; 19 O. G. 603.

That the act of March 3, 1875, changed the law of 1789, and gave jurisdiction to the Circuit Court over all

patent cases wherever the parties may reside, see *Colluloid Mfg. Co. v. Good-year Dental Vulcanite Co.* (1876), 10 O. G. 41; 13 Blatch. 375; 2 Bann. & A. 334.

That the jurisdiction of the Federal courts over patent cases is not dependent on the amount involved, see *St. Paul Plow Works v. Starling* (1888), 127 U. S. 376; 43 O. G. 1350.

That under the act of March 3, 1887, the \$2,000 limitation does not apply to jurisdiction over patent cases, see *Miller Megee Co. v. Carpenter* (1887), 43 O. G. 1118.

That the object of conferring jurisdiction over all patent cases on the Federal courts was to secure uniformity in the law on all points as to rights and remedies, see *Read v. Miller* (1867), 3 Fisher, 310; 2 Bissell, 12.

That the Supreme Court will not reverse a decree for want of jurisdiction in the court below, if the court had jurisdiction, though on narrow grounds, when the bill was filed, and the defendant did not then except, see *Clark v. Wooster* (1886), 119 U. S. 322; 37 O. G. 1477.

tinguished from the monopoly, nor with the mode and extent of the enjoyment of the privileges which the monopoly confers. They vest in the patentee an exclusive right to practise the invention and thereby forbid all other persons to employ it except with his consent; and while this right exists and remains uninvaded by the wrongful use of the invention their object is accomplished. The rights of the patentee in the patented invention considered as an article of property, and the obligations into which he enters with others as to its ownership or enjoyment, are matters collateral to the existence and continuance of the monopoly, dependent upon it indeed but not affecting it, and capable of assertion or repudiation without impairing the exclusive privilege which it bestows. Until, therefore, a controversy arises involving the existence or preservation of the monopoly, there can be no case under the Patent Laws.¹ All other controversies relate to property rights or contract rights which fall within the purview of the general laws, and are thus to be determined by the tribunals having ordinary jurisdiction over such subjects.²

§ 856. ¹ That the Federal courts have no jurisdiction unless the rights of the patentee under the Patent Laws of the United States are directly in issue, see *Teas v. Albright* (1882), 22 O. G. 2069; 13 Fed. Rep. 406.

That a patent matter, conferring jurisdiction, is a matter regulated by the Patent Laws of the United States, see *Blanchard v. Sprague* (1859), 1 Clifford, 288.

That the Federal courts do not have jurisdiction over a suit merely because it may become necessary in it to attack or defend a patent, see *Merserole v. Union Paper Collar Co.* (1869), 3 Fisher, 483; 6 Blatch. 356.

That the existence and validity of the monopoly, as claimed under the patent, are the only questions arising under the Patent Laws, see *Blakeney v. Goode* (1876), 30 Ohio St. 350; *Cellu-*

loid Mfg. Co. v. Goodyear Dental Vulcanite Co. (1876), 10 O. G. 41; 13 Blatch. 375; 2 Bann. & A. 334.

² That a question of contract concerning a patent-right or a patented invention is not a question under the Patent Laws, see *Ingalls v. Tice* (1882), 14 Fed. Rep. 352; *Hartell v. Tilghman* (1878), 99 U. S. 547; *Tilghman v. Hartell* (1876), 9 O. G. 886; 2 Bann. & A. 260; *Hill v. Whitcomb* (1874), 5 O. G. 430; 1 Bann. & A. 34; *Holmes*, 317; *Green v. Wilson* (1870), 6 C. E. Green, (N. J.) 211; *Bloomer v. Gilpin* (1859), 4 Fisher, 50; *Goodyear v. Union Rubber Co.* (1857), 4 Blatch. 63; *Nesmith v. Calvert* (1845), 1 W. & M. 34; 2 Robb, 311.

That a bill to subject a patent to an execution does not present a case under the Patent Laws, see *Ryan v. Lee* (1882), 10 Fed. Rep. 917.

§ 857. **Three Classes of Cases Affect the Monopoly.**

Controversies involving the existence and preservation of the monopoly may assume any one of three forms: (1) An affirmation and denial as to the legal existence of the monopoly in favor of any person; (2) An affirmation and denial as to the existence of the monopoly in favor of the patentee; (3) An affirmation and denial concerning the character of the matters embraced in the monopoly. In the first form, the patentability of the invention is the subject of dispute; in the second, the title of the patentee or his assignee; in the third, the scope of the monopoly, or in other words its existence as to certain instruments or operations claimed by the patentee to lie within it.¹ None of these controversies can be decided

§ 857. ¹ That any issue concerning the validity of a patent, the title of the alleged owner of the patent, or the fact of infringement, involves the monopoly itself, and is consequently under the exclusive jurisdiction of the Federal courts, has been recognized in a multitude of cases, both Federal and State, of which the following are examples:—

As to validity:

Dale Tile Mfg. Co. v. Hyatt (1888), 125 U. S. 46; 43 O. G. 249; *Brown v. Texas Cactus Hedge Co.* (1885), 64 Tex. 396; *Maurice v. Devol* (1883), 23 W. Va. 247; *Rawson v. Harger* (1878), 48 Iowa, 269; *Green v. Willard Improved Barrel Co.* (1876), 1 Mo. Ap. 202; *Page v. Dickerson* (1871), 28 Wis. 694; *Mer-serole v. Union Paper Collar Co.* (1869), 3 Fisher, 483; 6 Blatch. 356; *Tomlinson v. Battell* (1857), 4 Abb. Pr. 266; *Rich v. Atwater* (1844), 16 Conn. 409.

As to title:

In *Duke v. Graham* (1884), 19 Fed. Rep. 647, Hill, J. : (648) "If this had been a transaction accruing after the issuance of the letters-patent, the parties both being citizens of this State, it is clear that this court would have no jurisdiction of the subject-matter of the suit; but it is a question involving the property rights, so to speak, of the

defendant in the letters-patent themselves, and as between the co-partners themselves. The bill seeks to set aside the rights conferred upon defendant as one of the partners, and to vest the entire right in complainant. This, it seems to me, affects the patent, and also seeks to restrain the defendant from using in any way the rights conferred under the Swift patent, and which, by the understanding of the parties, was to become, in connection with complainant's improvement thereon, the joint property of complainant and defendant,—the rights secured by the letters-patent issued by the government Nov. 16, 1880,—and is essentially different from rights growing out of contracts between the patentees and third parties. I am of opinion that this court has jurisdiction to determine the question as to the right of the parties to the rights and benefits conferred by the patent issued to them by the government, and enforce their rights by a proper decree."

In *Hyatt v. Ingalls* (1883), 49 Sup. Ct. (N. Y.), 375, Freedman, J. : (378) "A grant to a patentee of an exclusive right to manufacture and vend an article described therein is a grant of property; and if the validity of the

without affecting the monopoly and enforcing, enlarging, or curtailing the rights created and bestowed under the Patent Laws; while if the patentability and scope of the invention and the title of the patentee are conceded, there can be no question in relation to the existence and continuance of the monopoly. Cases not presenting one or more of these three forms of controversy are, therefore, not cases arising under the Patent Laws.

patent is unquestioned, State courts will protect the owner of such property in the enjoyment thereof, by means of a decree of injunction, to the same extent as they would do were the subject-matter of the litigation of any other description. But where the validity of the plaintiff's patent is put in question by the pleadings in a State court, and the defendants present such proofs upon the trial as render it necessary for the court to examine and pass upon conflicting patents or claims of priority in invention, in order to determine whether the plaintiff has such a property in the subject-matter of the grant as entitles him to the exclusive and unmolested use of it, and an objection is taken to the jurisdiction of the court for that reason, the bill must be dismissed; for in such cases the jurisdiction is in the courts of the United States exclusively. (*Hovey v. Rubber Tip Pencil Co.*, 33 Sup. Ct. 522; affirmed 57 N. Y. 119.)"

In *Campbell v. James* (1880), 18 O. G. 1111, Wheeler, J. : (1113) "It is quite obvious from this statement that all these questions are questions of title to the patent which arise under the Patent Laws. . . . It has never been doubted but that the Circuit courts have jurisdiction of all such questions, whatever the doubts and decisions may have been when neither the title itself nor any question as to whether there was an infringement was before the court. (*Hartell v. Tilghman*, 99 U. S.

547.)" 2 Fed. Rep. 338 (344); 18 Blatch. 92 (98); 5 Bann. & A. 354 (360).

That the Federal courts have jurisdiction over a controversy as to what patents are covered by the assignment of an invention before patent, see *Puetz v. Bransford* (1887), 41 O. G. 353; 32 Fed. Rep. 318.

As to infringement :

That the jurisdiction of the Federal courts over the question of infringement is exclusive, see *Kayser v. Arnold* (1886), 41 Hun, 275; *Continental Store Service Co. v. Clark*, (1885), 100 N. Y. 365; *Kelly v. Kelly Scroll Mfg. Co.* (1884), 15 Bradwell (Ill.), 547; *Smith v. Standard Laundry Mach. Co.* (1882), 22 O. G. 587; 20 Blatch. 360; 19 Fed. Rep. 825; *Campbell v. James* (1880), 18 O. G. 1111; 2 Fed. Rep. 338; 18 Blatch. 92; 5 Bann. & A. 354; *Satterthwait v. Marshall* (1872), 4 Del. Ch. 337; *Merserole v. Union Paper Collar Co.* (1869), 3 Fisher, 483; 6 Blatch. 356; *Bloomer v. Gilpin* (1859), 4 Fisher, 50.

That actions under the Patent Laws are only for the purpose of protecting the patentee from infringements, see *Celluloid Mfg. Co. v. Goodyear Dental Vulcanite Co.* (1876), 10 O. G. 41; 13 Blatch. 375; 2 Bann. & A. 334.

That a proceeding to enforce a contract is totally different from an infringement suit, see *Brown v. Shannon* (1857), 20 How. 55.

§ 858. **Controversies Collateral to Cases not Embraced in one of these Three Classes are not Cases Affecting the Monopoly.**

Furthermore, a case or cause is a controversy in which the rights of the parties are judicially determined. The affirmations and denials constituting the controversy must result in one or more issues which by the judgment of the court are to be conclusively and permanently settled, so far as the parties and their privies are concerned. A controversy which arises collaterally to some other controversy, and whose decision enters into the adjudication of the latter only as a matter of evidence and not as an essential element in the judgment, is not a cause, nor is its decision binding even on the same parties when engaged in a different litigation. Subordinate controversies of this character constantly arise in the course of legal proceedings, such as the controversy as to title in actions *quare clausum*, or as to the truth of the publication in actions for slander, but they are no part of the cause itself, and the finding of the court concerning them is simply the determination of a fact which serves as the basis of an inference regarding some essential matter covered by the issue. The mere presence in the cause of a controversy relating to the patentability or the scope of an invention, or the title of the patentee, does not bring the case among those which arise under the Patent Laws. The existence or continuance of the monopoly must be put in issue, and submitted to the judgment of the court for permanent and conclusive settlement between the parties, and not as a subordinate or collateral matter whose decision paves the way to that of the real controversy.¹

§ 858. ¹ In *Tomlinson v. Battell* (1857), 4 Abb. Pr. 266, Duer, J. : (268) "It is not necessary to deny that when a question as to the construction, and, perhaps, as to the validity, of a patent arises, collaterally, in the progress and upon the trial of a cause, the necessity of its determination will not oust a State court of the jurisdiction which it derived from the nature of the action and the state of the pleadings. But here the existence and validity of a patent concerning the process, by which are produced the pictures to which alone the name of ambrotypes can properly be given, lie at the very foundation of the plaintiff's claim. They are facts constituting, in part, the cause of action; as such they are averred in the complaint, and as such are put at issue by the answer. It is upon an exclusive right secured by a patent that the action is founded. It is this exclusive right that the answer denies, and it is

§ 859. **An Action to Repeal a Patent is a Case Affecting the Monopoly.**

The principal, if not the only, cases in which the existence or continuance of the monopoly are directly in issue and determined by the judgment are actions brought to repeal a patent, actions to annul an interfering patent, and actions for infringement. An action to repeal a patent is instituted for the purpose of destroying the monopoly. It is an effort of the sovereign power to frustrate the creative act in which the monopoly originated, and to return the invention to its former unpatented condition. It puts in issue the right of the government to grant or of the patentee to receive the patent, and if successful terminates in a judgment which conclusively and permanently deprives the patentee of his exclusive rights. Such actions are, therefore, pre-eminently cases arising under the Patent Laws, and consequently are within the exclusive jurisdiction of the Federal courts.¹

§ 860. **An Action to Annul an Interfering Patent is a Case Affecting the Monopoly.**

An action to annul an interfering patent does not aim at the entire destruction of all monopoly in the invention, but at the discontinuance of that created in favor of the defendant patentee. It can be instituted only between parties who concede the patentability of the invention and the right to a monopoly in some one as against the public, but each of whom claims for himself the right to that monopoly to the exclusion of the others. Before its institution at least two patents covering the same invention must have been granted to two inde-

this denial which raises a question that, when thus raised, neither this nor any other State court, in my judgment, has authority to determine, — a question which I have no right to determine, and must refuse to consider."

Further, that the Federal courts obtain jurisdiction, on the ground of the subject-matter of the controversy, only when validity, title, or infringement are put in issue by the pleadings and must enter into the judg-

ment, see *Teas v. Albright* (1882), 22 O. G. 2069; 13 Fed. Rep. 406; *Blakey v. Goode* (1876), 30 Ohio St. 350; *Satterthwait v. Marshall* (1872), 4 Del. Ch. 337; *Green v. Wilson* (1870), 6 C. E. Green (N. J.), 211; *Rich v. Atwater* (1844), 16 Conn. 409.

§ 859. ¹ That a suit for the repeal of a patent is within the exclusive jurisdiction of the Federal courts, see *Merserole v. Union Paper Collar Co.* (1869), 3 Fisher, 483; 6 Blatch. 356.

pendent patentees, thereby apparently creating two distinct concurrent monopolies in the same art or article, one of which only can be valid, the prior inventor having the sole right to a patent protecting him in its exclusive use.¹ This proceeding, being intended to avoid the patents granted to his later rivals, denies the legal existence of the monopolies which they appear to have received, and seeks the cancellation of their letters-patent in order to deprive them of their *prima facie* title to the invention, and to remove the cloud which their possession of these patents casts upon his own. The fact in issue is the title of the patentee to his monopoly, and the judgment rendered, in accordance with the issue, conclusively confirms or destroys this monopoly as between the parties to the action. An action to annul a patent is thus a case arising under the Patent Laws, and hence is within the exclusive jurisdiction of the Federal courts.³

§ 861. **An Action for Infringement is a Case Affecting the Monopoly.**

An action for infringement, though an action of tort demanding compensation for the past invasion of the patentee's exclusive rights, nevertheless directly involves the existence or the scope of the monopoly or the title to the patent. An infringement can be committed only by the practice of the patented invention without the permission of the patentee. An allegation of infringement, therefore, includes an averment that the invention is the proper subject of a monopoly, an averment that the monopoly has been properly conferred upon the patentee as the first and true inventor, and an averment that the monopoly embraces the invention practised by the alleged infringer. A denial of infringement controverts the patentability of the invention, or the title of the patentee, or the scope of the monopoly, and thus puts in issue the exist-

§ 860. ¹ As to the nature of an action to annul an interfering patent, &c., see §§ 721-724, and notes, *ante*.

² That the Federal courts have exclusive jurisdiction over actions to annul an interfering patent, see *Rice v. Garnhart* (1874), 34 Wis. 453; *Gibson*

v. Woodworth (1840), 8 Paige (N. Y.), 132.

That the Federal courts have exclusive jurisdiction over all actions between adverse patentees as to infringement or priority, see *Rice v. Garnhart* (1874), 34 Wis. 453.

ence of the monopoly so far forth as the acts of the alleged infringer are concerned. A judgment on this issue determines, as between the parties, either that the monopoly does or does not legally exist at all; or does or does not legally exist in favor of the patentee; or does or does not legally exist as against the acts performed by the defendant; none of which questions can arise except under the Patent Laws, or be decided elsewhere than in the Federal courts.¹

§ 861. ¹ That the Federal courts have exclusive jurisdiction over all actions for infringement, see *De Witt v. Elmira Nobles Mfg. Co.* (1876), 66 N. Y. 459; *Smith v. McClelland* (1875), 11 Bush, 523; *Rice v. Garnhart* (1874), 34 Wis. 453; *Stone v. Edwards* (1872), 35 Tex. 556; *Slemmer's Appeal* (1868), 58 Pa. St. 155; *Kendall v. Winsor* (1860), 6 R. I. 453; *Elmer v. Pennel* (1855), 40 Me. 430; *Dudley v. Mayhew* (1849), 3 Comst. (N. Y.), 9; *Burrall v. Jewett* (1830), 2 Paige (N. Y.), 134; *Parsons v. Barnard* (1810), 7 Johns. 144; and cases cited in § 857, note 1, *ante*.

That one co-owner of a patent cannot sue for compensation for its use by an infringer in a State court, the cause of action not being contract but infringement, see *De Witt v. Elmira Nobles Mfg. Co.* (1876), 66 N. Y. 459.

That the purchaser of an exclusive right to sell must sue an infringer in the Federal courts, see *Stone v. Edwards* (1872), 35 Tex. 556.

That the Federal courts have jurisdiction over a suit for infringement by a licensor against his licensee though both are citizens of the same State, and the licensee denies that the license is terminated and that he infringes, see *Smith v. Standard Laundry Mach. Co.* (1882), 19 Fed. Rep. 825; 20 Blatch. 360; 22 O. G. 587.

That the Federal courts have juris-

isdiction over a suit for infringement brought by the licensee against the licensor, see *Stanley Rule & Level Co. v. Bailey* (1878), 14 Blatch. 510; 3 Bann. & A. 297.

That when a licensor annuls the license and obtains a decree for a rescission and an account to that date, a future use of the invention by the licensee will be an infringement of which only the Federal courts can take cognizance, see *Hyatt v. Ingalls* (1883), 49 Sup. Ct. N. Y. 375.

That a State Court cannot restrain a licensee from using the invention pending a suit by the patentee against him for royalties, see *Hat Sweat Mfg. Co. v. Remoehl* (1886), 102 N. Y. 167.

That a State court cannot enjoin against a suit for infringement in the Federal courts, see *Kendall v. Winsor* (1860), 6 R. I. 453.

That a State statute cannot deprive a Federal court of jurisdiction by conferring power on local officers to adjust claims against their local governments, see *May v. Saginaw Co.* (1887), 32 Fed. Rep. 629.

That in a suit for infringement in the Federal courts the rights of the parties will be determined under the Patent Laws without regard to the decision of a State court in a suit concerning their contract relations, see *Oliver v. Rumford Chemical Works* (1883), 109 U. S. 75; 25 O. G. 784.

§ 862. **Cases Affecting the Monopoly are within the Exclusive Jurisdiction of the Federal Courts though Involving Collateral Controversies not Arising under the Patent Laws.**

The exclusive jurisdiction of the Federal courts over all cases which involve the existence or continuance of the monopoly is not affected by the complication of this question with others which, if presented independently, these courts would have no power to decide.¹ Claims of infringement growing out of contract relations between the parties are no less proper subject-matter for the Federal Courts than similar claims based on wanton and malicious interference with the patented invention. Where, for example, a co-owner, under an agreement to procure a re-issue in the names of all, accepts the title to the patent and fraudulently obtains a re-issue to himself, under the color of which he employs infringing articles, his breach of contract and of trust, though affording his co-owners other grounds of action, do not deprive them of their right to sue him for infringement in the Federal courts.² Or where a licensor, who should protect his licensee against infringement, himself becomes the infringer and consequently cannot vindicate the rights he has conferred, the licensee, although he has a remedy upon his contract, is not deprived of his right to have the infringer punished or restrained, and is permitted to proceed against him in his own name, *ex necessitate rei*, in the Federal tribunals.³ Or again, where a

§ 862. ¹ That the Federal courts have exclusive jurisdiction over all questions of validity, title, or infringement, though other matters are collaterally involved, see *Teas v. Albright* (1882), 22 O. G. 2069; 13 Fed. Rep. 406; *Smith v. Standard Laundry Mach. Co.* (1882), 22 O. G. 587; 20 Blatch. 360; 19 Fed. Rep. 825; *Brooks v. Stolley* (1845), 3 McLean, 523; 2 Robb, 281.

That the Federal courts have jurisdiction over a suit to prevent the violation of a patent though the defence may rest on a contract between the parties, see *Seibert Cylinder Oil-Cup*

Co. v. Manning (1887), 32 Fed. Rep. 625.

² That the Federal courts have jurisdiction over a bill to enjoin a co-owner from using the invention, under an agreement to re-issue in their joint names as such co-owners, see *Duke v. Graham* (1884), 19 Fed. Rep. 647.

³ In *Stanley Rule & Level Co. v. Bailey* (1878), 14 Blatch. 510, *Shipman, J.*: (511) "It is not necessary in this case, the patentee and legal owner of the patent being the alleged infringer, to determine whether, under the recited agreement, the plaintiff is the grantee of such an exclusive right

license has existed but has been annulled and the licensee continues to practise the invention, or where the licensor alleges that the license has expired and the licensee insists that it is still in force,⁴ and in all other cases where the existence and scope of the monopoly are put in issue and decided, whatever may have been the circumstances out of which the alleged infringement has arisen and by whatever implications or agreements it may now be justified or excused, the controversy is a cause under the Patent Laws of the United States, and the exclusive jurisdiction of the Federal courts on this issue draws after it the power to decide all other matters which are necessary to its full determination.⁵

§ 863. Cases Affecting the Monopoly not Brought within the Jurisdiction of State Courts by Consent of Parties.

Where jurisdiction is exclusively conferred on one tribunal on the ground of subject-matter, no other tribunal can in any manner obtain cognizance thereof. Neither the convenience nor consent of the parties can bestow a power which the law has expressly or impliedly withheld, and though for want of this the interests of parties are imperilled, it is a defect in practical jurisprudence which the law itself and not the courts

that it can bring suit in its own name alone against strangers who are infringers, or is, as is claimed by the defendant, merely a licensee. In this case the patentee is the alleged infringer, and the Circuit Court has jurisdiction of the cause, whether the plaintiff is grantee or licensee. When the patentee has infringed his license, and, while holding the legal title to the patent in trust for his licensee, has been faithless to his trust, 'Courts of equity are always open to the relief of such a wrong. This wrong is an infringement. Its redress involves a suit, therefore, arising under the Patent Laws, and of that suit the Circuit Court has jurisdiction.' *Littlefield v. Perry*, 21 Wall. 205, 223." 3 Bann. & A. 297 (299).

⁴ That when a licensee continues to practise the invention after his license

is expired, claiming it to be still in force, the question is one for the Federal courts, being a question of infringement, see *Smith v. Standard Laundry Mach. Co.* (1882), 20 Blatch. 360; 22 O. G. 587; 19 Fed. Rep. 825.

That an action for royalties in which the validity of the patent and the fact of infringement are in issue and must be decided, is within the jurisdiction of the Federal courts, see *St. Paul Plow Works v. Starling* (1888), 127 U. S. 376; 43 O. G. 1350.

⁵ That jurisdiction having been once acquired on the ground of infringement, the court may grant complete relief and settle all other matters, though they are not original grounds of jurisdiction, see *Bloomer v. Gilpin* (1859), 4 Fisher, 50; *Brooks v. Stolley* (1845), 3 McLean, 523; 2 Robb, 281.

must remedy.¹ Thus in regard to cases which arise under the Patent Laws, and over which exclusive jurisdiction has been vested in the Federal courts, no State court can under any circumstances assume to exercise its judicial powers. Under whatever guise an action may be brought, if in reality it is a case which puts in issue and requires a judgment upon the existence or continuance of the monopoly created by a patent, it is the duty of the local court to dismiss it or provide for its removal to the courts by whom alone such issues can be lawfully determined.

§ 864. Actions for Breach of Contract or for Tort to the Patented Article are not Cases Affecting the Monopoly.

The existence and scope of the monopoly conferred by letters-patent rest entirely upon the provisions of the Patent Law. Whether or not the invention possesses the several requisites for patentability, whether or not the patentee is the first and true inventor, and whether or not the monopoly embraces any given art or article are facts which no act of the patentee or other parties can in any manner change; and when the law acting in view of these facts has bestowed the monopoly and defined its limits, its existence and its scope are fixed beyond the power of individuals to alter. Hence no contract entered into between the patentee and other persons, either before or after the issue of the patent, can in any degree affect the nature or extent of the monopoly. No injury to the property of the patentee in the invention, other than its unauthorized appropriation in violation of the patent, is an invasion of the monopoly. Neither the breach of such a contract, nor the commission of such an injury, can, therefore, form the basis of an action arising under the Patent Laws, although the subject-matter of the one and the property affected by the other is a patented invention. The wrongs

§ 863. ¹ That a defendant cannot waive an objection to the want of jurisdiction of a State court over an action for infringement, see *Dudley v. Mayhew* (1849), 3 Comst. (N. Y.), 9.

That a State court cannot assume jurisdiction on the ground that the

parties can be witnesses under State laws, see *Kendall v. Winsor* (1860), 6 R. I. 453.

That no laches of the defendant can waive an objection to the jurisdiction over the subject-matter, see *Creamer v. Bowers* (1887), 30 Fed. Rep. 185.

are in both cases wrongs at common law, and are to be redressed in the tribunals and by the methods ordinarily provided for such injuries. Over these, therefore, the State courts have exclusive jurisdiction, unless a difference in the citizenship of the opposing litigants confers it also on the Federal courts.

§ 865. **Actions for Breach of Contract, and for Torts to the Patented Article, are within the Jurisdiction of State Courts.**

Citizenship being the same, the State courts have sole cognizance of all actions based on contracts between the parties, whether to compel their performance, to rescind them, or to award damages for their violation.¹ Actions for breach of warranty, for fraud, for royalties or purchase-money, and for

§ 865. ¹ That an action to compel specific performance is within the exclusive jurisdiction of State courts unless the parties are of different citizenship, see *Wren v. Annin* (1888), 34 Fed. Rep. 435; *Perry v. Littlefield* (1879), 4 Bann. & A. 624; 17 O. G. 51; 17 Blatch. 272; *Brown v. Shannon* (1857), 20 How. 55.

That the fact that the subject-matter of the suit is a contract concerning a patent-right does not give the Federal courts jurisdiction, and that a bill for specific performance of such a contract must contain averments showing other grounds of jurisdiction, see *Nesmith v. Calvert* (1845), 1 W. & M. 34; 2 Robb, 311; *Burr v. Gregory* (1828), 2 Paine, 426.

That a breach of contract between assignor and assignee as to the mode of enjoying the patent is not within Federal jurisdiction, see *Williams v. Star Sand Co.* (1888), 35 Fed. Rep. 369.

That a suit to cancel or enforce a license is not within the jurisdiction of the Federal courts unless the parties reside in different States, and this must be alleged in the bill, see *Merserole v. Union Paper Collar Co.* (1869), 3 Fisher,

483; 6 Blatch. 356; *Goodyear v. Union Rubber Co.* (1857), 4 Blatch. 63.

That the Federal courts have no jurisdiction of a bill to enforce a contract as to the use of a patent where both of the parties are citizens of the same State, though they may protect the patentee from infringement by injunction, see *Brooks v. Stolley* (1845), 3 McLean, 523; 2 Robb, 281.

That Federal courts have no jurisdiction by virtue of the Patent Laws over a suit to enforce or rescind a license-contract, see *Dale Tile Mfg. Co. v. Hyatt* (1888), 125 U. S. 46; 43 O. G. 249; *Hammacher v. Wilson* (1886), 36 O. G. 233; 26 Fed. Rep. 239; *Hartell v. Tilghman* (1878), 99 U. S. 547.

That if a subsisting license is proved, and the parties are citizens of the same State, the Federal courts have no jurisdiction, see *Jencks v. Langdon Mills* (1886), 36 O. G. 347; 27 Fed. Rep. 622.

That the Federal courts may decide whether there is a subsisting license, or whether a license has been forfeited, but cannot enforce or avoid it where citizenship is the same, see *Hammacher v. Wilson* (1886), 36 O. G. 233; 26 Fed. Rep. 239.

the non-fulfilment of other collateral contracts, are also within their exclusive jurisdiction.² In such actions the validity of the patent, and consequently the existence of the monopoly, may be disputed and incidentally decided as preliminary to some point in issue, and thus the court may pass upon the same matters as are involved in cases arising under the Patent Laws; but upon these the judgment has no effect even between the parties, and the same questions are still open in any other litigation in which they may engage.³ An action

² That where the validity of the patent and the use by the defendant are admitted, and all the rights are covered by contracts, the case does not arise under the Patent Laws, and the Federal courts have no jurisdiction unless the citizenship of the parties is different, see *Ingalls v. Tice* (1882), 14 Fed. Rep. 352; *Hartell v. Tilghman* (1878), 99 U. S. 547; *Tilghman v. Hartell* (1876), 9 O. G. 886; 2 Bann. & A. 260; *Lockwood v. Lockwood* (1871), 33 Iowa, 509; *Green v. Wilson* (1870), 6 C. E. Green (N. J.), 211; *Bloomer v. Gilpin* (1859), 4 Fisher, 50.

That Federal courts have no jurisdiction over suits for royalties, see *Albright v. Teas* (1883), 106 U. S. 613; 23 O. G. 829.

That the Federal courts have no jurisdiction over contracts between patentees and their licensees, see *Willis v. McCollin* (1886), 38 O. G. 1017; *Hill v. Whitcomb* (1874), 5 O. G. 430; *Holmes*, 317; 1 Bann. & A. 34.

That one holding an exclusive license may be protected against injuries by injunction in a State court, unless the patent is in question, see *Hyatt v. Ingalls* (1883), 49 Sup. Ct. N. Y. 375.

³ In *Hyatt v. Ingalls* (1883), 49 Sup. Ct. N. Y. 375, *Freedman, J.* : (378) "There is, however, a class of cases in which the defendant cannot question the validity of the plaintiff's patent, because by his contract he has estopped himself from so doing, and of these a

State court may take cognizance. In them the question concerning the validity of the patent is merely a question collateral to the main issue, and goes only to the question whether there is a consideration to support the promise to pay. A case arising on a contract to pay royalties, or, in other words, a case between patentee and licensee, falls generally within the class last referred to."

In *Merserole v. Union Paper Collar Co.* (1869), 3 Fisher, 483, *Blatchford, J.* : (487) "A State court has jurisdiction to decree the license and agreement to be void and inoperative for fraud, or any other adequate reason; and the fact that in the investigation the State court will be obliged to inquire whether there was anything new in the patents which could operate as a consideration for the license and the agreement, cannot deprive the State court of jurisdiction, or confer it on this court. It is true that a State court cannot take cognizance of a suit brought for the infringement of a patent, nor of a direct suit brought to decree a patent to be void. But, as is well said by Chief Justice Williams, in *Rich v. Atwater*, 16 Conn. 409, 414, "That the validity of patent rights is a subject peculiarly within the jurisdiction of the courts of the United States is true; but it is equally true that when they come in question collaterally their validity must become a subject of inquiry in the State courts. Thus, in a suit upon a note, if

for the purchase-money of a patent right, for instance, may be defeated by proving that the patent was invalid and the con-

it is claimed that the note was given for a patent-right, and the patent is invalid, and so there was no consideration for the note, the State courts constantly exercise jurisdiction.' In *Rich v. Atwater* the plaintiff owned a patent for a machine which the defendant was infringing. The defendant, by a covenant, agreed not to use the infringing machine any longer, but nevertheless went on using it, and the plaintiff brought a suit founded on the agreement for an account and an injunction. The defendant offered to prove that the patent was invalid for want of novelty. The plaintiff objected to the evidence, and took the point before the full court, which held that the evidence was admissible. In *Cross v. Huntley*, 13 Wend. 385, the suit was brought on a note given on the sale of the patent for a machine. In defence it was proved that the machine was not new, and that the specification of the patent was so defective as to avoid the patent. Mr. Justice Nelson, in delivering the opinion of the court, says: "It is insisted by the defendant below that the patent is void, on the grounds (1), that the machine, for the making and vending of which the patent was granted, is not a new invention; and (2) if new in parts the patent is void, inasmuch as it is for the whole machine and not for the improvement. If either of these positions were sustained by the proof, the defendant was entitled to judgment in the court below, as in such case a failure of the consideration of the note was shown. From the evidence, there cannot be a doubt but that the patent, in both respects, is defective and void. . . . The patent being void, nothing passed to the plaintiff in error, and the note was given without consideration.' The case of *Head v. Stevens*, 19 Wend.

411, was one of the same character. It can make no difference whether the payee of the note, or the licensor in the license, brings the suit to enforce the note or the license, or whether the suit is brought by the maker of the note, or the licensee in the license, to cancel the instrument. The State court has jurisdiction in either case to inquire collaterally into the validity of the patent. It is true that a State court cannot entertain jurisdiction of a direct suit to repeal a patent. Every citizen has, abstractly, the same interest with every other citizen that a void patent shall not be in existence. Yet such interest is not sufficient to warrant the maintenance of a suit to repeal a patent. Such a suit cannot be brought in a State court." 6 Blatch. 356 (360).

Further, that validity, title, and infringement may be collaterally questioned in a State court, see *Continental Store Service Co. v. Clark* (1885), 100 N. Y. 365; *Brown v. Texas Cactus Hedge Co.* (1885), 64 Tex. 396; *Keith v. Hobbs* (1878), 69 Mo. 84; *Green v. Wilson* (1870), 6 C. E. Green (N. J.), 211; *Slemmer's Appeal* (1868), 58 Pa. St. 155; *Billings v. Ames* (1862), 32 Mo. 265; *Lindsay v. Roraback* (1858), 4 Jones Eq. (N. C.), 124; *Tomlinson v. Battell* (1857), 4 Abb. Pr. 266; *Vannini v. Paine* (1833), 1 Harr. (Del.) 65.

That a State court may collaterally inquire into identity of purpose and result, and into the utility of the invention, see *Hunt v. Hoover* (1868), 24 Iowa, 231.

That if the plaintiff must show the validity and existence of a patent in order to make out his case, the State courts have no jurisdiction, see *Tomlinson v. Battell* (1857), 4 Abb. Pr. 266; *Rich v. Atwater* (1844), 16 Conn. 409.

That a State court cannot go behind

tract therefore without consideration, but the judgment rendered affects only the contract, not the patent, and leaves the latter to stand or fall by the decision of the Federal courts.⁴ The same rules apply to actions *ex delicto*, as for a libel on a patent, — whatever the defendant may deem it expedient to allege, in excuse or justification of his acts, concerning the patentability of the invention, or the title of the patentee, being but collateral matter belonging to the field of evidence rather than to that of pleading, and in no wise determined by the judgment in that cause.

§ 866. Original Jurisdiction over Cases Arising under the Patent Laws is Vested in the Circuit Courts, and other Courts having Circuit Court Powers.

The entire original jurisdiction of the Federal courts over cases arising under the Patent Laws is vested in the Circuit courts, in the Supreme Court of the District of Columbia, and in such District courts as are endowed with Circuit court powers.¹ The Supreme Court of the United States obtains its jurisdiction by appeal from the Circuit Court.² These courts

a patent to inquire into its validity, see *Cowan v. Mitchell* (1872), 11 Heisk. (Tenn.) 87.

That it is doubtful whether a State court can pass upon novelty, see *Rawson v. Harger* (1878), 48 Iowa, 269.

That it is doubtful whether State courts of equity have concurrent jurisdiction where the Patent Laws are collaterally questioned, or where the relief would not invalidate the patent, see *Gibson v. Woodworth* (1840), 8 Paige (N. Y.), 132; qualifying *Burrall v. Jewett* (1830), 2 Paige (N. Y.), 134.

That a State court may punish for contempt in interfering with the receiver of a corporation appointed by the court, though the interference consists in the purchase of a new license by a member of the corporation for the making of an article which the corporation had an exclusive right to make, and which the receiver is making under order

of the court, and though such contempt is also an infringement, see *In re Woven Tape Skirt Co.* (1877), 12 Hun, 111.

⁴ That actions for royalties or purchase-money are within the jurisdiction of State courts though the validity of the patent, and the consequent want of consideration for the contract, are denied, see note 3, *ante*, and § 1257 and notes, *post*. But see *contra*, *St. Paul Plow Works v. Starling* (1888), 127 U. S. 376; 43 O. G. 1350.

§ 866. ¹ That the jurisdiction of the Circuit courts in patent cases is not changed by the Revised Statutes, see *Cochrane v. Deener* (1876), 94 U. S. 780; 11 O. G. 687.

That the Supreme Court of the District of Columbia has the same powers in patent cases as a Circuit court, see *Cochrane v. Deener* (1876), 94 U. S. 780; 11 O. G. 687.

² That the Supreme Court has no

will always consider the question of their jurisdiction, and a case improperly instituted will be dismissed or remanded to the appropriate tribunal.³ Objections to jurisdiction must be taken before the pleadings are closed and the evidence published, or they will be waived as far as the parties have power to waive them; but the want of jurisdiction on the ground of subject-matter is incurable by any laches of the parties, and whenever it may be discovered the case will be dismissed.⁴

original jurisdiction over questions of fact, such as infringement, &c., see *Wilson v. Barnum* (1850), 8 How. 258.

That the Supreme Court of the United States has no jurisdiction over a bill to enforce a contract for a patent unless the amount is over two thousand dollars, see *Brown v. Shannon* (1857), 20 How. 55.

³ That the Federal courts will always consider the question of their jurisdiction, see *Spring v. Domestic Sewing Mach. Co.* (1882), 22 O. G. 1445; 13 Fed. Rep. 446.

That a case erroneously brought from a State court will be remanded, on mo-

tion, where the want of jurisdiction appears, see *Teas v. Albright* (1882), 22 O. G. 2069; 13 Fed. Rep. 406.

⁴ That an objection to jurisdiction should be taken before the pleadings are closed and the evidence is published, see *Nesmith v. Calvert* (1845), 1 W. & M. 34; 2 Robb, 311.

That when the court has no jurisdiction the cause will be dismissed, see *Blanchard v. Sprague* (1859), 1 Clifford, 288.

That laches of the defendant cannot confer jurisdiction over the subject-matter, see *Creamer v. Bowers* (1887), 30 Fed. Rep. 185.

CHAPTER II.

OF WRONGS AGAINST UNPATENTED INVENTIONS.

§ 867. The Right of an Inventor to Preserve the Secret of his Invention Rests on Natural Law.

Whatever rights an inventor may possess in his unpatented invention vest in him by virtue of his inventive act alone. The conception of an idea of means makes that idea the absolute and exclusive property of its conceiver until in some manner he communicates it to others.¹ Although he embodies it in tangible materials and reduces it to practical operation it still belongs to him, unless its embodiment or operation discloses its essential characteristics to his fellow-men. In this condition of affairs the security of the inventor's property depends upon his preservation of his secret. While he successfully conceals the principle of his invention it is incapable of imitation, and his exclusive enjoyment of the fruits of his inventive skill must be as perfect and as certain as if sheltered under the most rigorous provisions of positive law.

§ 868. Forcible or Fraudulent Discovery of a Secret Invention Violates the Inventor's Rights.

The only wrong which an inventor can sustain in respect to his entirely undisclosed inventions, is that by which his secret is wrested from him against his will. This wrong may be committed either by force or fraud. Through physical compulsion, in the form of violence or threats, he may be driven to divulge the idea which he would otherwise have concealed, and be thus deprived of that exclusive knowledge which rendered his property in this idea secure. Or by a

§ 867. ¹ That an inventor preserving a right to its undisturbed enjoyment, his secret has, under the law of nature, see § 24 and notes, *ante*.

forcible invasion of his premises, or the asportation of the device in which his idea is embodied, the same result may be effected. Or by deceit and imposition he may be induced to yield the secret which he intended to preserve, and lose beyond recovery that dominion over it which, in the nature of things, was previously his.

§ 869. Remedies for the Forcible or Fraudulent Discovery of the Inventor's Secret.

The remedies for this wrong, in whatever way it may be committed, must be sought in the local courts having jurisdiction over the defendant, and in the ordinary forms of civil or equity procedure. The tort involved in either of its methods calls for compensation in damages, which are to be measured by the ordinary rules followed in other civil actions, and into which the violation of the inventor's secret may enter as a necessary element. The power which the wrong-doer has acquired to work him further injury through the possession and employment of his idea of means demands the interference of a court of equity, enjoining the defendant against the use of the invention and the communication of its principles to others. By these remedies, although the secret cannot be restored to the inventor nor the knowledge of it be obliterated from the memory of the wrong-doer, the disastrous consequences of the wrong to the inventor may be averted, and his practical enjoyment of his property be henceforth secured.¹

§ 869. ¹ Although direct authorities in support of these positions cannot be adduced, analogy and principle both require that this protection should be afforded to inventors who are not yet patentees. The case of an inventor whose process or device is wrongfully appropriated by another, without any prior contract between himself and the wrong-doer, so closely resembles that of an author whose productions are forcibly or fraudulently converted, that the rights and remedies of the latter may properly be predicated of the for-

mer. That the author has his remedies both at law and in equity is undoubted, see *Jeffreys v. Boosey* (1854), 4 H. L. 815, and other cases cited in *Kerr on Injunctions*, 182, &c. On principle, also, an inventor whose rights have been invaded by force or fraud without contract is certainly entitled to protection and redress, although courts of equity, in adherence to the ancient theories concerning their own jurisdiction in matters of tort, have formerly been inclined to refuse their assistance unless a trust relation of some character

§ 870. The Right of an Inventor to the Preservation of his Secret by those to whom he has Confidentially Communicated it.

Not every voluntary disclosure of his secret impairs the right of the inventor to an exclusive property in his unpatented invention. His confidential communication of it to others, through motives of friendship or of business, does not make it any less his secret or deliver it from his personal control.¹ It may be necessary to his practical enjoyment of its benefits that he should impart it to his co-partners or his employees, and if he does this under pledges of their secrecy, or with restrictions as to their power of using it or revealing it to others, he is entitled to have his confidence respected, and the limits he has fixed to the disclosure faithfully observed. An invention thus communicated does not cease to be a secret invention, however numerous the individuals may be on whom the knowledge of its essential characteristics is bestowed. They hold their knowledge in trust for the uses and purposes for which it was received, and are responsible to the inventor for their exact compliance with the conditions that he has imposed upon them.

§ 871. The Disclosure or Misuse of an Inventor's Secret by those to whom it was Confidentially Communicated is a Breach of Trust and Actionable.

The rights of an inventor in a secret invention, confidentially communicated to others, are capable of violation either on the part of those to whom it has never been disclosed by the inventor or on the part of those to whom he has entrusted it. With reference to the first class of persons it is still an entire secret, the knowledge of which they can obtain only by force or fraud. The wrongful acts by which they acquire possession of the secret are, therefore, as was stated in a preceding paragraph, torts to be compensated for in an action at

was discernible between the inventor and the defendant. See § 872 and notes, *post*.

§ 870. ¹ That an inventor may communicate his secret to others, in con-

fidence, without losing his exclusive rights therein, see *Salomon v. Hertz* (1886), 35 O. G. 1109; *Peabody v. Norfolk* (1868), 98 Mass. 452.

law for damages, while the practical enjoyment of the stolen secret is prevented by injunction.¹ With reference to the second class of persons the invention, though no longer secret, is known only for certain definite purposes, within the scope of which their employment of their knowledge must be confined. Any use of their knowledge for a different purpose, and any communication of it to others beyond the limits of the authority conferred upon them by the inventor, is a breach of trust, and an invasion of the rights expressly or impliedly reserved to him in the disclosure through which their own knowledge of the invention was obtained.

§ 872. Remedies for the Disclosure or Misuse of the Inventor's Secret.

The remedy for wrongs already committed against an inventor by persons entrusted with his secret is an action at law for damages in the State courts, or, where citizenship confers the necessary jurisdiction, in the Federal courts. This action has been variously regarded as one of tort based on the fraud involved in the breach of trust or as one of contract on the express or implied agreement to respect the reserved rights of the inventor, but in one form or the other adequate compensation is awarded for the injury sustained. Against a future and expected invasion of the inventor's rights equity will interpose an injunction, forbidding the unauthorized use of the knowledge of the defendant or his disclosure to others of the secret of the invention.¹ The latter remedy is open to the personal representatives of a deceased inventor, and to

§ 871. ¹ See § 869, *ante*.

§ 872. ¹ That equity will protect an inventor who preserves his secret against its fraudulent disclosure by another, see *Peabody v. Norfolk* (1868), 98 Mass. 452.

That the contract of a workman to preserve his employer's secret can be enforced in equity, see *Peabody v. Norfolk* (1868), 98 Mass. 452.

That an injunction will issue to prevent an employee from fraudulently dis-

closing the secret invention of his employer, see *Salomon v. Hertz* (1886), 35 O. G. 1109.

That whenever the disclosure of a secret invention involves a breach of trust or contract, equity will prevent it by injunction, see *Morison v. Moat* (1851), 9 Hare, 241; 21 L. J. Ch. 248; *Green v. Folgham* (1823), 1 S. & St. 398; *Yovatt v. Winyard* (1820), 1 J. & W. 394; *Williams v. Williams* (1817), 3 Mer. 157; *Smith v. Dickenson* (1804),

those whose fiduciary relations toward the defendant are derived from and identical with his.²

§ 873. **The Right of an Inventor to his Secret Protected though the Secret Invention is not Patentable.**

As the rights of an inventor to his secret invention, and to a remedy for the wrongs by which his property therein is injured, are not dependent upon the provisions of Patent Law, they exist equally whether the invention is or is not in its nature patentable. It must indeed be the product of inventive skill, for otherwise no title to it could vest in its inventor. But numerous products of inventive skill lie outside the field of those six classes of inventions which the Patent Law has undertaken to protect, and these are often as meritorious and valuable as those for which a patent can be legally granted. If the creator of these unpatentable inventions chooses to preserve his secret he has a right to do so, as also to communicate it confidentially under such restrictions as he deems expedient, and for an invasion of his rights he has the same redress as if the subject-matter of his invention were entitled to the protection of a patent.¹

3 Bos. & Pul. 630 ; Kerr on Injunctions, 181 ; Coryton on Patents, 30 ; Phillips on Patents, 333-341 ; Godson on Patents, 170.

Contra, *Newberry v. James* (1817), 2 Mer. 446.

² That an executor may maintain a bill in equity to protect the secret of his decedent, see *Peabody v. Norfolk* (1868), 98 Mass. 452.

§ 873. ¹ In *Peabody v. Norfolk* (1868), 98 Mass. 452, Gray, J. : (458) "If he invents or discovers, and keeps secret a process of manufacture, whether a proper subject for a patent or not, he has not indeed an exclusive right to it as against the public, or against those who in good faith acquire knowledge of it ; but he has a property in it which a

court of chancery will protect against one who, in violation of contract and breach of confidence, undertakes to apply it to his own use, or to disclose it to third persons. The jurisdiction in equity to interfere by injunction to prevent such a breach of trust, when the injury would be irreparable and the remedy at law inadequate, is well established by authority."

That a secret scientific invention improving a process may be protected by an injunction in the State courts, though it is not of a patentable nature, and persons who are intrusted with the secret may be enjoined from disclosing it, see *Hammer v. Barnes* (1863), 26 How. Pr. 174.

§ 874. The Right of an Inventor to his Unpatented Invention Forfeited by its Unrestricted Disclosure to Others unless Protected by Statute.

In the absence of any provision of positive law relating to the subject, the unrestricted disclosure of his secret by the inventor is destructive to his property therein. His idea of means then passes into the possession of mankind, becomes a portion of the common stock of knowledge, is open to the enjoyment of all who choose to use it, and thus escapes entirely from the ownership and control of the inventor.¹ It is immaterial whether such disclosure be made to one person or to many, since an unrestricted communication to a single individual gives him the right to disseminate his information without limit and thereby effectually and permanently deprives the inventor of his dominion over the invention. Nor is the method by which the disclosure is accomplished of any consequence provided that it be complete and voluntary. Verbal descriptions, drawings, models, the practical employment of the invention, the gift or sale of articles in which it is embodied, alike render it accessible to the general public and terminate the exclusive rights of its inventor.

§ 875. The Right of an Inventor to his Unpatented Invention, Notwithstanding its Unrestricted Disclosure to Others, Protected by Statute during, and for Two years Prior to, his Application for a Patent.

Under the laws of the United States, however, an exception to this general rule has been established. A patentable invention may be used openly by the inventor, and freely communicated by him to others, for the space of two years before his application for a patent as well as during the pendency of his application, without the dedication of his invention to the public, and consequently without forfeiting his right to its protection by a patent. Concerning the effect of this provision upon the right of the inventor to a patent and upon the completeness of the protection afforded him after the patent has been granted, there can be no question. In reference to these points, his situation is the same as if he had preserved

§ 874. ¹ See §§ 24, 71, 345-360 and notes, *ante*.

his secret until his patent had been issued. But concerning the nature of his property in the invention during this period of open use before the patent, the mode by which his rights in it are vindicated, and the forum in which his remedies for their invasion must be sought, some doubts exist which only future decisions or legislation can resolve. Yet reason and analogy indicate, sufficiently to warrant their discussion, the principles upon which these doubts must be settled, and the results at which the legislatures and the courts must eventually arrive.

§ 876. Three Views of the Inventor's Right to his Disclosed Invention, under this Statute, During and Prior to his Application for a Patent.

As to the nature of the inventor's property in his unpatented invention during this period of unrestricted disclosure, three views are possible: (1) That such disclosure deprives him of his vindicable property in the invention until the patent issues, leaving it open meanwhile to the public use, without power on his part to prevent it or liability on theirs for its employment, and that the issue of the patent reverts in him this property with all the other rights of the monopoly; (2) That such disclosure does not affect the property of the inventor nor confer upon the public the right to use the invention, but suspends his power to protect and vindicate it until his patent has been granted, the remedies then afforded relating back and covering the wrongs committed before the issue of the patent; (3) That notwithstanding such disclosure the invention still possesses all the attributes of a secret invention, remaining under the inventor's entire control and entitled to the same protection as if it continued undisclosed.

§ 877. First View, — Temporary Abandonment and Resumption, — Untenable.

The first of these views is evidently untenable. A temporary abandonment of the invention, followed by its resumption at the issue of the patent, is in opposition to the fundamental notion of abandonment, which consists in an irrevocable dedication to the public. It confers no important benefit on the

community at large to allow them to enjoy an invention of which they may, at any moment, be deprived, while it imposes an unnecessary and unreasonable burden on the inventor as the condition of his own privilege of public use and sale. It was, of course, within the power of Congress to separate, for the time being, the right to a patent from the property in the invention, and permit its disclosure to suspend the latter in favor of the public, though it preserved the former in full force against them. But nothing in the spirit of the law, or in the language or the object of this particular provision, is in harmony with this position. Before the insertion of this clause in the statutes the inventor was, as he still is, completely protected in his ownership of the invention, unless he voluntarily and without restrictions communicated it to others, in which case his invention was abandoned without the possibility of a recovery. This clause prevents the public from taking advantage of such unrestricted disclosure as an abandonment of the invention, except when it has continued beyond a certain period or was accompanied by other circumstances which established an intention to abandon; and though the principal relief expected was undoubtedly to be afforded by still permitting the inventor to obtain a patent, there is no indication that in other respects the invention was to lie at the mercy of the public. On the contrary, the whole doctrine of public use and sale, as expounded by the courts, regards the invention as within the dominion of the inventor, however freely he may part with his control over the articles in which it is embodied. Until, therefore, this first view has been explicitly adopted by competent authority as truly presenting the rights of the inventor during this period of unrestricted disclosure, it must be presumed to be erroneous and deserving of no serious attention.

§ 878. Second View, — that Violations of this Right are Infringements for which an Action will lie after the Patent is Granted, — Objectionable.

According to the second view, the property of the inventor is not affected by his disclosure, but his pursuit of a remedy for its invasion is postponed until his patent has been granted.

In support of this view certain reasons may be urged which are entitled to consideration. The first grows out of the uncertainty whether the inventor will procure, or even attempt to procure, a patent, and the injustice of allowing him to retain, for any period, his control over an invention which he has fully communicated to the public and for which he is unable, or does not purpose, to secure the exclusive privileges of a patentee. Opposed to this reason, however, is the rule that the presumption that the inventor does not intend to abandon his invention can be rebutted only by conclusive evidence that he has such an intention, that his disclosure unaccompanied by other acts within the period prescribed is not such evidence, and therefore that until this period has elapsed he must be regarded as expecting to obtain a patent and perpetuate his rights. Another reason rests upon the fact that his rights after disclosure subsist only by virtue of the positive provisions of the Patent Laws, under which he can have no remedy until the patent has been granted. This reason cannot prevail; first, because wherever the law creates or declares a right and does not provide a remedy, the owner of the right may have recourse to any appropriate existing remedy, — of which in this case there are several, both at law and equity; second, because although this right depends upon the Patent Law, it is not a right under or collateral to a patent, but the prolongation and enlargement of a natural right, which is capable of protection and vindication in the same manner as if no disclosure had been made. Other reasons of less weight than the foregoing might be suggested in support of this view, but to each of them the answer is so clear that in the absence of express decisions in its favor adherence to it as the true statement of the inventor's rights must be withheld.

§ 879. Third View, — that the Right of the Inventor under this Statute is a Continuation of his Natural Right and Entitled to the same Protection, — Probable.

According to the third view the inventor's property in his invention and his right to an immediate remedy in case of its actual or threatened invasion are not affected by its unrestricted disclosure, unless such disclosure is protracted

beyond the lawful period or is accompanied by other acts establishing his intention to abandon it. In other words, his invention, though universally known, has all the legal attributes of a secret invention until the lapse of time or other circumstances make it apparent that the inventor has dedicated it to the public. This view is the most simple, the most intelligible, and the most consistent with the liberal spirit of our laws toward the inventor. That it is also the correct one is shown by the purpose and character of this provision of the law itself, and by its agreement with the other rights which are already recognized as vesting in him. At the time of the introduction of this provision into our Patent Law, the inventor did not lose his property in his invention, nor his right to protect it by immediate remedies and to secure for it the ultimate protection of a patent, by any involuntary disclosure or by any voluntary disclosure in the confidence of business or of friendship. As this provision was evidently not intended to restrict the rights of the inventor it must have been intended to extend them, and to extend them in such directions as would relieve him from existing difficulties. His principal difficulties at that time were these: the difficulty of proving that a given disclosure was confidential or restricted by conditions; the difficulty of ascertaining whether his invention had sufficient commercial value to warrant him in patenting it, unless it could be, to some extent, subjected to the test of public use; and the difficulty of determining whether the instrument or operation produced by the inventor were original with him, and due to his inventive rather than his imitative skill, until it had been submitted to those acquainted with the art, among whom alone its prior existence and its patentable merit could be known. Congress removed these difficulties by fixing a period within which it should be immaterial whether the disclosure were confidential or unrestricted, and during which the commercial importance of the invention and its patentable merit could be fully ascertained. But it had no occasion to interfere with the property or the remedies already conferred on the inventor, or to introduce new theories of ownership, or to establish new relations between him and the public. The simple provision that two

years of unrestricted disclosure should be allowed to the inventor without affecting his rights in his invention was sufficient to accomplish all the objects for which this alteration in our law was then designed.

§ 880. Third View Alone Consistent with the Other Rights of the Inventor in his Unpatented Invention.

Moreover, the character of this provision itself indicates that this view is correct. It fixes a limit only to use or sale with the inventor's knowledge and consent. Under it an unauthorized use or sale for any period of time, however long, confers no rights upon the public and curtails no rights of the inventor.¹ Although a single instance of authorized use or sale may place the invention within the knowledge of the public, the possession of such knowledge does not empower them to employ it without the inventor's acquiescence or consent. The language of this provision thus contemplates a complete dominion of the inventor over the enjoyment of his invention except so far as he relinquishes it in favor of individual vendees or licensees, — a dominion which would be practically valueless were he not able to assert it by the immediate application of remedies for its invasion.

§ 881. Third View Alone Consistent with the Contract Rights of the Inventor in Reference to his Unpatented Invention.

Again, during this period of unrestricted disclosure, the law recognizes the contract rights of the inventor over his invention as unimpaired, and affords him ample and immediate remedies for their violation. He can assign it with or without the right to obtain a patent; he can license its employment in such a manner as to bind him as well after as before the patent has been granted; and the obligations growing out of these conveyances can be enforced irrespective of the issue of a patent. It would be indeed a strange anomaly in our law if property thus the subject of a contract were not also

§ 880. ¹ It will be perceived that which was recognized in all our courts in this connection the author adheres prior to the new departure discussed in to the view of public use and sale § 357 and notes, *ante*.

regarded as liable to tortious injury, or if the remedies for the latter class of wrongs were suspended while the remedies for the former were applied. Analogy requires that the ownership of the inventor should be protected against invasion by the tort-feasor as well as against breaches of contract, and that his action for either injury should be at once available.

§ 882. Third View Indicates that the Inventor's Right, under this Statute, is Subject to the same Violations and Entitled to the Same Redress as his Right to his Secret Invention.

It may, therefore, be safely predicted that when the law on this point becomes settled, the third view of the inventor's rights will be the one adopted by the courts, and that pending this period of unrestricted disclosure his invention will be treated as within his own control as fully as while he still preserved his secret. In this event the wrongs by which his property in it may be violated, and the remedies by which those wrongs may be redressed, must be the same as those already discussed with reference to secret inventions. For its unauthorized employment an action for damages must lie at law, the damages being computed on the same general basis as if the suit were brought for the infringement of a patent. For a threatened infraction of his rights an injunction must be obtainable in equity.¹

§ 883. Inventor's Right in his Unpatented Invention not Violated by the Independent Inventive Acts of Others, nor by the Enjoyment of their Results.

It is to be remembered that the wrongs considered in this chapter can be committed only by the unauthorized appropriation of the fruits of the inventor's own inventive skill. His property vests in him by virtue of his inventive act, and is invaded only when the results of that inventive act are

§ 882. ¹ That an infringement after the patent has been applied for, and pending proceedings in the Patent Office, may be prevented by injunction, see *Butler v. Ball* (1886), 28 Fed. Rep. 754; 38 O. G. 420.

That an injunction will lie to prevent the unauthorized use of an uncopyrighted production, see *Goldmark v. Kreling* (1885), 25 Fed. Rep. 349; 11 Sawyer, 215; *Kerr on Injunctions*, 182.

forcibly or fraudulently converted to the use of others. An independent exercise of inventive skill by a different inventor, though developing and embodying the same idea of means, is not a violation of his rights, but on the contrary confers on that inventor the same property and privileges that he enjoys. Rival inventors in their use of their own inventions are, therefore, not tort-feasors as against each other, nor is the invader of the rights of one necessarily a transgressor against the other. To be liable to either, the wrong-doer must not only have appropriated the invention, but appropriated it from him. It is not until a patent has been granted that the question of priority of invention can be settled, and the first and true inventor can monopolize the invention against all mankind.

CHAPTER III.

OF WRONGS AGAINST PATENTEES.

§ 884. Wrongs against a Patentee are Violations of his Right in his Monopoly.

By the issue of letters-patent the inventor is endowed with a monopoly in the invention against all other persons, — rival inventors as well as mere imitators, — and is entitled to its uninterrupted enjoyment, without loss, diminution, or control, except by due process of law. Any act of others by which its value to him is wrongfully decreased is an injury to his rights as patentee for which the law, whereby these rights are created or declared, is bound to provide an ample and appropriate remedy. No act, however, constitutes a wrong against the patentee unless it embraces both elements of a tort, the *damnum* and *injuria*. A lawful act, such as the original invention of a superior art or instrument, may entirely destroy the commercial importance of his patent and render all his labor and expenditure in connection with it utterly unproductive. This is *damnum absque injuria*, for which of course no action lies. In order to invade his rights as patentee such acts must be directed against the monopoly conferred upon him by the patent, attacking the franchise which it purports to bestow, and destroying or curtailing the privileges which, by virtue of it, he alone is authorized to enjoy.¹

§ 884. ¹ Injuries to a patented article by force or negligence, and injuries to a patented art or instrument by acts or representations creating doubts as to its industrial value, are simple torts, not affecting the existence or title to the monopoly, and are remediable, if at all, under the provisions of the common law, in the courts having jurisdiction over the parties.

§ 885. Rights in a Monopoly Violated by Injuring the Reputation of the Patented Invention or by its Unauthorized Use.

The rights conferred by a patent are subject to two forms of injury. One is committed by maliciously and publicly injuring the reputation of the patented invention, and does not involve the use of the invention itself; the other consists in an unauthorized use of the invention in violation of the exclusive privilege granted by the patent, with or without a denial of its validity. The latter wrong, commonly called infringement, is by far the most important, and is the occasion of nearly all the actions brought by patentees in vindication of their rights. But the former is of not infrequent occurrence and is often sufficiently disastrous in its consequences to the patentee to warrant his pursuit of the remedies which, in such cases, the law affords. These two wrongs we shall now consider, giving attention first to slander or libel against a patented invention, and second, to infringement.

SECTION I.

OF SLANDER OR LIBEL AGAINST A PATENTED INVENTION.

§ 886. Nature of the Injury Inflicted by Slander or Libel against a Patented Invention.

The commercial value of his patent to the patentee depends, in a great degree, upon the opinion entertained by other men concerning its validity. A patent is valid when its subject-matter is patentable and when the patentee is the first and true inventor. An opinion that the subject-matter is not patentable tends to promote infringements of the patent and to deprive the patentee of that dominion over his invention which it is the purpose of the patent to secure. An opinion that the patentee is not the first and true inventor destroys that confidence in his power to confer indisputable titles on his assignees and licensees without which it is often impossible for him to profit by his own invention. The dissemination of either of these opinions is thus an injury to the patentee,

and if malicious and unlawful is a wrong for which he is entitled to receive redress.¹

§ 887. Slander or Libel against a Patented Invention by Denying its Patentability.

The publication, verbal or in writing, of statements impugning the validity of a patent on the ground of the non-patentability of its subject-matter, are *prima facie* wrongful. The issue of a patent constitutes presumptive evidence that the invention comes in all respects within the purview of the law and is entitled to protection, and any private individual who publicly avers the contrary does so at his peril.¹ Like other slanders against business interests this is actionable only when it causes special damage, and it may be justified or excused by the defendant in the usual modes pertaining to this class of injuries.²

§ 888. Slander or Libel against a Patented Invention by Denying that the Patentee was the First and True Inventor.

Statements derogatory to the title of the patentee, as the first and true inventor, occupy a somewhat different position. When made by persons having no claim of right to the invention as the product of their own creative skill, they are slanders or libels for which a proper remedy may be obtained.¹

§ 886. ¹ That a libel or slander against a patent right is an injury for which the courts will afford an adequate redress, see *Palmer v. Travers* (1884), 20 Fed. Rep. 501; 22 Blatch. 185; *Bell v. Singer Mfg. Co.* (1880), 65 Ga. 452; *Whitehead v. Kitson* (1876), 119 Mass. 484.

That it is a libel to charge a man with infringing a patent, see *Watson v. Trask* (1834), 6 Ohio, 531.

That an infringer will not be protected against circulars warning the public, and the burden of proof as to his non-infringement is on him, see *Barney v. United Telephone Co.* (1884), L. R. 28 Ch. D. 394.

§ 887. ¹ That a public denial of the

title to a patented invention, if malicious, is actionable, see *Bigelow Leading Cas. Torts*, 42; 2 *Addison on Torts*, § 1137, p. 969, ed. 1876.

² That a libel or slander against the title to an invention is not actionable unless causing special damage, see 2 *Addison on Torts*, § 1137, p. 969, ed. 1876; 1 *Hill. Torts*, 342, *note*.

§ 888. ¹ That the public denial that the patentee or his assignor was the first and true inventor, if malicious and causing special damage to the owner of the patent, is actionable, see *Emack v. Kane* (1888), 34 Fed. Rep. 46; *Halsey v. Brotherhood* (1879), L. R. 15 Ch. D. 514; 19 Ch. D. 386; *Wren v. Weild* (1869), L. R. 4 Q. B. 730.

But rival inventors, whether patentees or not, may protect their own interests and warn the public against infringing on their rights by giving notice of their claims and denying the validity of a rival patent.² Such notices, however, must be couched in moderate language, and having conferred upon the public the necessary information must refrain from superfluous adverse commentary on the existing patent.³ Any excess, even in this case, becomes a libel for which the patentee may have redress.

§ 889. **Remedy for Slander or Libel against a Patented Invention.**

The remedy at law for slander against a patent is an action on the case praying damages according to the injury actually sustained. Whether equity affords relief by interfering to prevent the repetition of the wrongful publication has been variously held, — in some States the patentee being left to his legal remedy, in others being protected by injunction.¹ Where

² That a patentee may circulate notices warning the public not to buy the invention except from him, see *Hovey v. Rubber Tip Pencil Co.* (1871), 33 Sup. Ct. N. Y. 522.

That parties claiming rights under patents may publish their own claims and warn others, and if they act in good faith they will not be restrained, see *Croft v. Richardson* (1880), 59 How. Pr. 356.

That a circular forbidding persons to buy articles claimed to be infringements is not a libel calling for damages or injunction if in good faith, and the circulator's patent is apparently valid, see *Société Anonyme v. Tilghman's Patent Sand Blast Co.* (1883), L. R. 25 Ch. D. 1; *Halsey v. Brotherhood* (1879), L. R. 19 Ch. D. 386.

That a patentee will not be enjoined from circulating notices that his patent is infringed where the question of infringement had never been decided, and the patentee was guilty of no fraud, see

Chase v. Tuttle (1886), 27 Fed. Rep. 110.

That it is doubtful whether the Circuit Court has power to enjoin the publishing of circulars warning the public against certain infringements, see *Chase v. Tuttle* (1886), 27 Fed. Rep. 110.

That equity cannot restrain a plaintiff from publishing the fact that the defendant has been enjoined, see *Westinghouse Air Brake Co. v. Carpenter* (1887), 32 Fed. Rep. 545.

³ That in publishing the claims of patentees excessive language must not be used, beyond what is necessary to give the proper information, and any excess will be enjoined, see *Croft v. Richardson* (1880), 59 How. Pr. 356.

§ 889. ¹ That equity will enjoin against a libel on a patent right, see *Emack v. Kane* (1888), 34 Fed. Rep. 46; *Bell v. Singer Mfg. Co.* (1880), 65 Ga. 452. *Contra*, *Baltimore Car Wheel Co. v. Bemis* (1886), 29 Fed. Rep. 95; 38

the alleged offender is a rival inventor, but not a patentee, good faith requires him to make a speedy application for a patent in order that the question of priority between himself and the subsisting patentee may be determined; and his failure so to do deprives him of the excuse for his attack upon the patent which a diligent protection of his interests would otherwise afford.² The forum in which these remedies of the patentee are to be sought is that of the State having jurisdiction of the defendant, the Federal courts having no cognizance of such actions except in cases between citizens of different States.³

SECTION II.

OF INFRINGEMENT.

§ 890. Infringement Defined.

The issue of a patent confers upon the patentee the exclusive right to make, use, and vend the patented invention, throughout the United States and the Territories thereof, during the period for which the patent has been granted. The infringement of a patent, being the invasion of this exclusive right, therefore consists in the manufacture, use, or sale of the invention protected by the patent within the area and time described in the patent, by any person not duly author-

O. G. 1132; *Kidd v. Horry* (1886), 28 Fed. Rep. 773.

That equity has no jurisdiction of libel or slander affecting the title to a patent right, and cannot interfere unless a repetition is threatened and preventive measures become necessary, the remedy for past injuries being at law, see *Palmer v. Travers* (1884), 20 Fed. Rep. 501; 22 Blatch. 185.

That equity has no jurisdiction over a libel or slander or false representations that the plaintiffs are infringing a patent, unless there is a breach of trust or contract, the remedy, if any, being at law, see *Boston Diatite Co. v. Florence Mfg. Co.* (1873), 114 Mass. 69.

That no injunction will issue against one who falsely represents that the patentee's invention is an infringement of his, and thus deters purchasers, see *Whitehead v. Kitson* (1876), 119 Mass. 484.

² That one who claims that a patented invention is in fact his own discovery, must apply for a patent, if entitled to one, in order to justify his claims, see § 722 and notes, *ante*.

³ That the Federal courts have no jurisdiction over actions for libel or slander against patent rights where the parties are citizens of the same State, see *Prime v. Brandon Mfg. Co.* (1879), 16 Blatch. 453; 4 Bann. & A. 379.

ized to do so by the patentee.¹ As this is the principal wrong which an inventor is able to sustain, and as it forms the cause of action in by far the greater proportion of the suits to which the inventor is a party, it demands and will receive an extended consideration. In discussing it three topics require attention: (1) The invention whose manufacture, use, or sale constitutes the act of infringement; (2) The nature of the act of infringement, with the time when, the place where, the persons by whom, and the knowledge or intent with which it must be performed; (3) The application of the foregoing propositions to each of the six classes of inventions.

§ 891. No Infringement Exists unless the Invention Unlawfully Used is Identical with that Protected by the Patent.

The invention whose manufacture, use, or sale constitutes the infringement of a patent is the invention covered and protected by the patent.¹ The theory of the patentee as to the nature and scope of his invention is immaterial; its actual character as it exists practically in the arts is equally unimportant; the patent protects only the patentable subject-matter which it specifically claims, and is capable of infringement only by an invasion of the inventor's rights in that invention.² Hence, as no invention can be claimed in a patent unless it has been so described that any person skilled in the

§ 890. ¹ That infringement is a question of mixed law and fact, see *California Artificial Stone Paving Co. v. Molitor* (1885), 113 U. S. 609; 31 O. G. 1044.

§ 891. ¹ That an infringement is a copy made after and agreeing with the principle laid down in the patent, see *Page v. Ferry* (1857), 1 Fisher, 298.

That a device not covered by the patent does not infringe though it effects the same purpose as the patented invention, see *Toohy v. Harding* (1880), 1 Fed. Rep. 174; 4 Hughes, 253; 5 Bann. & A. 195.

That an article is not an infringement unless it is to be used as pointed out in the patent, see *Campbell v. Kav-*

anaugh (1882), 11 Fed. Rep. 83; 20 Blatch. 256.

That a person who licenses others to use certain improvements of his own does not infringe the original patent, see *Hussey v. Bradley* (1863), 2 Fisher, 362; 5 Blatch. 134.

² That the theory of the patentee as to his invention is of no consequence on the question of infringement, see *Foss v. Herbert* (1856), 2 Fisher, 31; 1 Bissell, 121.

That whether a device is an infringement is determined by the Claims of the patent, not by the actual invention, see *Meissner v. Devos Mfg. Co.* (1872), 2 O. G. 545; 9 Blatch. 363; 5 Fisher, 285.

art could practise it without a further exercise of the inventive faculties, an invention which is not disclosed in the patent, or is only partially disclosed, although alluded to and indispensable to the enjoyment of the inventions properly claimed, is not susceptible of an infringement.³ But every invention lawfully described and claimed is covered by the patent, and where a patent includes two or more inventions the wrongful manufacture, use, or sale of either one is an infringement of the patent.⁴

§ 892. Identity, how Determined.

The identity of the invention made, used, or sold by the alleged infringer with that described and claimed in the patent

That the use of one form of old devices is no infringement of a patent which claims only a new form of them, see *Barker v. Todd* (1882), 13 Fed. Rep. 473 ; 22 O. G. 1448.

That an invention which would not anticipate will not infringe, see *Cook v. Sandusky Tool Co.* (1884), 26 O. G. 1114. This can be true only where the scope of each invention is the same, not where the infringing device is merely included in the patented invention.

³ In *Page v. Ferry* (1857), 1 Fisher, 298, *Wilkins, J.* : (309) "An infringement will not have taken place unless the invention can be practised completely by following the specifications. An infringement is a copy made *after*, and agreeing with the principle laid down in, the patent ; and if the patent does not fully describe *everything* essential to the making of the thing patented, there will be no infringement by the fresh invention of processes which the patentee has withheld from the public."

That if the patented invention is not operative it cannot be infringed by one that is, see *Royer v. Coupe* (1886), 29 Fed. Rep. 358 ; 39 O. G. 239.

⁴ In *Lee v. Blandy* (1860), 2 Fisher,

89, *Leavitt, J.* : (92) "There can be no question but that there may be a claim for two inventions in the same patent, if they both relate to the same machine or structure ; and an action can be sustained for the infringement of either one or the other of these separate inventions where claimed as separate and distinct in their character. There can be no doubt if one of these be infringed it is properly a subject for an action." 1 Bond, 361 (365).

See also *Matthews v. Spangenberg* (1883), 23 O. G. 1624 ; 15 Fed. Rep. 813 ; *Singer v. Walmsley* (1860), 1 Fisher, 558 ; *Waterbury Brass Co. v. N. Y. & Brooklyn Brass Co.* (1858), 3 Fisher, 43 ; *Emerson v. Hogg* (1845), 2 Blatch. 1 ; *Moody v. Fiske* (1820), 2 Mason, 112 ; 1 Robb, 312.

That two patents cannot supplement each other, but each by itself is the sole subject of infringement, see *Blades v. Rand, McNally, & Co.* (1886), 27 Fed. Rep. 93 ; 37 O. G. 99.

That one valid Claim in a re-issue may be infringed though the other Claims are not valid, see *Cote v. Moffitt* (1883), 15 Fed. Rep. 345 ; and § 684, note 5, *ante*.

is determined by the same tests which are applied in ascertaining the novelty of an invention when comparing it with things already known.¹ Novelty and infringement are not precisely the same questions, since an invention, however new, may include some patented instrument or operation and thus be an infringement.² But into both these questions that of identity enters as an essential factor, and in each it is settled by a reference to the same standards and in accordance with the same rules. As these have been discussed at great length in connection with the subject of novelty, a general review of them in this place will be sufficient.

§ 893. Identity must be Identity in the Idea of Means.

In the first place, the identity sought and found must reside in the idea of means embodied in each invention.¹ Whether the purpose intended, the effect produced, or the functions performed are the same is of no consequence, except that functions and effects which are essentially distinct indicate

§ 892. ¹ That identity is determined by comparing the two inventions, see *Fuller v. Yentzer* (1876), 94 U. S. 288; 11 O. G. 551.

That inventions which are the same in fact are the same in law, see *Ex parte Merrill* (1874), 5 O. G. 120; 1 MacArthur, 301.

That expert evidence may aid in determining identity, see *Page v. Ferry* (1857), 1 Fisher, 298.

See also §§ 228-314 and notes, *ante*.

² That novelty and infringement are in some respects different questions so far as the relations of different inventions to each other are concerned, see *Union Sugar Refinery Co. v. Matthieson* (1865), 2 Fisher, 600; 3 Clifford, 639; *Judson v. Cope* (1860), 1 Fisher, 615; 1 Bond, 327.

§ 893. ¹ In *Burr v. Cowperthwait* (1858), 4 Blatch. 163, Ingersoll, J.: (167) "The end or result produced is not secured by the patent, but only the substantial means used and specified to produce the end or result, — these, and

nothing more. The same end or result may be produced by means other than those substantially described in the specification without infringing the patent."

In *American Pin Co. v. Oakville Co.* (1854), 3 Blatch. 190, Ingersoll, J.: (192) "The rules thus laid down must govern this case. The patent does not secure to the patentee the result or effect produced, but only the means described by which such result or effect is produced. The means which he specifies to produce the result or effect are secured, and nothing more. And all other means to produce the same result or effect, and not patented to any one, are open to the public."

See also *Dryfoos v. Wiese* (1888), 42 O. G. 490; *Dryfoos v. Wiese* (1884), 26 O. G. 639; 22 Blatch. 19; 19 Fed. Rep. 315; *Hall v. Stern* (1882), 15 Fed. Rep. 463; 24 O. G. 206; *Anilin v. Levinstein* (1883), L. R. 24 Ch. D. 156.

essential differences in the means.² In comparing these ideas of means it must be borne in mind that identity, with reference to infringement, does not require that each idea shall be the exact counterpart of the other. The idea covered by the patent must be completely embraced in the idea expressed in the infringement, but the latter may be far more comprehensive than the former.³ A familiar instance occurs where a patented invention is employed as an element in a later combination, — the combination being no less an infringement of the patent because it includes many other subordinate ideas of means. Identity exists, therefore, with reference to the question of infringement, if the idea of means protected by the patent is found, substantially existing, in the invention practised by the alleged infringer.⁴

§ 894. Identity in Ideas of Means, how Determined.

Identity in the ideas of means subsists where the compared inventions perform the same functions by the same modes of

² That where the same advantages are gained by substantially the same means there is an infringement, see *Wallicks v. Cantrell* (1882), 15 Phila. 446; 21 O. G. 1878; 12 Fed. Rep. 790; *California Artificial Stone Paving Co. v. Perine* (1881), 8 Fed. Rep. 821; 20 O. G. 813; 7 Sawyer, 190.

That if the principle of an invention is pirated there is an infringement, see *Page v. Ferry* (1857), 1 Fisher, 298.

That identity of ideas, though different in appearance, is infringement, see *Smith v. Higgins* (1859), 1 Fisher, 537.

³ That a device employing an essential feature of the patented invention is an infringement, see *Forehand v. Porter* (1883), 15 Fed. Rep. 256.

That wherever the defendants' devices require the use of those patented there is an infringement, see *Sayles v. Chicago & Northwestern R. R. Co.* (1871), 4 Fisher, 584; 3 Bissell, 52.

That the test of infringement is whether the defendant uses anything

which the plaintiff invented, see *Crompton v. Knowles* (1881), 7 Fed. Rep. 199; *Crompton v. Knowles* (1881), 7 Fed. Rep. 204.

That a device may be an infringement though it constitutes a new invention, see *Zeun v. Kaldenberg* (1883), 16 Fed. Rep. 539; 23 O. G. 2514.

⁴ That the infringing art or article must embrace the substance of the patented invention, see *Sessions v. Romadka* (1884), 28 O. G. 721; 21 Fed. Rep. 124; *Morgan Elevated R. R. Co. v. Pullman* (1882), 14 Fed. Rep. 648; *Henderson v. Cleveland Co-operative Stove Co.* (1877), 12 O. G. 4; 2 Bann. & A. 604; *Sewall v. Jones* (1875), 91 U. S. 171; 9 O. G. 47; *Converse v. Cannon* (1873), 9 O. G. 105; 2 Woods, 7; *McComb v. Brodie* (1872), 2 O. G. 117; 5 Fisher, 384; 1 Woods, 153; *Carter v. Baker* (1871), 4 Fisher, 404; 1 Sawyer, 512; *Smith v. Higgins* (1859), 1 Fisher, 537; *Smith v. Downing* (1850), 1 Fisher, 64.

operation. If the effects produced are substantially different, there is no identity.¹ If the effects are the same and the functions are essentially distinct, there is no identity.² If the functions are the same and the modes of operation by which they are performed are radically unlike, there is no identity.³ Contrariwise, where the effects are identical, the functions identical, and the modes of operation identical, the ideas embodied in the two inventions must also be identical.⁴ Identity being thus established, all variations in shape, size, capacity, arrangement, and materials become unimportant.⁵ The sub-

§ 894. ¹ That difference in the nature of the result shows that there is no infringement, see *May v. County of Fond du Lac* (1886), 27 Fed. Rep. 691.

That identity of result is *prima facie* evidence of identity of process where both are new, see *Pickhardt v. Packard* (1884), 30 O. G. 179; 22 Fed. Rep. 530; 23 Blatch. 23.

See also § 117 and notes, *ante*.

² That infringement does not exist unless there is identity of function as well as of parts, see *Racine Seeder Co. v. Joliet Wire Check Rower Co.* (1886), 27 Fed. Rep. 367; 37 O. G. 452; *Pelham v. Domarest* (1882), 12 Fed. Rep. 494; 22 O. G. 772.

That an article incapable of performing the functions of a patented device cannot be an infringement, see *Railway Register Mfg. Co. v. Broadway & Seventh Ave. R. R. Co.* (1887), 30 Fed. Rep. 238; 40 O. G. 1243.

See also § 235 and notes, *ante*.

³ That identity in mode of operation is necessary to infringement, see *Evory v. Burt* (1883), 15 Fed. Rep. 112; 23 O. G. 2121; *Lull v. Clark* (1882), 13 Fed. Rep. 456; 22 O. G. 1535; 21 Blatch. 95.

See also §§ 235, 236, and notes, *ante*.

⁴ That to obtain the same result by the same mode of operation is infringement, see *Shaver v. Skinner Mfg. Co.* (1887), 30 Fed. Rep. 68; 41 O. G. 232;

Collignon v. Hayes (1881), 8 Fed. Rep. 912; 20 O. G. 447; *Singer Mfg. Co. v. Stewart Mfg. Co.* (1881), 8 Fed. Rep. 920; 20 O. G. 524.

⁵ That an infringement is committed whenever the defendant avails himself of the patented invention without such variations as constitute a different invention, see *May v. County of Fond du Lac* (1886), 27 Fed. Rep. 691; *Carter v. Baker* (1871), 4 Fisher, 404; 1 Sawyer, 512.

That a mere formal change is infringement, see *Strobridge v. Landers, Frary, & Clark* (1881), 11 Fed. Rep. 880; 20 Blatch. 73; 21 O. G. 1027; *McKesson v. Carnrick* (1881), 9 Fed. Rep. 44; 19 Blatch. 158; 21 O. G. 137.

That variations in size, form, and degree, do not prevent infringement, see *Asmus v. Alden* (1886), 27 Fed. Rep. 684; 36 O. G. 231; *Lull v. Clark* (1882), 13 Fed. Rep. 456; 22 O. G. 1535; 21 Blatch. 95; *Judson v. Cope* (1860), 1 Fisher, 615; 1 Bond, 327.

That an invention limited to certain forms is infringed only by the use of those forms, see *Wright v. Yuengling* (1888), 42 O. G. 829; *Dosh v. A. J. Medlar Co.* (1887), 40 O. G. 1242; *Toepfer v. Goetz* (1887), 41 O. G. 933; 31 Fed. Rep. 913.

That a patent limiting the invention to certain materials is infringed only by

stitution of equivalents, whether greater or less in number than the discarded elements, and though performing additional functions; ⁶ the capability of fewer or more numerous uses by reason of its new connections; ⁷ the increase or dimi-

the use of such materials, see *Western & Wells Mfg. Co. v. Rosenstock* (1887), 30 Fed. Rep. 67; 41 O. G. 354.

That a change of arrangement may be infringement, see *Belle Patent Button Fastener Co. v. Lucas* (1887), 37 O. G. 1004; 28 Fed. Rep. 371.

That where the same result is accomplished, the same function performed, and the mode of operation is the same, a mere difference in the location of parts will not avoid infringement, see *Kirk v. Du Bois* (1887), 42 O. G. 297.

That a mere formal modification affecting only the quantity of the result does not avoid infringement, see *Coupe v. Weatherhead* (1883), 23 O. G. 1927; 16 Fed. Rep. 673.

That the function and mode of operation of the plaintiff's and defendant's devices being identical, the latter is an infringement, though the means of communicating power may differ, see *Piper v. Shedd* (1885), 26 Fed. Rep. 151; 35 O. G. 256.

See also as to formal diversities §§ 237-244, and notes, *ante*.

⁶ That a device though employing equivalents may be an infringement, see *Barnes v. Ruthenberg* (1887), 40 O. G. 693; 32 Fed. Rep. 159; *Kimball v. Hess* (1883), 26 O. G. 107; 15 Fed. Rep. 393; *Carter v. Baker* (1871), 4 Fisher, 404; 1 Sawyer, 512.

That the substitution of one known device for another, though complex, is infringement, see *Foster v. Moore* (1852), 1 Curtis, 279.

That the use of part of a mechanical device, invented to produce a particular general effect, in connection with a substituted device to produce another part

of the same effect, is a use of the patented invention, see *Johnson v. Willimantic Linen Co.* (1866), 33 Conn. 436.

That to make new devices which are equivalents of the patented device, but go beyond it and include more, is infringement, see *Loercher v. Crandall* (1881), 11 Fed. Rep. 872; 20 Blatch. 106; 21 O. G. 863.

That the use of an equivalent is not an infringement where the specification says it is not within the patent, see *Byam v. Farr* (1852), 1 Curtis, 260.

That there is no infringement when an essential element is omitted and another substituted accomplishing the same result in a different manner, see *Schmidt v. Freese* (1882), 12 Fed. Rep. 563; 21 O. G. 1876.

See also as to equivalents, §§ 245-258, and notes, *ante*.

⁷ That a difference in the purpose for which the invention is used will not prevent an infringement, see *Thompson v. Gildersleeve* (1888), 43 O. G. 886; *Stegner v. Blake* (1888), 45 O. G. 126.

That a device may be an infringement though it can be used in a way in which the patented device cannot, see *Yale Lock Mfg. Co. v. Norwich National Bank* (1881), 6 Fed. Rep. 377; 19 Blatch. 123.

That a device so incorporated into the infringer's machine as to do more effective and better work, or even different work, is still an infringement, see *Hartford Woven Wire Mattress Co. v. Peerless Wire Mattress Co.* (1885), 23 Blatch. 227; 23 Fed. Rep. 587; *Buerk v. Valentine* (1872), 2 O. G. 295; 5 Fisher, 366; 9 Blatch. 479.

That a device may be an infringe-

nation of simplicity and expensiveness;⁸ the separation of the invention into several parts or the consolidation of many parts in one;⁹ the addition of new features, whether with or without improvement in the operation of the means;¹⁰ all these are changes consistent with the preservation of the identity of the patented invention, and with its wrongful appropriation by the alleged infringer.

ment though it is less useful than the patented invention, see *Sewall v. Jones* (1875), 91 U. S. 171; 9 O. G. 47; *Union Paper Bag Mach. Co. v. Binney* (1871), 5 Fisher, 166.

That a device may be an infringement though it only accomplishes in part the result attained by using the patented invention, see *Coupe v. Weatherhead* (1883), 16 Fed. Rep. 673; 23 O. G. 1927; *Sewall v. Jones* (1875), 91 U. S. 171; 9 O. G. 47.

See also as to diversity of use §§ 259-271, and notes, *ante*.

⁸ That a device affecting the same thing in the same way is an infringement though it be simpler and cheaper, see *Evory v. Burt* (1883), 15 Fed. Rep. 112; 23 O. G. 2121.

That a device though more expensively fitted up may be an infringement, see *Brown v. Guild* (1874), 23 Wall. 181; 6 O. G. 392.

That difference in degree may be infringement, see *May v. County of Fond du Lac* (1886), 27 Fed. Rep. 691.

⁹ That to divide or consolidate parts does not prevent infringement, see *Thompson v. Gildersleeve* (1888), 43 O. G. 886; *Wheeler v. Clipper Mower & Reaper Co.* (1872), 2 O. G. 442; 10 Blatch. 181; 6 Fisher, 1; *Baldwin v. Bernard* (1872), 2 O. G. 320; 9 Blatch. 509, note; 5 Fisher, 442.

That if material parts of the patented invention are omitted there is no infringement, see *Snow v. Lake Shore & Mich. Southern R. R. Co.* (1883), 25 O. G. 1280; 18 Fed. Rep. 602.

¹⁰ That an improvement may be an

infringement, see *Shaver v. Skinner Mfg. Co.* (1887), 41 O. G. 232; 30 Fed. Rep. 68; *Filley v. Littlefield Stove Co.* (1887), 39 O. G. 1203; 30 Fed. Rep. 434; *Wilson v. Cubley* (1886), 35 O. G. 257; 26 Fed. Rep. 156; *Hoff v. Iron Clad Mfg. Co.* (1886), 35 O. G. 1230; 27 Fed. Rep. 307; 23 Blatch. 481; *Reed v. Street* (1885), 34 O. G. 339; *Tate v. Thomas* (1885), 35 O. G. 258; 27 Fed. Rep. 306; *Filley v. Littlefield* (1885), 25 Fed. Rep. 282; *Bostock v. Goodrich* (1884), 21 Fed. Rep. 316; 29 O. G. 278; *Frost v. Marcus* (1882), 13 Fed. Rep. 88; *Union Stone Co. v. Allen* (1882), 14 Fed. Rep. 353; *Cross v. Mackinnon* (1882), 22 O. G. 586; 11 Fed. Rep. 601; 20 Blatch. 395; *Foye v. Nichols* (1882), 13 Fed. Rep. 125; 22 O. G. 2243; 8 Sawyer, 201; *Brainard v. Cramme* (1882), 12 Fed. Rep. 621; 22 O. G. 769; 20 Blatch. 530; *White v. Heath* (1882), 10 Fed. Rep. 291; 22 O. G. 500; *Star Salt Caster Co. v. Alden* (1882), 10 Fed. Rep. 555; *Maxheimer v. Meyer* (1881), 20 Blatch. 17; 9 Fed. Rep. 460; 20 O. G. 1162; *Pennington v. King* (1881), 7 Fed. Rep. 462; 19 O. G. 1568; *Turrell v. Spaeth* (1878), 14 O. G. 377; 3 Bann. & A. 458; *De Florez v. Reynolds* (1878), 14 Blatch. 505; 3 Bann. & A. 292; *Holbrook v. Small* (1876), 10 O. G. 508; *Jackson v. Allen* (1876), 120 Mass. 64; *Robertson v. Blake* (1876), 94 U. S. 728; 11 O. G. 877; *Carstaedt v. U. S. Corset Co.* (1876), 10 O. G. 3; 13 Blatch. 371; 2 Bann. & A. 331; *Richardson v. Noyes* (1876), 10 O. G. 507; 2

§ 895. Identity may Result from Use as well as from Original Construction.

The identity of the alleged infringement with the patented invention is not to be determined by its condition merely at

Bann. & A. 398 ; *Westinghouse v. Gardner & Ranson Air Brake Co.* (1875), 9 O. G. 538 ; 2 Bann. & A. 55 ; *La Baw v. Hawkins* (1874), 6 O. G. 724 ; 1 Bann. & A. 428 ; *Baldwin v. Bernard* (1872), 2 O. G. 320 ; 5 Fisher, 442 ; 9 Blatch. 509, note ; *Woodward v. Morrison* (1872), 2 O. G. 120 ; 5 Fisher, 357 ; Holmes, 124 ; *Goodyear Dental Vulcanite Co. v. Evans* (1868), 3 Fisher, 390 ; 6 Blatch. 121 ; *Roberts v. Harnden* (1865), 2 Clifford, 500 ; *Forbes v. Barstow Stove Co.* (1864), 2 Clifford, 379 ; *Howe v. Morton* (1860), 1 Fisher, 586 ; *Carr v. Rice* (1856), 1 Fisher, 198 ; *Pitts v. Wemple* (1855), 6 McLean, 558 ; *Woodworth v. Rogers* (1847), 3 W. & M. 135 ; 2 Robb, 625 ; *Gray v. James* (1817), Peters C. C. 476 ; 1 Robb, 140.

That an improvement and its original are separate inventions, and the inventor of one infringes by the use of the other, see *Royer v. Coupe* (1886), 39 O. G. 239 ; 29 Fed. Rep. 358 ; *American Bell Telephone Co. v. Dolbear* (1883), 23 O. G. 535 ; 15 Fed. Rep. 448 ; *Robertson v. Blake* (1876), 94 U. S. 728 ; 11 O. G. 877 ; *Fales v. Wentworth* (1872), 2 O. G. 58 ; Holmes, 96 ; 5 Fisher, 302 ; *Whipple v. Baldwin Mfg. Co.* (1858), 4 Fisher, 29 ; *Pitts v. Wemple* (1855), 6 McLean, 558.

That where the patentee of the original invention and the patentee of the improvement make a contract allowing each to use both patents in a different way, if either uses them contrary to the agreement he infringes, see *Star Salt Caster Co. v. Crossman* (1878), 4 Clifford, 568 ; 3 Bann. & A. 281.

That a device may be an infringement though additional elements are

employed increasing its utility, see *Waterbury Brass Co. v. N. Y. & Brooklyn Brass Co.* (1858), 3 Fisher, 43.

That an improver may infringe though his improvement gives to the invention all its value, see *Gray v. James* (1817), Peters C. C. 476 ; 1 Robb, 140.

That an improvement has supplanted the patented device in the trade does not prevent it from being an infringement, see *Turrell v. Spaeth* (1878), 14 O. G. 377 ; 3 Bann. & A. 458.

That evidence that the defendant's device is better than the plaintiff's is only admissible to show substantial difference, see *Alden v. Dewey* (1840), 1 Story, 336 ; 2 Robb, 17.

That if an alleged original invention is not operative, the improver does not infringe by embodying it in his own, see *Royer v. Coupe* (1886), 39 O. G. 239 ; 29 Fed. Rep. 358.

That a device may be an infringement though it works better than the patented invention, see *Howes v. McNeal* (1878), 15 O. G. 608 ; 15 Blatch. 103 ; 3 Bann. & A. 376 ; *Odiorne v. Denney* (1878), 13 O. G. 965 ; 3 Bann. & A. 287 ; *Miller's Falls Co. v. Ives* (1877), 14 O. G. 203 ; 14 Blatch. 169 ; 2 Bann. & A. 574 ; *McComb v. Brodie* (1872), 2 O. G. 117 ; 5 Fisher, 384 ; 1 Woods, 153 ; *Carter v. Baker* (1871), 4 Fisher, 404 ; 1 Sawyer, 512 ; *Forbes v. Barstow Stove Co.* (1864), 2 Clifford, 379 ; *Cox v. Griggs* (1861), 2 Fisher, 174 ; 1 Bissell, 362 ; *Whipple v. Middlesex Co.* (1859), 4 Fisher, 41 ; *Foss v. Herbert* (1856), 2 Fisher, 31 ; 1 Bissell, 121.

That an invention may be an infringement though it does more than

the time of its original construction. The cunning of infringers is not allowed to circumvent the provisions of the law for the protection of inventors. An instrument which in itself may not resemble the patented invention, even in its idea of means, may when employed in practice develop new features that perform the functions of the patented invention by the same mode of operation. If such a result is intended by the maker, user, or seller of the instrument, or follows necessarily from its employment, the instrument thereby becomes identical with the patented invention, and such identity, by virtue of the intention now accomplished, is imputed to the instrument in its original condition.¹ But the develop-

the patented invention, see *Shaver v. Skinner Mfg. Co.* (1887), 30 Fed. Rep. 68 ; 41 O. G. 232 ; *Wilson v. Cubley* (1886), 26 Fed. Rep. 156 ; 35 O. G. 257 ; *Zeun v. Kaldenberg* (1883), 16 Fed. Rep. 539 ; 23 O. G. 2514 ; *Wilt v. Grier* (1881), 19 O. G. 427 ; 5 Fed. Rep. 450 ; *California Artificial Stone Paving Co. v. Perine* (1881), 20 O. G. 813 ; 8 Fed. Rep. 821 ; 7 Sawyer, 190 ; *Strobridge v. Lindsay* (1880), 18 O. G. 62 ; 2 Fed. Rep. 692 ; 5 Bann. & A. 411 ; *Williams v. Boston & Albany R. R. Co.* (1879), 16 O. G. 906 ; 17 Blatch. 21 ; 4 Bann. & A. 441 ; *Hart, Bliven, & Mead Mfg. Co. v. Sargent* (1878), 14 O. G. 45 ; 3 Bann. & A. 263 ; *Converse v. Cannon* (1875), 9 O. G. 105 ; 2 Woods, 7 ; *New York Rubber Co. v. Chaskel* (1875), 9 O. G. 923 ; *Foss v. Herbert* (1856), 2 Fisher, 31 ; 1 Bissell, 121.

That one invention may include others and yet infringe the patent which protects them, see *Cochrane v. Deener* (1876), 94 U. S. 780 ; 11 O. G. 687.

That a device may be an infringement though used in connection with other devices not included in the patent, see *Wirt v. Brown* (1887), 30 Fed. Rep. 188 ; 41 O. G. 236 ; *Tate v. Thomas* (1885), 30 O. G. 345 ; 22 Fed. Rep. 660 ; *Roemer v. Simon* (1884), 20 Fed. Rep. 197 ; 28 O. G. 194 ; *Andrews*

v. Eames (1883), 15 Fed. Rep. 109 ; 23 O. G. 1123 ; *Union Stone Co. v. Allen* (1882), 14 Fed. Rep. 353 ; *Turrell v. Spaeth* (1878), 14 O. G. 377 ; 3 Bann. & A. 458 ; *Herring v. Nelson* (1877), 12 O. G. 753 ; 14 Blatch. 293 ; 3 Bann. & A. 55 ; *Jackson v. Allen* (1876), 120 Mass. 64 ; *Cochrane v. Deener* (1876), 94 U. S. 780 ; 11 O. G. 687 ; *McComb v. Brodie* (1872), 2 O. G. 117 ; 5 Fisher, 384 ; 1 Woods, 153 ; *Chicago Fruit House Co. v. Busch* (1871), 2 Bissell, 472 ; 4 Fisher, 395 ; *Imlay v. Norwich & Worcester R. R. Co.* (1858), 1 Fisher, 340 ; 4 Blatch. 227 ; *Johnson v. Root* (1858), 1 Fisher, 351 ; *Carr v. Rice* (1856), 1 Fisher, 198 ; *Pitts v. Wemple* (1855), 6 McLean, 558.

That a device may be an infringement though connected with useless additional parts, see *Poppenhusen v. Falke* (1862), 2 Fisher, 213 ; 5 Blatch. 46 ; *Poppenhusen v. Falke* (1861), 2 Fisher, 181 ; 4 Blatch. 493 ; *Waterbury Brass Co. v. N. Y. & Brooklyn Brass Co.* (1858), 3 Fisher, 43.

§ 895. ¹ That where a device is intentionally so constructed as in use to become the patented invention, it is identical therewith and an infringement, see *Page v. Ferry* (1857), 1 Fisher, 298.

See also § 903 and note 7, *post*.

ment of such new features without the intention of the alleged infringer, as by accident or wear and tear, does not produce an identity which can be regarded on the question of infringement.²

§ 896. **Identity not Controverted by the Issue of a Later Patent for the Infringing Invention.**

The fact that the invention made, used, or sold by the alleged infringer is itself the subject of a later patent does not conclusively establish the absence of identity.¹ Every patent is *prima facie* evidence of the novelty of the invention which it claims, and every patented invention is thus presumed to be essentially different from every other until the contrary appears.²

² That an article which is not an infringement when constructed cannot become such by accident, or wear and tear, or usage, unless so intended, see *Page v. Ferry* (1857), 1 Fisher, 298.

That a device which may be forced to operate like the plaintiff's device is not an infringement if such use was not an object of its construction, see *Buzzell v. Andrews* (1885), 25 Fed. Rep. 822; 34 O. G. 830.

See also § 903 and note 7, *post*.

§ 896. ¹ That a patented invention may infringe a prior patent, see *Holliday v. Pickhardt* (1882), 12 Fed. Rep. 147; 22 O. G. 420; *Brainard v. Cramme* (1882), 12 Fed. Rep. 621; 20 Blatch. 530; 22 O. G. 769; *Star Salt Caster Co. v. Alden* (1882), 10 Fed. Rep. 555; *Pennington v. King* (1881), 7 Fed. Rep. 462; 19 O. G. 1568; *Maxheimer v. Meyer* (1881), 20 Blatch. 17; 20 O. G. 1162; 9 Fed. Rep. 460; *Holly v. Vergennes Mach. Co.* (1880), 4 Fed. Rep. 74; 18 O. G. 1177; 18 Blatch. 327; *Nathan v. N. Y. Elevated R. R. Co.* (1880), 2 Fed. Rep. 225; 5 Bann. & A. 280; *Robertson v. Blake* (1876), 94 U. S. 728; 11 O. G. 877; *Cochrane v. Deener* (1876), 94 U. S. 780; 11 O. G. 687; *Converse v. Cannon* (1875), 9

O. G. 105; 2 Woods, 7; *Goodyear Dental Vulcanite Co. v. Gardiner* (1871), 3 Clifford, 408; 4 Fisher, 224; *Goodyear Dental Vulcanite Co. v. Evans* (1868), 3 Fisher, 390; 6 Blatch. 121; *Smith v. Pearce* (1840), 2 McLean, 176; 2 Robb, 13.

That where a later patent includes the subject-matter of a prior patent neither patentee can use the other's invention without his consent, see *Cantrell v. Wallick* (1886), 117 U. S. 689; 35 O. G. 871.

That where a later patent includes an earlier, a stranger cannot defend against the second patent by setting up the first, see *Cantrell v. Wallick* (1886), 117 U. S. 689; 35 O. G. 871.

² That it is presumed that use under one patent does not infringe another, see *Smith v. Woodruff* (1874), 4 O. G. 635; 6 Fisher, 476; 1 MacArthur, 459.

That the grant of a second patent is *prima facie* evidence that the inventions are different, and that the later patented invention is not an infringement of the former, see *La Baw v. Hawkins* (1874), 6 O. G. 724; 1 Bann. & A. 428; *American Pin Co. v. Oakville Co.* (1854), 3 Blatch. 190.

Where two patents apparently describe and claim the same art or article the question of identity is open for examination, with the presumption in favor of their diversity; but when this presumption has been overcome, through the application of the tests by which identity must in all cases be finally determined, the later patent affords no protection to its patentee in the practice of the invention, and does not in any degree relieve him from liability for infringement to the owner of the only valid patent.

§ 897. Nature of the Act of Infringement.

The nature of the act of infringement is indicated by that of the exclusive right which it invades. Hence an infringement may be committed either by making, using, or selling the patented invention.¹ These words, however, are interpreted as comprehending every method by which the invention can be made available for the benefit of the infringer, and any person who participates in any wrongful appropriation of the invention becomes thereby a violator of the rights protected by the patent.² Such participation may be direct or indirect; it is sufficient if it promotes in any degree the

§ 897. ¹ In *Haselden v. Ogden* (1868), 3 Fisher, 378, Sherman, J. : (380) "An infringement is a copy made after and agreeing substantially and in principle with the article described in the letters-patent. The act of Congress confers upon the patentee and his assigns the exclusive right to make, to use, or to sell to others to be used, the article patented. It is, therefore, an infringement to make or manufacture a patented article though it is never used by the maker. It is likewise an infringement to use a patented article though made by another. It is also an infringement to sell to others the article when it is manufactured by another. The law vests the exclusive right to do all these three things in the patentee, and hence for another to do one or all of them is an infringement."

See also *Tuttle v. Matthews* (1886), 28 Fed. Rep. 98; 36 O. G. 694; *Slesinger v. Buckingham* (1883), 17 Fed. Rep. 454; 8 Sawyer, 469; *Allis v. Stowell* (1881), 19 O. G. 727; *Carter v. Baker* (1871), 4 Fisher, 404; 1 Sawyer, 512; *Waterbury Brass Co. v. N. Y. & Brooklyn Brass Co.* (1858), 3 Fisher, 43; *Boyd v. Brown* (1843), 3 McLean, 295; 2 Robb, 203.

² That any party making profits by an infringement is a wrongdoer, and is liable to the patentee, see *Vaughn v. East Tennessee, Virginia, & Georgia R. R. Co.* (1877), 11 O. G. 789; 1 Flippin, 621; 2 Bann. & A. 537.

That to share in the fruits of an infringement is such complicity as renders the parties jointly liable, see *Wells v. Jaques* (1874), 5 O. G. 364; 1 Bann. & A. 60.

unauthorized manufacture, use, or sale of the invention.³ Thus when a patented invention is inseparably annexed to other property without permission of the patentee, any one who owns or uses or buys or sells or leases such property, either as principal or agent, is guilty of infringement.⁴ But if the interest of the alleged participant is not dependent on the invention, though casually enhanced by its wrongful use, the enjoyment of such interest is not infringement. Thus where a landlord in consideration of the occupation of his premises by manufacturers, who employ infringing devices in their business, receives part of the profits of their business in addition to the sums paid to him as rent, he is not *ipso facto* an infringer, although he would infringe were this arrangement a mere cover for his participation in the operations of his tenants.⁵ For while the law does not impose unwarrantable burdens on the public by holding every one who derives a benefit from the prohibited manufacture, use, or sale of an invention responsible as an infringer of the patent, it does not permit any one, under any color or pretence, to employ the patented invention as a means of advancing his own interest, except in due subordination to the wishes of the patentee.

§ 898. No Act an Infringement unless it Affects the Pecuniary Interests of the Owner of the Patented Invention.

Moreover, the interest to be promoted by the wrongful employment of the invention must be hostile to the interest of

³ That no one can infringe unless he has some interest in the making, selling, or using the invention, see *United Nickel Co. v. Worthington* (1882), 13 Fed. Rep. 392; 23 O. G. 939.

⁴ That persons owning, renting, or occupying premises on which an infringing well is used, or buying or letting such premises without occupying them, are infringers, and liable to injunction and account, see *Green v. Gardner* (1882), 22 O. G. 683.

⁵ That one who leases to persons who infringe by making tools for their

own use, and who pay him rent and part profits of their business, is not an infringer, see *Starrett v. Athol Machine Co.* (1883), 14 Fed. Rep. 910; 23 O. G. 1729.

That where several parties infringe, some by making, others by selling, the infringing articles, the infringement is joint and several, and judgment may be rendered against each, though only one satisfaction can be had, see *Jennings v. Dolan* (1887), 29 Fed. Rep. 861; 38 O. G. 1018.

the patentee. The interest of the patentee is represented by the emoluments which he does or might receive from the practice of the invention by himself or others. These, though not always taking the shape of money, are of a pecuniary character, and their value is capable of estimation like other property. Hence acts of infringement must attack the right of the patentee to these emoluments, and either turn them aside into other channels or prevent them from accruing in favor of any one. An unauthorized sale of the invention is always such an act. But the manufacture or the use of the invention may be intended only for other purposes, and produce no pecuniary result. Thus where it is made or used as an experiment, whether for the gratification of scientific tastes, or for curiosity, or for amusement, the interests of the patentee are not antagonized, the sole effect being of an intellectual character in the promotion of the employer's knowledge or the relaxation afforded to his mind.¹ But if the products of the experiment are sold, or used for the convenience of the experimenter, or if the experiments are conducted with a view to the adaptation of the invention to the experimenter's business, the acts of making or of use are violations of the rights of the inventor and infringements of his patent.² In reference to

§ 898. ¹ That to experiment with a patented article to gratify scientific tastes, or for curiosity or amusement, is not infringement, see *Poppenhusen v. Falke* (1861), 2 Fisher, 181; 4 Blatch. 493; *Sawin v. Guild* (1813), 1 Gallison, 485; 1 Robb, 47.

That to make and exhibit at a fair, but not for use or sale, is not an infringement, see *Standard Measuring Machine Co. v. Teague* (1883), 15 Fed. Rep. 390.

That to make a patented article in order to experiment with it as a basis for proposed improvements by the maker is not an infringement, see *Frearson v. Loe* (1878), L. R. 9 Ch. D. 48.

That to use for the experimental instruction of pupils may be an infringe-

ment, see *United Telephone Co. v. Sharples* (1885), L. R. 29 Ch. D. 164.

² In *Poppenhusen v. New York Gutta Percha Comb Co.* (1858), 2 Fisher, 62, Ingersoll, J.: (72) "The next question, gentlemen, is, Has there been a violation or infringement? It is said, gentlemen, that there has not been, for the reason that whatever use was made of it was an experimental use, — a use merely for experiment, and not with a view to profit; and when there has been no profit and no sale, it will not make a party liable, because the patentee would not be injured by it. But where, gentlemen, it is done as a matter of business, where the product of that experiment has been thrown into the market to compete with the products of the plaintiff, although he

such employments of a patented invention the law is diligent to protect the patentee, and even experimental uses will be sometimes enjoined though no injury may have resulted admitting of positive redress.⁸

§ 899. Infringement not Committed by Possessing, Exposing for Sale, Advertising, &c.

A further distinction is to be made between acts which, in themselves or constructively, are acts of making, use, or sale, and acts which though collateral to these are after all only evidence that these acts have been performed. Among the latter are the mere possession of the patented invention when such possession does not constitute its use, its exposure for sale, its exhibition to others as meritorious and effective, advertising it, and the like; none of which, taken alone, disturb the enjoyment of his property by the patentee, however strong a presumption they may raise of its invasion by acts of real infringement.¹

§ 900. Infringement not Committed by Use of Part of the Patented Invention.

The acts of manufacture, use, and sale must, of course, relate to the precise invention claimed in the patent. To

may call it an experiment, yet, if it is a matter of business, and thrown into the market for the purpose of being sold, and is sold with his other products, why, that will be such a use as will make the party liable."

See also *Poppenhusen v. Falke* (1861), 2 Fisher, 181; 4 Blatch. 493; *Frearson v. Loe* (1878), L. R. 9 Ch. D. 48.

⁸ That experimental making and use is an infringement and may be restrained by injunction, though no account will be ordered, see *Albright v. Celluloid Harness Trimming Co.* (1877), 12 O. G. 227; 2 Bann. & A. 629.

That to make for use in order to see whether the use will be profitable, and using for that purpose, is an act demanding compensation to the patentee,

see *Palmer v. United States* (1885), 20 Ct. of Claims, 432.

§ 899. ¹ That the possession of infringing articles by a defendant who bought them for use, but has not yet used them, is an infringement, see *United Telephone Co. v. London & Globe Telephone Co.* (1884), L. R. 26 Ch. D. 766; *Adair v. Young* (1879), L. R. 11 Ch. D. 136; 12 Ch. D. 13.

That exposure for sale is not infringement, see *Minter v. Williams* (1835), 4 A. & E. 251; 1 Web. 135.

That advertising the invention is not infringement, see *Allis v. Stowell* (1881), 19 O. G. 727.

That advertising the device is strong evidence of infringement, see *Allis v. Stowell* (1881), 19 O. G. 727.

make or use or sell a part of the invention, especially a part covered by a different patent or disclaimed in the patent which protects the entire invention, is not an infringement of the latter patent.¹ An apparent exception to this rule exists in reference to machine patents, which are infringed by acts that involve so much of the invention as embraces the complete expression of its structural law; but this exception is apparent only, for such acts in reality appropriate the whole idea of means, although excluding unessential matters of construction.² As more explicitly stated in preceding paragraphs, the invention made or used or sold must be the exact patented invention, — identical in effect, identical in function, identical in mode of operation.

§ 901. Intention of Actual Infringer Immaterial: When Intention may Evidence Infringement.

As a general proposition, the intention with which an act of infringement is performed is immaterial.¹ The rights of the patentee are equally invaded whether or not the infringer purposes to violate them, and even though he may be ignorant of their existence;² and the duty of the law to redress his in-

§ 900. ¹ That to employ a distinct part of a patented invention is not an infringement, unless such part is also patented, see §§ 923, 924, and notes, *post*.

That the use of the essential parts of an invention, or their equivalents, is an infringement, see *Sessions v. Romadka* (1884), 28 O. G. 721; 21 Fed. Rep. 124.

That it is no infringement of a patent to make and sell that part of the patented invention which is not covered by the Claims of the patent, see *Simon v. Neumann* (1884), 20 Fed. Rep. 196; 27 O. G. 918.

That there is no infringement where the device was intended to be a reproduction of a device made two years before the patented invention, see *Delamater v. Woodruff* (1882), 11 Fed. Rep. 414.

That to make and improve upon a disclaimed part of the invention is not an infringement, see *Hatch v. Moffitt* (1883), 15 Fed. Rep. 252.

² That a machine-patent is infringed whenever the structural law of the machine is employed, though the parts vary in number or appearance, see § 926 and notes, *post*.

§ 901. ¹ That the motive with which an infringement is committed is immaterial, see *Parker v. Hulme* (1849), 1 Fisher, 44.

² That there may be an infringement though the infringer does not work by the patent or even know of the patent, see *Royer v. Coupe* (1886), 39 O. G. 239; 29 Fed. Rep. 358; *Matthews v. Skates* (1860), 1 Fisher, 602; *Parker v. Hulme* (1849), 1 Fisher, 44.

That all persons are bound to take notice of a patent duly issued, see

juries is not affected by the mental condition of the person by whom they are inflicted.³ But there are many actions, equivocal in character so far as the external operation is concerned, which are or are not acts of infringement according to the object contemplated by their actor, — actions otherwise innocent thus being regarded as violations of the rights secured by the patent, when intended as parts of a transaction which taken as a whole would be an infringement.⁴ Like the specific intent in certain criminal cases, the intention of the infringer thus becomes an element in the act of infringement, the mental and physical operations concurring to complete the wrong by which the exclusive privileges of the patentee are violated.⁵

§ 902. Infringement through Ignorance of the Patent, how Prevented.

To guard as far as possible, however, against an ignorant infringement, the law imposes on the patentee the obligation of notifying the public of his claims at the same time that he informs them of the existence and the mode of practising his invention. In the case of an art this is sufficiently accomplished by the patent itself, since without recourse to the specification, or to some one who had learned the art therefrom or

National Car Brake Shoe Co. v. Terre Haute Car & Mfg. Co. (1884), 28 O. G. 1007 ; 19 Fed. Rep. 514.

³ In *Hogg v. Emerson* (1850), 11 How. 587, Woodbury, J. : (607) "The intent not to injure, also, never exonerates, as is contended in these cases, from all damages for the actual injury or encroachment, though it may mitigate them."

That the fact that an infringement serves the public does not excuse it, see *American Bell Telephone Co. v. Cushman Telephone & Service Co.* (1888), 45 O. G. 1193.

⁴ That an act of making with intent to sell or use, an act of making a part with intent that others shall make the remainder and unite them, an act of making a different article with intent

that in its use it shall become the patented invention, &c., &c., are infringements, though the act of making without such intent would not be, see §§ 903, 924, and notes, *post*.

That acts of user or sale may thus be changed in character by their intent, see §§ 903-905, 924, and notes, *post*.

⁵ That infringement is deliberate where the infringer knows of the patent, though he supposes that a patent of his own gives him the right to use the invention, see *Burdett v. Estey* (1880), 3 Fed. Rep. 566 ; 19 Blatch. 1 ; 5 Bann. & A. 308.

That a person who wrongfully uses the invention under claim of ownership of the patent is an infringer, see *Continental Store Service Co. v. Clark* (1885), 100 N. Y. 365.

from the inventor, the public could not gain the knowledge necessary to its use. But in the case of a patented article the article itself, being permanent and susceptible of examination, discloses its own nature, and being found in open market communicates to the public such knowledge as enables them to make and use it, and may thus be manufactured, used, and sold by others without any intimation of the exclusive privileges of the patentee. In reference to patented articles, therefore, the law provides that notice of the inventor's claims shall be given to the public by stamping the word "patented" with the date of the patent upon each article itself or on the package which contains it;¹ and that upon his failure so to do the owner of the patent shall not recover substantial damages for its infringement against any person who was not otherwise actually notified of the existence of the patent and his own violation of its claims.

§ 903. Infringement by Unlawful Making.

The act of making can be predicated only of an article as distinguished from an art, — the latter being intangible and fugitive, capable of use but not of manufacture or of sale. Making may consist in the construction of the article, or in such repairs upon it as amount to an entire or partial reconstruction.¹ The act of making is complete when the article exists in a condition fit for use, though still in parts which

§ 902. ¹ That a defendant cannot be held in damages as an infringer if the patentee put his invention on the market unstamped, unless he had notice of the patent, see *Allen v. Deacon* (1884), 10 *Sawyer*, 210; 21 *Fed. Rep.* 122.

See also, on the duty of stamping, etc., § 628 and notes, *ante*.

§ 903. ¹ That an infringement may be committed by repairing as well as making the invention, if repairing involves reconstruction either in whole or in part, see *Goodyear Dental Vulcanite Co. v. Preterre* (1878), 14 *O. G.* 346; 15 *Blatch.* 274; 3 *Bann. & A.* 471.

To replace a part where the patent

specially claims that part is infringement, see *Gottfried v. Conrad Scipp Brewing Co.* (1881), 8 *Fed. Rep.* 322; 10 *Bissell*, 368.

That where the different parts of a machine are covered by different patents a purchaser of the machine from the patentee cannot replace one of the parts separately patented when worn out, see *Singer Mfg. Co. v. Springfield Foundry Co.* (1888), 34 *Fed. Rep.* 393.

That a machine wrongfully sold by an infringer cannot be repaired without further infringement, see *Graham v. Mason* (1872), 1 *O. G.* 609; *Holmes*, 88; 5 *Fisher*, 290.

are to be united by the user.² To make a patented article is not *ipso facto* an infringement.³ The intent of the maker here determines the legal complexion of his act, the purpose of the manufacture being an essential element of the transaction. To make as an experiment only, or for exhibition as a specimen of the manufacturer's mechanical skill, is not infringement.⁴ To make for practical use or for sale is an infringement although the article be never used or sold, or be sold or used outside the territorial limits within which it is protected by the patent.⁵ To make a single part of the invention with intent to use it in connection with the other parts already made, or to sell it to others by whom it will be united with the remaining portions of the article elsewhere obtained, is also an infringement.⁶ To make a different article intending that by use it shall become the patented article, is likewise an infringement, — the maker being responsible for such changes as he contemplates in making it, though not for those which without his co-operation are subsequently introduced by those who use it.⁷ On the other hand, to make the same tangible

² That to construct the parts ready for union by the purchaser is making, see § 924 and notes, *post*.

³ That a mere making, without intent to sell or use, is not infringement, see § 898 and notes, *ante*.

⁴ That to make for experiment, or amusement, or exhibition merely, is not an infringement, see *Standard Measuring Machine Co. v. Teague* (1883), 15 Fed. Rep. 390; *Poppenhusen v. Falke* (1861), 2 Fisher, 181; 4 Blatch. 493.

See also § 898 and notes, *ante*.

⁵ That it is an infringement to make an article for use, though it is never used or sold, see *Haselden v. Ogden* (1868), 3 Fisher, 378; *Whittemore v. Cutter* (1813), 1 Gallison, 429; 1 Robb, 28.

That to make for sale abroad is an infringement, see *Ketchum Harvester Co. v. Johnson Harvester Co.* (1881), 8 Fed. Rep. 586; 19 Blatch. 367.

⁶ That to make a part with intent

to use it, or to sell it to be used, in connection with the other parts of the invention, is infringement, see *Celluloid Mfg. Co. v. American Zylonite Co.* (1887), 30 Fed. Rep. 437; 40 O. G. 1453; *Travers v. Beyer* (1886), 26 Fed. Rep. 450; 23 Blatch. 423; *Snyder v. Bunnell* (1886), 29 Fed. Rep. 47; 38 O. G. 1130; *Schneider v. Pountney* (1884), 21 Fed. Rep. 399; 29 O. G. 84.

See also § 901 and notes, *ante*, and § 924 and notes, *post*.

⁷ That to make a device with a view to a result produced by its use which would make it the same as the patented device is infringement, see *N. Y. Bung & Bushing Co. v. Hoffman* (1881), 20 Blatch. 3; 20 O. G. 1451; 9 Fed. Rep. 199; *American Diamond Rock Boring Co. v. Sullivan Mach. Co.* (1877), 14 Blatch. 119; 2 Bann. & A. 522; *Renwick v. Pond* (1872), 2 O. G. 392; 10 Blatch. 39; 5 Fisher, 569.

That an innocent manufacturer does

article for use or sale but as the embodiment of a distinct idea of means, or to make a single part not intended by the maker for use in union with the other parts, or to replace a part not covered by the patent, are not infringements.⁸ A patent for the use of an article is not invaded by the act of making it, nor is the maker liable for its use by those to whom he sells it.⁹ To make by the agency of others, whether workmen or co-partners, is infringement, and though the maker pays for the articles only by the piece and when completed and delivered.¹⁰

§ 904. Infringement by Unlawful Using.

To use a patented art or article for purposes of experiment only is not an infringement. But to employ it in any manner for beneficial uses of a pecuniary character is an invasion of the privileges of the patentee. It is immaterial that the article was made by others and has been purchased by the user, or now subsists in an altered condition, or is divided into parts

not infringe through changes made in his device after it leaves his hands and control, see *De Long v. Bickford* (1882), 13 Fed. Rep. 32 ; 22 O. G. 2242.

That it is not an infringement to make a device which can be forced to operate like the patented invention if such was not the intention of the maker, see *Buzzell v. Andrews* (1885), 25 Fed. Rep. 822 ; 34 O. G. 830.

That to make an article, not intended to resemble the patented invention, but which becomes like it by accident, wear and tear, or usage, is not an infringement, see *Page v. Ferry* (1857), 1 Fisher, 298.

⁸ That if the article embodies a distinct idea of means and was so intended, though apparently similar to the patented invention, its manufacture is not infringement, see *National Car Brake Shoe Co. v. D., L. & N. R. R. Co.* (1880), 4 Fed. Rep. 224 ; *Pitts v. Wemple* (1855), 1 Bissell, 87 ; 2 Fisher, 10.

See also § 230 and notes, *ante*.

That to make an article which may be used in combination with others to form a patented invention is not infringement, unless intended for such use, see *Campbell v. Kavanaugh* (1882), 11 Fed. Rep. 83 ; 20 Blatch. 256.

See also §§ 900, 901, and notes, *ante*, and § 924 and notes, *post*.

⁹ That a patent covering only the "use" of a certain thing is not infringed by "making" or "selling" it, nor are the maker or seller responsible for its use, see *Keystone Bridge Co. v. Phoenix Iron Co.* (1872), 5 Fisher, 468 ; 1 O. G. 471.

¹⁰ That it is an infringement to employ a workman to infringe, see *Lightner v. Brooks* (1864), 2 Clifford, 287.

That a manufacturer infringes if his men work by the piece in making the device, see *Wooster v. Marks* (1879), 17 Blatch. 368.

which are successively employed, or is applied to different purposes from those intended by the inventor or to but one of several purposes for which it was designed, or is joined with new elements which enable it to perform additional functions, or is divested of its non-essential features, — the use is still an infringement of the patent, however meritorious may be the new uses or improvements discovered and made available by the infringer.¹ To use in part with intent that others shall complete the operation, or to use only through the agency

§ 904. ¹ That to use an infringing device made by another is an infringement, see *Haselden v. Ogden* (1868), 3 Fisher, 378.

That the use of the device in an altered condition is infringement, see *Illinois Central R. R. Co. v. Turrill* (1876), 94 U. S. 695 ; 12 O. G. 709.

That to divide a single part into two parts, doing the same thing in the same way, is infringement, see *Wheeler v. Clipper Mower & Reaper Co.* (1872), 2 O. G. 442 ; 10 Blatch. 181 ; 6 Fisher, 1.

That to use two dies instead of one may be an infringement, see *Baldwin v. Bernard* (1872), 2 O. G. 320 ; 9 Blatch. 509 note ; 5 Fisher, 442.

That to take an invention for one purpose only is an infringement, see *Adair v. Thayer* (1880), 4 Fed. Rep. 441 ; 17 Blatch. 468 ; 5 Bann. & A. 118.

That to use a patented device for a new purpose is infringement, see *Zinn v. Weiss* (1881), 7 Fed. Rep. 914.

That the use of an invention for a purpose not specified nor contemplated by the inventor is infringement, see *Cincinnati Ice Mach. Co. v. Foss-Schneider Brewing Co.* (1887), 31 Fed. Rep. 469.

That to use an invention for a part of an operation, instead of the whole, is infringement, see *Eames v. Andrews* (1887), 122 U. S. 40 ; 39 O. G. 1319.

That to use a less quantity of a patented material is infringement, see *Celluloid Mfg. Co. v. Chrolithion Collar & Cuff Co.* (1885), 31 O. G. 519 ; 23 Fed. Rep. 397.

That the use of the essential features of the invention or their equivalents is infringement, see *Sessions v. Romadka* (1884), 28 O. G. 721 ; 21 Fed. Rep. 124.

That the use of a device which is an equivalent for the patented device and more, though in a way in which the patented device cannot be used, is infringement, see *Yale Lock Mfg. Co. v. Norwich National Bank* (1881), 6 Fed. Rep. 377 ; 19 Blatch. 123.

That the use of a separable patented part of the invention is an infringement, see *Fetter v. Newhall* (1883), 21 Blatch. 445 ; 17 Fed. Rep. 841 ; 25 O. G. 502.

That it is not infringement for the purchaser of a device to use it in a way forbidden to his vendor, see *Goodyear v. Beverly Rubber Co.* (1859), 1 Clifford, 348. But see §§ 824, 826, and notes, *ante*.

That a purchaser from a later inventor cannot use the device, pending an injunction against such inventor, without infringing, see *Woodworth v. Edwards* (1847), 3 W. & M. 120 ; 2 Robb, 610.

That the use of an invention involving a patented process is a continuing infringement, see *Beadle v. Bennett* (1887), 122 U. S. 71 ; 39 O. G. 1326.

of others who furnish to their principal the finished product resulting from such use, is likewise an infringement.²

§ 905. Infringement by Unlawful Selling.

To sell a patented article without authority from the patentee is always an infringement. A sale, in its true legal sense, imports a transfer of the ownership of property, accompanied by its delivery to the vendee, in consideration of a price or recompense in value. But any form of transfer, under whatever disguise concealed, which directly or indirectly passes the apparent title from one person to another, is a sale within the purpose and construction of the Patent Laws, and makes the transferor an infringer of the patent.¹ To sell a part of the invention with the intent that it shall be united or used in connection with its other parts, to sell a different article with the intent that in its use it shall become the one claimed in the patent, to transport knowingly for use and sale in collusion with infringing makers or vendors, are also acts of infringement.² But a sale pro-

² That a partial use to be completed by others is an infringement, see § 901 and notes, *ante*, and § 924 and notes, *post*.

That a merely colorable contract for the product by one who procures the infringing machine or process to be used for his benefit is an infringement, see *Keplinger v. De Young* (1825), 10 Wheaton, 358; 1 Robb, 458.

That a person who makes a *bona fide* contract with an infringer to take the entire product of the infringing process or machine is not *per se* an infringer himself, though he knows that the machine or process is an infringement, see *Keplinger v. De Young* (1825), 10 Wheaton, 358; 1 Robb, 458.

That where the users of an infringing machine lease it to others who use it in complicity with the lessors, they may be joined as defendants, being joint infringers, see *Wells v. Jaques* (1874), 5 O. G. 364; 1 Bann. & A. 60.

§ 905. ¹ That any transaction, whether it assume the form of a sale proper or an exchange or a judgment and recovery, or any other transfer of ownership, is a sale within the intent of the Patent Laws, see § 1252 and notes, *post*.

That to sell an infringing article is an infringement whoever may have been the maker, see *Haselden v. Ogden* (1868), 3 Fisher, 378.

That it is not infringement to make and sell to one who has a license to use, where the invention is a mere appendage and the patentee has agreed to license all makers who apply, see *Saxe v. Hammond* (1875), 7 O. G. 781; Holmes, 456; 1 Bann. & A. 629.

² That the manufacture and sale of a part of the device, with intent that it shall be used in infringing the patent, is itself an infringement, see *Travers v. Beyer* (1886), 26 Fed. Rep. 450; 23 Blatch. 423; *Schneider v. Pountney*

cured by the patentee or his agent is not an infringement, although it furnishes evidence of other sales which are infringements.³ The sale of a part covered by one patent is not an infringement of a different patent for the entire article,

(1884), 21 Fed. Rep. 399; 29 O. G. 84.

That a sale of a machine to be used in infringing a patented combination is an infringement, see *Holly v. Vergennes Mach. Co.* (1880), 4 Fed. Rep. 74; 18 Blatch. 327; 18 O. G. 1177.

That sale of part of an article is not *ipso facto* an infringement, see *American Cotton Tie Co. v. Simmons* (1882), 106 U. S. 89; 22 O. G. 1976.

That the sale of an article which can be used only for the purpose of an infringement is itself an infringement, see *Snyder v. Bunnell* (1886), 29 Fed. Rep. 47; 38 O. G. 1130; *Alabastine Co. v. Payne* (1886), 27 Fed. Rep. 559; 35 O. G. 1438.

That mere capability of use for infringing purposes does not make the seller an infringer, see *Snyder v. Bunnell* (1886), 38 O. G. 1130; 29 Fed. Rep. 47.

That to make and sell an instrument capable of being used, and designed to be used, to effect the result of the patented invention by the means described in its claims is an infringement, see *Renwick v. Pond* (1872), 2 O. G. 392; 10 Blatch. 39; 5 Fisher, 569.

That to make and sell a device which in using it will become the same device covered by the patent is infringement, see *N. Y. Bung & Bushing Co. v. Hoffman* (1881), 20 Blatch. 3; 20 O. G. 1451; 9 Fed. Rep. 199; *American Diamond Rock Boring Co. v. Sullivan Mach. Co.* (1877), 14 Blatch. 119; 2 Bann. & A. 522.

That to sell with such directions as to use as, by the use, to copy the patented invention, is an infringement, see *Boyd v. Cherry* (1883), 4 McCrary, 70.

That to make and sell materials, knowing and intending their use for infringing purposes, makes the seller a joint infringer, see *Celluloid Mfg. Co. v. American Zylonite Co.* (1887), 30 Fed. Rep. 437; 40 O. G. 1453.

That knowingly to transport an invention to be used by consignees in violating a patent is an infringement, see *American Cotton Tie Supply Co. v. McCready* (1879), 17 O. G. 565; 17 Blatch. 291; 4 Bann. & A. 588.

That infringement by complicity must be clearly proved both as to act and intent, see *Snyder v. Bunnell* (1886), 38 O. G. 1130; 29 Fed. Rep. 47.

³ In *De Florez v. Reynolds* (1878), 14 Blatch. 505, Wheeler, J.: (509) "The infringement shown is by proof of the sale of a can by the defendants, purchased for and by the direction of the orators. It is claimed that the orators so participated in this transaction that the defendants cannot be liable on account of it. This is probably true, and if this was all the defendants have done the orators would not be entitled to a decree. But this can was purchased of the defendants in the usual course of their business, which is some evidence that they are dealing in those articles. This evidence they have not met and denied, but have rather supported. From it it is found that they are dealing in these infringing cans in such a manner that, except as to this one purchased for the orators, they are liable to account, and to prevent which they should be restrained." 3 Bann. & A. 292 (296).

See also *Byam v. Bullard* (1852), 1 Curtis, 100.

nor is the sale of a part not intended for use in the infringing article, though capable of such use as well as others.⁴ A sale by a sheriff, under legal process, of the materials of a patented article, though ready to be united and practically used, is not infringement.⁵ A patent for the use of the article is not infringed by selling it, nor is the vendor responsible for its use by his own vendees.⁶ An infringing sale may be effected through the agency of others, for whose acts the principal must answer as if they were committed by himself.⁷ But acts of agents outside their authority implicate themselves alone; and personal representatives, by wrongful sales of patented articles found among the assets of the decedent, create no liability against his estate.⁸

§ 906. Infringement a Single Tort though Embracing Acts of Making, Use, and Sale.

Although a complete infringement is committed by a single act of either making, use, or sale, yet when the same person performs two or more of these, the number of the infringements is not thereby increased. To make and use, or to make and sell, or to make and use and sell are the same tort, perpetrated through the medium of different acts, and constituting a single cause of action.¹ The measure of damages may

⁴ That to sell a part covered by one patent does not infringe another patent covering the whole, see *Buerk v. Imhaeuser* (1876), 11 O. G. 112; 2 Bann. & A. 465.

That to make and sell a useless part of a structure, not sold to be used nor used in an infringing structure, is not an infringement, see *Campbell v. Kavanaugh* (1882), 11 Fed. Rep. 83; 20 Blatch. 256.

⁵ That a sale of the materials of a patented device by a sheriff on legal process is not infringement, see *Sawin v. Guild* (1813), 1 Gallison, 485; 1 Robb, 47.

⁶ That a patent for the "use" is not infringed by a "sale," nor is the seller liable for the use by the vendee, see

Keystone Bridge Co. v. Phoenix Iron Co. (1872), 5 Fisher, 468; 1 O. G. 471.

⁷ That a sale by an agent is infringement by the principal, see *Jones v. Sewall* (1873), 3 Clifford, 563; 6 Fisher, 343; 3 O. G. 630; *Poppenhusen v. N. Y. Gutta Percha Comb Co.* (1858), 2 Fisher, 62.

⁸ That a sale of infringing articles by an administrator does not make the estate liable for infringement, see *Thompson v. Canterbury* (1881), 2 McCrary, 332.

§ 906. ¹ In *Steam Stone Cutter Co. v. Sheldon* (1884), 21 Fed. Rep. 875, Wheeler, J. : (877) "The orator could not in any mode recover both for the profits of the sale for use and the profits

differ, as will be hereafter seen, as one or more of these acts enter into the infringement, but for all purposes of compensation to the patentee, and of judicial restraint on the infringer, they are one wrong demanding but one redress.²

§ 907. No Infringement can be Committed before the Issue of the Patent.

No act of making, use, or sale can be an infringement of a patented invention unless it be performed during the life of the patent. An infringement may indeed be committed by the use, after the patent issues, of a device constructed before the creation of the monopoly, notwithstanding the good faith of its purchaser or maker and his belief that it will never be protected by a patent.¹ But an unauthorized appropriation of the invention, before the patent issues, although a tort for which the inventor has his remedy, is not an infringement

of the use. Each was a trespass upon the orator's exclusive rights, but not a separate and distinct trespass. A recovery for one would include a recovery for a part, at least, of the other, so that a recovery could be had for either, but not for both. The orator having had a recovery for one, cannot now have another for the other." 22 Blatch. 484 (487).

² That acts of making by one person and of use or sale by another are distinct infringements, see *Blake v. Greenwood Cemetery* (1883), 16 Fed. Rep. 676; 25 O. G. 89; 21 Blatch. 222.

That as determining the measure of damages, acts of making, use, and sale are essentially distinct, and vary in their effect according to the patentee's method of enjoying his monopoly, see *Colgate v. Western Electric Mfg. Co.* (1886), 28 Fed. Rep. 146; 37 O. G. 893.

That where one party makes and another sells they are liable jointly and severally, see *Jennings v. Dolan* (1887), 38 O. G. 1018; 29 Fed. Rep. 861.

§ 907. ¹ In *Evans v. Weiss* (1809), 2 Wash. 342, Washington, J.: (344) "It must be admitted, that cases of great hardship may occur, if, after a man shall have gone to the expense of erecting a machine, for which the inventor has not then, and never may obtain a patent, he shall be prevented from using it by the grant of a subsequent patent, and its relation back to the patentee's prior invention. But the law in this case cannot be termed *ex post facto*, or even retrospective in its operation; because the general law declares, beforehand, that the right to the patent belongs to him who is the first inventor, even before the patent is granted; and, therefore, any person, who, knowing that another is the first inventor, yet doubting whether that other will ever apply for a patent, proceeds to construct a machine, of which it may afterwards appear he is not the first inventor, acts at his peril, and with a full knowledge of the law that, by relation back to the first invention, a subsequent patent may cut him out of the use of the machine thus erected.

capable of redress under the Patent Law.² In the English courts a contrary view has been taken and the relief due to the patentee has been extended to wrongs committed after the filing of the specification and before the patent had been sealed.³ But under our system the privilege created by the patent is alone subject to infringement, and the invasion of the right has uniformly been held to be impossible until the right itself has been conferred. The date of the patent is thus the earliest moment at which an infringement can occur; and this is true not only in original patents but in re-issues also, which for this purpose are considered new patents and cannot be infringed by acts performed before they have been granted.⁴

§ 908. Infringement after the Patent has Expired.

As a general rule, the act must also be committed before the term, for which the patent issued or was extended, has expired. The termination of the exclusive privileges of the

Not only may individuals be injured by a literal construction of the words of the law, but the public may suffer, if an obstinate or negligent inventor should decline obtaining a patent, and at the same time keep others at arm's length, so as to prevent them from profiting by the invention for a length of time during which the fourteen years is not running on. But all these hardships must rest with Congress to correct. It is beyond our power to apply a remedy." 1 Robb, 10 (12).

² That no infringement can take place before the issue of the patent, see *Lyon v. Donaldson* (1888), 34 Fed. Rep. 789.

That an injunction will not be granted where the evidence shows that the defendant is using the same devices or process which he employed before the patent was granted, see *Dorlan v. Guie* (1885), 25 Fed. Rep. 816; 34 O. G. 702.

That there can be no infringement

by using an invention invented but withheld from the public by the patentee, see *Page v. Ferry* (1857), 1 Fisher, 298.

³ That an infringement may be committed at any time after a complete specification is filed, see 15 & 16 Vict. c. 83.

⁴ That a re-issue is not infringed by acts committed under the original patent, see § 696 and notes, *ante*.

That a re-issue with a broader Claim is not infringed by the use of devices made before the original patent, though they are covered by the new Claim, see *Ives & Miller v. Hartford Spring & Axle Co.* (1882), 11 Fed. Rep. 510; 20 Blatch. 333; 22 O. G. 1037.

That a device which does not infringe the original cannot infringe the re-issue, if the scope of original is measured by its description and not by its Claims alone, see *Cammeyer v. Newton* (1879), 16 O. G. 720; 4 Bann. & A. 159.

patentee is contemporaneous with the expiration of the patent which creates them, and the right to make, and use and sell the invention is then vested in the public beyond the control or interference of the inventor. To this rule there is one exception. As before stated, the making of the invention is not *ipso facto* an infringement, though it becomes such when coupled with an intent that the invention shall be used or sold in violation of the patent. Under this doctrine there is nothing to prevent the manufacture of the patented article in unlimited quantities during the life of the patent, to be put upon the market or into operation as soon as the patent expires to the possible injury of the business of the patentee or his licensees. The law regards such a transaction as a fraud upon the rights of the patentee, and an evasion of the rules by which those rights are protected; and the courts have therefore treated the use and sale, after the patent has expired, of articles made for that purpose without due authority while the patent was in force as infringements of the patent and as rendering the parties liable in the same manner and to the same extent as if the acts of use and sale, as well as that of making, had been committed during the existence of the patent.¹ The expiration of one among a series of connected

§ 908. ¹ In *American Diamond Rock Boring Co. v. Sheldon* (1880), 1 Fed. Rep. 870, Wheeler, J. : (872) "The defendants have machines made during the term of the patent, and which were infringements when made. If they could be made then and used now, in defiance of the owner of the patent, the exclusive right granted would not be fully enjoyed. The grant of the exclusive right is substantially the same in this country as it is in England. The question raised here arose there in *Crossley v. Derby Gas-light Co.*, Webst. Pat. Cas. 119. The case is more fully reported in 4 Law Jour. N. S. Chan. 25. There the patent would expire on the ninth of December, 1829; and on the twenty-eighth of November before a bill was filed praying for an injunction

against using infringing machines and for an account, the vice chancellor granted the injunction, and directed the account, and the defendants appealed. After argument, the lord chancellor, Lyndhurst, said: "This is an appeal from his honor, the vice chancellor, and is a case for an injunction against the invasion of a patent-right by preventing the use of certain gas-meters. This case is very peculiar, and is distinguishable from all other cases in the books. It appears that the plaintiff obtained his patent on the ninth of December, 1815, and that on the twenty-eighth of November, 1829, only a few days before the patent expired, he filed a bill. It was objected that the court would not interfere, just on the eve of the expiration of the patent, and grant an injunction

patents does not release to the public any invention covered by the others, and if the instrument or operation it protected cannot be enjoyed without the employment of the associated inventions, the public must postpone its appropriation to their use until the patents for these have also terminated.²

which would only last a week. The point has never yet been decided; but I am of opinion that the court would interfere after a patent had expired to restrain the sale of articles manufactured previous to its expiration in infringement of a patent-right, and that a party would not be allowed to prepare for the expiration of a patent by illegally manufacturing articles, and immediately after its expiration to deluge the markets with the products of his piracy, and thus reaping the reward of his improbous labor in making it. The court would, I say, in such case restrain him from selling them, even after the expiration of the patent.' This doctrine does not appear to have been denied or questioned afterwards, and was frequently carried out, in effect, by decreeing the destruction of infringing machines. *Betts v. De Vitre*, 34 Law Jour. Ch. 289; *Needham v. Oxley*, 11 Weekly Rep. 852. In *Curtis on Pat.* § 436, it is laid down as clear law that, 'if the patent has expired, the account and the injunction will extend to all the articles piratically made during the existence of the patent, though some of them may remain unsold.' The illegality attaches to the things themselves. The person making them has no right to make them — no right to them when made; he can impart none, and none will accrue by their passing into time when they might be made. The ordinary injunction in such cases, in effect, restrains all infringement of the patent, and is, in form, perpetual. It would, doubtless, cover an illegal sale or use after the expiration of the patent." 18 Blatch. 50 (52); 5 Bann. & A. 292 (294).

See also *New York Belting & Packing Co. v. Magowan* (1886), 27 Fed. Rep. 111; 34 O. G. 1278.

That the sale of an article after the patent expires is not an infringement though it were made under the patent, if the patentee consented to the making, see *Reay v. Rau* (1883), 23 O. G. 1928; 15 Fed. Rep. 749.

² In *McKay v. Dibert* (1881), 5 Fed. Rep. 587, *Nixon, J.*: (590) "Taking the case, then, as we find it, the naked question presented is: If an inventor embody in a machine a new mechanism to accomplish a desired and express purpose, does the Patent Law authorize him to procure (1) a patent for the machine, (2) a patent for the process by which the result was achieved, and (3) a patent for the product of the process as a new article of manufacture; and if such patents expire at different times has the court the power to decree that the younger patents in the series shall die when the older one runs out? Or, to state the proposition more succinctly, is there authority in the law to continue to an inventor the monopoly in the product of a machine after the machine itself has become public property by falling into the domain of public use? In determining such a question reference must be had, of course, to the law as it stood when the several patents were issued. These were the acts of July 4, 1836, and March 3, 1839, which were substantially the same as the present statute in regard to patentable subjects. By the sixth section of the first recited act the Commissioner of Patents was authorized to grant letters-patent to any person who had dis-

§ 909. Infringement can be Committed only within the Area of the United States.

A patent purports to protect the invention throughout the United States and the territories thereof. This protection

covered or invented 'any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement in any art, machine, manufacture, or composition of matter, not known or used by others before his or their discovery or invention thereof, and not, at the time of his application for a patent, in public use or on sale with his consent or allowance as the inventor or discoverer.' By the seventh section of the later act such public use or sale shall not avoid the patent, unless the same has continued for two years prior to the application for the patent. It is here we find the scope and extent, as well as the limitation, of the power of the Commissioner of Patents in regard to granting or withholding letters-patent. If the inventor, after obtaining his first patent for the machine, had waited for more than two years before applying for the process and product patents, there may have been such disclosure and public use of the invention that the limitation would have applied, and the Patent Office been compelled, under the provisions of the supplement of 1839, to have rejected the subsequent application. But no such time elapsed, and I am of the opinion that it was competent for the patentee, within the two years, to take out his process and product patents, and thus to guard himself against the danger and loss that might arise from others using the process to accomplish other results, or securing the product by the agency of other means and instrumentalities. Two reasons were forcibly presented by the learned counsel for the defendant why the act should not have the above interpreta-

tion: (1) Because it was asking the court, by judicial construction, to extend the monopoly and life of a patent for two years beyond the time prescribed by the law; (2) because the machine patent having expired, and belonging to the public, it was a contradiction in terms to hold that its use could be restrained on the ground that by its use other patents were infringed. These reasons need not be considered separately, and I think the difficulties which they suggest grow out of a misapprehension of what the court is supposed, in fact, to do in the case. The argument was that if an inventor procures a patent for a machine, and, after holding it for any length of time less than two years, is permitted, without the surrender of the original and a re-issue, to apply for a patent for the process employed, and the product obtained from the use of the machine, and then, after the expiration of the machine patent, may restrain its use by the public until the process and product patents run out, it is practically extending the life of the first patent, and giving the owner a monopoly beyond the period of time to which the law in express terms limited it. But the court does not propose to restrain generally the use of the machine but only such unlawful use of it as infringes the vested rights of others. As long as separate patents for a machine, and the process and the product, are allowable, they represent distinct inventions (*Kelleher v. Darling*, 14 O. G. 673), and each one may live, without interference or molestation, its whole life, without regard to the death of the others. While the product patent continues in existence, the manufac-

exhausts the powers of Congress, so far as the place of its exercise is concerned. It also marks the limits within which acts of infringement must occur.¹ The area of the United States for this purpose as well as others is held, however, to include not only all the waters which embrace its shores but American vessels sailing upon whatever seas.² To make, use, or sell the patented invention within the area thus defined, or to make within the United States for sale abroad, is an infringement.³ Foreign vessels, though within our territory, are

ture of the product by any instrumentality is prohibited, and it is no answer to the charge of infringement to say, 'I had the right to use the particular mechanism by which I obtained the product.' But the defendant insists that the machine belongs to the public to use, and that nothing can be manufactured from it except the product, of which the complainant has yet the monopoly. If this be true, then the public must find out some other use to put it to, or abstain from its use until the time comes in which it may be used without infringing the rights of others." 19 O. G. 1351 (1352).

But see *McKay v. Jackman* (1882), 12 Fed. Rep. 615; 22 O. G. 85; 20 Blatch. 466.

§ 909. ¹ That a purchaser in England from the vendee of the patentee, who has sold the article without restrictions, is not an infringer when he uses or sells in the United States, see *Holliday v. Matheson* (1885), 23 Blatch. 239; 24 Fed. Rep. 185; 31 O. G. 1444.

That the use in England of infringing apparatus purchased abroad is infringement under English laws, see *United Telephone Co. v. Sharples* (1885), L. R. 29 Ch. D. 164.

² In *Gardiner v. Howe* (1865), 2 Clifford, 462, Clifford, J.: (464) "Reference is made by the defendant to the case of *Brown v. Duchesne*, 2 Cur. 371, and *Same v. Same*, 19 How. 183; but

these cases do not apply where, as in this instance, the vessel where the act of infringement took place was American. Were it to be held that in cases like the present the plaintiff is not entitled to recover, patents for improvements in the tackle and machinery of vessels, or in their construction, would be valueless. The Patent Laws of the United States afford no protection to inventions beyond or outside of the jurisdiction of the United States; but this jurisdiction extends to the decks of American vessels on the high seas, as much as it does to all the territory of the country, and for many purposes is even more exclusive."

³ In *Ketchum Harvester Co. v. Johnson Harvester Co.* (1881) 8 Fed. Rep. 586, Blatchford, J.: (586) "Although the patent could give no protection abroad in the sale of machines abroad, it gave protection in the United States in making machines in the United States for sale abroad. The patent prevented all persons but the patentee from making in the United States. The privilege of making in the United States, for sale abroad, was valuable, as was shown by the fact that the defendant made in the United States for sale abroad. The plaintiff was entitled to that privilege exclusively, and to damages for its violation. It may be that in the case of manufacture in the United States, without sale anywhere, nominal damages only are to be allowed; but where such

not within the jurisdiction of the United States, and the use thereon of articles procured abroad is not an infringement.⁴ Articles procured here for use upon such vessels would involve an act of infringement on the part of the person by whom they were furnished, although their use may be beyond the reach of our judicial powers.

§ 910. Infringement by the Government and its Officials.

Any person, whether natural or artificial, who without due authority from the patentee performs an act of making, using, or selling a patented invention, or procures such an act to be performed, or adopts it and accepts its benefits when performed, is guilty of an infringement. Even the government of the United States, from whom the patent emanates, can neither grant to others the right to practise the invention, nor itself employ it, without the permission of the patentee.¹ Though

manufacture is followed by sale abroad, it cannot be said that the damages ought to be only nominal. It is true that the sale is the fruition and gives the profit, and that the sale is abroad, and the patent does not cover the sale abroad. But the unlawful act of making is made hurtful by a sale, wherever made. The legal damages for making and selling here may be, in some cases, greater than the legal damages for making here and selling abroad; but to deprive the patentee of all damages for unlawful making here, because the article is sold abroad, is to deprive him of part of what his patent secures to him." 19 Blatch. 367 (367).

⁴ In *Brown v. Duchesne* (1856), 19 How. 183, Taney, J.: (198) "And the court are of opinion that the rights of property and exclusive use granted to a patentee does not extend to a foreign vessel lawfully entering one of our ports; and that the use of such improvement in the construction, fitting out, or equipment of such vessel while she is coming into or going out of a port of the United States, is not an infringement of

the rights of an American patentee, provided it was placed upon her in a foreign port, and authorized by the laws of the country to which she belongs."

§ 910. ¹ In *James v. Campbell* (1882), 104 U. S. 356, Bradley, J.: (357) "That the Government of the United States, when it grants letters-patent for a new invention or discovery in the arts, confers upon the patentee an exclusive property in the patented invention, which cannot be appropriated or used by the Government itself without just compensation any more than it can appropriate or use without compensation land which has been patented to a private purchaser, we have no doubt. The Constitution gives to Congress power 'to promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries,' — which could not be effected if the government had a reserved right to publish such writings or to use such inventions without the consent of the owner." 21 O. G. 337 (337).

See also *Palmer v. United States*

the invention be of no utility except for governmental purposes, or pertain to an art over which another grantee of the United States has an exclusive control, it is no less within the entire dominion of the patentee, and cannot be appropriated to such uses without incurring liability to him.² Officers of the United States, contractors on its public works, and others acting upon its behalf but guided by their own volition as distinguished from superior authority, are also responsible for acts committed by them in violation of the patent, although the ultimate benefit of the infringement accrues not to themselves but to the government for which they act.³ In cases of great

(1885), 20 Ct. of Claims 432; *Campbell v. James* (1880), 18 O. G. 1111; 2 Fed. Rep. 338; 18 Blatch. 92; 5 Bann. & A. 354; *Cammeyer v. Newton* (1876), 94 U. S. 225; 11 O. G. 287; *Brady v. Atlantic Works* (1876), 2 Bann. & A. 436; 10 O. G. 702; 4 Clifford, 408; *United States v. Burns* (1870), 12 Wall. 246; *quere*, *Heaton v. Quintard* (1869), 7 Blatch. 73.

That the government cannot grant the right to use a patented invention, see *Colgate v. International Ocean Telegraph Co.* (1879), 17 O. G. 194; 17 Blatch. 308; 4 Bann. & A. 609.

That a grant by the government of exclusive rights to carry on a certain business does not authorize the use of a patented invention in that business, see *Colgate v. International Ocean Telegraph Co.* (1879), 17 O. G. 194; 17 Blatch. 308; 4 Bann. & A. 609.

² In *James v. Campbell* (1882), 104 U. S. 356, Bradley, J. : (358) "Many inventions relate to subjects which can only be properly used by the government, such as explosive shells, rams, and submarine batteries, to be attached to armed vessels. If it could use such inventions without compensation, the inventors could get no return at all for their discoveries and experiments. It has been the general practice, when inventions have been made which are

desirable for government use, either for the government to purchase them from the inventors and use them as secrets of the proper department, or if a patent is granted, to pay the patentee a fair compensation for their use. The United States has no such prerogative as that which is claimed by the sovereigns of England, by which it can reserve to itself, either expressly or by implication, a superior dominion and use in that which it grants by letters-patent to those who entitle themselves to such grants. The government of the United States, as well as the citizen, is subject to the Constitution; and when it grants a patent the grantee is entitled to it as a matter of right, and does not receive it, as was originally supposed to be the case in England, as a matter of grace and favor." 21 O. G. 337 (337).

³ That it is not held in *James v. Campbell*, 104 U. S. 356, that an United States official is not liable for an infringement, see *Forehand v. Porter* (1883), 15 Fed. Rep. 256.

That a postmaster is liable if he uses an infringing device in the postal service, see *Campbell v. James* (1880), 18 O. G. 1111; 2 Fed. Rep. 338; 18 Blatch. 92; 5 Bann. & A. 354. But see *James v. Campbell* (1882), 104 U. S. 356; 21 O. G. 337.

That the employees and contractors

public emergency, however, inventions may be taken by the government without the consent of the inventor under a right akin to eminent domain, and in these cases the officers through whom it acts are not infringers, although the patentee is entitled to compensation from the United States.⁴ In suits against the United States, and in proceedings instituted in pursuance of an act of Congress for determining its liability for the use of patented inventions, its measure of responsibility is the same as that of private individuals.⁵

§ 911. Infringement by Public Corporations.

A municipal corporation is responsible for acts of infringement performed by its officers and agents for its benefit.¹ It is immaterial whether such officers are appointed by itself or constitute an independent corporation acting on its behalf by virtue of legislative authority; it is sufficient if it reaps the

of the government are liable if they infringe, see *Brady v. Atlantic Works* (1876), 10 O. G. 702; 4 Clifford, 408; 2 Bann. & A. 436.

That a patent for the application or employment of armor on war vessels is not infringed by a mere workman who applies it to a vessel of the United States, see *Heaton v. Quintard* (1869), 7 Blatch. 73.

⁴ In *Brady v. Atlantic Works* (1876), 4 Clifford, 408, Clifford, J.: (412), "Private property, the Constitution provides, shall not be taken for public use without just compensation, and it is clear that that provision is as applicable to the government as to individuals, except in cases of extreme necessity, in time of war, and of immediate and impending public danger. Exigencies of the kind do arise where the prohibition does not apply to the public, and in such cases it must be conceded that the officer in the public service is not a trespasser, but it is equally true that the government is bound to make full compensation to the owner. *Mitchell v. Harmony*, 13

How. 134; *United States v. Russell*, 13 Wall. 627." 10 O. G. 702 (702); 2 Bann. & A. 436 (436).

⁵ That the remedy against the United States is to be sought in the Court of Claims, where adequate compensation for the injury inflicted on the patentee may be obtained, see § 1258 and notes, *post*.

That it is doubtful whether a government official who uses an invention solely for the benefit of the government can be sued for infringement, and whether the case is not one solely for the Court of Claims, see *James v. Campbell* (1882), 104 U. S. 356; 21 O. G. 337.

§ 911. ¹ That a city may be sued for infringement, see *Bliss v. City of Brooklyn* (1871), 4 Fisher, 596; 8 Blatch. 533.

That a city is liable in its corporate capacity for an infringement by its officers for its benefit, see *Munson v. Mayor of New York* (1880), 3 Fed. Rep. 338; 18 Blatch. 237; 5 Bann. & A. 486.

actual or supposed advantages of their infringement.² But a municipal corporation is not liable for infringements com-

² In *Brickill v. Mayor of New York* (1880), 7 Fed. Rep. 479, Wheeler, J.: (482) "It is urged that an infringement by the fire department of the city is not an infringement by the defendant, because that department was, under the law, a corporation of itself, over which the officers of the city had no control. It is understood, however, as was said in *Allen v. The Mayor, etc.*, that the fire department was a mere agency of the city, having no funds of its own, and making no profits for itself apart from those of the city. If there are any gains and profits in the hands of any party to be accounted for, under these circumstances, on account of an infringement, they must be in the general treasury of the city, and the city itself must be liable to account for them." 18 O. G. 463 (464); 18 Blatch. 273 (276); 5 Bann. & A. 544 (547).

In *Allen v. City of New York* (1879), 17 O. G. 1281, Wheeler, J.: (1281) "The proof in respect to infringement is to the effect that seats embodying this invention were bought by the Board of Education of the city of New York for the use of the schools of the city, and have been in use in those schools under the direction of the Board of Education and the Department of Public Instruction, which has superseded the Board of Education. It is argued that upon this proof the city is not liable in this suit for two reasons. One is because these instrumentalities having charge of the schools are corporations themselves over which the city has no control; the other is that the use is under sovereign authority delegated by the State of New York in its sovereign capacity, for which the city or the Board of Education or the Department of Public Instruction can no more be held liable to suit than the State itself. It is under-

stood that the Board of Education was, and that the Department of Public Instruction is, a corporation under the laws of the State, recognized and treated as such by the courts of the State, and having exclusive charge and control of the schools of the city, without whose action the city cannot be made liable for anything connected with the schools, and for whose contracts the city cannot be held liable otherwise than through proceedings against them. *Ham v. The Mayor, etc.*, 70 N. Y. 459; *Dannatt v. The Mayor, &c.*, 6 Hun, 88. But still the schools are the schools of the city, the Board of Education or Department of Public Instruction takes charge of them for the city, they are paid for with the money of the city, and whatever is saved in providing for them is to the advantage of the city. The corporation which that department or board constitutes is within that of the city, and is an instrumentality through which the educational interests of the city are cared for the same as if done by officers having the same powers, except that the officers could have only a personal and official period of existence, while that of the corporation is, under the law, theoretically perpetual. One principal ground of a suit in equity for the infringement of a patent is to compel an account of the gains or profits accrued to those proceeded against by means of the infringement. Obviously the proper party to proceed against is the one that has received the profits, or to whom the gains have accrued. If any party has saved or made anything by this infringement, it is the city, and the city seems clearly to be a proper party to account for these savings or profits. The board and department are proper parties also, for they have been directly engaged in the

mitted by a contractor on its public works, nor for the use of articles furnished to it by him although they are the product of infringing processes; nor can any agreement between the contractor and the patentee shift the responsibility for the infringement from the contractor to the corporation.³ Public bodies which are not corporations, although composed of sev-

infringement. It is argued that the city as such could not stop the infringement nor control it, and therefore could not be guilty of any tort by which to acquire profits to account for. Probably the city could not, independently of this board or department, stop the infringement; but that is on account of the mode in which the law requires the educational matters of the city to be attended to, and not because the city has any just right to advantages which the wrongful acts of its board or department may acquire. Officers might be able to do the same, but, if so, the city would not be shielded. That the acts constituting the infringement were committed in the exercise of authority derived from the State cannot shield the defendant from liability. The grant of the exclusive right to this invention came from the sovereign power of the general government, and the right is a species of property secured to the inventor by law. It is not subservient to public uses without just compensation, ascertained and furnished upon being taken in a regular and lawful mode, any more than other property of any kind is. It has not been taken by any regular proceeding, but only by mere wrong-doing, which could of itself furnish no legal right. *Cammeyer v. Newton*, 4 Otto, 234." 17 Blatch. 350 (350); 5 Bann. & A. 57 (59).

Contra, that a city is not liable for the acts of a public board of education over whom it has no control, see *Allen v. City of Brooklyn* (1871) 4 Fisher, 598; 8 Blatch. 535.

³ In *Lightner v. Brooks* (1864), 2

Clifford, 287, Clifford, J.: (293) "Where parties contract for implements, machines, or structures to contain any of the modern patented improvements, without any knowledge that the contractor is an infringer, or intends to use the improvement without authority, it is not the just and legal implication from the contract that the party ordering the article contemplates that the contractor will violate the rights of the patentee, or that he thereby commands or directs an infringement. Such contracts are now of daily occurrence, and unless there is some proof of concert, or something in the terms of the contract to indicate a contrary intent, the presumption must be that the person ordering the article either supposed that the contractor had the right to use the improvement, or, as part of the price to be paid by the purchaser of the article ordered, would procure the right of use from some person authorized to grant it for that purpose."

That a public body, employing a contractor to furnish articles for its buildings, is not liable for infringements by the contractor in supplying patented articles without authority, see *May v. Juneau Co.* (1887), 30 Fed. Rep. 241; 41 O. G. 578.

That where a contractor acting under a license does not pay his royalties, the principal hiring him does not infringe, see *Stow v. Chicago* (1877), 8 Bissell, 47; 3 Bann. & A. 83.

That a city using the product made by an infringing process by a contractor does not infringe, see *Brown v. District of Columbia* (1884), 3 Mackey, 502.

oral individuals exercising certain statutory powers, are not capable of committing an infringement or any other wrong except those specified in the statute which creates them.⁴ Contractors and officials acting for such bodies are alone answerable for their unauthorized appropriation of a patented invention.⁵

§ 912. Infringement by Private Corporations: Liability of Officers and Stockholders.

A private corporation infringes by any act of its agents or employees, authorized or ratified by it, which wrongfully appropriates the patented invention. By procuring infringing devices and permitting its workmen to use them, by hiring contractors to practise the invention for its benefit, and in similar ways, it may commit a direct act of infringement; but it is not permitted to escape responsibility by any disguise of its transactions, and to accept, however indirectly, the benefit of the infringing acts of its officers and servants renders it liable to the patentee.¹ It cannot avoid this liability although

⁴ That a county may be liable for infringements, see *May v. Saginaw Co.* (1887), 32 Fed. Rep. 629; *May v. County of Logan* (1887), 30 Fed. Rep. 250; 41 O. G. 1387; *May v. County of Rolls* (1887), 31 Fed. Rep. 473; 40 O. G. 575; *May v. Mercer Co.* (1887), 41 O. G. 815; 30 Fed. Rep. 246.

Contra, *May v. Juneau Co.* (1887), 30 Fed. Rep. 241; 41 O. G. 578.

That where a county is a municipal corporation, it is liable for infringements by contractors, see *May v. Mercer Co.* (1887), 41 O. G. 815; 30 Fed. Rep. 246.

That a State cannot exempt counties from liability for infringement, see *May v. County of Rolls* (1887), 31 Fed. Rep. 473; 40 O. G. 575.

That a board of county commissioners in Ohio is not a corporation and has no other liability than that imposed by statute, and can neither commit a wrong nor be liable for one, see

Jacobs v. Board of Commissioners of Hamilton Co. (1862) 4 Fisher, 81; 1 Bond, 500.

Contra, *May v. County of Logan* (1887), 30 Fed. Rep. 250; 41 O. G. 1387.

⁵ That a contractor working for a body which cannot be liable for infringement is himself liable and cannot justify under his contract, though ignorant that he did infringe, see *Jacobs v. Board of Commissioners of Hamilton Co.* (1862), 4 Fisher, 81; 1 Bond, 500.

§ 912. ¹ In *Poppenhusen v. New York Gutta-Percha Comb Co.* (1858), 2 Fisher, 62, Ingersoll, J. : (72) "A corporation can act only by their agents. It can act only by those who are in their employ. And when one in the employ of a corporation, in the business of his employment, does an act for their benefit, and which they adopt and approve and take advantage of, they will be deemed to have authorized

its stockholders constitute another corporation organized under the jurisdiction of a different State, and carrying on its business with their own employees and machinery, — the corporation whose affairs are thus conducted is still the actual infringer and is answerable therefor.² How far the officers, stockholders, and employees of a private corporation participate in its infringing acts and thereby share its liability is still an open question. That they may be enjoined whenever this is necessary to protect the patentee against future infringements is universally conceded;³ but whether they can

the act, and will be as much bound by it as though expressly authorized. You are here to determine, gentlemen, whether these articles, manufactured by their agent, he being in the employment of the corporation, whether he did it in the business or employment of the corporation, whether it was for their benefit, and if they adopted and approved of it, by selling it in the market, and thereby took advantage of it, they will be deemed to have authorized the act, and will be bound by it." See also *Jacobs v. Commissioners of Hamilton Co.* (1862), 4 Fisher, 81; 1 Bond, 500.

That a corporation infringes by procuring the patented devices and permitting its employees to use them, see *Ransom v. Mayor of New York* (1856), 1 Fisher, 252.

That where the contractor is hired to work for the corporation and to use the infringing device, the hirer is probably liable, see *Lightner v. Brooks* (1864), 2 Clifford, 287.

That corporations cannot escape their liability by any disguise, see *York & Maryland Line R. R. Co. v. Winans* (1854), 17 How. 30.

² That where a railroad company was organized in one State, and all its stock was owned by a railroad company in another State, the latter company operating the road with its own agents and cars, the former company infringes by the use of a patented device on such

cars, see *York & Maryland Line R. R. Co. v. Winans* (1854), 17 How. 30.

³ In *Goodyear v. Phelps* (1853), 3 Blatch. 91, Nelson, J. : (91) "A point has been made, that the defendants are not liable for the infringement charged, as the only participation alleged in the same is as stockholders of an incorporated company, which company is engaged in manufacturing and selling the patented article. However that may be, it appears that the defendants are either directors of the company, who have the management and superintendence of the business, and under whose direction the articles are manufactured and sold, or are the agents of the same, concerned in conducting the business. On this ground, I am of opinion that they are responsible, and are properly made parties defendants." This was a bill for an injunction; the question of liability for damages not being raised.

That officers of an alleged infringing corporation may be joined with the corporation as defendants in an application for an injunction, see *Consolidated Safety Valve Co. v. Ashton Valve Co.* (1886), 26 Fed. Rep. 319.

That the officers of an infringing corporation may be enjoined, even if not liable for damages, see *United Nickel Co. v. Worthington* (1882), 23 O. G. 939; 13 Fed. Rep. 392.

That the managing officers of an in-

be held in damages for past infringements has been variously decided. One opinion, following the doctrine of limited liability as usually applied to private corporate bodies, regards the infringing act as the act of the corporation alone, and declares that none of its members or officials legally participate therein.⁴ Another, affirming the rule that every vol-

fringing corporation may be made co-defendants and individually enjoined, see *Iowa Barb Steel Wire Co. v. Southern Barbed Wire Co.* (1887), 30 Fed. Rep. 123 ; 40 O. G. 577.

That an officer of a corporation acting on its behalf in renting infringing machines to users is a proper party defendant with such users, in a bill for an injunction, see *Nichols v. Pearce* (1869), 7 Blatch. 5.

⁴ In *United Nickel Co. v. Worthington* (1882), 13 Fed. Rep. 392, Lowell, J. : (393) "The question, then, is whether the directors, stockholders, and workmen of the corporation are liable. It has been held that a mere workman who makes a patented article is not an infringer. *Delano v. Scott*, Gilp. 489 ; *Heaton v. Quintard*, 7 Blatch. 73. The reason given by Hopkinson, J., in the first of these cases goes far to decide the present. He says that the statute does not mean to class mere agents, servants, etc., as makers and venders of the patented improvement, but the principals, for whose account and benefit they act. It was conceded, but without being decided, in *Lightner v. Brooks*, 2 Clifford, 287, and in *Lightner v. Kimball*, 1 Low. 211, that a director who has acted affirmatively, so to speak, and ordered an infringement by the corporation, would subject himself to an action. But, upon further examination, I think the law is not so. Infringement is not a trespass. The form of action is case ; and this is because the act done is not of itself a direct interference with the tangible property of the plaintiff, but an indirect inter-

ference with his paramount right. It is like the building of a house upon a man's own land, which shuts out a light which his neighbor has a prescriptive right to enjoy. The person who is to pay damages for a disturbance is not every one who has had anything to do with the building, but he who owns it. It would be a great hardship if the directors of a railway or manufacturing corporation were bound, at their personal peril, to find out that every machine which the company uses is free of all claim of monopoly. No case precisely in point has been cited ; but the practice certainly is to ask for damages only against the corporation. Joinder in equity for purposes of discovery and injunction is another matter ; but I have not known damages to be asked for against the directors of a corporation, excepting in one case, which did not come to trial, but was discontinued as to the directors. I am of opinion that the only persons, who can be held for damages are those who should have taken a license, and that they are those who own or have some interest in the business of making, using, or selling the thing which is an infringement ; and that an action at law cannot be maintained against the directors, shareholders, or workmen of a corporation which infringes a patented improvement." 23 O. G. 939 (939).

That where a railroad company contracted for cars on which a patented invention was to be put, and the contract was signed by its president, who did not contemplate any infringement of the patent, he is not liable as an in-

untary perpetrator of a wrongful act of manufacture, use, or sale is an infringer, considers its directors, agents, and other servants, actually employing or authorizing the employment of the patented invention, as guilty of the infringement and personally answerable to the patentee.⁶ A third, viewing the acceptance of the benefit of the infringing act as furnishing the test of liability, treats its stockholders as infringers, whether or not they are its officers or agents, and exempts the latter unless they are also members of the corporation.⁶ The first opinion is scarcely consistent with a due regard to the rights of the patentee, whose invention might then be practised with impunity by an insolvent corporation, nor with the general tenor of the Patent Laws, which permit no voluntary and unauthorized act of manufacture, use, or sale, direct or indirect, to pass unpunished. The third confuses the benefit derived by the stockholders with that accruing to the corporation, — the benefit of the former being no more closely related to the infringement than that of creditors or

fringer, see *Lightner v. Brooks* (1864), 2 Clifford, 287.

That a liability for infringement is not a "debt" for which the officers of a corporation may be liable because it was improperly contracted, see *Child v. Boston & Fairhaven Iron Works* (1884), 137 Mass. 516.

⁶ That all who join in an infringement are liable for damages as defendants though some are mere officers of corporations, see *National Car Brake Shoe Co. v. Terre Haute Car & Mfg. Co.* (1884), 19 Fed. Rep. 514 ; 28 O. G. 1007.

That the president of a defendant corporation named as one of the defendants, but not personally served, who owns all the stock and swears to and signs the answer, and enters a general appearance without naming the other defendants, is personally liable for the infringement, see *Smith v. Standard Laundry Mach. Co.* (1883), 19 Fed. Rep. 826 ; 25 O. G. 393 ; 21 Blatch. 184.

⁶ In *Tyler v. Galloway* (1882), 22

O. G. 1294, Blatchford, J. : (1294) "It is shown that the infringing cheese-hoop was owned by the association, and was used by its agents in making cheese in its business at its works for the benefit of its stockholders. Galloway, Durfee, and Billings were shareholders. The use aforesaid was a use by each of them quite as much as if there had been a co-partnership without shares of stock, or one with shares belonging to less than seven shareholders in number. The use by each was a tort, and each is liable to be enjoined." 13 Fed. Rep. 477 (478) ; 21 Blatch. 66 (67).

That the stockholders of an infringing incorporation may be held individually as infringers, see *St. Louis Stamping Co. v. Quinby* (1880), 18 O. G. 571 ; 5 Bann. & A. 275.

That a secretary of an infringing corporation is not liable unless he is also a stockholder, see *Tyler v. Galloway* (1882), 13 Fed. Rep. 477 ; 22 O. G. 1294 ; 21 Blatch. 66.

innocent employees, or that of dealers in or users of the products of infringing processes ; and is pregnant with evil and unjust consequences to all members of private corporations, especially to minorities who neither acquiesce in the infringement nor in the appointment of the officers or agents by whom it is committed. The second is in harmony with other doctrines of the law, sufficiently protects the patentee, and justly punishes those whose wilful acts place them on the same footing with individual infringers. Under this opinion, all agents who perform acts of infringement, and all stockholders, directors, and other officers who in the prosecution of the business of the corporation authorize them, participate in the infringement and are personally responsible to the patentee.

§ 913. Infringement by a Joint-Owner of the Patent.

One of two or more co-owners of a patented invention may be guilty of infringement as against the others. The field of such infringement is of course comparatively narrow, since in the present condition of our law his right to profit by the patented invention is unlimited. While he restricts himself to the manufacture, use, or sale of this invention he does not, therefore, incur any liability to his co-owners. But his employment of other arts or articles, embracing the substance of the patented invention, and yet possessing different or additional features whereby he gains an advantage over his co-owners, is prohibited. The practice of such inventions by non-owners of the patent would be an infringement equally with that of the precise and separate invention which the patent claims, but would often strike more deeply at the interest of the patentee by driving his invention from the market through the superior utility of the infringing instrument or operation. If a co-owner were permitted to avail himself of these by virtue of his ownership of part of the patented invention, the property of the other owners might easily be rendered worthless ; and hence the courts have held that his departure from the patented invention, as described and claimed in the patent, puts him in the same position as a non-owner, and renders him liable in the same manner to the other owners

for his infringing acts.¹ The measure of his liability, however, differs, since the infringement is committed not only against their interest in the patented invention but against his own also, and the injury inflicted and the compensation awarded is consequently apportioned to the other owners according to their respective shares.

§ 914. **Infringement by Assignors, Grantors, and Grantees.**

An assignment either transfers the entire interest of the assignor in a patented invention, or makes him a co-owner with the assignee. In the former case, the assignor becomes a stranger to the patent and capable of infringement by any act of unauthorized manufacture, use, or sale.¹ In the latter case, he is liable to the same extent and for the same acts as an ordinary co-owner, and has the same right to protection against his assignee. A grantor is a stranger to the patent within the territory exclusively conveyed to his grantee, while

§ 913. ¹ In *Herring v. Gas Consumers' Association* (1878), 9 Fed. Rep. 556, Treat, J.: (157) "Can a part-owner infringe the common patent and escape all liability" If he can, it is obvious that, however small his aliquot part, he can make the enjoyment of the patent valueless to his joint-owner. He has, by virtue of the joint-ownership, a right to use the patent, but he has no right more than a stranger to infringe the same. If there is an infringement, the right of recovery is in the party wronged. All the joint-owners should ordinarily be parties plaintiff; but if the wrong-doer is one who is guilty to the damage of the other joint-owner, the latter should not be left remediless. As to such infringement they are strangers. All the joint-owners are on the record, and the amount of the recovery determines their respective interests. The infringer cannot escape the consequences of his wrong to his joint-owner by averring that he was by his infringement injuring not his joint-owner alone, but him-

self also. In other words, he cannot, under cover of his interest in the common patent, shield every wrong-doer who may infringe that patent. He can, as to the other part-owners, by infringing, become liable to them for the wrong done. The amount of recovery will be in proportion to their respective interests. Were this not so, the door would be open to the grossest frauds by one joint-owner against all other joint-owners." 13 O. G. 637 (637); 3 McCrary, 206 (206); 3 Bann. & A. 253 (254).

That an owner infringes if he uses or sells as to the right of his co-owner, see *Pitts v. Hall* (1854), 3 Blatch. 201.

That one co-owner cannot sue his co-owner for infringement by using the patented invention, see *Aspinwall Mfg. Co. v. Gill* (1887) 32 Fed. Rep. 697.

§ 914. ¹ That an assignor may become liable to his assignee for an infringement, see *Onderdonk v. Fanning* (1880), 4 Fed. Rep. 148; 5 Bann. & A. 85.

the grantee is a stranger outside the limits of such territory ; and each may thus invade the other's rights by any of the usual methods of infringement.² When the effect of the grant is to make them territorial co-owners, their liabilities to each other for acts performed within such territory are the same as those of other co-owners of a patent.

§ 915. Infringement by Licensees.

A license transfers an interest in the invention and estops the licensor from interfering with the enjoyment of such interest by asserting his monopoly against the licensee. If the license is an express license, the rights of the licensee and the estoppel against the licensor are defined by its specific terms. If the license is implied, the duties and obligations of the parties are defined by law.¹ No license can convey an interest in the invention or work an estoppel unless the licensor was an owner of the patent at the time the license was granted. While acting under his license, and within the scope of the interest it confers, the licensee does not infringe the patent, and on a failure to perform his own part of the agreement is liable only to an action on the contract in the local courts.² If the license is granted on conditions, it affords no protection to the licensee unless the conditions are fulfilled, though late authorities declare that it must be rescinded by agreement, or by a decree in equity, before an action for infringement by

² That a grantor reserving the right to use is not guilty of infringement by such use, see *Hobbie v. Smith* (1886), 27 Fed. Rep. 656.

That a grantee infringes by making outside his territory for use outside it, see *American Paper Barrel Co. v. Laraway* (1886), 37 O. G. 674 ; 28 Fed. Rep. 141.

That a sale of patented articles in the ordinary course of business beyond the territory of the grantee by his vendee is an infringement, see *Hatch v. Adams* (1884), 29 O. G. 776 ; 22 Fed. Rep. 434.

§ 915. ¹ As to the nature of a license and the reciprocal rights and duties of licensors and licensees, see §§ 806-834 and notes, *ante*, and §§ 979, 1044, 1243-1252, and notes, *post*.

That the scope of an implied license to make and sell is fixed by the circumstances out of which the license arises, see *Montross v. Mabie* (1887), 30 Fed. Rep. 234 ; 41 O. G. 931.

² That a party acting under a license is not an infringer, and is only liable for fees, not in United States courts for infringement, see *Kelly v. Porter* (1883), 17 Fed. Rep. 519 ; 8 Sawyer, 482.

acts done under color of the license can be maintained.³ A licensee repudiating the license, or abandoning it, or claiming his right against the licensor on other grounds, forfeits the privilege which it confers and can no longer set up its estoppel against the licensor.⁴ Notwithstanding the existence of a license, therefore, the apparent licensee will be in reality a stranger to the patent, and will be guilty of infringement by any act of manufacture, use, or sale, if the license were originally invalid, or through his default never took effect, or being once effective has now ceased to operate.

§ 916. Infringement by a Licensee under an Express License.

A licensee, having an express license, infringes by the practice of any other patented invention than the one covered by his license, or by employing that in any other manner than

³ That licensees under conditions infringe unless they fulfil the conditions, see *Steam Cutter Co. v. Sheldon* (1872), 5 Fisher, 477; 10 Blatch. 1.

That the use of the licensed invention beyond the limits of the license and against the reserved rights of the licensor is an infringement, see *Chambers v. Smith* (1870), 5 Fisher, 12.

That where a licensee had the option to use during the extension upon paying new fees, he will be an infringer if he uses without first exercising his option and paying the new fees, see *England v. Thompson* (1869), 3 Clifford, 271.

That a licensee may be sued for an infringement if his license were rescinded by a notice to that effect given in the mode prescribed by the license itself, see *Hammacher v. Wilson* (1886), 26 Fed. Rep. 239; 36 O. G. 233.

That a licensor cannot sue his licensee for infringement upon a failure to pay royalties unless the license contains a clause of forfeiture, see *Consolidated Middlings Purifier Co. v. Wolf* (1886), 28 Fed. Rep. 814; 37 O. G. 567.

That though it is agreed in a license that it is to be void in a certain event,

and that the licensee may then be treated as an infringer, the license must be annulled by a separate proceeding in equity before a suit for infringement can be brought, see *Adams v. Meyrose* (1881), 7 Fed. Rep. 208; 2 McCrary, 360.

⁴ That a licensee abandoning his license, or defending on other grounds, forfeits its protection, see *Bell v. McCullough* (1858), 1 Fisher, 380; 1 Bond, 194.

That a licensee having repudiated his license may be treated as an infringer, and his license will be no defence, see *Hat Sweat Mfg. Co. v. Porter* (1888), 34 Fed. Rep. 745; *Cohn v. National Rubber Co.* (1878), 3 Bann. & A. 568; 15 O. G. 829; *Moody v. Taber* (1874), 5 O. G. 273; *Holmes*, 325; 1 Bann. & A. 41.

That a licensee making the licensor's invention under a different name, must pay the agreed license fees, and if he repudiates the license may be sued as an infringer, see *Starling v. St. Paul Plough Works* (1887), 41 O. G. 818; 32 Fed. Rep. 290.

his license specifies.¹ If he appropriates a different invention belonging to his licensor, whether protected by the same or by a different patent, and not essential to the enjoyment of the licensed invention;² or if he makes, or sells, or uses inventions of his own or of some other patentee which in themselves are infringements of the one that he is licensed to employ;³ or if he performs an act in reference to the licensed invention which his license does not authorize, as by selling or using under a license to manufacture only;⁴ or if he per-

§ 916. ¹ That a licensee acting outside his license is an infringer, see *Fetter v. Newhall* (1883), 17 Fed. Rep. 841; 25 O. G. 502; 21 Blatch. 445; *Wood v. Wells* (1873), 6 Fisher, 382; *Goodyear v. Providence Rubber Co.* (1864), 2 Clifford, 351; 2 Fisher, 499.

That a licensee merely refusing to pay his royalties cannot be treated as an infringer, see *Seibert Cylinder Oil-Cup Co. v. Detroit Lubricator Co.* (1888), 34 Fed. Rep. 216.

That a licensee violating the terms of his license by doing acts not authorized thereby, at once infringes the patent and breaks his contract, see *Pope Mfg. Co. v. Owsley* (1886), 27 Fed. Rep. 100; 37 O. G. 781.

That a licensee infringes if he exceeds the number of patented articles covered by his license, see *Aspinwall Mfg. Co. v. Gill* (1887), 32 Fed. Rep. 697.

That the covenants in a license cannot deprive the licensee of the right to show that his acts do not infringe, see *White v. Lee* (1882), 23 O. G. 1621; 14 Fed. Rep. 789.

² That a license under one patent affords no protection against another, see *Stuart v. Shantz* (1872), 6 Fisher, 35; 2 O. G. 524; *Blanchard v. Putnam* (1869), 8 Wall. 420.

That a plaintiff may recover for the infringement of one Claim of a patent though the defendant is licensed under other Claims, and though his infringement is accomplished by using the li-

censed inventions, see *United Nickel Co. v. California Electrical Works* (1885), 11 Sawyer, 250; 25 Fed. Rep. 475.

That the license to make an article described in the patent does not protect the licensee if he makes one different from the one described, see *Miller's Falls Co. v. Ives* (1877), 14 O. G. 203; 14 Blatch. 169; 2 Bann. & A. 574; *Magic Ruffle Co. v. Elm City Co.* (1875), 8 O. G. 773; 13 Blatch. 151; 2 Bann. & A. 152.

That a licensee authorized to sell materials, to be used in a patented process, to the licensees of such process, infringes by selling to others who are known not to be licensees, see *Willis v. McCullen* (1886), 29 Fed. Rep. 641; 38 O. G. 1017.

³ That if the licensee practices his own infringing invention under cover of the license, he is an infringer, see *Miller's Falls Co. v. Ives* (1877), 14 O. G. 203; 14 Blatch. 169; 2 Bann. & A. 574.

That under a license to use six or more of the patented machines upon certain conditions, the licensee using one under the patent and five under an infringing patent infringes as to the five, see *Steam Cutter Co. v. Sheldon* (1872), 5 Fisher, 477; 10 Blatch. 1.

⁴ That a license to use does not give the right to make or sell, see *Aiken v. Manchester Print Works* (1865), 2 Clifford, 435. See also §§ 812, 827, and notes, *ante*.

forms the licensed act outside the territory or the period for which his license has been granted;⁵ or in any other way exceeds the power conferred upon him,— he is guilty of infringement.⁶ Where a license is assignable, the assignee rests under the same limitations as the original licensee, and may infringe the patent by the same modes of action.⁷ A licensee may infringe not only by his own personal misappropriation of the patented invention, but through the agency of any others who unlawfully practise it with his consent.⁸

⁵ That where a license permits use in only one place it is an infringement to use elsewhere, see *Steam Cutter Co. v. Sheldon* (1872), 5 Fisher, 477; 10 Blatch. 1.

That a licensee, having a right to sell the product of the patented device only in the section where made, infringes by selling outside it, see *Wilson v. Sherman* (1850), 1 Blatch. 536.

That a licensee to sell within certain territory infringes if he sells in that territory to those who he knows will sell outside it, see *Hatch v. Hall* (1887), 30 Fed. Rep. 613; 40 O. G. 1342.

That a licensee practising the invention after his license has expired is an infringer, see *Wetherill v. Passaic Zinc Co.* (1872), 9 Phila. 385; 6 Fisher, 50; 2 O. G. 471.

That the use of two machines in succession under a license to use one is an infringement, see *Bloomer v. Gilpin* (1859), 4 Fisher, 50.

⁶ That it is not an infringement to use a second time an article marked, "Licensed to use once only," see *American Cotton Tie Co. v. Simmons* (1878), 13 O. G. 967; 3 Bann. & A. 320.

Contra, *American Cotton Tie Co. v. Simmons* (1882), 106 U. S. 89; 22 O. G. 1976; *American Cotton Tie Supply Co. v. Bullard* (1879), 17 O. G. 389; 17 Blatch. 160; 4 Bann. & A. 520.

⁷ That where a license is assignable, the assignee is not an infringer, see *Wilson v. Stolly* (1849), 5 McLean, 1.

That a railroad company being licensed to use a device on their cars, the transfer of their rolling stock and revenues to a preferred creditor gives him the same right, he being the agent of the company and not a purchaser, and his use is not an infringement, see *Ernigh v. Chamberlain* (1861), 2 Fisher, 192; 1 Bissell, 367.

That an assignee of a license is under the same restrictions and subject to the same liabilities as the original licensee, see *Moody v. Taber* (1874), Holmes, 325; 1 Bann. & A. 41; 5 O. G. 273.

That under a personal and unassignable license to make and sell, the articles on hand at the death of the licensee may be sold by his representatives, see *Montross v. Mabie* (1887), 30 Fed. Rep. 234; 41 O. G. 931.

That an optional contract to purchase a patent does not operate as a license to the vendee's licensees to make infringing articles, see *Iowa Barb Steel Wire Co. v. Southern Barbed Wire Co.* (1887), 30 Fed. Rep. 615; 40 O. G. 578.

⁸ That a licensee infringes by an unlawful use of his machine by others with his consent, see *Steam Cutter Co. v. Sheldon* (1872), 5 Fisher 477; 10 Blatch. 1.

§ 917. Infringement by a Licensee under an Implied License.

A license is implied by law in various cases, its scope being determined by the nature of the circumstances from which it arose. A patentee who acquiesces in the practice of his invention by another person, receiving compensation or the promise of compensation therefor, or looking to a different source for his reward, cannot thereafter deny the right of such other person to practise the invention in the manner and to the extent established by this actual enjoyment.¹ The law here implies a license whose limits are indicated by the past conduct of the licensee as acquiesced in by the licensor, and in these cases acts outside such customary employment of the invention are infringements.² Again, a person who, before the patent has been issued, or before the grant of a re-issue or extension, has constructed the patented article for his own use with the permission of the patentee, acquires the right to use such article until it ceases to exist;³ though to replace

§ 917. ¹ That a long use, with the acquiescence of the patentee and an agreement to pay license fees, raises an implied license, see *Blanchard v. Sprague* (1859), 1 Clifford, 288.

That a patentee by taking compensation for the right to make, use, or sell the invention, impliedly licenses these acts and cannot enjoin them, see *Gilbert & Barker Mfg. Co. v. Bussing* (1875), 8 O. G. 144; 12 Blatch. 426; 1 Bann. & A. 621.

That where a patentee gave permission to the contractors for a city to use an invention, saying to them that he would look to the city for his royalty, the city received an implied license and was not liable for any royalty, see *Rigelow v. City of Louisville* (1869), 3 Fisher, 602.

That an absolute release *in presenti* to an infringer, and a contract by him to pay royalties for past infringements in pursuance of such release, relieves him from accountability for practising the invention in future, except as to the

royalties, until the release is set aside, see *Seibert Cylinder Oil-Cup Co. v. Detroit Lubricator Co.* (1888), 34 Fed. Rep. 216; *Loercher v. Crandall* (1881), 11 Fed. Rep. 872; 21 O. G. 863; 20 Blatch. 106.

² A license by acquiescence in the practice of an invention rests either in implied contract or in estoppel. That in both cases the limits of the license are determined by the conduct of the parties, under the ordinary principles governing estoppels and implied agreements, and any use of the invention beyond these limits has the same legal aspect as an infringing use by an express licensee, see *Montross v. Mabie* (1887), 30 Fed. Rep. 234; 41 O. G. 931; also § 834 and notes, *ante*.

³ That a person who with the consent of the inventor has constructed the invention before the patent issued, may use it after the patent is granted, see Sec. 4899, Rev. Stat.; *Wade v. Metcalf* (1889), 129 U. S. 202; *Brickill v. Mayor of New York* (1880), 18 O. G.

it with another, or to make such repairs upon it as practically amount to reconstruction, is infringement.⁴ Again, an employee by applying his invention to the business of his employers and annexing it to their apparatus, or otherwise incorporating it into their property, confers on them a license to enjoy it which neither he nor his subsequent assignees can revoke.⁵ This license gives to the employers a right to use

463 ; 7 Fed. Rep. 479 ; 18 Blatch. 273 ; 5 Bann. & A. 544 ; also § 831 and notes, *ante*, and §§ 979, 1044 and notes, *post*.

That a person who has constructed the invention under a defective patent with the consent of the inventor, may employ it after a re-issue, see §§ 698, 699, 831 and notes, *ante*.

That a person who has constructed the invention during the original term, by consent of the inventor, may use it during an extension, see *Wooster v. Sidenberg* (1875), 10 O. G. 244 ; 13 Blatch. 88 ; 2 Bann. & A. 91 ; *Wood v. Michigan Southern & Northern Indiana R. R. Co.* (1868), 3 Fisher, 464 ; 2 Bissell, 62.

See also § 831, 843 and notes, *ante*.

That where a patentee had publicly authorized all persons to use his invention, in connection with certain others, one who did this under the original term may use up, during the extension, whatever he had on hand at the end of the term, see *Wooster v. Sidenberg* (1875), 13 Blatch. 88 ; 2 Bann. & A. 91 ; 10 O. G. 244.

That the use of the patented invention with impunity, before the patent was amended, does not work a license to use it, see *Howe v. Williams* (1863), 2 Fisher, 395 ; 2 Clifford, 245.

That an unauthorized use under a defective patent confers no license to use under an amended one, see *McWilliams Mfg. Co. v. Blundell* (1882), 11 Fed. Rep. 419 ; 22 O. G. 177 ; *Stimpson v. Westchester R. R. Co.* (1846), 4 How. 380 ; 2 Robb. 335.

⁴ That under Sec. 7, act of 1839, and

the act of 1870, the license is to use only the precise thing after patent which was made or purchased before it, and to make and use others is infringement, see *Brickill v. Mayor of New York* (1880), 18 O. G. 463 ; 7 Fed. Rep. 479 ; 18 Blatch. 273 ; 5 Bann. & A. 544.

That the act of 1839, protecting the use of inventions which were used before the patent, does not cover the whole patented invention, but only such parts of it as were in use, see *Brickill v. Mayor of New York* (1880), 7 Fed. Rep. 479 ; 18 Blatch. 273 ; 18 O. G. 463 ; 5 Bann. & A. 544.

That though an assignee of the original term may use the articles constructed during the term after the extension, he has no implied license to make them for any purpose, see *Wood v. Michigan Southern & Northern Indiana R. R. Co.* (1868), 3 Fisher, 464 ; 2 Bissell, 62.

⁵ That an employer has an implied license to use such inventions of his employee as were by the latter applied to the business of the former during the term of employment, see *Herman v. Herman* (1886) 37 O. G. 892 ; 29 Fed. Rep. 92 ; *Whiting v. Graves* (1878) 13 O. G. 455 ; 3 Bann. & A. 222 ; *Continental Windmill Co. v. Empire Windmill Co.* (1871), 8 Blatch. 295 ; 4 Fisher 428.

See also §§ 832, 833 and notes, *ante*.

That where a partner patents a design and applies it to articles made in the business of the firm, the firm may use the design until the partnership is dissolved, and after dissolution may sell by receiver or otherwise the articles on

the invention in the manner in which their employee, the inventor, has applied it, and until it is no longer capable of use. But to rebuild it, or supply its place with others of the same character, or to appropriate it to different uses, are acts beyond their implied authority and are infringements of the patent. Finally, the purchaser of a patented article from one who had a right to sell it, or who, having sold it wrongfully, has compensated the owner of the patent for the injury inflicted by the wrongful sale, has an implied license to use it for any purpose and in any place until it is destroyed, unless the terms of his purchase have otherwise provided.⁶ But such a licensee cannot reconstruct the article, nor procure and use a new one in its stead, nor, if the purchase be restricted by conditions, use it in violation of his contract, without committing an infringement.⁷ These are the principal cases in which a license is implied, and the tests of infringement em-

hand containing such design, see *Montrouss v. Mabie* (1887) 30 Fed. Rep. 234 ; 41 O. G. 931.

⁶ That the purchaser of a patented material without restrictions, from one who had a right to sell it, may use it for any purpose, see *Metropolitan Washing Mach. Co. v. Earle* (1861), 2 Fisher, 203 ; 3 Wall. Jr. 320.

See also §§ 824, 826 and notes, *ante*.

That such purchaser may use the article in any place, see *Roosevelt v. Western Electric Co.* (1884), 20 Fed. Rep. 724 ; 28 O. G. 812.

That a purchaser of articles with knowledge of prior grants cannot use the articles within the granted territory, see *Sheldon Axle Co. v. Standard Axle Works* (1889), 37 Fed. Rep. 789.

That a purchaser of articles cannot sell them in the way of trade in another's exclusive territory, see *Standard Folding Bed Co. v. Keeler* (1889), 37 Fed. Rep. 693.

See also §§ 824, 826 and notes, *ante*.

That a purchaser from an infringing seller acquires no license to use, see *Gilbert & Barker Mfg. Co. v. Bussing*

(1875), 8 O. G. 144 ; 12 Blatch. 426 ; 1 Bann. & A. 621.

See also §§ 824-830 and notes, *ante*.

That a purchaser from a licensee, who has previously repudiated his license, acquires no right to use if he knew of such repudiation, see *Moody v. Taber* (1874), 1 Bann. & A. 41 ; Holmes, 325 ; 5 O. G. 273.

That a purchaser from a wrongful seller, who has compensated the owner of the patent for the wrongful sale, has an implied license to use, see *Steam Stone Cutter Co. v. Sheldon* (1884), 22 Blatch. 484 ; 21 Fed. Rep. 875 ; *Allis v. Stowell* (1883), 16 Fed. Rep. 783 ; *Gilbert & Barker Mfg. Co. v. Bussing* (1875), 8 O. G. 144 ; 12 Blatch. 426 ; 1 Bann. & A. 621 ; *Eunson v. Dodge* (1873), 18 Wall. 414 ; 5 O. G. 95.

See also §§ 829, 830 and notes, *ante*.

That a vendee, under an unlawful but subsequently legalized sale, may himself resell, see *Alabastine Co. v. Richardson* (1886), 26 Fed. Rep. 620 ; 35 O. G. 1225.

⁷ That his implied license to use gives the purchaser no right to rebuild,

ployed in these will furnish a sufficient guide for cases of less frequent occurrence.

§ 918. Infringement by Common Carriers.

A common carrier may participate in the infringing acts of others by aiding in their perpetration or in securing their unwarranted reward.¹ Thus if he conspires with an infringing manufacturer of the invention to transport his products to a market though beyond the limits of the United States, or with

see *Gottfried v. Philip Best Brewing Co.* (1879), 17 O. G. 675; 5 Bann. & A. 4.

See also § 827 and notes, *ante*.

That the purchaser's license does not authorize him to replace the purchased articles with new ones, see *Aiken v. Manchester Print Works* (1865), 2 Clifford, 435.

See also § 825 and notes, *ante*.

§ 918. ¹ In *American Cotton Tie Supply Co. v. McCready* (1879), 17 O. G. 565, Blatchford, J. : (567) "It is contended for the defendants that the steamship company, as it acts solely in the capacity of common carrier of these ties, does not come within the meaning of the statute as an infringer of the patents; that it has nothing to do with the rights of the plaintiff or the invasion of those rights by others; that it does not use or aid others in using the ties, because such use cannot be had until after transportation and delivery; that the company, by transporting the ties, does not sell them to others to be used, or aid in selling them to others to be used; that as a common carrier the company is bound to receive and carry all goods offered by any person; that it would be against public policy to restrain the company; that it would impede its business and inflict injury on the whole community; that the suit is improperly brought against the defendants, and should be brought against the company; that the defend-

ants are only officers of the company, with distinct duties, and have no control over the goods and no power to refuse to receive them; that the company ought not to be compelled, at its own expense, to protect the plaintiff's business; and that it owes no duty to the plaintiff to answer for the diligence which the plaintiff ought to use in the protection of its own interests. It is entirely clear that the owners of the infringing and unlicensed cotton ties, who are causing them to be transported by the vessels of the Old Dominion Steamship Company, are sending them for sale and use, and are employing said company and its officers as agents and servants in promoting and effecting such sale and use. It would seem, on principle, that there ought to be no difficulty in restraining by injunction all persons, whether officers of a corporation or not, who are aiding in the promotion of the infringing sale and use, whether such persons would be liable for profits or damages or not. It has been so held by this court. (*Goodyear v. Phelps*, 3 Blatch. C. C. R. 91; *Poppenhusen v. Falke*, 4 Blatch. 493)." 17 Blatch. 291 (298); 4 Bann. & A. 588 (595).

That a steamship company transporting infringing articles, after due notice from the patentee, act as an agent of the infringer, and are liable to injunction unless they disclose the names of the shipper, see *American Cotton Tie*

persons who desire to use or sell the invention in violation of the patent to procure it and deliver it to them, he makes himself an agent in the wrong and is responsible as a direct infringer. Whether he is accountable for the injury resulting to the patentee from the infringing manufacture, use, or sale, and if so in what measure, is not yet determined, though he thereby subjects himself to the restraining process of a court of equity. But in these cases the assistance given must have been wilful and collusive; for service rendered in the ordinary course of business and without illegitimate intent is merely a fulfilment of his duty, and does not make him liable for wrongs committed through his means by shippers or consignees.

§ 919. Infringement by Contractors.

The obligations under which a private individual may rest, either to other individuals or to the public, do not authorize him to practise any patented invention without permission from the patentee, even though his obligations were created in ignorance of the existence of the patent.¹ A contractor, in

Supply Co. v. McCready (1879), 17 O. G. 565; 17 Blatch. 291; 4 Bann. & A. 588.

That importation and transshipment by custom-house agents of the importers, having no possession nor control of the infringing articles, does not make them liable for infringement, see Nobel's Explosives Co. v. Jones (1881), L. R. 17 Ch. D. 721; 8 App. Cas. 5.

§ 919. ¹ In *Jacobs v. Commissioners of Hamilton Co.* (1862), 4 Fisher, 81, Leavitt, J.: (85) "There can be no question that if the contractor, in the fulfilment of his obligation, violates the patent-right of another, he is answerable for the infringement. He cannot defend himself against the claim of the patentee by asserting that he committed the wrong under a contract with the county commissioners. It was his own folly to have imposed on himself such an obligation, and he alone is

responsible for the injury which another may sustain as the consequence. If he had foreknowledge that the work he had bound himself to perform involved an infringement of a patent-right, it was his business to have procured a license for the use of the improvement; and, failing to do so, he takes on himself the responsibility of a violation of the patent. If he entered into the contract in ignorance of the fact that the work he has agreed to do would violate a patent-right, he is not therefore protected from liability. This fact may have a bearing on the question of the amount of damages to be recovered, but does not destroy the right of action by the injured party. And it is no answer to this view of the subject that cases may occur in which the patentee may fail in the enforcement of his just rights by the insolvency or irresponsibility of the contractor. This is an incident,

entering into an agreement to perform certain services or supply certain articles, assumes the risk of being prevented from the fulfilment of his contract by the assertion of the rights of some unknown patentee; and if he violates those rights he cannot screen himself under the duty which he owes to others. Where the public are interested in the fulfilment of the contract the remedies applied may be less peremptory than where the individual contractor or his promisee are alone concerned, and the completion of the contract may be permitted, leaving the patentee to seek his compensation from the contractor after his contract obligations are discharged;² but this lenity is not extended on account of the contractor, who in some form of remedy is compelled to pay the full penalty of his infringement.

§ 920. Infringements by Agents, and Workmen.

Agents who, of their own volition, participate in an infringing act thereby become infringers, although in the performance of the act itself they have no pecuniary interest.¹ No act of a mere agent is infringement, unless it would be such if personally perpetrated by his principal.² But salesmen selling on commission, and other servants who derive a distinct and independent benefit from their invasions of the patent, incur a separate liability upon their own account, as well as in the capacity of employees.³ A workman acting

often connected with cases of legal liability, which can have no influence upon the application of known and settled legal principles. Such a result may be a great misfortune to a losing party, but cannot furnish a reason for casting responsibility upon another party not legally chargeable with it." 1 Bond, 500 (504).

² That a contractor may be allowed to finish a work of importance to the public, though enjoined as to all other uses of the invention, see § 1200 and notes, *post*.

§ 920. ¹ That a sale by a salesman having no interest in the sale is an in-

fringement, see *Potter v. Crowell* (1866), 3 Fisher, 112; 1 Abbott, 89.

That an accommodation partner, who takes no part in the business and allows his co-partner to receive all its benefits, is liable as joining in and inducing the infringement and may be sued alone or jointly with the active infringer, see *American Bell Telephone Co. v. Albright* (1887), 32 Fed. Rep. 287.

² That unless the parties who are primarily liable infringe, those who are secondarily liable do not, see *Bigelow v. City of Louisville* (1869), 3 Fisher, 602.

³ In *Steiger v. Heidelberger* (1880), 4 Fed. Rep. 455, Blatchford, J. : (457)

under orders and exercising no choice as to the objects upon which his energies are expended does not infringe by manufacturing or using patented inventions.⁴

§ 921. Infringement by Private Individuals.

All private individuals who voluntarily engage in the unauthorized manufacture, use, or sale of the patented invention, whether by itself or as a part of some more comprehensive instrument or operation, are guilty of infringement.¹ Neither the motive prompting the infringing act, nor the knowledge of his own wrong-doing on the part of the offender, are elements to be considered.² Where a specific intent is necessary

“As to the first branch of the plea, or the first plea, whichever it may be, . . . the plea must be overruled. The substance of it is that the defendant is not liable in this suit for what the plea sets forth as having been done by him. This is not so. The plea shows that the defendant has made a separate and independent profit to himself out of the sale of such goods as he has been instrumental in selling, by receiving a commission thereon, in which commission Loeb & Schoenfeld have no interest; that his commission is dependent on the sales; that he has made the sales for the purpose of receiving the commission; and that he obtains the commission by making the sales. This is a distinct profit from any profits made by Loeb & Schoenfeld. The commission to this defendant would not be included in any profits to be accounted for by Loeb & Schoenfeld, and such commission is a direct profit to this defendant from the sale of the goods. Moreover, this defendant, although selling only under the circumstances set forth, is liable to be restrained in this court by an injunction from selling the infringing goods, and this suit is properly brought against him for that purpose. This court has obtained jurisdiction over his person. The plaintiff has a

right to restrain the defendant, by injunction, from participating in the way set forth in such sales, although a bill will also lie against Loeb & Schoenfeld to restrain them from participating in the way they do in the same sales (*Malthy v. Boto*, 14 Blatch. 53).” 18 O. G. 1463 (1463); 18 Blatch. 426 (428).

⁴ That workmen, having no option, do not infringe by obeying orders, see *Young v. Foerster* (1889), 37 Fed. Rep. 203; *United Nickel Co. v. Worthington* (1882), 23 O. G. 939; 13 Fed. Rep. 392; *Heaton v. Quintard* (1869), 7 Blatch. 73; *Delano v. Scott* (1834), Gilpin, 489; 1 Robb, 700.

That a son acting under his father cannot be sued for infringement if he has no interest in the business, see *McDonald v. Whitney* (1885), 24 Fed. Rep. 600; 32 O. G. 1465.

That a father may be liable for the infringements of a minor son in his employ, see *Dunks v. Grey* (1880), 3 Fed. Rep. 862; 5 Bann. & A. 634.

§ 921.¹ That the voluntary maker is an infringer though he is employed by another to do so, see *Bryce v. Dorr* (1845), 3 McLean, 582; 2 Robb, 302.

² That knowledge and intent are immaterial, see § 901 and notes, *ante*.

That ignorance of the patent does

to constitute the infringing act, it must of course be present, but otherwise the exterior action is alone regarded.³ The injury to the patentee and not the moral guilt of the infringer is the basis and the measure of responsibility, and though the infringer were a lunatic the rights and remedies of the patentee would be the same.⁴

§ 922. Infringement of a Patent for a Combination.

In applying the foregoing propositions to the different classes of inventions, the fundamental distinction between combinations and simple inventions must be first considered. A combination is a group of instruments or operations united under a co-operative law. Its identity depends upon the presence in the combination of each one of these elements or its equivalent, and upon their co-operation in this specific manner to produce the ultimate result. Hence any change in the number of its elements, or in their essential character, or in their mode of co-operation, is a departure from the substance of the combination, and constitutes a different invention. A patented combination is the combination described and claimed in the patent which protects it. Of whatever elements it may actually be composed and whatever may be the method of their union as the inventor conceived and practises his invention, the elements specified in the patent, and the co-operative law there prescribed, are those which characterize the patented combination and form the subject of the exclusive privileges of the patentee.¹ The infringement of a combination-patent

not excuse, see *Royer v. Coupe* (1886), 29 Fed. Rep. 358; 39 O. G. 239.

³ That a specific intent to infringe may qualify acts otherwise innocent, see § 901 and notes, *ante*, and § 924 and notes, *post*.

⁴ That a lunatic may infringe and be liable for profits and costs, see *Avery v. Wilson* (1884), 20 Fed. Rep. 856.

§ 922. ¹ That the patentee of a combination cannot aver that any one of its claimed elements is useless and may be dispensed with, see *Rowell v. Lindsay* (1881), 6 Fed. Rep. 290; 19

O. G. 1565; 10 Bissell, 217; *Coolidge v. McCone* (1874), 5 O. G. 458; 2 Sawyer, 571; 1 Bann. & A. 78; *Westlake v. Cartter* (1873), 6 Fisher, 519; 4 O. G. 636; *Vance v. Campbell* (1861), 1 Black, 427; and §§ 278, 282, 527, 670, and notes, *ante*.

That the courts cannot decide that any element in a combination is immaterial, but merely whether an omitted part is supplied by an equivalent, see *Water Meter Co. v. Desper* (1879), 101 U. S. 332.

That if an inventor regards an ele-

therefore, consists in the manufacture, use, or sale of any combination in which precisely the same elements or their equivalents are united under the same co-operative law.² To make or use or sell a combination in which the same elements are differently combined,³ or a combination which comprises only a portion of these elements, though the discarded elements are practically useless, and though the combination thus created was suggested by the former, is not an infringement.⁴

ment as material, those who claim under him cannot assert that it is immaterial, see *Lo Fever v. Remington* (1882), 13 Fed. Rep. 86; 22 O. G. 1537; 21 Blatch. 80.

² That a combination is infringed when the same elements and plan of co-operation are employed, see *Dederick v. Cassell* (1881), 9 Fed. Rep. 306; 20 O. G. 1233; 14 Phila. 503.

That a combination is infringed if equivalents are used, see *Dederick v. Whitman Agricultural Co.* (1886), 36 O. G. 570; 26 Fed. Rep. 763; *Wheeler v. Morris* (1886), 36 O. G. 822; 26 Fed. Rep. 918; *Reay v. Raynor* (1884), 26 O. G. 1111; 22 Blatch. 13; 19 Fed. Rep. 308; *Mundy v. Lidgerwood Mfg. Co.* (1884), 20 Fed. Rep. 114; 27 O. G. 718; and § 254 and notes, *ante*.

That a combination is not infringed by a union of different mechanical devices accomplishing the same result, see *Good v. Bailey* (1887), 41 O. G. 935; 33 Fed. Rep. 42.

³ That a different combination of the same elements is not an infringement, see *Pattee v. Moline Plow Co.* (1881), 9 Fed. Rep. 821; 22 O. G. 173; 10 Bissell, 377; *Byam v. Eddy* (1853), 2 Blatch. 521; 24 Vt. 666.

That a change of arrangement may be infringement, see *Belle Patent Button Fastener Co. v. Lucas* (1886), 37 O. G. 1004; 28 Fed. Rep. 371.

⁴ In *Rowell v. Lindsay* (1881), 6 Fed. Rep. 290, Dyer, J.: (297) "It follows, therefore, from these state-

ments of the law, that if the defendants omit entirely one of the elements of the complainants' combination without substituting any other, or if they substitute another which is new, or which performs a substantially different function, or if it is one that is old, but was not known at the date of the complainants' patent as a proper substitute for the omitted ingredient, or if their machine consists in a new combination of the same ingredients, then the defendants do not infringe." 19 O. G. 1565 (1567); 10 Bissell, 217 (225).

Further, that the use of less than all the elements of a combination does not infringe a patent for the combination alone, see *Byerly v. Cleveland Linseed Oil Works* (1887), 31 Fed. Rep. 73; *Thoens v. Israel* (1887), 31 Fed. Rep. 556; *Newark Mach. Co. v. Hargett* (1886), 36 O. G. 692; 28 Fed. Rep. 567; *Newark Mach. Co. v. Gaar* (1886), 37 O. G. 1250; 29 Fed. Rep. 322; *Tobey Furniture Co. v. Colby* (1885), 34 O. G. 1276; 26 Fed. Rep. 100; *Rowell v. Lindsay* (1885), 113 U. S. 97; 31 O. G. 120; *Saladee v. Racine Wagon & Carriage Co.* (1884), 20 Fed. Rep. 685; 27 O. G. 1133; *Sharp v. Reissner* (1883), 23 O. G. 1530; 15 Fed. Rep. 919; *Doane & Wellington Mfg. Co. v. Smith* (1882), 24 O. G. 302; 15 Fed. Rep. 459; *Goss v. Cameron* (1882), 14 Fed. Rep. 576; 11 Bissell, 389; 23 O. G. 741; *Hammerschlag v. Garrett* (1882), 21 O. G. 1199; 10 Fed. Rep. 479; *Fuller v. Yentzer* (1876), 94 U. S. 288; 11

To select the most available elements in two distinct patented combinations, and unite them in a third, does not invade the

O. G. 551 ; *Sands v. Wardwell* (1869), 3 Clifford, 277 ; *Caso v. Brown* (1862), 2 Fisher, 268 ; 1 Bissell, 382 ; *Singer v. Walmsley* (1860), 1 Fisher, 558 ; *Byam v. Eddy* (1853), 2 Blatch. 521 ; 24 Vt. 666 ; *Foster v. Moore* (1852), 1 Curtis, 279 ; *Evans v. Eaton* (1816), Peters C. C. 322 ; 1 Robb, 68 ; and other cases cited in § 282, note 1, *ante*.

That a combination is not infringed unless all its elements, as they are claimed, are used, whether they are essential or not, see *Royer v. Schultz Bolting Co.* (1886), 38 O. G. 898 ; 28 Fed. Rep. 850.

That a combination is not infringed by the use of less than all its elements unless the elements used were new and patentable to the same inventor, see *Thoens v. Israel* (1887), 31 Fed. Rep. 556.

That a combination is not infringed if one of its elements is omitted where the omitted element performs a function of its own not discharged by the remaining elements, see *Tobey Furniture Co. v. Colby* (1885), 26 Fed. Rep. 100 ; 34 O. G. 1276.

That a patent for a combination of old elements is not infringed by using less than all the elements, where the two combinations are not the same in operation, see *Faurot v. Hawes* (1880), 3 Fed. Rep. 456.

That a Claim for a combination of three elements is not infringed by the use of two only, though the third is useless, for the patentee must stand by his Claim, see *Coolidge v. McCone* (1874), 5 O. G. 458 ; 2 Sawyer, 571 ; 1 Bann. & A. 78.

That it is no infringement to use less than all the elements of a combination, though nearly all the material parts of the alleged infringing device were suggested by the other, see *Snow v. Lake Shore & Mich. Southern R. R.*

Co. (1883), 18 Fed. Rep. 602 ; 25 O. G. 1280.

That a combination is not infringed where one essential element is omitted and another is substituted accomplishing the same result in a different way, see *Schmidt v. Freese* (1882), 21 O. G. 1876 ; 12 Fed. Rep. 563.

That a combination of old elements is not infringed by substituting a new element not known at the date of the patent, see *Rowell v. Lindsay* (1881), 6 Fed. Rep. 290 ; 19 O. G. 1565 ; 10 Bissell, 217 ; *American Bell Telephone Co. v. Spencer* (1881), 8 Fed. Rep. 509 ; 20 O. G. 299.

That the combination may be infringed though some of the elements now used were unknown at the date of the patent, see *Potter v. Stewart* (1881), 19 O. G. 997 ; 7 Fed. Rep. 215 ; 18 Blatch. 561. For an explanation of the principle on which this doctrine rests, see § 256, note 2, *ante*.

That the substitution of a new element in a combination makes it a different combination, not an infringement, see *Babcock v. Judd* (1883), 15 Fed. Rep. 160 ; *Babcock v. Judd* (1880), 1 Fed. Rep. 408 ; 17 O. G. 1351 ; 5 Bann. & A. 127. This can be true only where the old combination loses its identity by the substitution of the new element.

That a combination is not infringed by using certain of its elements in connection with others which are not equivalents for those omitted, see *Archer v. Arnd* (1887), 31 Fed. Rep. 475 ; 40 O. G. 1032.

That a combination is not infringed where the elements used by the defendant will not make the patented combination in a practical form, see *Gray v. Bangs* (1887), 40 O. G. 812 ; 31 Fed. Rep. 342.

That where a Claim covers several

rights of either patentee.⁶ But where the patented combination is employed, either alone or with improvements or as an element in a new combination, the patent which protects it is infringed.⁶ A useless combination, although patented in violation of the law, is not patentable subject-matter, and if appropriated by one who so improves or adds to it as to produce a useful combination, he may practise it or patent it as his own invention.⁷

§ 923. Infringement of a Patent for a Combination : Unauthorized Use of its Elements and Sub-combinations.

A patent claiming a combination only does not protect the elements of which it is composed.¹ If these are old, they are

old parts and one new part, it is not infringed if the new part is not used, see *Bragg v. Fitch* (1887), 121 U. S. 478 ; 39 O. G. 829.

⁶ That where two patents for combinations are both assigned to the same person, his rights are not infringed by a combination distinct from either, but containing elements of both, see *Washburn & Moen Mfg. Co. v. Griesche* (1883), 16 Fed. Rep. 669 ; 5 McCrary, 246.

That a patent for a combination and a process is not infringed by the use of part of each, see *Howe v. Abbott* (1842), 2 Story, 190 ; 2 Robb, 99.

That Claims for a method and a combination are not infringed by a different method and fewer elements, see *Goss v. Cameron* (1882), 23 O. G. 741 ; 14 Fed. Rep. 576 ; 11 Bissell, 389.

⁶ That the use of a patented invention as an element in a new combination is an infringement, see *Cleveland v. Towle* (1869), 3 Fisher, 525.

That the use of a combination in a different machine from that in which it was first described is an infringement, see *La Rue v. Western Electric Co.* (1886), 28 Fed. Rep. 85 ; 36 O. G. 453.

That to use the entire patented com-

bination is an infringement though some of its details may be improved, see *White v. Heath* (1882), 22 O. G. 500 ; 10 Fed. Rep. 291 ; *Foster v. Moore* (1852), 1 Curtis, 279.

That where an element in a combination is improved, and yet performs the same functions in the same way, the use of the combination is an infringement, see *Potter v. Stewart* (1881), 19 O. G. 997 ; 7 Fed. Rep. 215 ; 18 Blatch. 561.

⁷ That to use a useless patented combination as part of a new one is not infringement, the old patent being invalid, see *Bliss v. Brooklyn* (1873), 3 O. G. 269 ; 6 Fisher, 289 ; 10 Blatch. 521.

That the addition to a combination of an element which alone makes it an operative combination, and the use of the whole so constituted, is not an infringement, see *Robertson v. Hill* (1873), 6 Fisher, 465 ; 4 O. G. 132.

As to various points concerning identity, equivalence, etc., in combinations, see §§ 156, 241, 242, 254, 256, 267, 268, 277-282, and notes, *ante*.

§ 923. ¹ That a combination is not infringed unless used as an entirety, see *Fuller v. Yentzer* (1876), 94 U. S. 288 ; 11 O. G. 551.

already the property of the public ; if they are new inventions of the patentee, his failure to claim them is a concession, so far as this patent is concerned, that they are old.² It has indeed been sometimes stated that a combination-patent covers such of its elements and sub-combinations as are original with the patentee, but this opinion is not consistent with the strictness of the rules which require the inventor to distinctly claim whatever the patent is intended to secure.³ The rea-

² That unless claimed as new in the patent, the elements of a combination are regarded as old, see *Rowell v. Lindsay* (1881), 6 Fed. Rep. 290 ; 19 O. G. 1565 ; 10 *Bissell*, 217.

³ In *Lee v. Blandy* (1890), 2 *Fisher*, 89, *Leavitt, J.* : (93) " There are two classes or kinds of combinations recognized by our Patent Laws, which are properly the subject of a patent. The first may be defined to be one in which all the parts were before known, and where the sole merit of the invention consists in such an arrangement of them as to produce a new and useful result ; or where, by adopting parts of a machine which may have been known for ages, an inventor has succeeded in making such an arrangement of them as that they produce a result never before obtained, and have in that point of view the merit of originality, and are, therefore, patentable. There is another class of combinations, where some of the parts or elements of the combination are new, and their invention claimed, but where they are used in combination with parts or elements that were known before. It is well settled that a patent may be obtained for the first class of combinations, but it is a principle well recognized that there is no infringement unless the party has used all the elements. If the combination consists of A, B, C, — three mechanical structures long known, — and if the party sued has only the parts B, C, and not A, he is not regarded as

an infringer ; he must use all to subject himself to liability. If the combination have the other character to which I have referred, being, to a certain extent, new, but embracing some old parts or elements, then there is an infringement by the use of that part which is new and the invention of the patentee." 1 *Bond*, 361 (365).

In *Moody v. Fiske* (1820), 2 *Mason*, 112, *Story, J.* : (117) " Where the patent goes for the whole of a machine as a new invention, and the machine is in its structure substantially new, any person who pirates a part of the machine, substantially new in its structure, deprives the inventor so far of his exclusive right in his invention, and may in a great measure destroy the value of the patent. Where the patent is for several distinct improvements in an existing machine, or for an improved machine, incorporating several distinct improvements which are clearly specified, then if a person pirates one of the improvements, he violates the exclusive right of the patentee, for the patent is as broad as the invention, and the invention covers all the improvements ; and it is a wrong done to the patentee to deprive him of his exclusive right in any of his improvements. Where a patent is for a new combination of existing machinery or machines, and does not specify or claim any improvements or invention except the combination, unless that combination is substantially violated the paten-

sonable and generally acknowledged doctrine recognizes that elements and sub-combinations, being inventions entirely distinct from the combination into which they enter, must be separately claimed in order to make their appropriation an infringement of the patent.⁴

tee is not entitled to any remedy, although parts of the machinery are used by another, because the patent, by its terms, stands upon the combination only. In such a case proof that the machines, or any part of their structure, existed before forms no objection to the patent, unless the combination has existed before, for the reason that the invention is limited to the combination. And yet if the combination itself be not wholly new, but up to a certain point has existed before and the patentee claims the whole combination as new instead of his own improvements only, as by taking out a patent for the whole machine, doubtless his patent is void, for it exceeds his invention. But if there be different and distinct improvements constituting parts of the combination, which are specified as such in the patent and specification, and any one of them be pirated, the same rule seems to apply as in other cases where part of an invention is pirated, for the patent then shows that the invention is not limited to the mere combination but includes the particular improvements specified." 1 Robb, 312 (317).

See also *Thoens v. Israel* (1887), 31 Fed. Rep. 556; *Rowell v. Lindsay* (1881), 6 Fed. Rep. 290; 19 O. G. 1565; 10 Bissell, 217; *Holly v. Vergennes Mach. Co.* (1880), 18 O. G. 1177; 4 Fed. Rep. 74; 18 Blatch. 327; *Sharp v. Tiffit* (1880), 2 Fed. Rep. 697; 17 O. G. 1282; 18 Blatch. 132; 5 Bann. & A. 399; *Adair v. Thayer* (1880), 4 Fed. Rep. 441; 17 Blatch. 468; 5 Bann. & A. 118.

Although the foregoing cases are

often referred to as authorities for the position that a patent for a combination embraces such new elements and sub-combinations as are due to the same inventor's creative acts, yet in some of them, if not in all, the Claims of the patent were actually construed to cover the subordinate parts as well as the entire combination, and thus made the patent one for the elements as well as for the combination. In that view these cases are really in harmony with the proper and generally accepted rule.

⁴ In *McCormick v. Manny* (1855), 6 McLean, 539, McLean, J. : (547) "A patent which claims mechanical powers or things in combination, is not infringed by using a part of the combination. To this rule there is no exception."

In *Barrett v. Hall* (1818), 1 Mason, 447, Story, J. : (474) "In the next place, a patent may be for a new combination of machines to produce certain effects; and this, whether the machines constituting the combination be new or old. But in such case, the patent being for the combination only, it is no infringement of the patent to use any of the machines separately, if the whole combination be not used; for in such case the thing patented is not the separate machines, but the combination; and the statute gives no remedy, except for a violation of the thing patented. This was the doctrine of Mr. Justice Washington in his most able opinion in *Evans v. Eaton*; and it has not been in the slightest degree shaken in the Supreme Court. I hesitate not one moment in adopting it, as established on solid foundations. It has indeed

§ 924. Infringement of a Patent for a Combination: Unauthorized Use of Part of the Combination.

The acts by which a combination-patent is infringed thus involve the making, use, or sale of the complete combination. A combination is complete when all its elements, with their connecting parts, are finished ready to be united. But here, as elsewhere, the specific intent may supply in some degree the place of the exterior act. To make or sell a single element with the intent that it shall be united to the other elements, and so complete the combination, is infringement.¹

been said, that where there is a patent for the whole of a machine, whoever imitates it, either in whole or in part, is subject to an action at the suit of the patentee. But supposing this doctrine to be true in any case and under any qualifications (which may well be doubted), it can apply only where the whole machine is entirely new, and cannot apply where the patent is limited, by its very terms, to the combination of several machines." 1 Robb, 207 (235).

In *Evans v. Eaton* (1816), Peters C. C. 322, Washington, J. : (346) "If the plaintiff is not the inventor of the parts, he has no right to complain that they are used, if not in a way to infringe his right to their combined use. If he is the original inventor of the different machines constituting the whole discovery, or any of them, he might have obtained a separate patent for those of which he was the original inventor; in which case, the objections stated would not have been in his way." 1 Robb, 68 (94).

See also §§ 527, 670-672, and notes, *ante*.

That a combination-patent containing a Claim for each element is infringed by the use of any one element alone, see *Henderson v. Cleveland Co-operative Stove Co.* (1877), 12 O. G. 4; 2 Bann. & A. 604.

§ 924. ¹ In *Saxe v. Hammond* (1875),

7 O. G. 781, Shepley, J. : (782) "Different parties may all infringe by respectively making or selling, each of them, one of the elements of a patented combination, provided those separate elements are made for the purpose and with the intent of their being combined by a party having no right to combine them. But the mere manufacture of a separate element of a patented combination, unless such manufacture be proved to have been conducted for the purpose and with the intent of aiding infringement, is not, in and of itself, infringement." Holmes, 456 (459); 1 Bann. & A. 629 (632).

In *Barnes v. Straus* (1872), 2 O. G. 62, Blatchford, J. : (64) "The pair of springs of the patent—that is, the two springs connected by the clasps—constitutes, as a whole, a patentable combination. The two springs and the clasps connecting them are all required to make the article as a 'corset-spring' at all useful in performing the functions which it performs when the springs are actually combined by the clasps when the corset is worn. The combination does not have its full effects developed until it is in the corset. Yet it exists, *pro tanto*, so as to be an infringement, when the springs and clasps are made, ready to be inserted in a corset." 5 Fisher, 531 (536); 9 Blatch. 553 (558).

In *Wallace v. Holmes, Booth, & Haydens* (1871), 1 O. G. 117, Woodruff,

But to sell elements suitable for several different patented combinations does not make the vendor a partaker in the in-

J.: (122) "The rule of law invoked by the defendants is this: that where a patent is for a combination merely, it is not infringed by one who uses one or more of the parts, but not all, to produce the same results either by themselves or by the aid of other devices. This rule is well settled, and is not questioned in the trial. The rule is fully stated by Chief Justice Taney in *Prouty et al. v. Ruggles et al.*, 16 Peters, 341, and in other cases cited by the counsel: *Ryan v. Fearn*, 1 Curtis, 265; *Foster v. Moore*, 1 Curtis, 292; *Vance v. Campbell*, 1 Black, 427; *Godfrey v. Eames*, 1 Wallace, 79. But I am not satisfied that this rule will protect the defendants. If, in actual concert with a third party, with a view to the actual production of the patented improvement in lamps, and the sale and use thereafter, they consented to manufacture the burner, and such other party to make the chimney, and in such concert they actually make and sell the burner, and he the chimney, each utterly useless without the other, and each intended to be used and actually sold to be used with the other, — it cannot be doubtful that they must be decreed to be joint infringers of the complainants' patent. It cannot be that when a useful machine is patented as a combination of parts, two or more can engage in its construction and sale, and protect themselves by showing that, though united in an effort to produce the same machine, sell, and bring it into extensive use, each makes and sells one part only which is useless without the other, and still another person, in precise conformity with the purpose in view, puts them together for use. If it were so, such patents would indeed be of little value. In such cases all are tort-feasors, engaged in a common pur-

pose to infringe the patent, and actually, by their concerted action, producing that result. . . . Here the actual concert with others is a certain inference, from the nature of the case, and from the distinct efforts of the defendants to bring the burner in question into use, — which can only be done by adding the chimney. The defendants have not, perhaps, made an actual pre-arrangement with any particular person to supply the chimney to be added to the burner, but every sale they make is a proposal to the purchaser to do this, and his purchase is a consent with the defendants that he will do or cause it to be done. The defendants are therefore active parties to the whole infringement, consenting and acting to that end, manufacturing and selling for that purpose." 5 Fisher, 37 (46); 9 Blatch. 65 (75).

See also, *Maynard v. Pawling* (1880), 18 O. G. 244; 3 Fed. Rep. 711; 5 Bann. & A. 551; *Richardson v. Noyes* (1876), 10 O. G. 507; 2 Bann. & A. 398; *Coolidge v. McCone* (1874), 1 Bann. & A. 78; 2 Sawyer, 571; 5 O. G. 458; *Renwick v. Pond* (1872), 5 Fisher, 56^o; 2 O. G. 392; 10 Blatch. 39.

That to divide a device into two parts, and so sell it to be combined by the user, is an infringement, see *Strobridge v. Lindsay* (1881), 6 Fed. Rep. 510; 19 O. G. 1285.

That a sale of the materials of a patented combination with an intent that the purchaser should combine them is an infringement, see *Bowker v. Dows* (1878), 15 O. G. 510; 3 Bann. & A. 518.

That to make and sell part of a combination, with intent that it be used in connection with the other parts, is infringement, and such intent may be inferred when the part sold is appar-

fringement of any one of them in which it may eventually be used, unless he and the infringer were in concert with each other.²

§ 925. Infringement of a Patent for an Art.

An art is an invention distinct alike from the apparatus by which it is practised and the product in which it results, and hence, if patented, it can be infringed neither by making and selling the one nor by the sale and use of the other.¹ The infringement of a patented art consists only in the performance of all the acts of which it is composed or their equivalents, in the manner and in the order in which they are claimed in the patent.² If one of the steps claimed as essen-

ently capable of no other use, see *Schneider v. Pountney* 1884), 29 O. G. 84; 21 Fed. Rep. 399.

² That the seller of parts of a patented combination which are also useful in other connections does not infringe unless acting in concert with others, see *Bliss v. Merrill* (1887), 42 O. G. 97; *Maynard v. Pawling* (1880), 18 O. G. 244; 3 Fed. Rep. 711; 5 Bann. & A. 551; *Saxe v. Hammond* (1875), 7 O. G. 781; *Holmes*, 456; 1 Bann. & A. 629.

That it is not an infringement to make and sell elements which are useful in various combinations though the seller may expect them to be used in the patented combination, see *Millner v. Schofield* (1881), 4 Hughes, 258.

See also §§ 900, 903, and notes, *ante*.

§ 925. ¹ That the purchaser of the product of a process does not infringe the process, see *Brown v. District of Columbia* (1884), 3 Mackey, 502.

That where there are three patents, one for a machine, the second for a process, and the third for a product, and the machine patent first expires, the use of the machine may infringe the patent for the process or the product, see *McKay v. Dibert* (1881), 5 Fed. Rep. 587; 19 O. G. 1351. But see

McKay v. Jackman (1882), 12 Fed. Rep. 615; 22 O. G. 85; 20 Blatch. 466.

That identity of product shows identity of process, *prima facie*, where both are new, see *Pickhardt v. Packard* (1884), 30 O. G. 179; 23 Blatch. 23; 22 Fed. Rep. 530.

² That to use a patented process to perform part of an act which it usually performs entirely is infringement, see *Eames v. Andrews* (1887), 122 U. S. 40; 39 O. G. 1319; *Andrews v. Eames* (1883), 15 Fed. Rep. 109; 23 O. G. 1123.

That the use of an invention involving a patented process is a continuing infringement, see *Beedle v. Bennett* (1887), 122 U. S. 71; 39 O. G. 1326.

That the sale of materials to be used in an infringing process is infringement, see *Willis v. McCollin* (1886), 38 O. G. 1017; 29 Fed. Rep. 641.

That a patent for a process arriving at a known result is not infringed by another process attaining the same result, see *Anilin v. Levinstein* (1883), L. R. 24 Ch. D. 156.

That the use of a patented process is an infringement whether or not the infringer made or set up the apparatus, see *Andrews v. Cross* (1881), 8 Fed.

tial is omitted, and its place is left unsupplied, or if for it is substituted a step which the patentee intended to avoid, or if the succession of the acts is changed in any material degree, the identity of the invention practised with the patented invention is destroyed and the former is not an infringement.³ In that class of arts which express the idea of a force directed through the process upon a specific object, and thus involve the material to be treated as an essential element, the performance of the acts described in reference to other objects or materials is not infringement.⁴

Rep. 269 ; 19 O. G. 1705 ; 19 Blatch. 294.

That whenever one avails himself of another's patented discovery and process an infringement exists, see *American Bell Telephone Co. v. Dolbear* (1883), 15 Fed. Rep. 448 ; 23 O. G. 535.

That a patent for a process is infringed though an equivalent is used, see *Kimball v. Hess* (1883), 15 Fed. Rep. 393 ; 26 O. G. 107.

That when a patent describes a composition for producing a certain effect in a process, but does not give its ingredients as essential nor claim them, the process is infringed by the use of any equivalent composition, see *Johnson v. Willimantic Linen Co.* (1866), 33 Conn. 436.

That a patent for a process is infringed only where the same mode of reaching the result is followed as is described in the specification, see *Royer v. Chicago Mfg. Co.* (1884), 20 Fed. Rep. 853.

³ That a process is infringed only when every step claimed as essential is used, see *Arnold v. Phelps* (1884), 29 O. G. 538 ; 20 Fed. Rep. 315 ; *Hammerschlag v. Garrett* (1882), 10 Fed. Rep. 479 ; 21 O. G. 1199 ; 15 Phila. 474.

That a patent for a process is not infringed by the use of all except the first and last steps, all the steps used

being well known, see *Heller v. Bauer* (1884), 19 Fed. Rep. 96.

That a process omitting a patented step, and including a step which the patentee intended to avoid, is not an infringement, see *Cotter v. New Haven Copper Co.* (1882), 13 Fed. Rep. 234 ; 23 O. G. 740.

That a patent for a process and a combination is not infringed by the use of part of the combination and part of the process, see *Howe v. Abbott* (1842), 2 Story, 190 ; 2 Robb, 99.

That a process may be infringed though the order of the steps is varied, where the order is not essential, see *Hammerschlag Mfg. Co. v. Bancroft* (1887), 40 O. G. 1339 ; 32 Fed. Rep. 585.

That a process consisting in doing certain acts at a certain stage of events is not infringed by doing the same acts at a different stage, see *Boneless Fish Co. v. Roberts* (1882), 12 Fed. Rep. 627.

That a process may be infringed though its mode of use is varied, see *Cary v. Wolff* (1885), 32 O. G. 257 ; 24 Fed. Rep. 139 ; 23 Blatch. 92.

⁴ That where a process and its material both enter into an invention there is no infringement unless both are used, see *Goodyear Dental Vulcanite Co. v. Davis* (1880), 102 U. S. 222 ; 19 O. G. 543.

§ 926. Infringement of a Patent for a Machine.

A machine is a mode of operation permanently embodied in tangible materials. The *modus operandi*, or structural law of the mechanism, is the essence of the invention, and its identity is never lost while this remains. Differences in its form and construction, in the number and relation of its parts, and in the uses to which it may be adapted, are all compatible with the preservation of this essential characteristic. A patented machine is thus infringed by any other which embodies the same structural law.¹ It is immaterial whether it resembles the patented invention in appearance or in the nature and arrangement of its different members, or whether it is less perfect or more perfect, or serves the same or additional purposes, or employs the same parts or equivalent ones, — if the structural law of the patented machine is found oper-

§ 926. ¹ In *Foss v. Herbert* (1856), 2 Fisher, 31, Drummond, J. : (36) “An infringement of a patent takes place whenever a party avails himself of the invention of the patentee without such variation as will constitute a new discovery. A man may improve a patented machine so as to entitle him to a patent for his improvement, but that will not give him a right to use the invention of the first patentee without his license. A machine is an infringement of another if it incorporate in its structure and operation the substance of the invention, — that is, by an arrangement of mechanism which performs the same service, or produces the same effect, in the same way, or substantially the same way. Mere colorable alterations, or adroit evasions by substituting one mechanical equivalent for another in the combination which constitutes the machine, should never be allowed to protect a party.” 1 Bissell, 121 (126).

In *Sickels v. Borden* (1856), 3 Blatch. 535, Nelson, J. : (541) “However different, apparently, the arrangements and combinations of a machine

may be from the machine of the patentee, it may in reality embody his invention, and be as much an infringement as if it were a servile copy of his machine. According to the Patent Law, if the machine complained of involves substantial identity with the one patented, it is an infringement. If the invention of the patentee be a machine, it is infringed by a machine which incorporates, in its structure and operation, the substance of the invention, — that is, an arrangement which performs the same service, or produces the same effect, in the same way, or substantially the same way.”

Further, that a machine patent is infringed by every machine which operates under the same structural law, see *Cantrell v. Wallick* (1886), 117 U. S. 689 ; 35 O. G. 871 ; *Grier v. Castle* (1883), 17 Fed. Rep. 523 ; 24 O. G. 1176 ; *Brett v. Quintard* (1882), 10 Fed. Rep. 741 ; 20 Blatch. 320 ; *Waterbury Brass Co. v. Miller* (1871), 5 Fisher, 48 ; 9 Blatch. 77 ; *Cahoon v. Ring* (1861), 1 Clifford, 592 ; 1 Fisher, 397.

That a machine whose mode of

ating unchanged in the other, the latter is an infringement.³ An act of infringement is committed by the manufacture of the machine though it is never used or sold, the intent to put it to the practical use for which it is designed being inferred from its construction.³ The use of the machine in any manner or for any beneficial purpose is infringement, and where one of several co-owners of an infringing machine operates it with their consent the infringing act is theirs as well as his.⁴

operation is substantially different does not infringe, see *Schmidt v. Freese* (1882), 12 Fed. Rep. 563 ; 21 O. G. 1876 ; *Brett v. Quintard* (1882), 10 Fed. Rep. 741 ; 20 Blatch. 320.

That a particular device is infringed only by a copy thereof, see *Singer v. Walmsley* (1860), 1 Fisher, 558.

That a machine intended to be different does not infringe merely because it may be forced to operate like the patented machine, see *Buzzell v. Andrews* (1885), 34 O. G. 830 ; 25 Fed. Rep. 822.

That a machine patent is not infringed by the use of a different machine for the same purpose, see *Opinion Atty. Gen.* (1873), 14 Op. At. Gen. 209.

² That the structural law being the same, differences in form are of no consequence, see *Grier v. Castle* (1883), 17 Fed. Rep. 523 ; 24 O. G. 1176 ; *Brett v. Quintard* (1882), 10 Fed. Rep. 741 ; 20 Blatch. 320 ; *Dederick v. Cassell* (1881), 14 Phila. 503 ; 9 Fed. Rep. 306 ; 20 O. G. 1233 ; *Potter v. Wilson* (1860), 2 Fisher, 102.

That a machine may infringe although it is less perfect, see *Pitts v. Wemple* (1855), 2 Fisher, 10 ; 1 Bissell, 87.

That the use of the substantial features of a machine is an infringement, though certain parts are omitted or equivalents are used, see *Wheeler v. Clipper Mower & Reaper Co.* (1872), 2 O. G. 442 ; 10 Blatch. 181 ; 6 Fisher,

1 ; *Waterbury Brass Co. v. Miller* (1871), 5 Fisher, 48 ; 9 Blatch. 77 ; *Rich v. Close* (1870), 4 Fisher, 279 ; 8 Blatch. 41 ; *Foss v. Herbert* (1856), 2 Fisher, 31 ; 1 Bissell, 121 ; *Wyeth v. Stone* (1840), 1 Story, 273 ; 2 Robb, 23.

That a patent covering two machines is infringed by the use of either one of them, see *Wyeth v. Stone* (1840), 1 Story, 273 ; 2 Robb, 23.

That on the question as to the infringement of a machine, attention is to be directed to the parts which do the work, not to matters of construction, see *Holly v. Vergennes Mach. Co.* (1880), 18 O. G. 1177 ; 4 Fed. Rep. 74 ; 18 Blatch. 327.

³ That it is an infringement to make a patented machine though it is neither used nor sold, see *Butz Thermo Electric Regulator Co. v. Jacobs Electric Co.* (1888), 45 O. G. 833 ; *Bloomer v. Gilpin* (1859), 4 Fisher, 50.

⁴ That a machine capable of serving two uses, at the option of its user, is an infringement on the same device intended for one use only, though it has been improved, see *Holbrook v. Small* (1876), 10 O. G. 508 ; 2 Bann. & A. 396.

That where one runs an infringing machine owned by himself and two others, all claiming under a patentee who was previously enjoined, all are infringers, see *Woodworth v. Edwards* (1847), 3 W. & M. 120 ; 2 Robb, 610.

The sale of the machine is also an infringement; but neither the use nor the sale of its manufactured products violates the patent unless the user or the seller are in collusion with the infringing operator of the machine.⁶

§ 927. Infringement of a Patent for a Manufacture.

The essential characteristics of a manufacture are not capable of any accurate general statement. They are embraced in the idea of means which the inventor has conceived and expressed in the article itself, and are in each case to be determined by an examination of its effects, its functions, and its method of performing them. Notwithstanding the difficulty of ascertaining it, however, its real nature is as definite and exact as any other species of invention, and any variation in its necessary attributes involves the loss of its identity. A patented manufacture is infringed by the making, use, or sale of any manufacture which possesses the same essential characteristics, although in other qualities the inventions may be totally dissimilar.¹ The method of producing the infringing manufacture is not important, the article being the same though made by a different process or machine.² Its use or

⁶ In *Boyd v. McAlpin* (1844), 3 McLean, 427, *per Curiam*: (429) "A sale of the product of the machine is no violation of the exclusive right to use, construct, or sell the machine itself. If, therefore, the defendant has done nothing more than purchase the bedsteads from Brown, who may manufacture them by an unjustifiable use of the patented machine, still the person who may make the purchase from him has a right to sell. The product cannot be reached, except in the hands of one who is in some manner connected with the use of the patented machine." 2 Robb, 277 (279).

See also *Goodyear v. Railroad* (1853), 1 Fisher, 626; 2 Wall. Jr. 356.

That where a manufacture is in the market, purchasers are not obliged to find out whether it was made by a patented machine or a patented pro-

cess, see *Goodyear v. Railroad* (1853), 1 Fisher, 626; 2 Wall. Jr. 356.

§ 927. ¹ That the patent for a manufacture is infringed by the use or the sale of it, see *Goodyear v. Railroad* (1853), 1 Fisher, 626; 2 Wall. Jr. 356.

That a patented hotel register is infringed by the landlord who uses it, see *Hawes v. Washburn* (1872), 5 O. G. 491; *Hawes v. Cook* (1872), 5 O. G. 493; *Hawes v. Gage* (1871), 5 O. G. 494.

That the use of equivalents in a manufacture is an infringement, see *Singer v. Walmsley* (1860), 1 Fisher, 558.

² That a patent for a manufacture is infringed in whatever way the article is made, see *Celluloid Mfg. Co. v. American Zylonite Co.* (1887), 40 O. G. 1453; 30 Fed. Rep. 437; *Anilin v. Hamilton Mfg. Co.* (1878), 13 O. G.

sale may be restricted or extensive and for the same or other purposes than those intended by the inventor, since in every use of which it is capable it still belongs to him.³

§ 928. **Infringement of a Patent for a Composition of Matter.**

A composition of matter is a true combination whose elements are the ingredients of which it is composed, and whose co-operative law determines the mode in which each ingredient operates upon the others to develop the properties that characterize the finished composition. Two compositions are identical when they possess the same or equivalent ingredients, united together in the same manner to produce the same result.¹ If one of these compositions is protected by a patent the other will infringe it, whether or not it is prepared by the same process or is known in the market by the same appellation;² though where a composition is patented as the product

273 ; 3 Bann. & A. 235 ; Woodward v. Morrison (1872), 2 O. G. 120 ; Holmes, 124 ; 5 Fisher, 357.

That where a product is patented as the result of a certain process it is infringed only when made by that process, see Van Camp v. Maryland Pavement Co. (1888), 43 O. G. 884 ; Cochran v. Anilin (1884), 111 U. S. 293 ; 27 O. G. 813.

That where a patent covers an article only when made of certain materials it is not infringed by the same article made of different materials, see Western & Wells Mfg. Co. v. Rosenstock (1887), 30 Fed. Rep. 67 ; 41 O. G. 354.

That a patent for a new result is infringed by any process producing that result, see Anilin v. Levinstein (1883), L. R. 24 Ch. D. 156.

That identity of product is *prima facie* evidence of identity of process where both are new, see Pickhardt v. Packard (1884), 30 O. G. 179 ; 23 Blatch. 23 ; 22 Fed. Rep. 530.

³ That a valid patent for a fabric is infringed by any one who uses the fabric in any manner or degree, see

Celluloid Mfg. Co. v. Chrolithion Collar & Cuff Co. (1885), 23 Blatch. 205 ; 23 Fed. Rep. 397 ; 31 O. G. 519.

§ 928. ¹ That the use of chemical equivalents, though better, is an infringement, see Woodward v. Morrison (1872), 2 O. G. 120 ; Holmes, 124 ; 5 Fisher, 357.

That a patent for a composition of matter is infringed if the new element does the same thing as the one for which it is substituted, though otherwise it is different, see Woodward v. Morrison (1872), 2 O. G. 120 ; Holmes, 124 ; 5 Fisher, 357.

That a composition of matter is not infringed, if elements are substituted producing different results, see Smith v. Murray (1886), 27 Fed. Rep. 69 ; 36 O. G. 1045.

² That a composition of matter is infringed by making, using, or selling the same composition though made by a different process, see Woodward v. Morrison (1872), 2 O. G. 120 ; Holmes, 124 ; 5 Fisher, 357.

That a patent for the composition of old ingredients is not infringed by the

of a specific process the patented composition is not appropriated unless the prescribed process is employed.⁸ A patented composition is infringed not only by its unauthorized manufacture, but also by its wrongful use or sale.

§ 929. Infringement of a Patent for a Design.

A design is an appearance presented to the eye, and created by imposing upon physical substances some peculiar shape or ornamentation. Two designs are identical when they appear to be the same to the eye of an ordinary observer, though the lines or images of which they are formed are seen, on close inspection, to be different.¹ Design-patents are infringed by the same acts which violate the rights of other patentees, — the making, use, or sale of the physical substance bearing the design being the manufacture, use, or sale of the design itself. Where the physical substance is a patented invention of another class, the same act may thus violate the rights of different patentees and render the infringer liable for double compensation.

use or sale of any one of them, see *Geis v. Kimber* (1888), 444 O. G. 108.

⁸ That where a patent claims a process and the composition as made by that process, the same composition, if made by a different process, is not an infringement, see *Van Camp v. Maryland Pavement Co.* (1888), 43 O. G. 884; *Dittmar v. Rix* (1880), 1 Fed. Rep. 342; 17 O. G. 973; 5 Bann. & A. 240.

§ 929. ¹ In *Miller v. Smith* (1880), 18 O. G. 1047, Clifford, J. : (1048) "Speaking in the general sense, it is doubtless true that the test of infringement in respect to the Claims of a design-patent is the same as in respect to a patent for an art, machine, manufacture, or composition of matter; but it is not essential to the identity of the design that it should be the same to the eye of an expert. If in the eye of an ordinary observer, giving such at-

tention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer and sufficient to induce him to purchase one supposing it to be the other, the one first patented is infringed by the other." 5 Fed. Rep. 359 (365).

See also *Ex parte Gerard* (1888), 43 O. G. 1235; *Dreyfus v. Schneider* (1885), 25 Fed. Rep. 481; *Tomkinson v. Willetts Mfg. Co.* (1884), 23 Fed. Rep. 895; 31 O. G. 918; 32 O. G. 382.

That a patent for a design is infringed by copying a part thereof, if that part is covered by the patent, see *Dryfoos v. Friedman* (1884), 18 Fed. Rep. 824; 21 Blatch. 563.

That a design may be infringed though a different name be given it, see *Perry v. Starrett* (1878), 14 O. G. 599; 3 Bann. & A. 485.

§ 930. Infringement of a Patent for an Improvement.

An improvement is a development of the idea of means embodied in the original invention, and may relate to the entire idea or to one or more of its subordinate factors. Where it affects the whole invention its scope may be extensive and produce a great advancement in the art. Where it concerns only a single feature of the invention it is frequently confined within the narrowest limits. Its measure is found in the difference between the invention or the improved feature in its former state, and its condition since the improvement has been made. Applying to this difference the usual test, the improvement will be found to be that specific change in the invention or subordinate member by which its mode of operation in the performance of its functions is rendered more advantageous to the user. Other changes in the same part may have the same effect upon its mode of operation and be different improvements, but the essential attributes of this specific change belong to its inventor, and when protected by a patent are infringed by every other change which is substantially the same.¹ An improvement in an art can be infringed by practising the art in the peculiar manner discovered by the inventor of the improvement, but not by practising it in a different manner though the result of the two methods is the same. An improvement in an article can be infringed by making, using, or selling the improved device, but not by the appropriation of some different device improving the original invention in the same direction and to the same degree. An improver acquires thereby no right to practise the original invention, nor is the original inventor entitled to the use of the improvement.²

§ 930. ¹ For a discussion of the nature and scope of an improvement, see §§ 210-218, 307-313, and notes, *ante*.

That one improvement does not infringe a patent for a different one, see *Seymour v. Osborne* (1869), 3 Fisher, 555.

² That neither the original patentee nor the improver can employ the inven-

tion of the other, see *Cantrell v. Wallick* (1886), 117 U. S. 689; 35 O. G. 871; *Robertson v. Blake* (1876), 94 U. S. 728; 11 O. G. 877; *Fales v. Wentworth* (1872), 2 O. G. 58; *Holmes*, 96; 5 Fisher, 302; *Whipple v. Baldwin Mfg. Co.* (1858), 4 Fisher, 29; *Pitts v. Wemple* (1855), 6 McLean, 558.

That the improvement infringes the original though it gives the invention

SECTION III.

OF INFRINGEMENT: REMEDY AT LAW.

§ 931. Remedy for Infringement at Law : Action on the Case.

Prior to the Act against Monopolies (21 Jac. I., c. 3) the remedy for an infringement of the rights conferred by letters-patent was administered in the court of Star Chamber under its general jurisdiction over all offences not covered by the common or the statute law.¹ By that Act, however, it was provided that violations of such patents as were thereafter to be lawful should be redressed according to the common law and not otherwise, — thus bringing the infringement of a patent within that class of wrongs which had immemorially been remedied by the courts of ordinary jurisdiction.² Being a tort involving consequential damage only to the patentee, the form of action applicable to it was trespass on the case, through which from that time to the present the injured party has pursued his remedy at law.³

all its value, see *Gray v. James* (1817), *Peters C. C.* 476 ; 1 *Robb*, 140.

And though it has superseded the original in the trade, see *Turrell v. Spaeth* (1878), 14 *O. G.* 377 ; 3 *Bann. & A.* 458.

§ 931. ¹ That infringements of patent rights were cognizable in the Star Chamber, see 3 *Inst.* 183 ; *Godson*, 175 ; *Coryton*, 262. That the reason for this jurisdiction seems rather to reside in the unwillingness of the courts of common law to protect the owners of monopolies than in their inability to extend relief, see *Darcy v. Alleyn* (1602), *Noy*, 173 ; *Clothworkers of Ipswich* (1615), *Godbolt*, 252 ; both which were cases in King's Bench, where the patents were defeated, and the validity of letters-patent, except for new inventions, was denied. The Stat. Jac. I. not so much conferred jurisdiction over

infringements on the courts of common law as it abolished the jurisdiction of the royal tribunal and made that of the common law courts exclusive.

² Stat. 21 Jac. I., c. 3, Sec. 2. "And be it further declared . . . that all monopolies . . . letters-patent, . . . and all other matters and things tending as aforesaid, and the force and validity of them and every of them, ought to be and shall be forever hereafter examined, heard, tried, and determined by and according to the common laws of this realm and not otherwise."

³ That the action at common law for the infringement of letters-patent was trespass on the case, see *Godson*, 176 ; *Coryton*, 266 ; and all the English cases prior to our act of 1790. In the act of 1790 this form of remedy was directly prescribed (Sec. 4), and the same provision has been repeated in all

§ 932. **Remedy at Law Insufficient: Equitable Jurisdiction Established.**

The redress afforded by an action at law consisting simply in an award of damages for past infringements was early found to be inadequate for the protection of the patentee. In most instances the wrong is a continuing one, not capable of complete redress in any single proceeding but requiring numerous successive suits as new grounds of action may arise. It is also in many cases a secret injury which the patentee can neither discover by any of the usual methods of investigation nor establish under the common rules of evidence. For these and other reasons, inherent in the nature of the injury, the aid of courts of equity was first invoked to prevent the continuance of the wrong by injunction, to compel the alleged infringer to disclose the character and extent of his supposed infringement, and to bestow such other special relief as might be necessary to secure to the plaintiff at law the entire vindication and protection of his rights.¹ The assistance of equity

subsequent statutes. (Rev. Stat., 1874, Sec. 4919.) See also *May v. Mercer Co.* (1887), 41 O. G. 815; 30 Fed. Rep. 246; *Stein v. Goddard* (1856), 1 McAllister, 82.

That no previous notice is needed in order to sue for an infringement, see *Ames v. Howard* (1833), 1 Sumner, 482; 1 Robb, 689.

That a contract stipulating for an arbitration before suit is binding, and a plaintiff must show that he has made all reasonable efforts to arbitrate, see *Perkins v. United States Electric Light Co.* (1883), 24 O. G. 204.

That State laws may require claims against a county for infringement to be presented and payment demanded before suit, see *May v. Buchanan Co.* (1886), 39 O. G. 120; 29 Fed. Rep. 469.

That a patentee will not be enjoined from suing at law when the bill for an injunction shows a good defence at law, see *Hapgood v. Hewitt* (1886), 119 U. S. 226; 37 O. G. 1247.

§ 932. ¹ Such was the stringency of the provision in the Stat. Jac. I. confining jurisdiction to the courts of common law, and the influence of the language of Lord Coke, 3 Inst. 181, expressly declaring that this provision excluded chancery jurisdiction, that for many years the aid of equity was not invoked, and when invoked was not accorded unless the patentee had already established his right in an action at law. See *Blanchard v. Hill* (1742), 2 Atk. 484. The earliest reported case in which equity afforded relief without a previous trial at law was *Hicks v. Raincock* (1783), 1 Abb. P. C. 23; 2 Dick. 647. In *Boulton v. Bull* (1796), 1 Abb. P. C. 97, the same position was taken, the issues of fact being tried on separate proceedings in the common law courts. For a discussion of the attitude of courts of chancery toward patent causes prior to A. D. 1800, see *Coryton*, 319, 320; *Godson*, 183.

in actions at law being thus shown to be not only effective but often indispensable, original proceedings were at length commenced in chancery by a petition for an injunction or discovery, and under the jurisdiction so obtained complete redress was given to the patentee, the aid of a court of law being sought only where issues of fact required the verdict of a jury.² The complicated and technical questions embraced in these issues frequently rendering them unfit for disposition by the common law tribunal, this last link between the two procedures was finally abandoned, and courts of equity assumed entire control over all actions instituted before them, thus giving to the injured patentee two distinct methods of redress,—an action at law upon the case for damages, and a bill in equity for an injunction, discovery, account, or any other relief to which he might in justice be entitled.³ These gradual changes have been effected partly by judicial, partly

² In *Harmer v. Plane* (1807), 1 Abb. P. C. 166, after the issue of an injunction restraining the defendant until the merits could be tried at law, a case was stated by the chancellor and sent to King's Bench for a disposition of the issues of fact arising on the prayer for an injunction. These issues were duly tried (see *Harmer v. Plane* (1809), 1 Abb. P. C. 171), and the decision certified to the chancellor for the final disposition of the cause. This practice was followed in *Manton v. Manton* (1815), 1 Abb. P. C. 189; *Wood v. Zimmer* (1815), 1 Abb. P. C. 202; *Cochrane v. Smethurst* (1816), 1 Abb. P. C. 228. In other cases the patentee was ordered to institute independent proceedings in the courts of law, and the injunction was continued, or a bond and account was ordered, until the verdict could be obtained. See also *Godson*, 187.

³ See *Coryton*, 321, etc. In *Wilson v. Tindal* (1841), 1 Web. 730, n., on an application for an injunction, Lord Langdale, M. R., treated the entire matter of a trial at law as within the

discretion of the court of chancery before which the petition for equitable relief was pending. He says: "It is not the right of parties in every case to have an action tried in a court of law; it is a question of convenience, and the court is to exercise a fair discretion. I have no doubt whatever of the competency of this court to grant an injunction *simpliciter*." In *Young v. Fernie* (1866), 1 App. Cas. 63; 33 L. J. Ch. 192; 35 L. J. Ch. 523, after a trial had been once ordered at law without final result, the cause was heard and determined in equity without a jury. In *Bovill v. Hitchcock* (1868), L. R. 3 Ch. App. 417, the court refused to allow a trial at law, and this refusal was on appeal sustained. In *Patent Marine Inventions Co. v. Chadburn* (1873), L. R. 16 Eq. 447, Lord Selborne refusing a jury states that causes involving questions of Patent Law are generally unfit for a jury trial, and are more properly disposed of by a single judge. These cases mark the gradual steps by which complete jurisdiction in equity has been acquired.

by legislative, action. In England after the courts of equity had asserted, and for a considerable period had exercised, their peculiar authority for the protection of the patentee, an act of Parliament conferred equity powers upon the courts of law in patent cases, enabling them to prevent future infringements by injunction and to compel defendants to make discovery of their alleged unlawful acts.⁴ In this country the earlier statutes provided only for an action on the case, but under these the courts of equity interfered by injunction and otherwise when the circumstances demanded it, until in 1819 another statute bestowed original jurisdiction as well in equity as at law upon the Federal courts over all patent cases, and opened both methods of relief to the patentee, as far as the nature of his injury required. This statute has been re-enacted with varied phraseology at different periods in the history of our patent-system, and in its present form permits the patentee to sue at law for damages in all cases of past infringement, invoking the aid of equity wherever it may be required, or to resort originally to equity if the redress to which he is entitled necessitates the exercise of chancery powers.⁵ The

⁴ 17 & 18 Vict. c. 125 (1854). Under this act, injunctions could be ordered by the common law court at any stage in the case, either before or after judgment; an inspection of books and infringing inventions could be compelled, and an accounting could be decreed.

⁵ Prior to the act of 1819 the only remedy afforded under the statutes of the United States was the common law action on the case. That the Federal courts possessed no original equity powers in patent cases where the parties to the suit were citizens of the same State was conceded, though in *Livingston v. Van Ingen* (1811), 1 Paine, 45, Livingston, J., doubted whether these courts could not, when necessary, exercise chancery jurisdiction in aid of actions at law. In *Isaacs v. Cooper* (1821), 4 Wash. 259; 1 Robb, 332, Washington, J., speaks of the practice of giving such aid as if it were frequent,

and within the ordinary operations of the court, while in *Sullivan v. Redfield* (1825), 1 Paine, 441; 1 Robb, 477, Thompson, J., discusses the act of 1819 and declares that it neither enlarges nor alters the powers of the court to interfere, as a court of equity, but simply extends its jurisdiction to patent cases where the citizenship of the parties is the same. Thus it would appear always to have been the doctrine in this country that equity powers might be appropriately exercised in aid of a suit at law, without reference to the question of original jurisdiction over patent causes themselves. Comparatively few of the cases occurring before 1840 were, however, instituted in courts of equity, perhaps because of the construction given to the act of 1819 by Thompson, J., in *Sullivan v. Redfield*, *ante*. But after the passage of the act of 1836, the provisions of that statute, though couched

principal practical differences between these two remedies reside in their modes of procedure, and in the rules by which the compensation awarded to the plaintiff for the injury sustained by the infringement is determined. In considering each in detail the action at law will be first discussed, including all those topics which are common to both remedies, except that of Injunctions, whose intricacy and importance merit for it a separate examination. In this discussion the following order will be pursued:—

- I. Jurisdiction of Courts.
- II. Parties.
- III. Process, Pleadings, and Evidence.
- IV. Trial and Verdict.
- V. New Trial, and Writ of Error.
- VI. Costs.

§ 933. Jurisdiction over Actions for Infringement in General.

Jurisdiction over all cases arising under the Patent Laws is, as we have seen, vested exclusively in the Federal courts. The acts of Congress have further limited this jurisdiction to

in language closely resembling that of 1819, were held to confer full equity powers upon the Federal courts, as courts of original jurisdiction, over all cases arising under the Patent Laws, and to give the patentee an option either to seek his legal redress in one tribunal or his equitable remedy in the other. Actions in equity then became more frequent, but in these, as in actions at law, resort to a jury was considered necessary to determine any issue of fact involving the matter of infringement. This was accomplished by a feigned issue, according to the usual course of chancery practice. See *Brooks v. Bicknell* (1843), 3 McLean, 250; 2 Robb, 118; *Brooks v. Bicknell* (1845), 4 McLean, 70. Such a trial was nevertheless regarded as within the discretion of the court, which might substitute therefor a hearing before a master (*Parker v. Hatfield* (1845), 4 McLean,

61), or even before the chancery judge himself (*Van Hook v. Pendleton* (1846), 1 Blatch. 187; *Woodworth v. Rogers* (1847), 3 W. & M. 135; 2 Robb, 625). These modes of proceeding were found especially convenient, since a trial by jury must take place in the same court and involve nearly the same labor on the part of the judge as would his personal investigation and decision of the issues. Hence the transition was easy and rapid from the more ancient and complex to the later and more simple method of ascertaining the facts in controversy, and together with the growing distrust of juries in intricate cases has resulted in the almost entire substitution of actions in equity for actions on the case in courts of law where equity jurisdiction can be claimed.

As to the limits of equity jurisdiction and the line dividing it from law, see §§ 1082-1097, and notes, *post*.

the Circuit courts, to District and Territorial courts endowed with Circuit court powers, and to the Supreme Court of the District of Columbia, with an appellate jurisdiction in the Supreme Court of the United States. Every action for the infringement of a patent, whether at law or in equity, must, therefore, be instituted in one of the Circuit courts of the United States or in one of these equivalent tribunals. In determining what particular Circuit court has jurisdiction of any individual case, the question of locality is of paramount importance. An action for damages for past infringements is not a local action, and any court of competent jurisdiction may hear and determine all the matters in controversy between the parties, and render a judgment upon which process in the nature of an execution or of an action of debt upon the record may issue for the collection of the damages awarded to the plaintiff. As all Circuit courts and their equivalent tribunals have jurisdiction over the subject-matter in such actions for past infringement, the particular court before which any given case should be brought must be that court whose local jurisdiction embraces the parties to the suit; and any Circuit court obtaining jurisdiction over these may thus take complete cognizance of all matters properly in issue in any action at law between them.¹ An action in equity, as will hereafter more fully appear, stands on somewhat different ground. For the enforcement of the orders and decrees which may be necessary in the prosecution of this remedy, a more direct and permanent control over the parties and the subject-matter may be required than is afforded by that general jurisdiction over the subject and that temporary jurisdiction over the parties, which are sufficient for the purposes of an action at law; and a particular Circuit court may thus decline to take cognizance of such proceedings in cases where a suit at law would be unhesitatingly entertained.² This dis-

§ 933. ¹ That an action at law may be brought in any district where the defendant can lawfully be served with process, see *Thompson v. Mendelsohn* (1871), 5 Fisher, 187; *Allen v. Blunt* (1849), 1 Blatch. 480.

² That an action in equity praying

for an injunction can be brought only in the district where the defendant resides or does business, or where the infringement takes place, see *Wilson Packing Co. v. Clapp* (1878), 8 Bissell, 154; 3 Bann. & A. 243; 13 O. G. 368; *Hodge v. Hudson River R. R. Co.* (1868), 3

tion must be kept in mind in examining the decisions upon these questions of local jurisdiction, lest the sweeping propositions applicable to all actions at law, and to some actions in equity, be regarded as in conflict with apparently different rules which govern only certain special cases.

§ 934. Jurisdiction over Actions at Law Vests in the Court for the Circuit in which the Defendant Resides or is Found.

An action at law for infringement may be brought before any Circuit court which has jurisdiction over the persons of the plaintiff and defendant. A plaintiff places himself within the jurisdiction of the court by instituting his action therein. Hence where a plaintiff has the capacity to sue, no question as to the jurisdiction of the court over him can properly arise. This is the case with all natural persons, and with all corporations also unless restrictions in their charters or in the local laws otherwise provide.¹ In the absence of such restrictions, any corporation or individual, whose rights under a patent have been violated, may institute legal proceedings for redress in any Circuit court whose jurisdiction extends to the person of the defendant. A Circuit court has jurisdiction over a defendant when he resides or is lawfully served with process in either of the districts which are included in

Fisher, 410 ; 6 Blatch. 85 ; Goodyear v. Chaffee (1855), 3 Blatch. 268. *Contra* : Thompson v. Mendelsohn (1871), 5 Fisher, 187 ; Wilson v. Sherman (1850), 1 Blatch. 536 ; Boyd v. McAlpin (1844), 3 McLean, 427 ; 2 Robb, 277.

That an injunction may issue against an infringer in the district where he lives forbidding him to infringe anywhere, see Hatch v. Hall (1884), 22 Fed. Rep. 438 ; 30 O. G. 1096.

That an action in equity for an accounting or damages, etc., can be brought in any district where the defendant can lawfully be served with

process, see Allen v. Blunt (1849), 1 Blatch. 480 ; and §§ 1096, 1097, and notes, *post*.

§ 934. ¹ That the Patent Laws do not change the rules established by the judiciary acts as to territorial jurisdiction over parties, or the service of process, see United States v. American Bell Telephone Co. (1886), 29 Fed. Rep. 17 ; 38 O. G. 1237.

That a corporation may maintain a suit in the district where its rights are infringed, though it is created under the laws of another State, see Elm City Co. v. Wooster (1873), 4 O. G. 83 ; 6 Fisher, 452.

the circuit.² A resident defendant is always within the jurisdiction of the court, and the rules which require personal service of process upon him can at all times be fulfilled. Upon a non-resident defendant, however, process can be served only when he is personally within the territorial limits of the circuit.³ Service by publication or by the attachment of property, though often sufficient under State laws to confer

² In *Thompson v. Mendelsohn* (1871), 5 Fisher, 187, McKennan, J. : (188) "The Patent Laws confer exclusive jurisdiction upon the circuit courts of all suits, in law or equity, for invasion of the rights of inventors under them, and the judiciary act expressly authorizes such suits to be brought and process to be served upon defendants in any district in which they may be found. The conclusion is inevitable that where these conditions are complied with, the court has power to afford such measure of protection to the plaintiff's rights as it is competent to afford in any case, of the subject-matter of which it has jurisdiction, and in which the parties are before it by the due service of process. Certainly by no act of Congress is this power restricted by the fact of the defendant's residence in another district ; or that the wrong imputed to him was not committed in the district in which the suit is brought. The process of the court is primarily directed against the person of the wrong-doer, and it is no sufficient reason against the power of the court to award it, that it may not furnish to the plaintiff's effectual relief, or that its operation may be evaded by the defendant."

³ The law as stated in the text and illustrated in the notes of this and succeeding paragraphs is that of the judiciary acts, and the decisions under them, prior to the act of March 3, 1887. The latter act provides that "no civil suit shall be brought before" the circuit courts of the United States "against any person by any original process of

proceeding in any other district than that whereof he is an inhabitant." Whether this provision applies to cases arising under the Patent Laws may well be doubted. In *Preston v. Fire Extinguisher Co.* (1888), 46 O. G. 124, *Gormully Mfg. Co. v. Pope Mfg. Co.* (1888), 34 Fed. Rep. 818, and *Halstead v. Manning* (1888), 44 O. G. 344, it was held that patent causes were within the statute, and that a defendant must thus be sued in the district of his residence. On the other hand, it has been decided that another equally universal provision of the same act, limiting the jurisdiction of the circuit courts to controversies involving \$2,000 or upwards, does not apply to patent cases. See *Miller-Megee Co. v. Carpenter* (1887), 43 O. G. 1118, where it is also intimated that the act of 1887 does not relate to suits under the Patent Laws. Patent rights and their invasions, as well as patent litigations, being matters *sui generis*, the consequences of embracing them under the sweeping provisions of general statutes cannot always be foreseen ; but many reasons will suggest themselves to any person familiar with industrial affairs in this country in favor of the retention of the former rule of practice in suits against infringers. Until the new position has been fully discussed and finally adopted by the courts, or more specifically defined by Congress, its soundness may, therefore, be regarded as an open question, and the doctrine built up by a century of legislation and judicial explanation be still treated as at least possibly correct and

jurisdiction over him for the purposes of the action thus commenced, does not answer the requirements of the Federal law.⁴ Personal service within the circuit must be made upon him, and this must affirmatively appear upon the marshal's return, or the court acquires no jurisdiction over him.⁵ Such service must be lawful and not be procured by fraud or imposition. Service on a non-resident defendant attending court within the circuit, or present at an examination of witnesses by stipulation, or inveigled by any means within the circuit in order that service may be made upon him, is fraudulent and void, and will be set aside on motion by the court.⁶ But such a defendant, either without service or after improper service, may appear and submit himself to the jurisdiction of the court, whose authority thereafter over him will be as complete as if it had been regularly obtained.⁷

ultimately to prevail. In that view it is here considered as if the act of 1887 had not been passed.

That a circuit court has no jurisdiction unless the defendant is served in his own district, or is found and served where sued, see *Day v. Newark India Rubber Mfg. Co.* (1850), 1 Blatch. 628.

That suit may be brought in any district where the defendant can be served, whether either party lives there or not, but the defendant must be personally served therein, see *Allen v. Blunt* (1849), 1 Blatch. 480.

That service upon one co-partner does not give personal jurisdiction over a non-resident partner, see *United States v. American Bell Telephone Co.* (1886), 29 Fed. Rep. 17 ; 38 O. G. 1237.

That service cannot be made on an agent created by implication against the will of the parties and not actually appointed, see *United States v. American Bell Telephone Co.* (1886), 38 O. G. 1237 ; 29 Fed. Rep. 17.

⁴ That the existence of property rights or pecuniary interests within the district are not alone enough to confer jurisdiction, see *United States v. Ameri-*

can Bell Telephone Co. (1886), 29 Fed. Rep. 17 ; 38 O. G. 1237.

That a service by attaching the defendant's goods gives no jurisdiction over him, see *Chaffee v. Hayward* (1857), 20 How. 208.

⁵ That when a person is sued out of his own district it must affirmatively appear by the marshal's return that process was served on him in the district where the suit is brought or the court will acquire no jurisdiction, see *Thayer v. Wales* (1872), 5 Fisher, 448.

⁶ That service upon a defendant while attending court in another State as a party defendant, or witness, is not lawful, see *Wilson Sewing Mach. Co. v. Wilson* (1885), 23 Blatch. 51.

That a service of process on a party attending an examination of witnesses by stipulation out of his own district will be set aside on motion, see *Plimpton v. Winslow* (1881), 22 O. G. 1207 ; 20 Blatch. 82 ; 9 Fed. Rep. 365.

⁷ That a party appearing submits to the jurisdiction, see *Macauley v. White Sewing Mach. Co.* (1881), 21 O. G. 496 ; 9 Fed. Rep. 698.

That the judiciary acts, limiting

§ 935. Jurisdiction over Actions at Law against Domestic and Foreign Corporations.

A defendant corporation, like an individual, is always within the jurisdiction of the Circuit court in whose territory it is located by the act of its creation, and may there at any time be served with process. A corporation organized under the laws of a State is located at all places within the limits of the State, and may be sued in any Circuit court whose jurisdiction embraces any portion of such State.¹ Whether a corporation can be served with process outside the State of its location has been doubted.² Service within the circuit upon the officers of a non-resident corporation is clearly ineffectual, and does not become valid though the corporation appears by an attorney in order to plead to the jurisdiction.³ But where State laws provide that foreign corporations doing business in

jurisdiction to cases where the defendant resides or is found within the district, confer only a personal privilege which may be waived by voluntary appearance or by accepting general conditions which impose a liability to suit, see *United States v. American Bell Telephone Co.* (1886), 29 Fed. Rep. 17 ; 38 O. G. 1237.

That an appearance in order to move to quash or to plead to the jurisdiction does not waive objections thereto, see *United States v. American Bell Telephone Co.* (1886), 29 Fed. Rep. 17 ; 38 O. G. 1237.

That where a defendant appears by attorney and files his plea to the jurisdiction by attorney, this admits and submits to the jurisdiction of the court, and the same result follows from the entry of a special appearance on the order-book at the request of the defendant's attorney without special leave of the court, see *Thayer v. Wales* (1872), 5 Fisher, 448.

That irregularities in service are waived unless objected to before answer, see *Goodyear v. Chaffee* (1855), 3 Blatch. 268.

That the privilege of freedom from service while attending a trial must be insisted on at the proper time or it will be waived, see *Matthews v. Puffer* (1882), 22 O. G. 332 ; 20 Blatch. 233.

§ 935. ¹ That a corporation created by State laws resides in all parts of the State, and may be sued in any court whose jurisdiction embraces any part of such State, see *Locomotive Engine Safety Truck Co. v. Erie Railway Co.* (1872), 6 Fisher, 187 ; 3 O. G. 93 ; 10 Blatch. 292.

² That whether a suit can be brought against a corporation outside the district where it is located is doubtful, see *Jones v. Osgood* (1869), 3 Fisher, 591 ; 6 Blatch. 435.

³ That a Circuit court does not acquire jurisdiction over a corporation organized under the laws of another State by serving process in its district on an officer of the corporation, nor is the objection waived though the corporation appears by attorney and pleads to the jurisdiction, see *Decker v. New York Belting & Packing Co.* (1873), 3 O. G. 441 ; 6 Fisher, 374.

that State shall appoint certain resident officials upon whom service of process may be made on behalf of the corporation, such corporation is found within that State for all purposes of jurisdiction both of the local and the Federal Courts.⁴

* That the Federal courts must decide whether a corporation is so "found" within a district as to be liable to be sued there, see *St. Louis Wire Mill Co. v. Consolidated Barb Wire Co.* (1887), 32 Fed. Rep. 802.

That a foreign corporation transacting business in a State is "found within the State" for the purposes of suit, if it can be served with process under State laws, see *Williams & Albright v. Empire Transportation Co.* (1878), 14 O. G. 523; 3 Bann. & A. 533.

That a corporation is "found" within a State when it has established an office or agency there for carrying on the business for which it was incorporated, see *Carpenter v. Westinghouse Air Brake Co.* (1887), 32 Fed. Rep. 434.

That a Circuit court has no jurisdiction of an action against a corporation organized in another State, unless it carries on business within the district through some agent appointed by and representing the corporation in such district, and would thereby, under the local law, be amenable to suit in such district, as an implied or express condition of its right to do business therein, see *Carpenter v. Westinghouse Air Brake Co.* (1887), 32 Fed. Rep. 434; *United States v. American Bell Telephone Co.* (1886), 29 Fed. Rep. 17; 38 O. G. 1237.

That whether business is carried on is determined by what is done or has been done, not by what the corporation may have power to do, see *United States v. American Bell Telephone Co.* (1886), 29 Fed. Rep. 17; 38 O. G. 1237.

That a corporation does not become an "inhabitant" of a State, nor is it

"found there," for service of process merely by owning property there or by the fact that its officers reside there, see *Carpenter v. Westinghouse Air Brake Co.* (1887), 32 Fed. Rep. 434.

That a corporation doing no regular business and having no established agency within the district is not "found" there, simply because it sends there to purchase raw material, see *St. Louis Wire Mill Co. v. Consolidated Barb Wire Co.* (1887), 32 Fed. Rep. 802.

That to supply the means to do business is not the doing of business, see *United States v. American Bell Telephone Co.* (1886), 38 O. G. 1237; 29 Fed. Rep. 17.

That licenses rest on the common law, and a corporation licensor is not domesticated in the district of its licensees any more than any private person would be, see *United States v. American Bell Telephone Co.* (1886), 38 O. G. 1237; 29 Fed. Rep. 17.

That a "managing agent" is one who carries on the corporate business, or a substantial part thereof, see *United States v. American Bell Telephone Co.* (1886), 38 O. G. 1237; 29 Fed. Rep. 17.

That in New York service on the managing agent of a corporation organized in another State is service on a person "found" within the district, see *Hat Sweat Mfg. Co. v. Davis Sewing Mach. Co.* (1887), 31 Fed. Rep. 294.

That a "managing agent" of a foreign corporation need not have control of its entire business in the State, see *Hat Sweat Mfg. Co. v. Davis Sewing Mach. Co.* (1887), 31 Fed. Rep. 294.

That where a foreign corporation is amenable to suit under the local law, it

§ 936. Jurisdiction over Actions at Law where a Circuit Embraces Two or More Districts.

Where a Circuit court or its equivalent tribunal has jurisdiction over two or more districts, each district becomes the local unit of jurisdiction, and the rules hitherto applied to the territorial limits of the circuit are predicable of the district also. Thus a defendant must be sued in his own district or in a district where he can lawfully be served with process. Where there are several joint defendants resident in different districts proceedings may be properly commenced in either.¹ If the area of any district is identical with that of a State, a corporation created by that State is located within that district only and must there be sued, unless under the laws of other States where it does business it is also located within their borders.² On the other hand, if the State contains two or more districts, a corporation created by the State is located in all such districts and can be sued in that one which the plaintiff may elect.³ Where districts are subdivided for judicial purposes, each subdivision forms the local boundary of jurisdiction, within which all defendants must reside or be personally found and served.

§ 937. Plaintiff in Actions at Law Must be the Legal Owner of the Patent at the Date of the Infringement.

With a single exception the plaintiff in an action at law must be the person or persons in whom the legal title to the patent resided at the time of the infringement.¹ An infringe-

may be also sued in the Federal courts for infringement, see *Hussey Mfg. Co. v. Deering* (1884), 28 O. G. 193; 20 Fed. Rep. 795.

§ 936. ¹ That if joint infringers are living in different districts, suit may be commenced in either district against the defendant there residing, see *Goodyear v. Toby* (1868), 6 Blatch. 130.

² See § 935, notes 3, 4, *ante*.

³ That where a State has more than one district, and the statute provides that the defendant be sued in his own district, a corporation may be sued in

either, for it resides in all, see *Locomotive Engine Safety Truck Co. v. Erie Railway Co.* (1872), 6 Fisher, 187; 3 O. G. 93; 10 Blatch. 292.

§ 937. ¹ That the legal title must be in the plaintiff, see *Gamewell Fire Alarm Telegraph Co. v. City of Brooklyn* (1882), 14 Fed. Rep. 255; 22 O. G. 1978.

That no one can sue for damages for infringement except the patentee, the assignee, or the owner of a territorial interest exclusive of the patentee, see *Gordon v. Anthony* (1879), 16 O. G.

ment is an invasion of the monopoly created by the patent, and the law which defines and authorizes this monopoly confers only upon its legal owners the right to institute proceedings for its violation. These owners are the patentee, his assignee, his grantee, or his personal representatives; and none but these are able to maintain an action for infringement in a court of law. Moreover, the injury inflicted by an act of infringement falls upon the individual who owns the monopoly at the date of the infringement.² It does not affect former owners whose interest had terminated before the infringement was committed, nor does it so directly prejudice a future owner that the law can recognize his loss and give him a pecuniary redress. Hence the plaintiff must not only have a legal title to the patent, but must have also been its owner at the time of the infringement. The exception above referred

1135; 16 Blatch. 234; 4 Bann. & A. 248; *Hill v. Whitcomb* (1874), 5 O. G. 430; *Holmes*, 317; 1 Bann. & A. 34.

That owners of patents granted before the act of July 8, 1870, may maintain suits for infringements committed afterwards, see *Union Paper Bag Mach. Co. v. Newell* (1873), 6 Fisher, 582; 11 Blatch. 379.

That where a second original patent has been granted to the same inventor for the same invention, he can sue only on the first patent, see *Jones v. Sewall* (1873), 3 Clifford, 563; 6 Fisher, 343; 3 O. G. 630; *Odiorne v. Amesbury Nail Factory* (1819), 2 Mason, 28; 1 Robb, 300.

That parties equitably interested in the patent need not be joined as plaintiffs, see *Graham v. McCormick* (1880), 11 Fed. Rep. 859; 21 O. G. 1533; 10 Bissell, 39; 5 Bann. & A. 244.

That assignees are indispensable parties, see *Nellis v. Pennock Mfg. Co.* (1882), 22 O. G. 1131; 13 Fed. Rep. 451; 15 Phila. 493.

That one to whom the "exclusive right to the use of the improvement"

is transferred for the whole term of the patent, "by way of license and not as a transfer of a title," is the proper plaintiff in equity, see *Herman v. Herman* (1886), 29 Fed. Rep. 92.

² That a suit by "a party interested" means one interested in the patent when the infringement was committed, see *Moore v. Marsh* (1868), 7 Wall. 515.

That an interest in the proceeds of a suit for an infringement is not an interest in the patent, see *Tilghman v. Proctor* (1888), 125 U. S. 136; 43 O. G. 628.

That suit will lie to recover damages for infringement though the plaintiff assigned his interest in the patent before suit was brought, see *Spring v. Domestic Sewing Mach. Co.* (1882), 22 O. G. 1445; 13 Fed. Rep. 446.

That a patentee may sue an infringer though he has granted an exclusive license to another to make and sell, see *Freese v. Swartchild* (1888), 35 Fed. Rep. 141.

That the legal owner cannot sue the equitable owner for an infringement, see *Aspinwall Mfg. Co. v. Gill* (1887), 40 O. G. 1133; 32 Fed. Rep. 697.

to arises where an assignment of a patent is coupled with an assignment of a right of action for past infringements. In this case the present owner of the monopoly may institute proceedings for its violation during the ownership of his assignor as well as for infringements committed since the transfer of the title to himself.

§ 938. Licensees and Owners of Equitable Interests cannot be Plaintiffs in Actions at Law.

Two classes of persons having interests in patented inventions are, by this rule, debarred from suing for infringement in their own names in courts of law. These are licensees, and those who, under contracts with the legal owners, have acquired an equitable title to the patent. A licensee has no standing in a court of law as plaintiff in an action for infringement.¹ He does not own the monopoly or any part thereof, however widely the interest transferred to him in the invention may estop the owner of the patent from asserting the monopoly against him. Though possessing an exclusive territorial right to sell the invention, or an exclusive right to use it for a special purpose, or an exclusive right to use it and to license others to use it for a definite period of time, or an exclusive right to make the manufacture or machine in which it is contained, and though protected by a guaranty from his licensor, which guaranty his licensor and others are jointly violating, he is still only a mere licensee, and whatever relief equity may be able to afford him, a court of law cannot regard him as entitled to vindicate the monop-

§ 938. ¹ In *Birdsell v. Shaliol* (1884), 112 U. S. 485, Gray, J. : (486) "A licensee of a patent cannot bring a suit in his own name, at law or in equity, for its infringement by a stranger. An action at law for the benefit of the licensee must be brought in the name of the patentee alone." 30 O. G. 261 (261).

See also *Bogart v. Hinds* (1885), 33 O. G. 1268 ; 25 Fed. Rep. 484 ; *Wilson v. Chickering* (1883), 14 Fed. Rep. 917 ; 23 O. G. 1730 ; *Union Paper Bag Mach.*

Co. v. Nixon (1882), 105 U. S. 766 ; 21 O. G. 1275 ; *Gamewell Fire Alarm Telegraph Co. v. Brooklyn* (1882), 22 O. G. 1978 ; 14 Fed. Rep. 255 ; *Nellis v. Pennock Mfg. Co.* (1882), 22 O. G. 1131 ; 13 Fed. Rep. 451 ; 15 Phila. 493 ; *Ingalls v. Tice* (1882), 22 O. G. 2160 ; 14 Fed. Rep. 297, and other cases cited in note 2, *post*.

That the non-joinder of licensees is no ground of abatement, see *Forbes v. Barstow Stove Co.* (1864), 2 Clifford. 379.

only against its infringers.² Suits at law for the redress of injuries committed by infringement against licensees must be brought in the name of the real owner of the patent.³ It is a part of the implied agreement between a licensor and licensee that the former will protect the latter against these wrongful invasions of his rights by instituting such proceedings as may become necessary for that purpose, and if the legal owner of the monopoly refuses to perform this duty, or is inaccessible, the licensee may sue at law for damages in his name.⁴ A

² That a licensee having an exclusive right to sell for certain territory is not a proper plaintiff in infringement suits, but only the owner of the patent, see *Ingalls v. Tice* (1882), 22 O. G. 2160; 14 Fed. Rep. 297.

That a patentee, having transferred an exclusive right to use the invention for a particular purpose, is the only proper plaintiff, see *Blanchard v. Eldridge* (1849), 1 Wall. Jr. 337; 2 Robb, 737.

That a patentee having granted an exclusive right to use and to license others to use for five years has still a right to sue for infringements, see *Still v. Reading* (1881), 4 Woods, 345; 20 O. G. 1025; 9 Fed. Rep. 40.

That a suit at law to protect the licensee in his right to use a patented process for a particular manufacture should be brought in the name of the patentee, see *Goodyear v. Bishop* (1860), 2 Fisher, 96; 4 Blatch. 438.

That the owner of a patent having granted a license and agreed not to license any one else, and reserving a right to one half the damages for infringement, is a necessary party to a suit for infringement, see *North v. Kershaw* (1857), 4 Blatch. 70.

That the owner of a right to use and sell, but not to make, is a mere licensee and cannot sue, though protected by a guaranty from the patentee, and though the patentee with third parties are the infringers, see *Hill v. Whitcomb* (1874),

5 O. G. 430; Holmes, 317; 1 Bann. & A. 34.

³ That the patentee may sue in behalf of the licensee, see *Goodyear v. McBurney* (1853), 3 Blatch. 32.

That a licensee can sue for infringement in the name of his licensor, see *Birdsell v. Shaliol* (1884), 112 U. S. 485; 30 O. G. 261; *Wilson v. Chickering* (1883), 14 Fed. Rep. 917; 23 O. G. 1730; *Nellis v. Pennock Mfg. Co.* (1882), 22 O. G. 1131; 13 Fed. Rep. 451; 15 Phila. 493; *Union Paper Bag Mach. Co. v. Nixon* (1882), 105 U. S. 766; 21 O. G. 1275; *Gamewell Fire Alarm Telegraph Co. v. City of Brooklyn* (1882), 22 O. G. 1978; 14 Fed. Rep. 255; *Nelson v. McMann* (1879), 16 O. G. 761; 16 Blatch. 139; 4 Bann. & A. 203; *Littlefield v. Perry* (1874), 21 Wall. 205; 7 O. G. 964; *Potter v. Wilson* (1860), 2 Fisher, 102; *Gayler v. Wilder* (1850), 10 How. 477.

That a licensee can sue only for infringements which affect his own rights under the patent, see *Hayward v. Andrews* (1883), 106 U. S. 272; 23 O. G. 533.

⁴ That a stipulation by the licensor to sue infringers does not compel the licensees to look to him on his covenants, but they may institute suits in his name against infringers, see *Goodyear v. Bishop* (1860), 2 Fisher, 96; 4 Blatch. 438.

That if the owner of the patent will not sue or cannot be found, the licensee

suit thus brought is under the control of the licensee, and though the nominal plaintiff may claim indemnity against the costs and expenses of the suit, he cannot discontinue it or settle with the infringer in derogation of the rights of the real party in interest.⁵ This privilege does not extend to the personal representatives of licensees, the license and all obligations under it, except those of contract, expiring at the death of the licensee.⁶ To equitable owners of the patent, or of interests therein, relief can be afforded only in a court of equity.⁷

may use his name in a suit at law, and probably in equity also, see *Wilson v. Chickering* (1883), 14 Fed. Rep. 917; 23 O. G. 1730.

That the patentee is not obliged to sue after an assignment of his rights, see *Bicknell v. Todd* (1851), 5 McLean, 236.

⁵ In *Miller v. Liggett & Myers Tobacco Co.* (1881), 7 Fed. Rep. 91, McCrary, J.: (92) "I think that a party who contributes money for the purpose of employing counsel and carrying on a litigation, under a contract with a party to the record, must of necessity be held to have the right to take such action in the case as will protect his own interest in it. As, for example, suppose there is a case which is understood to be a test case, involving the validity of a patent, or anything else, against a particular individual, but involving a subject-matter concerning which a large number of other persons are equally interested with the particular defendant in that case, and suppose all the parties who are interested, or a number of them, come together, enter into a contract that they will raise a fund to carry on that litigation, that they will unite for the purpose of employing counsel, and combine to carry it on in the name of the party to the record,—it seems to me that the persons, who under such a contract as that actually contribute money for the purpose of carrying on a suit, are authorized to go into that

court and use the name of the party to the record in making such motions, and taking such steps as are necessary for the protection of their particular interest in it." 2 McCrary, 375 (377); 19 O. G. 1138 (1139).

That a nominal plaintiff cannot discontinue the suit brought to protect his licensee, and if he does so the real parties in interest will be permitted to make their rights apparent, see *Goodyear v. Bishop* (1860), 2 Fisher, 96; 4 Blatch. 438; *Goodyear v. McBurney* (1860), 3 Blatch. 32.

That a nominal plaintiff may claim indemnity against costs, see *Goodyear v. Bishop* (1860), 2 Fisher, 96; 4 Blatch. 438.

⁶ That the executor of a licensee cannot sue for infringement in the name of the licensor, the license being personal and expiring at the death of the licensee, see *Oliver v. Rumford Chemical Works* (1883), 109 U. S. 75; 25 O. G. 784.

⁷ In *Sanford v. Messer* (1872), 5 Fisher, 411, Shepley, J.: (413) "Unquestionably a contract for a purchase of a portion of the patent right may be good as between the parties as a license, and enforced as such in the courts of justice; but the legal right in the monopoly remains in the patentee, and he alone can maintain an action against a third party who commits an infringement upon it." Holmes, 149 (150); 2 O. G. 470 (471).

§ 939. **Patentee when Plaintiff in Actions at Law.**

The primary legal owner of a patent is the patentee, and until it is assigned or granted by him, or at his death is vested in his administrator or executor, all suits at law upon it must be brought in his name alone.¹ After he has transferred it he may still maintain an action for infringements committed during his ownership, and if the transfer covers only an undivided interest he must join with the transferee in suits arising out of subsequent infringements.² A patentee who has conveyed his patent and afterward regained it may sue for violations of the monopoly during either period of his ownership, but not for those committed while the patent was the property of others.³ In suits on a joint patent all the

§ 939. ¹ That a patent once granted authorizes a patentee to sue on it, see *Asbestos Felting Co. v. Salamander Felting Co.* (1876), 10 O. G. 828; 13 *Blatch.* 453; 2 *Bann. & A.* 369.

That no legal title exists in any one until the patent issues, see *Pontiac Knit Boot Co. v. Merino Shoe Co.* (1887), 31 *Fed. Rep.* 286.

That a patentee is presumed to be the owner of the patent if no assignment is alleged or proved, see *Fischer v. Neil* (1881), 6 *Fed. Rep.* 89; 19 O. G. 603.

That a patentee having contracted to sell portions of his right still owns the patent, and he alone can sue for infringement, see *Wheeler v. McCormick* (1873), 4 O. G. 692; 6 *Fisher*, 551; 11 *Blatch.* 334; *Sanford v. Messer* (1872), 5 *Fisher*, 411; 2 O. G. 470; *Holmes*, 149; *Park v. Little* (1813), 3 *Wash.* 196; 1 *Robb*, 17.

² That a patentee, excluded from certain business in certain places, may nevertheless maintain suit for the use of his invention by others in such places, see *Colgate v. International Ocean Telegraph Co.* (1879), 17 O. G. 194; 17 *Blatch.* 308; 4 *Bann. & A.* 609.

That patentees, having reversionary interests after those of their grantees

expire, may maintain a suit to protect their interests, see *Freese v. Swartchild* (1888), 35 *Fed. Rep.* 141; *Otis Bros. Mfg. Co. v. Crane Bros. Mfg. Co.* (1886), 27 *Fed. Rep.* 550; *Still v. Reading* (1881), 20 O. G. 1025; 9 *Fed. Rep.* 40; 4 *Woods*, 345.

That a patentee and licensor should be joined with the assignee of the licensor in a suit against the licensee if he is still interested in the patent, see *Woodworth v. Cook* (1850), 2 *Blatch.* 151.

That a former owner of the patent who has sold it, reserving certain special uses, is not a proper party plaintiff, see *Frankfort Whiskey Process Co. v. Pepper* (1885), 26 *Fed. Rep.* 336.

That the former owner of the patent may sue, after he has assigned it, for infringements committed against him during his ownership, see *Moore v. Marsh* (1868), 7 *Wall.* 515.

³ That a patentee taking a release of all outstanding rights may sue in his own name for all future, but not for past, infringements, see *Wheeler v. McCormick* (1873), 4 O. G. 692; 6 *Fisher*, 551; 11 *Blatch.* 334.

That a patentee cannot recover for damages arising since he assigned the patent, see *Wheeler v. McCormick*

patentees must be made plaintiffs, and the same rule applies in all cases of joint-ownership whether of assignees, grantees, or representatives.⁴ That one of the joint owners has conveyed his interest in the patent since the infringement does not dispense with the necessity of joining him as plaintiff in a suit therefor.⁵

§ 940. Assignee when Plaintiff in Actions at Law.

An assignee of the entire interest in the patented invention must sue alone for any infringement committed during his sole ownership.¹ It is immaterial whether the assignment was made before or after the issue of the patent, provided the legal title of the assignee has been perfected as the law requires; but while the title remains imperfect, or resides in contract only, a court of law cannot take cognizance of any action brought by the assignee in his own name.² The motive of the assignment is also of no consequence,—it being sufficient that the legal title is duly vested in him.³ An assignee of an

(1873), 4 O. G. 692; 6 Fisher, 551; 11 Blatch. 334.

⁴ That joint patentees and all other co-owners must be made plaintiffs, see *Moore v. Marsh* (1868), 7 Wall. 515; *Stein v. Goddard* (1856), 1 McAllister, 82; *Whittemore v. Cutter* (1813), 1 Gallison, 429; 1 Robb, 28.

⁵ That one of two joint owners of a patent having assigned his interest after infringement, both may still sue at law for the injury, and no equitable interference is required, see *Spring v. Domestic Sewing Mach. Co.* (1882), 22 O. G. 1445; 13 Fed. Rep. 446.

§ 940. ¹ That the assignee of the entire monopoly may sue in his own name, see *Nellis v. Pennock Mfg. Co.* (1882), 13 Fed. Rep. 451; 15 Phila. 493; 22 O. G. 1131; *Moore v. Marsh* (1868), 7 Wall. 515.

That an assignee can maintain a suit at law or in equity without joining the patentee, see *Brooks v. Bicknell* (1843), 3 McLean, 250; 2 Robb, 118.

That an assignee can sue in his own name only by force of the statute, see *Suydam v. Day* (1846), 2 Blatch. 20.

² That where an assignment was made before the patent was granted only the assignee can sue for infringements, see *Herbert v. Adams* (1825), 4 Mason, 15; 1 Robb, 505.

That an assignee before patent, with request that the patent issue to him, may sue in his own name though the patent actually issued to the inventor, see *Consolidated Electric Light Co. v. McKeesport Electric Light Co.* (1888), 34 Fed. Rep. 335; *Consolidated Electric Light Co. v. Edison Electric Light Co.* (1885), 25 Fed. Rep. 719; 23 Blatch. 412; 33 O. G. 1597.

³ That an assignee may sue, no matter what may have been the motive for the assignment, see *Seibert Cylinder Oil Cup Co. v. Phillips Lubricator Co.* (1882), 10 Fed. Rep. 677.

undivided interest cannot sue alone, but must join his co-owners; and where an assignment is conditional, and interests of the assignor are liable to be affected by the suit, he must be made a party also, or if this is impracticable under the rules of pleading, recourse must be had to equity in which the rights of all parties can be secured.⁴ An assignee in trust, though not entitled to the proceeds of the suit, is nevertheless the proper plaintiff until the trust has been fulfilled.⁵

§ 941. Grantee, when Plaintiff in Actions at Law.

The grantee of an exclusive territorial interest in the patented invention must sue alone for any infringement committed within his territory.¹ Under our earliest statutes grantees were not regarded as real owners of any part of the monopoly, and, therefore, could not sue at law for an infringement of the patent.² Since that power was conferred upon them, the close resemblance between many licenses and grants has caused some difficulty in determining whether given suits

⁴ In *Moore v. Marsh* (1868), 7 Wall. 515, Clifford, J. : (520) "Where the patentee has assigned his whole interest, either before or after the patent is issued, the action must be brought in the name of the assignee, because he alone was interested in the patent at the time the infringement took place; but where the assignment is of an undivided part of the patent, the action should be brought for every infringement, committed subsequent to the assignment, in the joint names of the patentee and assignee, as representing the entire interest."

See also *Stein v. Goddard* (1856), 1 McAllister, 82; *Whittemore v. Cutter* (1813), 1 Gallison, 429; 1 Robb, 28.

That unless an assignment is absolute and unconditional and passes the legal title, the interests of the assignor may be affected by the suit, and he is a necessary party to it, see *Cook v. Bidwell* (1879), 20 O. G. 1083; 8 Fed. Rep. 452.

⁵ That pending a trust conveyance

to the plaintiff, he may bring suit for infringement, having a title in him, see *Campbell v. James* (1879), 18 O. G. 979; 17 Blatch. 42; 4 Bann. & A. 456.

That the receiver of a corporation in Pennsylvania has no title to its patents, and cannot sue thereon in his own name, see *Dick v. Struthers* (1885), 34 O. G. 131; 25 Fed. Rep. 103.

§ 941. ¹ That a grantee may sue alone for an infringement in territory where his right is exclusive, see *Hobbie v. Smith* (1886), 27 Fed. Rep. 665; *Moore v. Marsh* (1868), 7 Wall. 515; *Gayler v. Wilder* (1850), 10 How. 477.

That where a grantee never performs the conditions of his grant or avails himself of it, but recognizes his grantor's exclusive rights, the grantor may sue for infringement in that territory after the grantee's death without naming him, see *Railroad Co. v. Trimble* (1870), 10 Wall. 367.

² That territorial grantees cannot sue under the act of 1793, Secs. 4 and

were properly instituted, and this difficulty is likely to continue as long as ambiguous agreements and conveyances afford room for doubt as to their true legal effect. But where the transferee is an actual grantee, as distinguished from a licensee, his right to sue for violations of the monopoly within his territory is as well established as that of an assignee.³ Joint grantees like joint assignees must unite as plaintiffs in an action for infringement.

§ 942. **Personal Representatives of Deceased Owner when Plaintiffs in Actions at Law.**

The personal representatives of the deceased owner of a patent must be the plaintiffs in an action for infringement committed either during their own ownership or that of their decedent. The heirs or devisees, though beneficially entitled to the proceeds of the suit, are mere *cestuis que trust* and cannot appear as plaintiffs in a court of law.¹ Where there are several executors, some of whom take no part in the administration of the estate, those who act should be sole plaintiffs; and where a patent issues or re-issues to one of several executors, he only has the legal title and can maintain a suit

5, not being true assignees, see *Tyler v. Tuel* (1810), 6 Cranch. 324; 1 Robb, 14.

That the grantee of an exclusive territorial right could maintain a suit in equity in his own name under the act of 1793, whether he could at law or not, see *Ogle v. Ege* (1826), 4 Wash. 584; 1 Robb, 516.

³ In *Hill v. Whitcomb* (1874), 5 O. G. 430, Shepley, J. : (431) "To enable the purchaser to sue, the assignment must undoubtedly convey to him the entire and unqualified monopoly which the patentee held in the territory specified, excluding the patentee himself as well as others. Any assignment short of this is a mere license, and the legal right in the monopoly remains in the patentee, and he alone can maintain an action against a third party who commits an infringement upon it."

1 Bann. & A. 34 (36); Holmes, 317 (321).

That a grantee of all right, title, and interest within certain territory may sue for infringement, see *Perry v. Corning* (1870), 7 Blatch. 195.

That an assignee of an exclusive right to use, but not to make, the invention within certain territory may sue an infringer in his own name, see *Chambers v. Smith* (1870), 5 Fisher, 12.

That the assignee of an exclusive territorial right to use two machines can sue in his own name even against the patentee, see *Wilson v. Rousseau* (1846), 4 How. 646; 2 Robb, 372.

§ 942. ¹ That the next of kin are not to be joined with the executor or administrator as plaintiffs in a suit for an infringement or an account, see *Hodge v. North Missouri R. R. Co.* (1869), 4 Fisher, 161; 1 Dillon, 104.

thereon.² An administrator or executor can sue in any district without qualifying in the probate courts of the State in which the district is comprised, his relation to the patented invention being that of a trustee under the acts of Congress, and not dependent upon any local law.³

§ 943. Assignee of Claim for Past Infringements, when Plaintiff in Actions at Law.

The law permits the owner of a patent who has been injured by its infringement to assign his right of action for

² That where one alone of several executors of the patentee acts, he alone can sue at law for infringement, see *Rubber Co. v. Goodyear* (1869), 9 Wall. 788.

That when a patent issues or re-issues to one of several executors, he is the sole patentee and the others need not join in the suit though the damages when recovered belong to the estate, see *Rubber Co. v. Goodyear* (1869), 9 Wall. 788; *Goodyear v. Providence Rubber Co.* (1864), 2 Fisher, 499; 2 Clifford, 351.

³ In *Goodyear v. Hullihen* (1867), 3 Fisher, 251, Jackson, J. : (253) "It does not appear to me that this point is well taken; the reasons which exist for requiring an administrator, in ordinary cases, to qualify in the State in which he sues, do not apply to suits brought by an administrator to whom a patent has been granted for the invention of his intestate, for infringement of the rights thus granted. Under the act of Congress patents are granted, in case of the decease of the inventor, to the executor or administrator of such person, in trust for the heirs-at-law of the deceased, in case he shall have died intestate, but if otherwise, then in trust for his devisees (act of July 4, 1836, § 10); and re-issues are also granted to the executor or administrator (act of July 4, 1836, § 13). In such cases

the administrator is a trustee holding the legal title, and the patent is not assets in his hands belonging to the personal estate of the intestate, but is a franchise granted to the administrator for the benefit of the heirs-at-law or devisees of the deceased inventor. There is, therefore, no reason for requiring him to qualify in this State; besides which, the question may be considered as set at rest by the authority of the following cases, cited in argument by complainant's counsel: 'It is not necessary in an action by an administrator that he should produce his letters of administration. The patent being renewed to him, as administrator, is proof that he had satisfied the officer authorized to grant a renewal of his being administrator, and it is not competent for the court to go behind that decision.' *Woodworth v. Hall*, 1 W. & M. 254. 'An administrator of a patentee, residing in one State, may commence an action in the United States Circuit Court of another State for the recovery of damages for an infringement of a patent, without taking out letters of administration in the latter State.' *Smith v. Mercer*, 5 Penn. Law Jour. 531." 2 Hughes, 492 (495).

See also *Hodge v. North Missouri R. R. Co.* (1869), 4 Fisher, 161; 1 Dillon, 104.

such injury in conjunction with an assignment of the patent, and thus to transfer to the assignee not only the monopoly itself, but also the power to recover compensation for its past infringements.¹ These assignments must expressly include the right of action,² and are made subject to all the equities existing between the alleged infringer and the assignor.³ The right of action cannot be conveyed separately from the patent, since this would confer the ability to sue for an infringement on other persons than those named in the statute as the legal owners of the monopoly.⁴ An assignee of this character may maintain an action in his own name for these infringements

§ 943. ¹ That a right to damages for past infringements is assignable, see *Hamilton v. Rollins* (1877), 3 Bann. & A. 157; 5 Dillon, 495.

That an assignment of a right to sue for the profits of an infringement is not an assignment of unliquidated damages, see *Jenkins v. Greenwald* (1857), 2 Fisher, 37; 1 Bond, 126.

That a right of action for past infringements vests in the administrator of the patentee, and may be sued on or assigned by him, see *May v. County of Logan* (1887), 30 Fed. Rep. 250; 41 O. G. 1387.

² That an assignment of a right of action for past injuries must be clearly expressed, see *Emerson v. Hubbard* (1888), 34 Fed. Rep. 327; *Knowlton Platform & Car Coupling Co. v. Cook* (1879), 70 Me. 143.

That the mere assignment of the patent does not transfer the right to sue for past infringements, see *Kaolatype Engraving Co. v. Hoke* (1887), 30 Fed. Rep. 444; 39 O. G. 589; *May v. Juneau Co.* (1887), 30 Fed. Rep. 241; 41 O. G. 578; *N. Y. Grape Sugar Co. v. Buffalo Grape Sugar Co.* (1883), 18 Fed. Rep. 638; 25 O. G. 1076; 21 Blatch. 519; *Merriam v. Smith* (1882), 11 Fed. Rep. 588.

That the assignment of a patent by an administrator does not cover claims for past infringements, especially where

only a nominal price is paid by the assignee, see *May v. Juneau Co.* (1887), 30 Fed. Rep. 241; 41 O. G. 578.

That the assignment of "all right, title, interest, claims, and demands whatsoever which the estate has in, to, by, under, and through" letters-patent carries rights of action for past infringement, see *May v. Logan Co.* (1887), 30 Fed. Rep. 250; 41 O. G. 1387.

That the assignee of claims for damages must allege and prove an assignment of such claims themselves, see *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.* (1883), 18 Fed. Rep. 638; 25 O. G. 1076; 21 Blatch. 519.

³ That the assignee of damages for past infringements takes his title subject to all the equities against the assignors, see *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.* (1883), 18 Fed. Rep. 638; 25 O. G. 1076; 21 Blatch. 519.

That laches of an assignor of rights of action binds his assignee, see *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.* (1885), 24 Fed. Rep. 604; 32 O. G. 1356.

⁴ That a claim for past infringements cannot be severed from the title to the patent by assignment so as to give a right of action contrary to the statutes, see *Gordon v. Anthony* (1879), 16 O. G. 1135; 16 Blatch. 234; 4 Bann. & A. 248.

under the former owner, either during the life of the patent or after it has expired.⁵ Transfers of title and of rights of action, *pendente lite*, do not affect the litigation unless the interests of the parties may require it, but notice of such transfer must be given to the defendant or he will be protected in his *bona fide* payments to the record plaintiff.⁶

§ 944. Plaintiff in Actions at Law must Sue in His Own Name.

The proper plaintiff in an action for infringement must institute the suit in his own name, according to the character imposed upon him by the local law.¹ Persons *sui juris* appear as the assertors of their legal rights. Married women must sue alone or jointly with their husbands, and infants by guardian or otherwise, as the State legislation fixing their capacity may indicate.² A corporation sues by its corporate

⁵ That an assignee of a patent and of all claims for past infringements may sue at law or for an injunction in his own name, see *May v. Logan Co.* (1887), 30 Fed. Rep. 250; 41 O. G. 1387; *Adams v. Bellaire Stamping Co.* (1885), 25 Fed. Rep. 270; 33 O. G. 623; *Spring v. Domestic Sewing Mach. Co.* (1882), 22 O. G. 1445; 13 Fed. Rep. 446; *Merriam v. Smith* (1882), 11 Fed. Rep. 588; *Campbell v. James* (1880), 2 Fed. Rep. 338; 18 O. G. 1111; 18 Blatch. 92; 5 Bann. & A. 354.

That in a suit at law, after a patent has expired, if the assignment does not cover claims for past infringements, the assignors must be joined as plaintiffs, see *Adams v. Bellaire Stamping Co.* (1885), 25 Fed. Rep. 270; 33 O. G. 623.

That where the plaintiff, when the suit begins, owns the patent and the entire interest in the claim for past infringements, he may recover for the infringements committed before he owned the patent, see *Consolidated Oil Well Packer Co. v. Eaton, Cole, & Burnham Co.* (1882), 12 Fed. Rep. 865.

⁶ In *Campbell v. James* (1880), 18 O. G. 1111, Wheeler, J. : (1113) "Conveyances *pendente lite* do not at all affect the litigation as between the parties to the original controversy unless there are special statutes or circumstances to control; but courts of justice, even courts of law, and especially courts of equity, often protect the rights of the real owners to the fruits of a recovery as against those who are nominal but not real owners whenever their rights may have been acquired." 2 Fed. Rep. 338 (345); 18 Blatch. 92 (98); 5 Bann. & A. 354 (361).

That on an assignment of a claim pending suit notice must be given to the defendant that he may not pay the wrong party, see *Gear v. Fitch* (1878), 16 O. G. 1231; 3 Bann. & A. 573.

§ 944. ¹ That the local law may determine who the real party in interest is, see *Lorillard v. Standard Oil Co.* (1880), 17 O. G. 1507; 18 Blatch. 199; 2 Fed. Rep. 902; 5 Bann. & A. 432.

² That in New York a married woman may sue alone in her own name for an infringement, she being by the State law a *feme sole* as to such matters,

name as determined by its charter, and an unincorporated association in the names of its individual members.³ No plaintiff can commence or prosecute a suit in the name of his attorney or any other delegate.⁴

§ 945. **Non-joinder or Misjoinder of Plaintiffs in Actions at Law.**

Objections for the non-joinder or misjoinder of plaintiffs are not favored by the courts where the plaintiffs of record have a legal title, and must be made in due season or they cannot be regarded.¹ A misjoinder cannot be noticed after a final judgment in the Supreme Court of the United States.² A non-joinder is cured by a disclaimer of title, on the part of the alleged omitted parties, in favor of the actual plaintiffs.³

see *Lorillard v. Standard Oil Co.* (1880), 2 Fed. Rep. 902; 17 O. G. 1507; 18 Blatch. 199; 5 Bann. & A. 432.

³ That in Pennsylvania the receiver of a corporation has no title to its property, and cannot sue on its letters-patent, see *Dick v. Struthers* (1885), 25 Fed. Rep. 103; 34 O. G. 131; *Dick v. Oil Well Supply Co.* (1885), 25 Fed. Rep. 105.

That the suit of an unincorporated company should be prosecuted in the names of the individual parties, not the company, see *Metal Stamping Co. v. Crandall* (1880), 18 O. G. 1531.

⁴ In *Goldsmith v. American Paper Collar Co.* (1880), 18 Blatch. 82, Blatchford, J. : (83) "The party in interest must bring the suit, whether at law or in equity, in his own name, and cannot delegate the right to another person to bring the suit in the name of such other person when the suit is not for the benefit in any way of such other person. It is a question of public policy. The defendant has a right to require that the real owner or party in interest shall be in court, so that the court may exercise a control over him in the course of the suit, if necessary, to require him to do something which the rights of the defendant may require to be done." 18

O. G. 192 (192); 2 Fed. Rep. 239 (240); 5 Bann. & A. 300 (301).

See also *Lorillard v. Standard Oil Co.* (1880), 17 O. G. 1507; 2 Fed. Rep. 902; 18 Blatch. 199; 5 Bann. & A. 432.

§ 945. ¹ That in equity an objection for non-joinder of plaintiffs is not favored if any of the parties to the suit have a legal title, see *Graham v. McCormick* (1880), 11 Fed. Rep. 859; 21 O. G. 1533; 10 Bissell, 39; 5 Bann. & A. 244; *Graham v. Geneva Lake Crawford Mfg. Co.* (1880), 11 Fed. Rep. 138; 21 O. G. 1536.

That an objection for non-joinder may be waived either at law or in equity, see *Adams v. Howard* (1884), 23 Blatch. 27; 22 Fed. Rep. 656.

² That a misjoinder of parties cannot be objected to after final decree and in the Supreme Court, see *Livingston v. Woodworth* (1853), 15 How. 546.

That defect of parties cannot be urged after a hearing on the merits, unless they are indispensable to a decree, see *Adams v. Howard* (1884), 23 Blatch. 27; 22 Fed. Rep. 656.

³ That a disclaimer of title in favor of the plaintiffs by persons not joined will cure the non-joinder, see *Graham v. Geneva Lake Crawford Mfg. Co.* (1880), 11 Fed. Rep. 138; 21 O. G. 1536.

§ 946. Defendant in Actions at Law must be the Person Guilty of the Act of Infringement.

Any person who has been guilty of an act of infringement may be made a defendant in an action at law. An act of infringement is committed by making, using, or selling the patented invention without authority from the owner of the patent; or by employing others to make, use, or sell it for the benefit of the employer; or by accepting and enjoying the direct advantage flowing from the infringement; or by acting in complicity with others under any cover or pretence the practical effect of which is an invasion of the monopoly created by the patent.¹ All who perform or who unite in the performance of an act of infringement, by any of these methods, may be sued jointly or severally at the option of the plaintiff, provided they can lawfully be served with process in the territory over which the court has local jurisdiction.²

§ 947. All Infringers Liable as Defendants in Actions at Law.

No exemption from this liability to suit exists in favor of any person on the ground of infancy, lunacy, or coverture.¹ The government of the United States when practising a patented invention without permission from its lawful owner, though not technically guilty of an act of infringement or capable of being reached by ordinary process, may be sued in the Court of Claims for compensation in pursuance of the Federal statutes enacted for that purpose.² An officer of

§ 946. ¹ See §§ 897-921 and notes, *ante*.

That infringements by the maker and the user are separate trespasses, see *Blake v. Greenwood Cemetery* (1883), 16 Fed. Rep. 676; 25 O. G. 89; 21 Blatch. 222.

² See §§ 947, 948, and notes, *post*.

That where defendants are jointly sued their relation to each other should be stated in the declaration, see *Shickle v. South St. Louis Foundry Co.* (1884), 22 Fed. Rep. 105.

That where several parties infringe,

some by making and the others by selling, the wrongs are both joint and several, and judgment can be obtained against each, though there can be only one satisfaction, see *Jennings v. Dolan* (1887), 29 Fed. Rep. 861; 38 O. G. 1018.

§ 947. ¹ That infants, married women, and lunatics are liable for damages for infringement, see § 921 and notes, *ante*.

² That the United States is liable, see § 910 and notes, *ante*, and § 1258 and notes, *post*.

the government infringing a patent in its service cannot be made defendant in an action for infringement when the judgment in such action would indirectly be a judgment against the United States, but he may be sued upon his personal account if his act of infringement has arisen from his own volition or has redounded to his individual benefit.³ Cities and other true municipal or private corporations are liable to actions for the infringements of their officers or agents, whether these were previously authorized or subsequently ratified by them; and with them may be joined as co-defendants such officers and agents when they have directed, or have voluntarily performed, or have immediately and personally profited by, the infringing act.⁴ All private individuals not acting under lawful obedience to their superiors are also liable to suit for their invasions of the monopoly, whether they are part owners, licensees, or strangers to the patent.⁵ The amenability of an infringer to another court, or upon different proceedings, is no bar to a suit against him for the infringement in a court of law.⁶

§ 948. Non-joinder and Misjoinder of Defendants in Actions at Law.

The misjoinder or non-joinder of defendants is immaterial unless the act of alleged infringement was inseparable and could not have been performed by the record defendants alone,—in which case the plaintiff may fail in his cause through inability to prove his allegations. As in other actions of tort, persons improperly joined as defendants may have a verdict and recover costs, while the plaintiff may

³ That government officials are liable, see § 910 and notes, *ante*.

⁴ That corporations, their officers and agents, are liable, see §§ 911, 912, and notes, *ante*.

⁵ That all private infringers are liable, see §§ 913-921 and notes, *ante*.

⁶ That a defendant who has violated an injunction and is liable for contempt may still be sued for infringement, see

Roemer v. Neumann (1885), 23 Fed. Rep. 447.

That a party who elects to take a judgment for the profits cannot have an action for damages for the same infringement while the former judgment is unreversed, since only one action will lie for a given tort if the damages can be ascertained in one, see *Child v. Boston & Fairhaven Iron Works* (1884), 19 Fed. Rep. 258.

prevail against the actual infringers.¹ No obligation rests upon the plaintiff to join all the defendants in one action. Like all wrong-doers each is liable for the entire loss occasioned by the infringement, and judgment may be obtained against each successively in different suits or against all collectively in one.² The plaintiff can, however, have but one satisfaction, and when he has received full compensation for his injury from one or more of the defendants, the judgments in all subsequent proceedings are restricted to the amount of taxable costs.³ The death of a defendant does not abate the action, nor does his bankruptcy or the marriage of a *feme sole* defendant affect the suit, except to introduce new parties to the record.⁴

§ 949. **Process in Actions at Law: The Declaration: Allegation of Inventive Act.**

The process in an action at law for infringement does not differ from that employed in the Federal courts, within the district, to secure the appearance of the defendant in other civil actions. The declaration must contain all the averments which are necessary to support the evidence of the plaintiff's right and its violation.¹ Of these essential averments there

§ 948. ¹ That a plaintiff may prove infringement against one of several defendants and recover against him alone, see *Reutgen v. Kanowrs* (1804), 1 Wash. 168; 1 Robb, 1.

² That non-joinder of defendants is no defence by joint infringers since each is liable for all, see *Wallace v. Holmes, Booth, & Haydens* (1871), 1 O. G. 117; 5 Fisher, 37; 9 Blatch. 65.

That whether joint infringers *must* be joined even in equity is doubtful, see *Goodyear v. Toby* (1868), 6 Blatch. 139.

³ That recovery and satisfaction against one joint tort-feasor is a bar to a recovery against the others, except as to the costs in pending suits, see *Sheldon v. Kibbe* (1819), 3 Conn. 214.

That recovery from one tort-feasor

is no bar to a suit against the others unless the judgment is satisfied or released, see *American Bell Telephone Co. v. Albright* (1887), 32 Fed. Rep. 287.

⁴ That a suit survives against a deceased infringer's estate, see *Kirk v. DuBois* (1886), 37 O. G. 102; 28 Fed. Rep. 460; *Smith v. Baker's Admr.* (1874), 10 Phila. 221; 1 Bann. & A. 117; 5 O. G. 496.

§ 949. ¹ That the allegations of the declaration must be as broad as the evidence needed to establish the plaintiff's right to recover, see *Stanley v. Whipple* (1839), 2 McLean, 35; 2 Robb, 1.

That an ordinary declaration on the case is sufficient, see *May v. Mercer Co.* (1887), 41 O. G. 815; 30 Fed. Rep. 246.

are five: (1) The invention of the patentable subject-matter by the patentee or his assignor; (2) The grant of letters-patent covering the invention; (3) The legal title of the plaintiff; (4) The infringement by the defendant; (5) The resulting damage to the plaintiff. Under the first averment the plaintiff must allege the performance of an inventive act on the part of the patentee or his assignor, producing a new and useful art or article not before known or used in this country, and not in public use or on sale more than two years before his application for a patent.² The date of this inventive act need not be stated, if it appears to have preceded that of the application.³ The art or article may be described in this averment by the title given to it in the patent.⁴ Though it is customary to allege the citizenship of the patentee it is not generally held to be essential.⁵

§ 950. The Declaration: Allegation of Grant of Letters-Patent.

Under the second averment the plaintiff must allege and describe the application of the inventor for a patent, its allowance by the Patent Office, and the issue of letters-patent thereon, specifying the nature of the invention which it purports to protect and making profert of the patent.¹ The compliance of the applicant with the preliminary requirements or of the officials of the department with their prescribed duties need not be stated, these being presumed from the

² That the declaration must tender an issue upon every point essential to the patentability of the invention, see *Wilder v. McCormick* (1846), 2 Blatch. 31; *Gray v. James* (1817), Pet. C. C. 476; 1 Robb, 140.

³ That the declaration need not aver the date when the invention was made, except that it was before the application, nor allege the taking of the required preliminary steps, all these being presumed from the grant of the patent, see *Wilder v. McCormick* (1846), 2 Blatch. 31.

⁴ That in averring the patentability of the invention it need not be particularly set forth, see *Turrell v. Cammer-*

rer (1868), 3 Fisher, 462; *Gray v. James* (1817), Pet. C. C. 476; 1 Robb, 140.

⁵ That citizenship is not in issue though alleged, see *Fischer v. Neil* (1881), 19 O. G. 603; 6 Fed. Rep. 89.

§ 950. ¹ That the declaration must set out the attestation of the President, and allege that the patent was delivered, or it may be demurred to, see *Cutting v. Myers* (1818), 4 Wash. 220; 1 Robb, 159.

That the declaration must allege the improvement and show in what it consists, see *Peterson v. Wooden* (1843), 3 McLean, 248; 2 Robb, 116.

grant of the patent.² Nor is it necessary that the claims and specifications of the patent be set out at length, although it may be done, since the profert of the patent makes it part of the declaration when it is afterwards produced.³ The patent should be indicated by its date and number, and if it be a re-issued patent its history should be traced by a recital of the grant of the original and intermediate re-issues as well as of the one on which the suit is brought.

§ 951. **The Declaration : Allegation of Legal Title of the Plaintiff.**

Under the third averment the exact legal title of the plaintiff must be set forth with certainty, as it appears or can be made to appear upon the records of the Patent Office.¹ If the plaintiff is the original inventor and patentee, this averment may consist of the simple affirmation that he is still the owner of the patent.² If he is an assignee of the inventor before patent, and by virtue of such assignment received the patent

² That the declaration need not aver that the preliminary steps to the issue of the patent were taken, see *Cutting v. Myers* (1818), 4 Wash. 220 ; 1 Robb, 159.

That the declaration must tender an issue on novelty and utility, not on the regularity of the proceedings in the Patent Office, see *Wilder v. McCormick* (1846), 2 Blatch. 31.

That a declaration need not describe the invention otherwise than as the patent does, for the defendant can crave oyer, if he desires it, of the specification, see *Cutting v. Myers* (1818), 4 Wash. 220 ; 1 Robb, 159 ; *Gray v. James* (1817), Peters C. C. 476 ; 1 Robb, 140.

That the profert of the patent makes it part of the declaration when afterwards produced, see *Pitts v. Whitman* (1843), 2 Story, 609 ; 2 Robb, 189.

That oyer of a patent or other public record is not demandable, see *Smith v. Ely* (1849), 5 McLean, 76.

That a declaration averring the patent and specification to be in "lan-

guage of the import and effect following" and setting them out in their exact words is sufficient, and correctly describes their legal tenor and effect, see *Wilder v. McCormick* (1846), 2 Blatch. 31.

That where profert is made of a recorded paper in the complaint it is part of the pleadings and demurrable, see *Bogart v. Hinds* (1885), 25 Fed. Rep. 484 ; 33 O. G. 1268.

§ 951. ¹ That the declaration must show title in the plaintiff with sufficient certainty, and set out all matters which are of the essence of the action, see *Gray v. James* (1817), Peters C. C. 476 ; 1 Robb, 140.

That the declaration must aver that the plaintiff had obtained a patent, not merely that he claimed one, see *Stanley v. Whipple* (1839), 2 McLean, 35 ; 2 Robb, 1.

² That an averment that the patent was issued to the plaintiff is a sufficient allegation of his title, see *Cutting v. Myers* (1818), 4 Wash. 220 ; 1 Robb, 159.

in his own name from the government, or if he has become an assignee or grantee since the patent, or holds as personal representative of a deceased owner, his entire chain of title must be alleged with such particularity that the defendant can investigate it and judge of its validity.³ Where his ownership is made dependent on the performance of conditions precedent, the conditions must be stated and their fulfillment be averred.⁴ These allegations of title, in all cases but that of the patentee, ought properly to be accompanied by proof of the instruments on which it rests, or by a reference to the records of the Patent Office on which they appear, and an averment that they have been lawfully recorded.⁵

§ 952. The Declaration : Allegation of Infringement.

Under the fourth averment the plaintiff must allege that the defendant has infringed the patent by making, using, or selling the invention therein described, without authority from the owner of the patent. This violation must be stated as broadly as the right claimed in the patent, in order that it may clearly appear that the acts of the defendant related to the precise invention thereby protected.¹ No specific phraseology is necessary for this purpose, the assertion that the in-

³ That an averment that the plaintiff became an assignee before the patent issued is a sufficient allegation of title, see *Rathbone v. Orr* (1850), 5 McLean, 131.

That a plaintiff assignee must fully set out the fact of the assignment, see *Dobson v. Campbell* (1833), 1 Sumner, 319 ; 1 Robb, 681.

⁴ That when the plaintiff's title depends on the performance of certain acts, he must set them out, see *Gray v. James* (1817), Peters C. C. 476 ; 1 Robb, 140.

⁵ That allegations of assignment should aver that the instruments have been duly recorded, see *Dobson v. Campbell* (1833), 1 Sumner, 319 ; 1 Robb, 681.

That an omission to aver material

facts in the declaration which must have been proved in order to obtain a verdict, and proof of which could have been made under the declaration, as, for example, the recording of an assignment, is cured by the verdict, see *Stanley v. Whipple* (1839), 2 McLean, 35 ; 2 Robb, 1 ; *Dobson v. Campbell* (1833), 1 Sumner, 319 ; 1 Robb, 681 ; *Gray v. James* (1817), Peters C. C. 476 ; 1 Robb, 140.

That if the declaration shows on its face that the plaintiff has not a legal title, but is merely a licensee, the defendant is entitled to judgment, see *Suydam v. Day* (1846), 2 Blatch. 20.

§ 952. ¹ That a breach of the patent is to be assigned as broadly as the right is stated, see *Cutting v. Myers* (1818), 4 Wash. 220 ; 1 Robb, 159.

vention practised by the defendant was an "imitation of the patent," or any equivalent language, having been held sufficient.² Repeated acts of infringement may be alleged in the same manner.³ In connection with this averment the acquiescence of all other persons in the plaintiff's exclusive right is sometimes declared, as well as the great worth and importance of the invention to the plaintiff, but these are not essential, since the infringement by the defendant is no less an actionable wrong though many others have been guilty of the same unlawful acts, and though the invention never has been recognized as possessing a commercial value.⁴

§ 953. The Declaration : Allegation of Damages.

The fifth averment is a formal though a necessary part of the declaration. It need not contain any special delineation of the methods in which the infringement has injuriously affected the plaintiff.¹ The law implies a damage to the owner

² That an averment that the defendant has made the device "in imitation of the patent" is sufficient, see *Parker v. Haworth* (1848), 4 McLean, 370 ; 2 Robb, 725.

That an averment that the defendant has "constructed, used, and vended" to others is sufficient, see *Case v. Redfield* (1849), 4 McLean, 526 ; 2 Robb, 741.

That the particular means by which the infringement was committed need not be averred, see *Turrell v. Cammerrer* (1868), 3 Fisher, 462 ; *Case v. Redfield* (1849), 4 McLean, 526 ; 2 Robb, 741.

³ That numerous acts of infringement may be averred in the same declaration without duplicity, see *Wilder v. McCormick* (1846), 2 Blatch. 31 ; *Case v. Redfield* (1849), 4 McLean, 526 ; 2 Robb, 741.

That it is not necessary that each act of infringement be the subject of a distinct action at law, or the inventor might be ruined, see *Motte v. Bennett* (1849), 2 Fisher, 642.

That an allegation that one Claim in

the patent is infringed discloses a cause of action, see *Cook v. Ernest* (1872), 2 O. G. 89 ; 5 Fisher, 396 ; 1 Woods, 195 ; *Lee v. Blandy* (1860), 2 Fisher, 89 ; 1 Bond, 361 ; *Singer v. Walmsley* (1860), 1 Fisher, 558 ; *Waterbury Brass Co. v. N. Y. & Brooklyn Brass Co.* (1858), 3 Fisher, 43 ; *Emerson v. Hogg* (1845), 2 Blatch. 1 ; *Moody v. Fiske* (1820), 2 Mason, 112 ; 1 Robb, 312.

That when a patent claims two inventions a suit may be brought on it for the infringement of either, and the patent will be treated as if it contained only that Claim, see *McComb v. Brodie* (1872), 5 Fisher, 384 ; 2 O. G. 117 ; 1 Woods, 153.

⁴ This averment is especially important where an injunction is, or is to be, moved for in connection with the suit, see §§ 1185-1188, and notes, *post*.

§ 953. ¹ That a declaration beginning in case and demanding actual damages in gross as a debt due is good, see *Wilder v. McCormick* (1846), 2 Blatch. 31.

of a patent from its wrongful invasion, and though evidence of actual loss is essential to the recovery of substantial damages the general averment is sufficient for the declaration.² A claim for treble damages is sometimes inserted, but as the power to award this increase over the amount found by the jury resides in the discretion of the court, it constitutes the proper subject of a motion rather than of the pleadings upon which the issues for the jury are to be framed.³

§ 954. The Declaration: Formal Requisites.

The language and logical coherence of a declaration are not severely scrutinized by the court, nor are objections to its modes of statement favored, if it accomplishes the object for which it was intended. It must put the defendant in possession of the facts on which the plaintiff's claim is based, and must leave open to the defendant every legal defence which he has a right to make. If it does this, its faults in other respects will not be critically regarded.¹ An omission to aver material facts which could have been proved under the pleadings as a whole, and which the jury must have found in order to have arrived at their decision, will be cured by verdict.²

² That nominal damages are implied from the violation of the patent, see *Poppenhusen v. N. Y. Gutta Percha Comb Co.* (1858), 2 Fisher, 62. See also §§ 1052, 1071, and notes, *post*.

That actual damages must be proved, see *Mayor of New York v. Ransom* (1859), 23 How. 487; *Seymour v. McCormick* (1853), 16 How. 480.

That in fixing the amount of damages the jury cannot exceed the sum named in the declaration, see *Winans v. N. Y. & Harlem R. R. Co.* (1855), 4 Fisher, 1.

³ That the trebling of damages is a matter for the discretion of the court, see *Seymour v. McCormick* (1853), 16 How. 480; *Stimpson v. Railroads* (1847), 1 Wall. Jr. 164; 2 Robb, 595; *Guyon v. Serrell* (1847), 1 Blatch. 244.

§ 954. ¹ That where a declaration contains all needed allegations to support the evidence of the plaintiff's right and its violation, and leaves every legal defence open to the defendants, it will not be critically regarded, see *Wilder v. McCormick* (1846), 2 Blatch. 31.

² That a verdict cures the defects which must have been supplied in order to enable the jury to reach their decision, see *Stanley v. Whipple* (1839), 2 McLean, 35; 2 Robb, 1; *Dobson v. Campbell* (1833), 1 Sumner, 319; 1 Robb, 681; *Gray v. James* (1817), Peters C. C. 476; 1 Robb. 140.

That the declaration need not conclude *contra formam statuti*, see *Parker v. Haworth* (1848), 4 McLean, 370; 2 Robb, 725; *Tryon v. White* (1815), Peters C. C. 96; 1 Robb, 64.

§ 955. **The Declaration: Joinder of Several Patents where Violated by One Act of Infringement.**

A single and indivisible act of infringement may often violate more than one patent belonging to the plaintiff, and render it essential to the vindication of his rights that all such patents should be joined as the foundation of a single action.¹ Such a case arises where an original invention and its improvements are covered by several patents owned by the same person, and are unlawfully appropriated by the same infringer. Here it would be impossible, on separate suits based on each patent, to distinguish the loss resulting to the plaintiff by the wrongful use of the original from that produced by the employment of the improvement. Other cases present the same difficulty, and in these the only recourse of the plaintiff is to join all such patents in one action and in one claim for damages. This he is permitted to do, and in his declaration he must then set out concerning each patent the matters properly embraced in the first three of the described averments, — the inventive act of the patentee or his assignor, the issue of the patent, and the title of the plaintiff. The averments of infringement and damages may be general, and refer to all the patents collectively.²

§ 956. **Pleadings in Actions at Law: Pleas in Abatement.**

The pleadings of the defendant in an action for infringement are either in abatement, by demurrer, or in bar. A plea in abatement should be filed whenever the defendant desires to object to the mode in which the proceedings have been instituted, whether the fault resides in the process or its service, in the incapacity, misdescription, misjoinder or non-joinder of

§ 955. ¹ That more than one patent may be included in the same suit, see *Bates v. Coe* (1878), 98 U. S. 31; 15 O. G. 337.

That separate suits between the same parties on separate patents, all infringed by the same machine, may be consolidated on motion, see *Deering v. Winona Harvester Works* (1885), 32 O. G. 654; 24 Fed. Rep. 90.

See as to the rule of joinder in equity cases, § 1108, and notes, *post*.

² That where the plaintiff is the owner of the patent for the original invention, and also of a patent for an improvement thereon, he cannot claim separate damages in separate suits for the infringement of each, if both are infringed, see *Case v. Redfield* (1849), 4 McLean, 526; 2 Robb, 741.

the parties, or the pendency of another action between the same parties seeking the same remedy for the same wrong. Most of these objections can be urged only under this dilatory plea, and are waived unless taken advantage of in this formal manner.¹ A suit is not abated on account of other suits against the same defendant for a different act of infringement, nor on account of other suits against different defendants for the same infringement.² The bankruptcy of the plaintiff during the litigation is no ground of abatement.³ The issues

§ 956. ¹ That a plea to the jurisdiction is proper both in law and equity though it be partly or wholly negative, see *Edison Electric Light Co. v. U. S. Electric Lighting Co.* (1888), 43 O. G. 1456.

That an objection to the right of an executor to sue must be taken by plea in abatement, see *Rubber Co. v. Goodyear* (1869), 9 Wall. 788.

That a non-joinder of executors, where necessary to join them, can be taken advantage of only by plea in abatement unless it appears on the record, see *Goodyear v. Providence Rubber Co.* (1864), 2 Fisher, 499; 2 Clifford, 351.

That a denial of the plaintiff's corporate capacity must be made by a plea in abatement, see *Dental Vulcanite Co. v. Wetherbee* (1866), 2 Clifford, 555; 3 Fisher, 87.

That if the plaintiffs are a corporation, the fact of their organization cannot be attacked in a plea in bar, but only by plea in abatement, see *Dental Vulcanite Co. v. Wetherbee* (1866), 3 Fisher, 87; 2 Clifford, 555.

That a plea that joint-infringers are not joined must allege that they all live within the district, see *Goodyear v. Toby* (1868), 6 Blatch. 130.

That if the defendant is sued out of his district he must plead his personal privilege, see *Teese v. Phelps* (1855), 1 McAllister, 17.

That defects in process or service, if

apparent on the face of the record, may be taken advantage of by motion to quash the service or abate the writ, and if not thus apparent, by plea in abatement, see *United States v. American Bell Telephone Co.* (1886), 29 Fed. Rep. 17; 38 O. G. 1237.

² That different suits for different infringements are proper though one is already pending, see *Rumford Chemical Works v. Hecker* (1874), 5 O. G. 644; 11 Blatch. 552; 1 Bann. & A. 120.

That a suit cannot be prosecuted for the infringement of an original patent pending an application for its re-issue, see *Burrell v. Hackley* (1888), 44 O. G. 1400; 35 Fed. Rep. 833.

That pending an accounting the plaintiff cannot sue at law for infringements committed since the decree, without leave of the court, see *Morse v. Knapp* (1888), 35 Fed. Rep. 218.

³ That bankruptcy of the plaintiff is not a ground of abatement in equity, see *Gear v. Fitch* (1878), 16 O. G. 1231; 3 Bann. & A. 573.

That a plaintiff becoming bankrupt, and then purchasing the right of action from his assignee, cannot be met with a plea in abatement, see *Gear v. Fitch* (1878), 16 O. G. 1231; 3 Bann. & A. 573.

That no rule to plead will be granted until the defendant has properly appeared, see *Parker v. Bigler* (1857), 1 Fisher, 285.

formed upon a plea in abatement, as well as the judgment and the subsequent proceedings thereon, are similar to those in other civil actions.

§ 957. Demurrers in Actions at Law.

The defendant may demur to the declaration, either specially on account of its formal defects, or generally on the ground that it sets forth no cause of action. Defects of form are now so little regarded by the courts, and are so easily remedied by amendment, that a special demurrer in this as in other actions is of rare occurrence. A general demurrer will not be sustained, however imperfect in statement or arrangement the declaration may appear, if it substantially includes the five essential averments, and does not mislead the defendant or preclude him from making under the subsequent pleadings those defences which are open to him by the law.¹ The issue and judgment on demurrer, in this class of cases, do not differ from those in ordinary suits at law.

§ 958. Pleas in Bar in Actions at Law: The Defences Possible in Actions at Law.

A plea in bar in actions for infringement assumes the form either of the general issue alone, or of the general issue with notice of special matters, or of a special plea. Before considering these it is important to examine and classify the various defences which may be made to such an action on its merits, in order that the propriety and scope of each of the three forms of plea may be perceived.¹ The general character

§ 957. ¹ That courts will sustain pleadings which are substantially sufficient even against a special demurrer, see *Wilder v. McCormick* (1846), 2 Blatch. 31.

§ 958. ¹ The classification here attempted is not offered as complete and covering every defence which can at any time be made. New grounds of objection to recovery by a patentee from time to time appear in practice, and are sustained by the courts. An interesting instance occurs in the present condition

of that defence which rests upon a simple use of the invention by the public for over two years before the application. Until recently no such defence was recognized except as a part of the wider defence of abandonment, the public use having no significance unless acquiesced in by the inventor. Where acquiescence is not required in order to give this use the force of a complete defence, it no longer can be based on the idea of an abandonment or directly on that of an estoppel, but assumes the law to be

of these defences is indicated by the several averments contained in the declaration, each of which must be found true in order to support a judgment for the plaintiff. The first averment is true only when seven different facts concur: (1) When the alleged invention is the result of an inventive act; (2) When this inventive act has been performed by the patentee or his assignor; (3) When its performance by the patentee or his assignor preceded its performance by any other person in this country; (4) When the alleged invention is embraced within one of the six classes of inventions made patentable by the acts of Congress; (5) When it is legally new; (6) When it is practically useful; (7) When it has not been abandoned to the public. The second averment is true only when nine different facts exist; (1) When the patent described in the declaration has been actually issued by the government; (2) When it was issued in the mode provided by the law; (3) When the invention which it purports to protect is, on its face, a patentable subject-matter; (4) When the specification is free from fraudulent assertion or concealment; (5) When the description is without ambiguity; (6) When the Claims do not embrace more than the actual invention, or if originally embracing more have been or may now properly be cured by a disclaimer; (7) When the Claims are free from ambiguity; (8) When the patent has not been surrendered; (9) When the patent has not been repealed. The third averment is true only when the plaintiff was the legal owner of the patent at the date of the infringement, or at the date of the commencement of the suit was the legal owner of the patent and the assignee of the right of action for the infringement. The fourth averment is

that an invention is not patentable after having been before the public for the period named. This is essentially a new defence, and would if fully established in our practice constitute an eighth species of defences to the first averment of the declaration. In like manner other defences, once employed, are no more in use (such as the non-introduction into market of the invention of an alien,

etc.), and though found formerly in the courts, are here unnoticed.

That defences are not limited to those named in the statute, but embrace all violations of law in granting the patent, such violations raising questions of law on which the decision of the Commissioner is not final, see *Gardner v. Herz* (1886), 118 U. S. 180; 35 O. G. 998.

true only when four facts concur: (1) When the identical invention protected by the patent has been made, or used, or sold; (2) When the act of making, use, or sale has been performed by the defendant, either alone or in complicity with others; (3) When this act was performed while the patent was in force; (4) When this act was performed without authority from the owner of the patent. The fifth averment tenders no issue, its truth being implied by law to an extent sufficient to secure a verdict for some damages in favor of the plaintiff, if the other four averments are established. As each of these averments must be proved in order to entitle the plaintiff to a judgment, and as each of its subordinate facts must exist in order to the truth of each averment, it is apparent that the successful denial of any one of these subordinate propositions constitutes a complete defence to the action and requires the verdict to be given for the defendant. In addition to these defences there are four others of a special nature, not suggested by the declaration, but common to all actions at law; (1) The Statute of Limitations; (2) Estoppel; (3) Release; and (4) *Res Adjudicata*. In reference to most of these defences the courts have given further explanations, and in some of them the statutes recognize minuter subdivisions, which next require attention.

§ 959. First Defence: Denial that the Patented Art or Instrument is the Result of an Inventive Act.

The first defence in the order of the foregoing enumeration consists in a denial that the alleged invention is the result of an inventive act. An inventive act may be performed in either one of three different ways; (1) By the discovery of a new force, or of a new capability in a known force, and the practical application of this new force or capability to some object through some mode of application, such object and such mode of application being new or old; (2) By the discovery of a new object or of a new susceptibility in a known object, and by rendering this object or susceptibility practically useful by subjecting it to the operation of some force through some mode of application, such force and mode of application being new or old; (3) By the discovery and practical embodi-

ment of a new mode of application by which forces may be brought into connection with their objects, such forces and objects being new or old. When either of these three mental and physical operations produces a means, as distinguished from a mere function or effect, it constitutes a true inventive act. Contrariwise, if the alleged invention is only an effect or a function, or if, being a means, it has resulted from an act wanting either the element of discovery or that of practical application, no complete inventive act has been performed.¹ This defence, therefore, is properly subdivided into four: (1) That the alleged invention is a mere effect; (2) That it is a mere function; (3) That it involved no exercise of the inventor's powers of original discovery, but could have been produced by the employment of his imitative faculties; (4) That it has never been made practically available. This is a defence based solely on the scientific and inherent character of the invention as apprehended by a mind familiar with the state of the art at the time when the inventive act is claimed to have been performed. Of it the courts will take judicial notice, whether urged or not by the defendant, whenever from their knowledge of the art it is apparent to them that it might successfully be made.²

§ 959. ¹ For a description of the inventive act and its patentable results, see §§ 78-156 and notes, *ante*.

That non-reduction to actual practice before application for a patent is no defence, see *Starr v. Farmer* (1883), 23 O. G. 2325; *Opinion Sec. Interior* (1883), 23 O. G. 2327; *Wheeler v. Clipper Mower & Reaper Co.* (1872), 2 O. G. 442; 6 *Fisher*, 1; 10 *Blatch*. 181.

² That where the court can see that a patent is void it may so declare it on a demurrer, see *Eclipse Mfg. Co. v. Adkins* (1888), 36 *Fed. Rep.* 554; *West v. Rae* (1887), 33 *Fed. Rep.* 45.

That a demurrer on the ground that the invention is not patentable should not be sustained unless the matter is so

evident that no question of fact can be made on it, see *Blessing v. Copper Works* (1888), 34 *Fed. Rep.* 753.

That a demurrer does not admit the patentability of the invention, see *Kaolatype Engraving Co. v. Hoke* (1887), 30 *Fed. Rep.* 444; 39 O. G. 589.

That the courts will not entertain an action where it is apparent that no inventive act has been performed, though the defendant may not defend on that ground, see *Ligowski Clay Pigeon Co. v. American Clay Bird Co.* (1888), 34 *Fed. Rep.* 328; *Slawson v. Grand St., Prospect Park, & Flatbush R. R. Co.* (1883), 107 U. S. 649; 24 O. G. 99.

§ 960. **Second Defence : Denial that the Patented Art or Instrument Resulted from the Inventive Act of its Alleged Inventor.**

The second defence consists in a denial that the inventive act from which the alleged invention has resulted was ever performed by the patentee or his assignor. This defence raises no question as to the existence of an inventive act, but simply excludes the alleged inventor from among those by whose inventive skill the invention was produced. It is equivalent to an averment that the patentee has surreptitiously appropriated to himself and patented the invention of another, and is proper only when the invention, having been completely conceived by its real inventor, has become known to and been imitated by the patentee.¹ It does not necessarily involve an

§ 960. ¹ This defence is liable to be confounded with the third, from the fact that the adverb "surreptitiously," which in the acts of 1790 and 1793 was employed in reference to the present subject, was in the act of 1836 and subsequent statutes applied to patents obtained by later inventors contrary to the rights of prior ones. This transfer of the adverb in the statutes has been followed naturally by its transfer in the decisions of the courts, and caution is thus necessary in its interpretation, lest the true nature of both defences be obscured.

The word "surreptitiously" first appears in the act of 1790, where it is used as an equivalent for "false suggestion," and is made a ground for repealing a patent thus obtained. In the act of 1793 it is employed in describing a defence of which the defendant must give previous notice to the plaintiff, the defence being that the patentee "had surreptitiously obtained a patent for the discovery of another person." Here again it conveys the idea of fraud either against the public whose rights are restricted by a patent granted to one who has no title to a monopoly, being a mere imitator of the invention of an-

other, or against the true inventor by forestalling him in the obtaining of a patent. (See *Dixon v. Moyer*, (1821), 4 Wash. 68; 1 Robb, 324.) The act of 1836 transfers the word to an entirely different defence by requiring notice, not when the patentee is denied to be an inventor, but when the defendant purposes to show "that he had surreptitiously or unjustly obtained the patent for that which was in fact invented or discovered by another who was using reasonable diligence in adapting and perfecting the same." This is obviously the third defence and not the second, for a patent is invalid when procured by the mere copyist of another's discovery, whether that other was using due diligence or not. But the word "surreptitiously" has here lost its former significance and become the equivalent of "unjustly," *i. e.*, against the rights of the prior inventor, since no fraud or deceit is necessary to render void a patent obtained by a later true inventor when the first inventor is complying with the obligation of diligence imposed upon him by the law. See *Phelps v. Brown* (1859), 4 Blatch. 362; 1 Fisher, 479; 18 How. Pr. 7; also § 995 and notes, *post*.

allegation of wilful deceit on the part of the patentee ; he may honestly but ignorantly believe that some substantial difference exists between his art or article and that which he has actually copied, and may suppose that his originated in his own inventive skill. The fact that instead of inventing a new means he has merely appropriated and obtained a patent for a means created by another, and is, therefore, not a true inventor, is sufficient to establish this defence.²

§ 961. Third Defence : Denial that the Alleged Inventor was the First Inventor of the Patented Art or Instrument.

The third defence consists in a denial that the patentee or his assignor performed the inventive act producing the alleged invention at an earlier date than any other inventors in this country. This defence concedes that the patentee or his assignor is a true inventor of the art or article in question, but denies that he was its *first* inventor.¹ It is equivalent to either one of two averments: (1) That rival inventors had completely conceived the idea of means embodied in the invention, and were using due diligence in reducing it to practice at the time when the patentee or his assignor conceived the same idea; or, (2) That although the patentee or his assignor had first conceived the idea he did not use due diligence in reducing it to practice, and that in the meantime some later conceiver but more prompt reducer had perfected the invention. This defence raises the same issue which is presented in interference cases in the Patent Office and in proceedings in equity to annul a rival patent, and is sustained when the evidence establishes either one of its equivalent averments.²

§ 962. Fourth Defence : Denial that the Patented Art or Instrument is within the Patentable Classes of Inventions.

The fourth defence consists in a denial that the invention falls within the classes protected by the acts of Congress as

² For the distinction between an imitation and a new invention, see § 78 and notes, *ante*.

§ 961. ¹ For the relations of rival inventors to each other and the public, see §§ 370-391, and notes, *ante*.

² For a description of the issues raised in interference proceedings and actions to annul, see §§ 586-603, 724, and notes, *ante*.

those acts are interpreted by the courts. This defence is proper where the result of the inventive act performed by the patentee or his assignor is not an art, a machine, a manufacture, a composition of matter, a design, or an improvement.¹ It is also appropriate when the invention, though it purports to be a combination, is in reality a mere aggregation of independent elements.² This defence, like the first, is based upon the inherent character of the invention. When the nature of the invention is apparent, the application to it of the legal definitions given to the protected classes of inventions determines whether this defence is applicable. The court whose duty it is to ascertain from the description and Claims embodied in the patent what the invention is, and to apply thereto the tests afforded by these definitions, may, therefore, take judicial notice of this defence also without reference to the pleadings; and if it finds that the result of an inventive act, though new and useful, is not legally patentable under the acts of Congress, may refuse to entertain proceedings against those who have without authority employed it.³

§ 963. Fifth Defence : Denial of the Novelty of the Patented Art or Instrument.

The fifth defence consists in a denial that the invention resulting from the inventive act of the patentee or his assignor is new within the meaning of the law. The defence of want of legal novelty in the invention is sometimes related to the third defence of prior invention, but must not be confounded with it. If a prior rival inventor has perfected his invention, and either put it to practical use in this country, or patented

§ 962. ¹ For the nature of each class of patentable inventions, see Art, §§ 159, 164-170, and notes, *ante*; Machine, §§ 173-179, and notes, *ante*; Manufacture, §§ 182-189, and notes, *ante*; Composition, §§ 192-197, and notes, *ante*; Design, §§ 200-207, and notes, *ante*; Improvement, §§ 210-218, 307-313, and notes, *ante*.

² For the nature of a combination, see §§ 153-156, 277-282, and notes, *ante*.

³ That the court may take judicial notice of the nature of the patented invention and of the fact that it is not legally patentable, and may thereupon refuse to entertain the action, see *Kaolatype Engraving Co. v. Hoke* (1887), 30 Fed. Rep. 444; 39 O. G. 589; *Slawson v. Grand St., Prospect Park & Flatbush R. R. Co.* (1883), 107 U. S. 649; 24 O. G. 99; and cases cited in § 959 note 2, *ante*.

it, or published a printed description of it, before its invention by the patentee or his assignor, the defence of want of legal novelty as well as that of prior invention is appropriate. But if the prior inventor has not practised his invention, or patented or published it before the patentee or his assignor performed the inventive act, or if the patentee or his assignor first conceived the idea but through his want of diligence in reduction has given a later conceiver and prompt reducer the superior right to the invention, the defence of want of legal novelty cannot be sustained. A patented invention is new, within the meaning of the law, unless before the date of its complete conception by the patentee or his assignor it had been known or used in this country, or had been patented or described in a printed publication either at home or abroad.¹ A prior use, in order to create a want of novelty, must consist in the practical employment of the identical invention for business purposes in the United States, in such a manner as to render the knowledge of the invention accessible to the public before and until the date of its conception by the patentee or his assignor.² A prior patent constitutes a want of novelty when it was issued to the public before the date of the inventive act in question, and contains so full and complete a description and claim of the identical invention as to enable any person skilled in the arts to practise it without further invention of his own.³ A prior publication proves a want of novelty when in its printed text, distributed to the public before the patentee or his assignor conceived the idea of the invention, the essential characteristics of the art or article are so disclosed that those skilled in the art can by the guidance of the publication alone construct it and apply it to practical use.⁴ It is to be remembered that these three conditions under which novelty is wanting are not merely evidence that the invention is not legally new, but are facts which cause it to be legally old. Novelty is a legal attribute consisting in

§ 963. ¹ For the nature of legal novelty as distinguished from actual novelty, see §§ 113, 123, 222-228, 315, 316, and notes, *ante*.

² As to prior use, see §§ 317-324, and notes, *ante*.

³ As to prior patent, see §§ 331-337, and notes, *ante*.

⁴ As to prior publication, see §§ 325-330, and notes, *ante*.

the absence of these three conditions, and when the existence of either is established by sufficient proof it is a conclusion of law, and not an inference of fact, that the invention is not new. Thus the defence of want of novelty may logically be subdivided into the three defences of prior use, prior patent, and prior publication, each of which may be urged without the others, and if found true forms a complete bar to the action.

§ 964. Sixth Defence: Denial of the Utility of the Patented Art or Instrument.

The sixth defence consists in a denial of the utility of the invention. An invention is useful within the meaning of the law if it is available for any use which on the whole is beneficial to the public. An utterly frivolous and worthless art or article has no utility. An invention capable of beneficial use, but so dangerous or disastrous to its employers as to be necessarily productive of more injury than advantage, is not useful. An invention whose practice may promote the interest of the individual user, but is inevitably prejudicial to the public, also wants utility.¹ This defence is thus equivalent to an averment that the invention is incapable of any beneficial use, or that its use involves a greater loss than gain to its employers, or that its use is detrimental to the public.² Defendants who have actually practised the invention, especially those who have endeavored to induce the public to participate in its results by purchasing the fruits of their infringements, are estopped from urging it on their own behalf when sued for their wrong-doing.³

§ 964. ¹ For the nature and necessity of utility, see §§ 338-343, and notes, *ante*.

² That the want of utility is a perfect defence, see *Bliss v. City of Brooklyn* (1873), 6 Fisher, 289; 3 O. G. 269; 10 Blatch. 521.

That the manifest frivolity of the invention patented is a good defence, see *Wilson v. Jones* (1854), 3 Blatch. 227.

That an immoral or dangerous in-

vention may lack utility, see § 340, and notes, *ante*.

³ That to sustain a defence of want of utility the evidence must show that the invention is utterly worthless, and if the defendant has used it, that fact is a strong argument in favor of utility, see *Kearney v. Lehigh Valley R. Co.* (1887), 32 Fed. Rep. 220.

That want of utility avails little as a defence for parties who used the in-

§ 965. **Seventh Defence: Abandonment of the Invention to the Public.**

The seventh defence consists in an averment that the invention was abandoned to the public before the commission of the acts of which the defendant is accused. In this defence there is no question of incomplete and abandoned experiments performed by the patentee or his assignor while endeavoring to perfect the invention, or by rival inventors in their attempts to reach the same result. Evidence of such experiments may be admissible under the defences of prior invention and of prior use, but of themselves they constitute no bar to an action on the patent, and especially have no relation to this defence of abandonment. Abandonment is synonymous with dedication to the public. It assumes that the invention is complete and practically operative, and it occurs only where the invention, being in that condition, is intentionally and unreservedly surrendered to the public by its lawful owner.¹ This defence is, therefore, proper when such an intentional surrender has been made, either by the inventor or the patentee or any subsequent owner of the patent. A public use or sale of the invention, by the inventor or with his consent, for more than two years before his application for a patent, is one form of surrender.² Any other conduct of his or of the owner of the patent, which unequivocally manifests the same intention, is also an abandonment of the invention. Such conduct may consist either in acts or declarations of the inventor before his application, or in describing and not claiming the invention in his application, or in disclaiming it in connection

vention, see *Phillips v. Carroll* (1385), 23 Fed. Rep. 249; 31 O. G. 265; *Cook v. Ernest* (1872), 2 O. G. 89; 5 Fisher, 396; *Vance v. Campbell* (1859), 1 Fisher, 483.

That a defendant using an entire process is estopped to claim that any part of it is injurious, see *Whitney v. Mowry* (1870), 4 Fisher, 207.

That the defendant is estopped from denying the utility of the invention after having made and sold large quan-

ties of it, and especially after advertising that the new invention had revolutionized the trade, see *Robertson v. Garrett* (1873), 6 Fisher, 278; 10 Blatch. 490.

§ 965. ¹ As to the nature of abandonment, and its distinction from abandoned experiments and abandoned inventions, see § 346 and notes, *ante*.

² As to abandonment by public use or sale, see §§ 354–360, and notes, *ante*.

with his application or his patent, or in words, actions, or omissions of the owner of the patent after the patent has been granted.³ This defence has sometimes been subdivided into two: (1) Abandonment by public use or sale; (2) Abandonment by conduct other than public use or sale. Between these two there is an important distinction which is well recognized in the forms of pleading and in the rules of evidence. A public use or sale is not simply an act from which an intention to abandon may be inferred, but it is conclusive evidence of that intention; and when such use or sale is proved there is no room for any further question as to the dedication of the invention to the public. Conduct other than public use or sale is merely a fact from which an intention to abandon may be inferred, but affords no conclusive presumption of such intention and may be rebutted by any evidence affording a contrary indication.⁴ This distinction in practical effect has led certain jurists of great authority to separate these two defences from each other, and to treat them as if resting upon different foundations.⁵ The doctrine which underlies them is nevertheless identical, as is apparent from the definitions given by the courts to the terms "public use and sale," each of which is limited to cases where the use or sale involves a voluntary and intentional surrender by the inventor of all control over the invention, neither an experimental use, however public, nor any sale restricted by conditions which the inventor can enforce against the property in the invention sold, falling within such definitions.⁶ This seventh defence

³ As to abandonment by general conduct, see §§ 350-353, and notes, *ante*.

⁴ That except in cases of public use or sale, the presumption of an intention to abandon may be rebutted, see §§ 347, 348, and notes, *ante*.

⁵ In *Jones v. Sewall* (1873), 3 O. G. 630, Clifford, J.: (637) "Persons charged with the infringement of letters-patent may set up as a defence that the inventor suffered the invention to be in public use and on sale more than two years before he applied for a patent; and they may also set up as a distinct de-

fence, even in the same answer, that the inventor, before he applied for a patent, abandoned the invention to the public; but these two defences ought not to be blended in the same allegation, as they depend in many respects upon very different principles." 6 Fisher, 343 (365); 3 Clifford, 563 (589).

⁶ That public use and sale are not abandonment except when unequivocal, unrestricted, and with the consent of the inventor, see §§ 354-360, and notes, *ante*.

completes the group of those which attack the merits of the invention and deny the right of the inventor or the owner of the patent to be protected in its exclusive use.⁷

§ 966. Eighth Defence: Denial of the Grant of the Alleged Letters-Patent.

The eighth defence, or the first one of that group which attacks the letters-patent as distinguished from the invention, consists in a denial that the patent described in the declaration was ever granted by the government. This defence is proper when the alleged invention never has been patented or when the patent which protects it is not correctly set forth by the declaration.¹ It simply raises an issue as to the existence of the document on which the plaintiff has based his suit, and is equivalent to the plea of *nul tiel record* at the common law. Any material variance between the actual patent and the statement of its tenor and effect in the declaration will support this defence, and unless cured by amendment will defeat the action.

⁷ That the use of an invention without the consent of the inventor, pending his application, is no defence against the patent, see *Dental Vulcanite Co. v. Wetherbee* (1866), 3 Fisher, 87; 2 Clifford, 555.

That the defence of public use and sale more than two years "before the invention" is not known to our law, see *Kelleher v. Darling* (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438.

That under the defence of two years' public use, the defence of prior use cannot be made, nor is it sustained by evidence of a prior patent without the plaintiff's knowledge over two years before, see *Myers v. Busby* (1887), 32 Fed. Rep. 670; *Parks v. Booth* (1880), 102 U. S. 96; 17 O. G. 1089.

That in an action brought after the act of 1837, ("two years") on a patent granted before it, public use prior to the application is a good defence, see

Winans v. New York & Harlem R. R. Co. (1855), 4 Fisher, 1.

That an application substituted at the instance of the Patent Office for one already filed dates from the filing of the former application as to the question of public use, see *International Tooth Crown Co. v. Richmond* (1887), 30 Fed. Rep. 775; 39 O. G. 1550.

N. B. In this seventh defence no notice is taken of the public use and sale "without the consent" of the inventor, which seems to be now recognized as a defence under the present statutes. That defence may perhaps rest indirectly on the doctrine of estoppel, but it is certainly not a simple dedication to the public. For a consideration of this subject, see §§ 357, 390, and notes, *ante*.

§ 966. ¹ As to the averment of the patent in the declaration, see § 950 and notes, *ante*.

§ 967. Ninth Defence: Denial that the Letters-Patent were Issued in Conformity with Law.

The ninth defence consists in a denial that the patent, though actually issued by the government, was issued in accordance with the formal requirements of the law. It is equivalent to an averment that, in the allowance of the patent, the Patent Office has disregarded the established legal methods of procedure or performed acts beyond its jurisdiction. The law imposes numerous duties on an applicant as conditions precedent to the issue of a patent, the enforcement of which is entrusted to the Patent Office, whose decision in the premises the courts will not review.¹ A patent granted without the fulfilment of these prerequisites cannot be on that account attacked.² The omission of the prescribed oath or fee, the absence of the proper attestations, and other similar informalities are cured by the allowance of the patent, and cannot be set up as a defence in any action based thereon. Certain irregularities in the procedure of the Office of a trivial character are in like manner overlooked.³ But there are some faults in the action of the Office of which courts do take notice and of which an infringer may avail himself in his defence. Thus if the patent has been issued upon a false oath or suggestion, or if the patent does not bear the signatures of the Secretary and Commissioner and the seal of the United States, or if it departs from the application and purports to protect a different invention or to secure it to a patentee other than the applicant or his lawful assignee,

§ 967. ¹ That the action of the Patent Office upon certain of the prerequisites to a patent is final, see §§ 423, 451, 617, and notes, *ante*.

² That a patent cannot be collaterally attacked for informality in the grant, see *Dorsey Harvester Revolving Rake Co. v. Marsh* (1873), 6 Fisher, 387.

³ That the want of legal prerequisites to the issue of the patent by the Commissioner, such as the grant for too long a term, or the want of proper signatures to the specification, is no defence to

an action for infringement, see *Railway Register Mfg. Co. v. North Hudson C. R. Co.* (1885), 23 Fed. Rep. 593; 32 O. G. 519.

That the unintentional issue of the patent by the Patent Office cannot be set up in defence, and that none but the United States can attack it on that ground, see *Doughty v. West* (1869), 3 Fisher, 580; 6 Blatch. 429.

That the omission of the oath or fee is cured by the allowance of the patent, see § 458 and notes, *ante*.

or if it has been granted without the required notice to a pending caveator, or if it issued to a sole applicant for a joint invention or to joint applicants as joint inventors when the inventive act was sole, — these are errors which may render it invalid, and can be urged against it by the defendant.⁴ Where the patent has been re-issued under circumstances which show that the alleged defect in the original was voluntary and intentional, and did not occur through inadvertence, accident, or mistake; or when the amended patent embraces matter which the inventor evidently did not intend or endeavor to protect in the original, the action of the Patent Office in allowing the re-issue transcends its jurisdiction, and a suit on the re-issued patent cannot be sustained.⁵ Fraud on the part of the officials of the government in issuing the patent is not, however, a permissible defence in any private action, — the United States alone having a right to seek the cancellation of a patent for this reason by instituting a suit for its repeal.⁶

⁴ That where the Commissioner exceeds his authority in issuing a patent, under a mistake of law, the question may be reviewed on a suit for infringement, see *Mahn v. Harwood* (1884), 112 U. S. 354; 30 O. G. 657.

That a patent issued upon a false oath or suggestion is invalid, see § 456 and notes, *ante*.

Contra, where the matter of the oath is formal only, and the falsehood unintentional, see *Tondeur v. Chambers* (1889), 46 O. G. 1110; 37 Fed. Rep. 333.

That a patent issued without the required official signatures or seal is void, see *Marsh v. Nichols* (1888), 128 U. S. 605; and § 620 and notes, *ante*.

That a patent granted without notice to a caveator is invalid against him, see *Phelps v. Brown* (1859), 4 Blatch. 362; 18 How. Pr. 7; 1 Fisher, 479.

That a sole patent for a joint invention is void, see § 402 and notes, *ante*.

That a joint patent for a sole invention is invalid, see § 402 and notes, *ante*.

⁵ That a re-issue embracing "new matter" is invalid, see §§ 635, 661-667, and notes, *ante*.

That the irregularity of re-issue proceedings is no defence unless it can be shown that the re-issue was contrary to law or was granted to the wrong party, see *Dental Vulcanite Co. v. Wetherbee* (1866), 2 Clifford, 555; 3 Fisher, 87.

⁶ That re-issued and extended patents cannot be impeached for fraud in suits for infringement, see *Schillinger v. Cranford* (1885), 4 Mackey, 450; 37 O. G. 1349; *Milligan & Higgins Glue Co. v. Upton* (1874), 6 O. G. 837; 4 Clifford, 237; 1 Bann. & A. 497; *Gear v. Grosvenor* (1873), Holmes, 215; 6 Fisher, 314; 3 O. G. 380.

That no defence can be based on an allegation of fraud in procuring an extension, see *Tilghman v. Mitchell* (1871), 4 Fisher, 615; 9 Blatch. 18; *Whitney v. Mowry* (1870), 4 Fisher, 207; *Goodyear v. Providence Rubber Co.* (1864), 2 Fisher, 499; 2 Clifford, 351.

That the decision of the Commis-

§ 968. Tenth Defence: Denial that the Invention Covered by the Patent is Legally Patentable.

The tenth defence consists in a denial that the invention covered by the patent is patentable subject-matter under the laws of the United States. The nature of this objection is the same as that urged in the fourth defence, the difference being in the point to which they are directed.¹ In that, the claim of the defendant is that the inventive act of the patentee or his assignor has not resulted in the production of any art or article which is entitled to protection, or which can lawfully be made the basis of a patent; in this, he claims that, be the actual invention of the plaintiff what it may, the one described in his patent does not fall within the classes mentioned in the statute. When this defect exists it is apparent on the face of the patent, and hence may be judicially noticed by the court as well as if pleaded and insisted on by the defendant.

§ 969. Eleventh Defence: Fraudulent Concealment or Misrepresentation in the Specification of the Patent.

The eleventh defence consists in a denial that the patentee or his assignor has acted in good faith toward the public in disclosing his invention in the specification annexed to his patent. This defence is equivalent to an averment that, for the purpose of deceiving the public, the description of the invention in the specification was made to contain less than the whole truth in reference to the invention or more than is necessary to produce the desired effect.¹ The essence of this

sioner on an extension is not reviewable in defence to an infringement suit, see *Whitney v. Mowry* (1870), 4 Fisher, 207.

§ 968. ¹ See § 962 and notes, *ante*.

§ 969. ¹ This defence, though stated in the language of the statute requiring notice to be given to the plaintiff when the defence is to be urged, does not itself rest upon the statute. A patent obtained by, or containing, wilfully false representations concerning the nature of the invention, has always been held void both in this country and in

England, and the doctrine has sometimes been pushed to an extreme degree.

See *Grant v. Raymond* (1832), 6 Peters, 218; 1 Robb, 604; and cases cited in note 2, *post*; and § 494 and notes, *ante*.

Also, *Tetley v. Easton* (1852), *Macrory*, P. C. 48; *Walton v. Bateman* (1842), 1 Web. 613; *Neilson v. Harford* (1841), 1 Web. 295; *Lewis v. Marling* (1829), 1 Web. 493; 1 Abb. P. C. 421; *Bovill v. Moore* (1816), *Davies* P. C. 361; 1 Abb. P. C. 231.

defence is the fraudulent intent with which the erroneous description has been made.² Ambiguities of idea or expression arising from the want of clear conceptions in the mind of the inventor, or from inability to delineate them in words or drawings, do not enter into this defence.³ A patent intended to deceive may be clear, precise, and graphic, and probably will be so; but however intelligible to those skilled in the art, if it is designed to mislead them as to the character of the real invention and either prevent them from employing it in its completeness or compel them to employ it at a disadvantage as compared with the inventor, his wilful endeavor to deceive forfeits all that right to protection which he might have otherwise enjoyed, and if established by sufficient evidence renders his patent void.⁴

§ 970. Twelfth Defence: Ambiguity in the Description of the Invention in the Patent.

The twelfth defence consists in an averment that the description of the invention in the specification is insufficient to enable persons skilled in the art to make and use it without the exercise of their own inventive skill. The law requires as a condition precedent to the issue of a patent that the applicant shall file in the Patent Office a written description of the invention, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to make, construct, compound, and use the same; and the decision of the Patent Office as to the applicant's compliance with this condition has, on numerous occasions, been held subject to reconsideration in the courts in cases of infringement.¹ Doubts have, however, been expressed from

² That to this defence a fraudulent intent is essential, see *Lowell v. Lewis* (1817), 1 Mason, 182; 1 Robb, 131; *Gray v. James* (1817), Peters C. C. 394; 1 Robb, 120; *Whittemore v. Cutter* (1813), 1 Gallison, 429; 1 Robb, 28.

³ That ambiguity in the description is a defence only when persons skilled in the art could not from it practise

the invention, see § 493 and notes, *ante*, and §§ 970, 1034, 1035, and notes, *post*.

⁴ That any fraudulent concealment or redundancy which gives the inventor an advantage over others, even in the mode of enjoying the invention, is fatal, see cases cited in note 1, *ante*.

§ 970. ¹ Sec. 4888, Rev. Stat. 1874. That unless a person skilled in the

time to time, and recently by high authority, whether simple ambiguity in the description, though so great as to prevent the public from acquiring any practical knowledge of the invention, if not intentional or fraudulent, could vitiate the patent, or enable an infringer to attack it on this ground alone.² This question is of great importance and will bear a somewhat extended consideration. In the first place, it is evident that on principle an ambiguous description of the invention in a patent ought to be regarded as a fatal defect. The contract between the inventor and the public, which is theoretically the basis of his rights, obliges him to place the invention fully before the public, and render it practically available to them, in return for the temporary protection which they accord to him.³ The method which the law prescribes to him for making this disclosure of his invention is its description in the specification; and if he there fails to sufficiently reveal it, the consequences to the public are the same whether the failure were inadvertent or intentional, since if, in either case, the patent were considered valid, the inventor would receive the protection he desired without bestowing on the public the consideration that the law provides. The doctrine that unless the failure is intentional and fraudulent the patent cannot be attacked therefor entirely loses sight of the true nature of the patent-contract, ignores the right of the public to the disclosure of the invention, and treats the inventor as responsible for no infraction of his own obligations unless they are not only voluntary but spring from a corrupt and evil motive. Such a doctrine is an anomaly in the law of contracts which uniformly regards a breach on one side, from whatever cause arising, as discharging the other party from his corresponding duties. In harmony with the spirit of that law, the protection given to

art can construct and practise the invention from the specification alone without further research or exercise of inventive skill the patent is invalid, see §§ 483-494, and notes, *ante*.

² That whether an insufficient description is a defence unless it is fraudulent, and the fraud is alleged, is doubt-

ful, see *Loom Co v. Higgins* (1882), 105 U. S. 530 ; 21 O. G. 2031.

³ That the sole consideration for the grant of the monopoly is the communication of the invention to the public by the specification of the patent, see §§ 41, 42, 481, and notes, *ante*.

the patentee should be dependent on his performance of his part of the contract, and his omission to perform it should leave him in the same position which he would have occupied had the contract not been made.⁴ Again, the law expressly provides that the patent shall not issue until a sufficient description has been filed. It does not authorize the Patent Office to grant a patent upon an honest attempt of the inventor to set forth his invention; it requires him to attain in his description a certain degree of perspicuity and completeness, to be measured by the ability of persons skilled in the art to practise the invention by merely following its directions. The Patent Office may not be able to subject the description to this test, and may award a patent upon a specification which will not endure it; but in so doing the Office acts beyond its jurisdiction as truly as if it had allowed the patent without requiring any specification whatever. The courts have always unhesitatingly gone behind the judgments of the Patent Office in all cases where its action was not warranted by law, and have held patents void whenever they were granted contrary to the express provisions of the law, although that fact could not be ascertained until some suit upon the patent gave the opportunity for an investigation of its merits.⁵ The claim that this particular condition precedent may safely be omitted by the patentee rests upon no exception in the statute, and is not justified by any legal analogy. Again, the fault of ambiguity in the description differs entirely in its character from that of fraudulent redundancy or concealment. In the latter, the inventor endeavors to deceive the public, intending at the outset to obtain an unfair advantage over all those who may attempt to practise his invention. It does not alter his offence nor decrease its gravity that he distinctly

⁴ That this doctrine works no hardship to the patentee is apparent from the fact that if his description is imperfect, experience must speedily demonstrate it to him, and the defect is then curable by re-issue. The hardship to the public of being compelled to respect the monopoly while unable to derive from the patent their lawful advantage

and of being debarred from defending actions for infringement unless deceit were provable is, on the contrary, great and irremediable.

⁵ That the action of the Patent Office in issuing a patent is only *prima facie* evidence of its validity see § 714 and notes, *ante*, and § 1016 and notes, *post*.

communicates a new invention to the public and renders practically available to them an art or instrument they had not before enjoyed. He may do this and still conceal matters which render the invention more available, or falsely represent as necessary to its operation objects or acts which make it more expensive or difficult to use. Such deceit avoids even a beneficial patent, not on the ground that the public have received no consideration for the patent, but on the ground that the attempted fraud forfeits all right of the inventor to protection. Thus though a patentee, who without intending to deceive has failed to properly disclose his invention, may have his patent declared void for want of that particular condition precedent or failure of consideration, he does not lose his right to the protection of his actual invention, but may amend his patent by re-issue and thereafter vindicate his privilege against infringers. But the fraudulent patentee has no such remedy. His patent, being declared void for intentional misrepresentation or concealment, cannot be amended. The defects therein did not occur through inadvertence, accident, or mistake, and hence he must remain perpetually deprived of his exclusive privilege while his invention passes into the free enjoyment of the public. Were these two faults united into one with these distinctions in their individual character and effect, no unintentional insufficiency in the description would in any case require amendment except for the more definite interpretation it might thereby furnish to the Claim, and every judgment against a patentee on the ground of ambiguity in the description would not only destroy the existing patent but debar him from procuring a re-issue. Such certainly has never been the doctrine of the courts, nor could it be adopted at the present day without disorganizing most important branches of our patent jurisprudence. The view here controverted being thus unsound in principle, contrary to statute, and impracticable in application, may safely be regarded as erroneous, and the general current of decisions be relied upon as accurate statements of the law.⁶ According to

⁶ This misconception arose like many others in the infancy of our patent system and before the distinctions now familiar were clearly recognized. Under the act of 1793 the court had power in a suit for infringement not merely to de-

these, the fact that persons skilled in the art could not from the description alone, without the exercise of their own inventive skill, make and use the invention, invalidates the patent, and constitutes a proper and complete defence in any action for infringement.

§ 971. **Thirteenth Defence: Excessive Claims.**

The thirteenth defence consists in an averment that the Claims contained in the patent are excessive and include matters which are either open to the public or have resulted from the inventive skill of other individuals. A patentee who intentionally puts forward such excessive Claims, or who persists in them after the discovery of his error, is presumed to be attempting to obtain an unfair advantage over the public by appropriating to himself inventions which belong to them or

side in favor of the defendant but also to declare the patent itself entirely void, provided certain defences were asserted in a notice and maintained by evidence. Among these was that of fraudulent concealment or redundancy; and though it was always held that other defences known to the law of patents might be urged without such notice, for the purpose of defeating the action against the defendant without affecting the validity of the patent, it seems to have been assumed that when a defendant urged a defective specification it was urged under this statutory privilege and for this double purpose. Hence various decisions are found before the act of 1836, in which the view is taken that a fraudulent intent is necessary in order to render a patent void on account of a defective specification. (See *Gray v. James* (1817), Peters C. C. 394; 1 Robb, 120; *Lowell v. Lewis* (1817), 1 Mason, 182; 1 Robb, 131; *Whittemore v. Cutter* (1813), 1 Gallison, 429; 1 Robb, 28.) In the act of 1836, the power to declare the patent void in infringement suits was not bestowed on the court, but notice was still re-

quired to be given if the defendant desired to offer evidence that the specification was fraudulently defective. With this change in the statute the old doctrine of the courts should have also disappeared, especially after the decision in *Grant v. Raymond* (1832), 6 Peters 218; 1 Robb, 604, in which Marshall, J., stated that the notice and evidence of fraudulent intent was necessary only where the purpose of the defendant was to obtain a judgment avoiding the patent, while a defective specification was a good defence under the general issue when the defendant desired only to protect himself against the patentee. Like other errors, however, whose correction depends on an historical study of the law, it has been from time to time revived, and as seen in the case cited in note 2, has even extracted a *quere* from the Supreme Court itself. The paragraphs referred to in note 1 with the cases cited under them sufficiently indicate that the general current of authority supports the position that a defective specification without fraud is now a good defence to an action for infringement.

which they might receive from the actual inventors; and he, therefore, justly forfeits all those rights which otherwise his patent might confer.¹ Under the early English practice this question was determined by a mere inspection of the patent, and if it claimed too much upon its face, it was irremediably defective and invalid.² But under our present statutes an excessive Claim may be amended by re-issue or disclaimer when the excessive matter was inserted through inadvertence, accident, or mistake, without wilful default or intent to defraud or mislead the public, and when the remaining matter is a material or substantial part of the invention as originally claimed, and can exist independently of the excess as a complete and patentable invention, provided the amendment is made without unreasonable delay.³ If, therefore, an excessive Claim is knowingly and wilfully inserted in the patent, or if although inserted without fault it cannot be amended without eliminating all patentable subject-matter from the Claim, or if although amendable its amendment has not been effected with reasonable diligence, the patentee cannot avail himself of the patent in the assertion or vindication of his rights. In all such cases this defence is proper, and the suit based on the patent fails. But in those cases where the Claim is amendable, and reasonable time for the amendment has not yet elapsed, the defect may be removed pending the suit, and this defence will only bar the plaintiff's right to costs.⁴ After such an amendment all issues concerning the patentability of

§ 971. ¹ That an intentional excessive Claim is an attempt to defraud the public and renders the patent void, see § 644 and notes, *ante*.

That where a Claim is intentionally excessive it cannot be cured by re-issue or disclaimer, see § 644 and notes, *ante*.

² That in England a Claim excessive on its face avoided the patent, see *Bovill v. Moore* (1816), *Davies P. C.* 361; *1 Abb. P. C.* 231; *Huddart v. Grimshaw* (1803), *1 Web.* 85; *1 Abb. P. C.* 128; *Rex v. Else* (1785), *1 Web.* 76; *1 Abb. P. C.* 40.

³ That an excessive Claim, if not

intentional, is curable by re-issue or disclaimer, see §§ 642-644, 656-658, 687, and notes, *ante*.

⁴ That a disclaimer restricting excessive Claims may be filed pending suit, and the plaintiff may then recover on the amended Claim, but without costs, see § 651 and notes, *ante*.

That where one Claim of a patent is declared invalid so nearly to the expiration of the patent that no disclaimer can be filed, the patentee can recover on the valid Claims, though he does not disclaim the invalid, see *Kittle v. Hall* (1887), *30 Fed. Rep.* 239.

the invention are limited to the subject-matter of the amended Claim.⁵

§ 972. **Fourteenth Defence: Ambiguity in the Claims.**

The fourteenth defence consists in a denial that the Claim defines the invention which the patent purports to protect with such precision and completeness as to distinguish it from all other inventions. It is equivalent to an averment that the Claim is ambiguous, uncertain, or unintelligible, and that the patent is therefore void. The Claim of a patent is the life of the patent; and either alone or as interpreted by the description, it must clearly and exactly draw the line between the inventions over which the patentee asserts his exclusive rights, and those which are beyond the scope of his monopoly. If the Claim is unintelligible and conveys no idea of the invention claimed; or if it is uncertain, conveying some idea but not precisely specifying its essential characteristics; or if it is ambiguous, expressing the ideas that underlie two or more different inventions but leaving it doubtful which the inventor actually intends to claim, the patent is inoperative as a grant, and affords no protection to the patentee.¹ In patents which embrace more than one Claim, either for the same or different inventions, the presence of defective Claims does not impair the validity of the others if these are in themselves sufficient.² Each Claim is judged by itself, and stands or falls as though it were the only one included in the patent. Hence this defence is proper in suits based on a patent which

⁵ That after a disclaimer all questions in reference to the patent concern it only in its amended state, see *McCormick v. Seymour* (1854), 3 Blatch. 209; *Clark v. Kenrick* (1843), 12 M. & W. 221.

That where a disclaimer is made pending suit, the proceedings need not be recommenced, unless the defendant has been prejudiced, see *Libbey v. Mt. Washington Glass Co.* (1886), 36 O. G. 572; 26 Fed. Rep. 757.

§ 972. ¹ That ambiguity in the Claim is fatal to the patent, see *Edgarton v.*

Furst & Bradley Mfg. Co. (1881), 10 Bissell, 402; 21 O. G. 261; 9 Fed. Rep. 450; *Blake v. Stafford* (1868), 6 Blatch. 195; 3 Fisher, 294; *Carr v. Rice* (1858), 4 Blatch. 200; 1 Fisher, 325; *Hovey v. Stevens* (1846), 3 W. & M. 17; 2 Robb, 567; *Brooks v. Jenkins* (1844), 3 McLean, 432; *Ames v. Howard* (1833), 1 Sumner, 482; 1 Robb, 689; *Barrett v. Hall* (1818), 1 Mason, 447; 1 Robb, 207.

² That defective Claims do not impair the validity of such as are sufficient, see §§ 537, 684, 695, and notes, *ante*.

contains a single and defective Claim, or on the invalid Claims of a patent which contains other perfect Claims not covering the infringed invention, but is of course inapplicable in cases where the invention in dispute is properly defined in any one Claim of the patent, however erroneously it is set forth in the others.

§ 973. Fifteenth Defence: Surrender of the Patent.

The fifteenth defence consists in a denial that the patent described in the declaration, though once existing as a valid patent, is now capable of serving as the foundation of a suit. This defence is equivalent to an averment that the patent and all rights of action under it have been extinguished. It concedes that the patent was lawfully issued to the patentee and complied with the various conditions requisite to its validity, but asserts that it has been determined in such a manner as to involve in its destruction all causes of action which had previously arisen. This can occur only in case of the surrender of a patent by its lawful owners, either for the purposes of a re-issue, or as a method of abandoning the invention to the public.¹ The expiration of a patent by lapse of the term for which it was granted does not affect the rights of action which already have accrued.² The repeal of a patent, whether at the suit of the government or of an interfering patentee, involves a judgment that it never existed as a valid patent. Thus this defence is applicable only in the case of a surrender, and is available whether the surrender took effect before or after the institution of the suit.

§ 974. Sixteenth Defence: Repeal of the Patent.

The sixteenth defence consists in a denial that the patent, though issued in apparent conformity with the requirements of the law, ever existed as a lawful patent, or still exists in any form whatever. It is equivalent to an averment that the patent was granted contrary to law, and has on that account

§ 973. ¹ That the surrender of a patent extinguishes all existing rights of action, see *Moffitt v. Gaar* (1860), 1 Bond, 315.

² That an action may be maintained after the expiration of a patent for infringements committed during its term, see §§ 908, 937, 1092 and notes, *post*.

been recalled and cancelled by the government. This occurs in the two cases where a prior inventor and rival patentee obtains the revocation of the patent by an equitable proceeding for that purpose, and where the government itself institutes and prevails in a suit for its repeal. In these cases the patent is held void *ab initio*, all rights acquired under it existing in appearance only, and the monopoly which it purported to create being a wrongful and unwarranted imposition on the public or the true inventor.¹ Where the patent has been repealed *in toto*, as in proceedings by the government or between the rival patentees, this defence is available in any suit based on the patent. Where it has been annulled only in reference to certain owners of the rival patents, this defence is no bar to an action between other owners, the patent as to them remaining unaffected by the judgment.² This defence completes the group of those by which the patent is attacked, and its existence or validity denied, on grounds which do not touch the patentability of the invention or the right of the alleged inventor to a patent.

§ 975. Seventeenth Defence: Denial of a Legal Title in the Plaintiff.

The seventeenth defence attacks the title of the plaintiff to the patent, and consists in a denial that his interest in the patented invention is of such a character as to enable him to maintain an action at law. Questions concerning the capacity of the plaintiff to sue, whether they relate to defective corporate organization or to infancy or coverture, and questions concerning the misjoinder or non-joinder of plaintiffs, are not embraced in this defence, such matters being available to the defendant only in abatement.¹ This defence rests upon the

§ 974. ¹ That the repeal or annulling of a patent is a rescission of the monopoly *ab initio*, and demonstrates that no rights under it could ever have existed, see §§ 723, 724, 730, and notes, *ante*.

² That where a patent is annulled as to certain parties or territory only, it remains in force as to other owners, see *Mowry v. Whitney* (1872), 14 Wall.

434 ; 1 O. G. 499 ; 5 Fisher, 513 ; and §§ 723, 724 and notes, *ante*.

§ 975. ¹ That the want of corporate capacity on the part of the plaintiffs is no defence, except in abatement, see *Dental Vulcanite Co. v. Wetherbee* (1866), 2 Clifford, 555 ; 3 Fisher, 87.

That a defect in the organization of a plaintiff corporation cannot be set up

doctrine that at law no one can sue for an infringement unless he is a legal owner of the monopoly, — that is, unless he is a patentee, an assignee, or a grantee enforcing his rights within his own territory.² Any defects in these legal titles may be taken advantage of under this defence, but equitable interests cannot be set up in a suit at law to defeat the claims of the record owner of the patent.³

§ 976. Eighteenth Defence: Denial that the Art or Instrument Employed by the Defendant is Covered by the Patent.

The eighteenth defence, which is the first one of the group raising an issue on the allegation of infringement, consists in a denial that the art or article employed by the defendant is covered by the patent of the plaintiff. This is equivalent to an averment that the idea of means, embodied and expressed in the invention described and claimed by the patent, is not identical with, or included in, the idea embodied in the invention used by the defendant. This defence does not simply deny the identity of the two inventions, for want of identity is not proof of non-infringement, — an original invention being infringed by the use of an improvement, though important differences subsist between them.¹ It denies that the defendant employs the patented invention either *in specie*, or as the foundation for, or as an element incorporated in, his own. Only, therefore, when his invention excludes the patented invention in every form can the defendant properly urge this defence, and seek escape from liability for an in-

as a defence in a suit for infringement, see *Dental Vulcanite Co. v. Wetherbee* (1866), 3 Fisher, 87; 2 Clifford, 555.

² That the legal owner of the patent at the date of the infringement, or the assignee of his cause of action, is the only proper plaintiff at law, see §§ 937-943 and notes, *ante*.

That it is no defence to a suit on an extended patent that third parties owned the territory where the infringement is claimed under the original patent, unless they owned the extension also, see *Aultman v. Holley* (1873), 5 O. G. 3.

³ That the equitable interests of third persons in the patent cannot be set up in defence against the legal title of the plaintiff, see *Graham v. McCormick* (1880), 21 O. G. 1533; 11 Fed. Rep. 859; 10 Bissell, 39; 5 Bann. & A. 244.

§ 976. ¹ That wherever the defendant uses the plaintiff's invention either alone or as part of another invention, or coupled with improvements, he is guilty of infringement, see §§ 891-894 and notes, *ante*.

fringement in the fact that the invention which he has employed is not within the monopoly created by the patent.²

§ 977. Nineteenth Defence : Denial that the Acts of the Defendant were Infringing Acts.

The nineteenth defence consists in a denial that the acts performed by the defendant in relation to the patented invention were of such a character as to subject him to an action for infringement. It is equivalent to an averment that whatever else he may have done, he has not voluntarily made or used or sold the patented invention. According to the judicial interpretation given to the terms "make" and "use" and "sell," they embrace many actions outside of their ordinary and technical meanings, their construction being extended to include the various artifices to which adroit infringers may resort, in order to effect the same results that are attained by the usual modes of making, use, or sale.¹ This defence is, therefore, appropriate when the conduct of the defendant in reference to the invention does not fall within the interpretation given to either of these terms. It is also proper where his acts, though in their nature true acts of infringement, were not voluntarily performed, as in the case of workmen, agents, or officials acting under orders and having no discretion as to the instruments or operations they employ in carrying out the commands of their superiors. In such cases the acts of infringement, though physically their own, are not legally imputable to them, but to the persons in obedience to whose orders and direction they have been committed.²

² That the defendant may show that he does not infringe at all or that he infringes only a part of the Claims, see *Bates v. Coe* (1878), 98 U. S. 31 ; 15 O. G. 337.

§ 977. ¹ As to the various forms which acts of infringement may assume, see §§ 897-905, 922-930 and notes, *ante*.

² That an involuntary act, or an act in obedience to legal superiors is not an infringement, see *Hollister v. Benedict Mfg. Co.* (1885), 113 U. S. 59 ; *Heaton v. Quintard* (1869), 7 Blatch. 73 ; *Delano v. Scott* (1834), 1 Gilpin, 489 ; 1 Robb, 700.

§ 978. **Twentieth Defence: Denial that the Alleged Acts of Infringement were Committed while the Patent was in Force.**

The twentieth defence consists in a denial that the patent was in force when the alleged acts of infringement were committed. It concedes that the patented invention has been made or used or sold by the defendant, but avers that these acts were performed either before the patent issued or after it expired. Whatever rights of action may accrue at common law to the owner of an invention from its unauthorized use before the date of his patent, and whatever redress for such use may be awarded in the English courts in a suit based upon the patent, our own courts have uniformly held that no suit for infringement can be sustained under our Patent Law unless the acts complained of were performed after the patent had been granted.¹ The patent is regarded as the foundation of the right which is invaded by the infringement, and only acts committed while the patent is in force can violate the right which it creates. For this reason, also, acts perpetrated after the patent has expired are not infringements, except in cases where they are performed in consequence of plans devised and preparations made during the life of the patent, the present act thereby relating back and constituting one transaction with the former, and thus rendering the defendant liable for both.² This defence, therefore, either simply puts in issue the date of the alleged infringement as compared with the dates of the grant and the expiration of the patent, or, in addition to these, it raises the question whether the acts performed after the patent had expired were connected with preceding acts as to make them elements in a line of conduct which, taken as a whole, amounted to infringement. In estimating the duration of a patent the term expressed upon its face is not conclusive.³ If prior foreign patents have been

§ 978. ¹ That no infringement of the patent is possible until after the patent has been granted, see § 907 and notes, *ante*.

² That acts of infringement may be committed after the patent has expired, if relating back to preparations made

while the patent was in force, see § 908, and notes, *ante*.

³ That the date of the expiration of a patent is fixed by law, whatever the term named therein may be, see § 622 and notes, *ante*.

issued for the same invention, the life of the domestic patent must be measured by that of the foreign patent which will first expire, if within the statutory period of seventeen years.⁴

§ 979. Twenty-First Defence: Co-ownership of the Patent, or License from its Lawful Owner.

The twenty-first defence consists in an averment that the acts of making, using, and selling the patented invention, though voluntarily performed by the defendant during the life of the patent, were not wrongful invasions of the plaintiff's rights. It is equivalent to a plea of justification, and an allegation that the defendant acted upon due authority. It is a proper defence where one part-owner of a patent is sued by his co-owner for acts which are confined to the employment of the patented invention, or where for similar acts a licensee is made defendant in proceedings instituted by his licensor.¹ But where the invention used by a part-owner or a licensee is not identical with that protected by the patent, this defence will not avail.² In such cases there is either no infringement because the invention practised does not include the patented invention, or the acts of the part-owner or licensee in employ-

⁴ That the duration of a patent is limited by that of the prior foreign patent having the shortest term, see § 622-624 and notes, *ante*.

That an English patent, taken out without authority from the American inventor, cannot affect his rights in the United States, see *Kendrick v. Emmons* (1875), 9 O. G. 211; 2 Bann. & A. 208.

That the validity of an American patent is not affected by that of a foreign patent, though its duration may be, see *Cornely v. Marckwald* (1883), 24 O. G. 498; 21 Blatch. 367; 17 Fed. Rep. 83.

§ 979. ¹ That a part-owner does not infringe by any use of the patented invention, see *Herring v. Gas Consumers Association* (1878), 9 Fed. Rep. 556; 21 O. G. 203; 13 O. G. 637; 3 McCrary, 206; 3 Bann. & A. 253; also §§ 796, 797, 913 and notes, *ante*.

That the acts of alleged infringement are performed under a license, is a sufficient defence, see *Watson v. Smith* (1881), 20 O. G. 300; 7 Fed. Rep. 350.

See also § 915 and notes, *ante*.

² That a part-owner may infringe by using an infringing invention, see *Herring v. Gas Consumers Association* (1878), 9 Fed. Rep. 556; 21 O. G. 203; 13 O. G. 637; 3 McCrary, 206; 3 Bann. & A. 253; also § 913 and notes, *ante*.

That a licensee may infringe by using an infringing invention, or by any use of the patented invention which is not covered by his license, see §§ 819, 915 and notes, *ante*.

That a receiver of a firm cannot defend on the ground of a license granted personally to the copartners, see *Curran v. Craig* (1884), 22 Fed. Rep. 101.

ing other inventions which include the patented invention lie outside the authority conferred upon them by the patent or the license, and hence are true infringements.⁸ This defence completes the group of those which, admitting the patentability of the invention, the validity of the patent, and the title of the plaintiff, deny that the defendant voluntarily and without authority made, used, or sold the patented invention.

§ 980. Twenty-Second Defence : Statute of Limitations.

The twenty-second defence is the first one of a special group whose members have no immediate resemblance to each other, save that they recognize the existence of a cause of action on the part of the plaintiff against the defendant, and aver that he has forfeited by his own conduct his right to legal redress. All these defences rest ultimately on the doctrine of estoppel, — the difference between them residing in the acts out of which the estoppel arises and the authority by which it is defined and enforced. The first consists in an averment that the plaintiff has not commenced his action within the time prescribed by the Statute of Limitations. Whether this defence is permissible in a suit for the infringement of a patent is a question of some difficulty, which has not been completely settled by the courts. That where an act of Congress fixes a period, within which actions of infringement must be brought, the expiration of that period effectually deprives the owner of the patent of his right to sue may be regarded as indisputable. But when no Federal statute of this character exists, as was the case before the

⁸ That mere non-payment of royalties does not forfeit a license unless the contract so provides, and the continued use of the licensed invention is a mere breach of contract, not an infringement, see *Consolidated Middlings Purifier Co. v. Wolf* (1886), 37 O. G. 567 ; 28 Fed. Rep. 814.

That the covenants in a license cannot deprive a licensee of the right to show that he does not infringe, see *White v. Lee* (1882), 23 O. G. 1621 ; 14 Fed. Rep. 789.

That if a license set up in defence is shown to have been revoked before the infringement, the defence will be overruled, and the defendant allowed to defend like other infringers, see *Wooster v. Singer Mfg. Co.* (1883), 23 O. G. 2513.

That the rights of a purchaser from a foreign maker are subordinate to those of the patentee under his American patent, see *Graff v. Boesch* (1887), 33 Fed. Rep. 279.

act of 1870 and has been since the Revision of 1874, the limitation, if there be any, must result from the statutes of the State in which the action is commenced. Whether such statutes apply to suits under the Patent Law is doubtful. Some courts have affirmed while others have denied it.¹ In

§ 980. ¹ In *Hayden v. Oriental Mills* (1883), 15 Fed. Rep. 605, Lowell, J. : (605) "Several judges of great ability and experience have held that the Statutes of Limitation of the States do not affect actions upon patent rights, upon the theory that Sec. 34 of the Judiciary Act (now Rev. Stat. Sec. 721), making the laws of the States the rules of decision in the courts of the United States, in actions at the common law, does not apply to actions which are within the exclusive jurisdiction of the courts of the United States. There are several able decisions on the other side, but perhaps the weight of authority is with the plaintiff on this point. We give the citations in a note at the end of this opinion. This is an action at law, and if the statutes in question do not apply, there is no limitation, unless it be that of Rhode Island in 1789, — for a court of common law has no discretion to refuse to entertain stale claims. This result appears to us to be inadmissible. No reason is given in any decision for excepting one class of cases out of Sec. 721. Some arguments upon the general question have been made which we shall advert to. There is no such exception in the statute itself, and none in its intent and purpose. Exclusive jurisdiction is given for reasons which are apart from this question. For instance, in patent cases the Federal courts have this control in order that the construction of the law and of the patents granted under it may be as nearly uniform as possible, not that the remedies of a patentee shall be of uniform duration. Equity is a uniform system in the Federal courts through-

out the United States, but the remedies in equity are barred in those courts by the State Statutes of Limitation in certain cases. . . . To us it seems as inadmissible to say that Sec. 721 does not apply to patent cases, as that the law adopting the general practice of the States does not apply to them. In one particular it perhaps does not, because the statute says that an action on the case shall be the remedy. This is a reproduction of the old law which was passed when all the States had that form of action, and may or may not now be an exclusive remedy; but no one can deny that in other respects the process and procedure acts apply to actions at law for the infringement of patent-rights. A dozen questions may arise in any patent case which can only be decided by the law of the State. There is no doubt, of course, of the right of Congress to make a Statute of Limitations for patent causes. The power is specially reserved in Sec. 721, and by the act of 1870, Sec. 55 (16 St. 206), they made such a law, which provides that all actions shall be brought within the term for which letters-patent shall be granted or extended, or within six years thereafter. Congress, when they passed this act, may have supposed that there was no limitation; but, if so, they found out their mistake, for they repealed this part of the patent law, when they passed the Revised Statutes, by omitting it from the chapter on patents. *Sayles v. Oregon Central R. R. Co.*, 6 Sawy. 31; *Vaughn v. East Tenn. &c. R. Co.*, 11 O. G. 789. When they thus repealed the act of Congress, the State law became again applicable

this divergence of authority no opinion can be more than probable. The peculiar nature of a patent right as a uni-

to future infringements, but one of the repealing sections (Sec. 5509) reserves all existing causes of action, so far as limitations are concerned, precisely as though no repeal had been made. *Sayles v. Oregon Central R. R. Co.*, *supra*; *Vaughn v. East Tenn. & C. R. Co. supra.*" 24 O. G. § 601 (601).

In *Sayles v. Richmond, Fredericksburg & Potomac R. R. Co.* (1879), 3 Hughes, 172, Hughes, J. : (173) "The thirty-fourth section of the Judiciary Act of 1789 (Sec. 721 of the Revised Statutes of the United States) is the only general statute of limitations known in Federal legislation. In providing that the laws of the several States shall be the rules of decision in trials at common law in courts of the United States, except where treaties or acts of Congress otherwise provide, Congress virtually adopted the Statute of Limitations of each State as the limitation of actions brought in the United States courts held in that State. This point is so thoroughly settled that it is useless for me to cite authorities on the subject." 4 Bann. & A. 239 (240); 16 O. G. 43 (43).

Further, that State Statutes of Limitation apply where there is no Federal statute, see *Royer v. Coupe* (1886), 29 Fed. Rep. 358; 39 O. G. 239; *Hayward v. City of St. Louis* (1882), 11 Fed. Rep. 427; 3 McCrary, 614; *Sayles v. Oregon Central R. R. Co.* (1879), 6 Sawyer, 31; 4 Bann. & A. 429; *Rich v. Ricketts* (1870), 7 Blatch. 230; *Parker v. Hawk* (1857), 2 Fisher, 58.

That State Statutes of Limitation do not apply where there is a Federal statute, see *Sayles v. Louisville City R. R. Co.* (1881), 9 Fed. Rep. 512; *Sayles v. Lake Shore & Michigan Southern R. R. Co.* (1879), 9 Fed. Rep. 515; *Sayles v. Dubuque & Sioux City R. R.*

Co. (1879), 9 Fed. Rep. 516; 5 Dillon, 561; 3 Bann. & A. 219.

On the contrary: In *Anthony v. Carroll* (1875), 2 Bann. & A. 195, Shepley, J. : (197) "Should the legislature of a State pass an act in express terms limiting the time for bringing an action in the Federal courts for infringement of patent-rights, there can be no reasonable doubt that such a statute would be unconstitutional and void. The policy of the government to provide a uniform system of rights and remedies throughout the United States upon the whole subject-matter of patents for new and useful inventions and discoveries by placing it under the control of Congress and the Federal courts would be frustrated if such State legislation could directly or indirectly limit, restrict, or take away the remedy. For these reasons I think no State Statute of Limitations can be pleaded in bar of this action." 9 O. G. 199 (200).

In *Read v. Miller* (1867), 3 Fisher, 310, McDonald, J. : (313) "Since, then, no State has any power to legislate concerning patent-rights, and no State court has jurisdiction to adjudicate concerning any violation of them, it can hardly be supposed that a State may, nevertheless, pass Statutes of Limitation concerning them, which shall control national courts in suits brought for their infringement. It ought not to be presumed that the State legislature, in passing a Statute of Limitation, ever intended it to extend to patent-right litigations, since such litigation cannot arise in a State court. Nor ought the presumption to be indulged that Sec. 34 of the Judiciary Act could have been intended to authorize State legislatures to pass Statutes of Limitation on subjects over which the States have no control. Moreover, it should

versal franchise co-extensive with the United States, its extreme susceptibility to secret invasion, the fact that numerous causes of action against different defendants involving in the main the same issues and practically requiring but one extended litigation often arise almost simultaneously, and the manifest advantage of uniformity throughout the entire country in all matters connected with the enforcement of any universal right, indicate that this important feature of remedial jurisprudence is solely within Federal jurisdiction, and can be regulated only by the acts of Congress. If these prescribe no period of limitation for the remedies which they provide in cases where the rights which they create are violated, it is a fair presumption that Congress, in whom the supreme power over all these subjects unquestionably resides, intends that no such limitation shall exist. In this view it seems probable that State Statutes of Limitation afford the defendant no ground of defence. The only Federal statute of this character which

be noted that Sec. 34 of the Judiciary Act only makes the laws of the several States rules of decision in the national courts '*in cases where they apply.*' Now, it appears to me that these State laws do not apply in cases over which State governments have no control whatever, and which are under the exclusive control of the general government. The counsel for the defendants seems to rely confidently on the case of *McLuny v. Silliman*, 3 Peters, 270, as sustaining the pleas in question. But I think that case not in point. It was an action against Silliman, a land officer, for official misconduct. Over the subject-matter of it, I suppose the State and national courts had concurrent jurisdiction. If so, the case evidently fell within the provisions of Sec. 34 of the Judiciary Act, and so it was decided by the Supreme Court. In that case, therefore, the plea of the Statute of Limitation of the State of Ohio was very properly held to be a good bar to the action. Upon the whole, I conclude that no State Statute of Limi-

tation can bar this action. And I think that, should a State legislature pass an act in express terms limiting the action on the case for violating patent-rights, a thing I believe never yet attempted by any State legislature, such an act would be unconstitutional and void." 2 Bissell, 12 (15).

Further, that State Statutes of Limitation do not apply to patent cases, see *May v. Logan Co.* (1887), 41 O. G. 1387; 30 Fed. Rep. 250; *May v. Ralls Co.* (1887), 40 O. G. 575; 31 Fed. Rep. 473; *May v. Cass Co.* (1887), 30 Fed. Rep. 762; *May v. Buchanan Co.* (1886), 39 O. G. 120; 29 Fed. Rep. 469; *Adams v. Bellaire Stamping Co.* (1885), 33 O. G. 623; 25 Fed. Rep. 270; *Anthony v. Carroll* (1875), 9 O. G. 199; 2 Bann. & A. 195; *Collins v. Peebles* (1865), 2 Fisher, 541.

That whether State Statutes of Limitation apply is doubtful, see *Stevens v. Kansas Pacific R. R. Co.* (1879), 5 Dillon, 486; *Sayles v. Dubuque & Sioux City R. R. Co.* (1878), 5 Dillon, 561; 3 Bann. & A. 219; 9 Fed. Rep. 516.

ever has existed formed a part of the Patent Act of 1870.² It provided that all actions should be brought during the term for which the letters-patent were granted or extended, or within six years after the expiration thereof. This enactment was omitted from the Revised Statutes of 1874, presumably because it was judged inexpedient to retain it. While it was in force its construction was disputed, — some authorities deciding that a cause of action arising under the original term of a patent was barred in six years after the expiration of that term although the patent might have been extended; others regarding the original and extended terms as legally but one and the statute as inoperative against any right of action until six years had elapsed after the patent had finally expired.³ To what causes of action the limitation applied was

² That before July 8, 1870, no Federal Statute of Limitations applied to patent cases, see *Wood v. Cleveland Rolling Mill Co.* (1871), 4 Fisher, 550.

³ In *Sayles v. Louisville City R. R. Co.* (1881), 9 Fed. Rep. 512, Barr, J. : (514) "It is not true that letters-patent run for only one term when the patent is extended. In such a case there are two terms, — the original term and the extended term, — and though the law provides that when a patent is extended it shall have the same effect in law as though it had been originally granted for twenty-one years, that does not change this fact, nor does it change the fact that the original term was for fourteen years, and not twenty-one years. The act does not provide that the two terms shall be considered as one term in law, but simply provides that the extension of a patent shall have the same effect in law as though it had been originally granted for twenty-one years. I think Congress has, in the clause under consideration, clearly recognized that an extended term and the original term of letters-patent are distinct terms. An extended term of letters-patent can have the same effect in law as though it had been granted for

twenty-one years, in the granting of a monopoly, without extending the time of the bar of the Statute of Limitation on existing causes of action. The patent-right is quite distinct from the causes of action which a patentee may have for its infringement; and because a patent-right may be extended it does not follow that the time within which such causes of action should be brought should also be extended."

In *Sayles v. Lake Shore & Mich. So. R. R. Co.* (1879), 9 Fed. Rep. 515, Harlan, J. : (515) "I have reached a conclusion entirely satisfactory to my own mind, and I think that statute means that where the party sues for any infringement under the original term, he must bring his action within six years after the expiration of that term; and when he sues for anything that has occurred under the extended term, he must sue within six years after the expiration of that extension; and that the statute does not mean, as contended for by the learned counsel for the complainant, that the party has the right to sue for an infringement, either under the original or extended term, within six years after the expiration of the extended term, and thus bring the

also doubtful. Under the general doctrine that Statutes of Limitation are not retrospective unless expressly so provided, this Federal statute could not affect a right of action existing at the date of its enactment, though based upon a patent which had long before expired, at least till after six years from the passage of the act.⁴ Rights of action accruing under patents which expired while the act remained in force were held to have been barred in six years after such expiration, although meantime the act had been repealed.⁵ And it has been asserted that rights of action, growing out of infringements committed during the existence of the statute against patents which expired after the statute was repealed, were also barred unless suit were commenced within six years after the patent had expired.⁶ Giving to this defence its wid-

suit within twenty-seven years. I do not think that was the purpose of Congress, and I therefore sustain the grounds of demurrer as to all causes of action."

Further, that a suit for a cause of action arising under the original term must be brought within six years after such term expires, though the patent be meanwhile extended, see *Hayden v. Oriental Mills* (1884), 22 Fed. Rep. 103.

That under the Statute of Limitations of 1870, if a suit is brought within five years after the expiration of the extended term, the plaintiff may recover only for infringements during the extension, see *Sayles v. Dubuque & Sioux City R. R. Co.* (1878), 5 Dillon, 561; 3 Bann. & A. 219; 9 Fed. Rep. 516.

Contra: That where a patent has been extended and a suit is brought within the time limited by the statute after the extension expires, the plaintiff may recover for the entire twenty-one years of the patent, see *Sayles v. Richmond, Fredericksburg, & Potomac R. R. Co.* (1879), 3 Hughes, 172; 16 O. G. 43; 4 Bann. & A. 239.

⁴ That Statutes of Limitation are only prospective unless the contrary appears, see *Vaughn v. East Tennessee, Vir-*

ginia, & Georgia R. R. Co. (1877), 11 O. G. 789; 1 Flippin, 621; 2 Bann. & A. 537.

That Sec. 55, act July 8, 1870, under Sec. 5599, Rev. Stat. 1874, applies to rights of action which were old enough at the time of its approval to have been fully barred by the State statute if such statute had been pleaded, see *Hayden v. Oriental Mills* (1884), 22 Fed. Rep. 103.

⁵ That since the repeal of the limitation clause in Sec. 55, act of 1870, an action upon a patent expiring before the Revised Statutes were adopted may be brought within six years after the expiration of the patent, see *Vaughn v. East Tennessee, Virginia, & Georgia R. R. Co.* (1877), 11 O. G. 789; 1 Flippin, 621; 2 Bann. & A. 537.

⁶ That Sec. 55, act of July 8, 1870, is not repealed so as to relieve either party from the rule limiting actions to six years after the end of the extended term, see *Hayward v. City of St. Louis* (1882), 11 Fed. Rep. 427; 3 McCrary, 614.

That no Federal Statute of Limitations affecting infringements committed since June 22, 1874, is now in force, see *May v. Logan Co.* (1887), 30 Fed. Rep. 250; 41 O. G. 1387.

est scope, it may, therefore, be proper for a defendant, now sued for an infringement committed while the Federal statute was in force, to urge that statute as a bar, in case the patent has expired more than six years before the suit was brought. It may also be proper to seek refuge in this statute in cases where the patent expired during its existence, although the infringement took place before it was enacted, as well as in cases where the patent had expired before the act was passed. It is not proper to urge the Federal statute where the infringement occurred after its repeal. In cases where the Federal statute is not applicable, a defence based on State statutes may be sustained. But the entire subject is involved in so much obscurity, through the doubt as to State jurisdiction in any case, and the confusion incident to the repeal of the Federal statute before the limitation could have affected any cause of action, that every form of this defence must be experimental until new legislation, or a decision of the court of last resort, shall make the matter plain.

§ 981. **Twenty-Third Defence . Estoppel.**

The twenty-third defence consists in an averment that the plaintiff, though having an existing cause of action, is estopped by his own conduct from pursuing any remedy against the defendant. This defence is based on that form of estoppel which arises out of the actions or omissions of the plaintiff in reference to the defendant or out of the relations which subsist between them. The doctrine of estoppel *in pais*, as applicable to suits at law, is not at the present time entirely clear. That where the plaintiff has designedly misled the defendant by his actions or omissions, he cannot take advantage of the position, in which the defendant has placed himself in consequence thereof, to injure the defendant, is now, as it has always been, a settled rule of law.¹ That where the law imposes on the plaintiff the performance of a

§ 981. ¹ That the plaintiff cannot recover damages for acts which he has intentionally misled the defendant to perform, see *Dickerson v. Colgrove* (1879), 100 U. S. 578; *Morgan v. R.*

R. Co. (1877), 96 U. S. 716; *Barnard v. Campbell* (1874), 55 N. Y. 456; *Rice v. Barrett* (1874), 116 Mass. 312; *Bronson v. Chappell* (1870), 12 Wall. 681.

certain duty for the protection of the defendant, he cannot avail himself of any fault of the defendant which his own fulfilment of that legal duty might have prevented, is equally indisputable.² In both these cases there is present an element of wilful wrong on the part of the plaintiff, which the law will not permit him to employ to his own benefit and the defendant's injury. In equity, however, this element of wilful wrong is not essential in order that the plaintiff may be bound by an estoppel. Equity places on an equal footing acts of intentional wrong and intentional acts whose consequences are identical with those of acts of intentional wrong. It looks upon the effect of conduct, not upon its motive, and thus works an estoppel whenever the voluntary actions or omissions of the plaintiff were calculated to and did mislead the defendant, although the plaintiff may have actually contemplated and designed no such result.³ While courts of equity and courts of law were entirely distinct, each retained its own doctrine of estoppel *in pais*, and administered it without modification by the other. But in the recent approach and intermingling of these two systems of practical jurisprudence, the courts of law have adopted wider views of this as well as many other doctrines, and the precise line of demarcation between them has disappeared. Thus, as a defence to an action at law, estoppel *in pais* might unquestionably be urged by the defendant whenever the plaintiff had intentionally misled him into the violation of the plaintiff's rights, or where the plaintiff had neglected some legal duty by whose performance such viola-

² That the plaintiff cannot recover damages for acts which it was his own legal duty to prevent the defendant from ignorantly committing, unless his duty has been performed, see *Pickard v. Sears* (1837), 6 A. & E. 469; *Young v. Grote* (1827), 4 Bing. 253.

That silence when it is a duty to speak works an estoppel, see *Bank v. Lee* (1839), 13 Peters, 107.

That a plaintiff is not estopped by silence, unless his failure to speak when it was his duty to do so has misled the defendant, see *Reay v. Raynor*, (1884),

26 O. G. 1111; 19 Fed. Rep. 308; 22 Blatch. 13; *N. Y. Grape Sugar Co. v. Buffalo Grape Sugar Co.* (1883), 25 O. G. 1076; 18 Fed. Rep. 638; 21 Blatch. 519; *R. R. Co. v. DuBois* (1870), 12 Wall. 47.

³ That in equity a plaintiff cannot recover for acts which his own conduct or declarations induced the defendant to perform, although such inducement were not intentional, see *Bispham*, Eq. Jur., Secs. 282-290; 2 Story, Eq. Jur., Sec. 1538.

tion might have been prevented. According to the current of authority this defence can also be made when the conduct of the plaintiff, though he did not explicitly intend to mislead the defendant, was of such a character that he might reasonably have expected that the defendant would thereby be misled.⁴ But conduct of the plaintiff, lawful in itself, and not of such a nature or coupled with such circumstances as indicate that he must reasonably have expected the defendant to be influenced by it in his own behavior, seems not yet regarded as working an estoppel in a court of law.⁵ The estoppel which arises out of the relations that subsist between the parties is also of equitable origin, and the extent to which it may be made available in courts of law is not determined. Applying the foregoing doctrines to a suit at law for the infringement of a patent, this defence may be urged whenever the conduct of the plaintiff toward the defendant has been such as might reasonably be expected to mislead and has misled the defendant into the commission of the acts for which he is now sued.⁶ Any enumeration of the actions or omissions of the

⁴ That a party is bound by acts which his own conduct or declarations induced others to perform, if under the circumstances he might reasonably have expected that they would be misled, see *Bassett v. Bradley* (1880), 48 Conn. 224.

That in this country equitable estoppel is as valid a defence at law as in equity, see *Concord v. Norton* (1883), 16 Fed. Rep. 477.

⁵ That in law the mere fact that the defendant was misled by the conduct or declarations of the plaintiff does not work an estoppel on the latter, see *Drexel v. Berney* (1883), 16 Fed. Rep. 522; 21 Blatch. 348.

⁶ That a patentee cannot sue persons using the invention under a license from a third party whose interest in the patent has been admitted by the patentee, unless they continue such use after being notified of his exclusive rights, see *Gear v. Grosvenor* (1873), 3 O. G. 380; 6 Fisher, 314; Holmes, 215.

That an inventor who permits another to take out a patent, and then himself takes out a different patent for a different invention, is estopped to allege that he invented the subject-matter of the first patent, see *Fraim v. Keen* (1885), 25 Fed. Rep. 820; 34 O. G. 1048.

That where the officers of an infringing corporation purchase the patent and retire from the corporation, they cannot sue the corporation for infringing the patent under their management, see *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.* (1885), 24 Fed. Rep. 604; 32 O. G. 1356.

That the owner of the patent is not estopped from suing by his admissions that he was not the owner, if the admissions were in good faith and were recalled before they were acted on, see *Gear v. Grosvenor* (1873), Holmes, 215; 6 Fisher, 314; 3 O. G. 380.

That an inventor is not estopped by a mistaken claim in his application that

plaintiff which constitute such conduct is, of course, impossible. An estoppel is pre-eminently the creature of circumstances, and only in the light of all those which enter into and surround the given transaction can its character be definitely known. Many of the actions of the plaintiff which might be relied on as resulting in an estoppel have also been regarded by the courts as creating an implied license to practise the invention, and such acts may be taken advantage of either under this or that form of defence.⁷ Among the omissions of the plaintiff, one derives its character and effect from the express provisions of the law. This consists in the neglect of the owner of the patent for an article to give the public information that the same is patented by stamping the article itself, or the package in which it is contained, with the word "patented," accompanied by the date of the patent. A plaintiff, who omits this duty, is estopped from claiming substantial damages for any infringement committed by the defendant before he receives notice from the plaintiff that his acts are an invasion of the patent.⁸ An omission to commence legal proceedings against infringers, within a reasonable time after their infringements became known to the owner of the patent, may work an estoppel in a court of equity.⁹ Whether it has the same effect in a court of law may well be doubted, except in cases where it is sufficient evidence of an abandonment of the invention to the public.¹⁰ But the institution of a single suit against one infringer is notice to all others that the plaintiff intends to vindicate his rights under the patent, and no delay in suing them can then raise an estoppel in their favor.¹¹ The relation that subsists between

his invention is the same as that covered by his foreign patents, see *Commercial Mfg. Co. v. Fairbank Canning Co.* (1886), 27 Fed. Rep. 78; 36 O. G. 1473.

⁷ For a discussion of license by estoppel, see § 834 and notes, *ante*.

⁸ For the effect of a failure to stamp patented articles as required by law, see § 628 and notes, *ante*.

⁹ That a mere delay in suing an infringer may work an estoppel in equity,

see §§ 1114, 1194, 1195, and notes, *post*.

¹⁰ That in the absence of a Statute of Limitations a delay in suing an infringer does not work an estoppel, unless the conduct of the patentee is equivalent to an abandonment of the invention to the public, see *Ransom v. Mayor of New York* (1856), 1 Fisher, 252.

¹¹ That the bringing a suit against one infringer is, in equity, notice to all

a transferor or transferee of any interest in a patented invention is also ground for an estoppel in a court of law, in any case where the transferor is plaintiff, and in his suit he must attack either the existence or validity of the transfer he has made.¹²

§ 982. Twenty-Fourth Defence: Release.

The twenty-fourth defence consists in an averment that the cause of action formerly existing in favor of the plaintiff against the defendant has been voluntarily extinguished by the plaintiff. A cause of action arising from the infringement of a patent may be destroyed by the owner of the patent in either of two methods: (1) By a surrender of the patent to the government, which terminates alike the existence of the patent and all rights of action based thereon; or, (2) By a release to the infringer, which terminates the cause of action but does not affect the existence of the patent. As the present defence does not attack the validity or existence of the patent, but the cause of action only, it is proper in the single case where the owner of the patent, subsequently to the infringement, has expressly or impliedly released the infringer from his liability therefor.¹ Such a release may be in writing under seal, or may arise by presumption of law out of other transactions between the parties.² The releasor must have had the legal right to grant it, and the defendant must have received it in good faith

others of their liability, and prevents an estoppel by laches, see § 1114 and notes, *post*.

¹² That a transferor is estopped to deny the validity of the patent or the rights of his transferee, see *Birdsall v. Curran* (1887), 31 Fed. Rep. 918; 42 O. G. 1167; *American Paper Barrel Co. v. Laraway* (1886), 28 Fed. Rep. 141; 37 O. G. 674; *Alabastine Co. v. Payne* (1886), 27 Fed. Rep. 559; 35 O. G. 1438; *Parker v. McKee* (1885), 32 O. G. 137; 24 Fed. Rep. 808; *Underwood v. Warren* (1884), 21 Fed. Rep. 573; *Thomas v. Quintard* (1855), 5 Duer, 80; and §§ 787, 789, and notes, *ante*.

That a plaintiff cannot deny the ex-

istence of a corporation through which he derived title, see *Bogart v. Hinds* (1885), 33 O. G. 1268; 25 Fed. Rep. 484.

§ 982. ¹ That a release is a good defence to an action for infringement, see *Goodyear v. McBurney* (1853), 3 Blatch. 32.

That a written release under seal of one of two joint infringers is a bar to a suit against the other, though he may still be enjoined from further infringements, see *Babcock & Wilcox Co. v. Pioneer Iron Works* (1888), 43 O. G. 756.

² That a release may be implied from circumstances, see 2 Pars. Cont. 715.

and not in fraud of other owners of the patented invention; and if it were conditional, such conditions must have been fulfilled.³ A plaintiff having given a valid release to the defendant is bound by it, not only as a contract relinquishing his former cause of action, but as an estoppel which prevents him from pursuing any remedy thereon.⁴

§ 983. **Twenty-fifth Defence : Res Adjudicata.**

The twenty-fifth defence consists in an averment that whatever cause of action may have once subsisted in favor of the plaintiff against the defendant, it has now been merged in, or extinguished by, a lawful judgment. The doctrine of *res adjudicata* is fully applicable to cases of infringement. The recovery of a judgment by the plaintiff against the defendant for a given act of infringement changes the character of the plaintiff's claim from tort to contract, and when the judgment has been satisfied destroys it altogether. This defence is, therefore, proper when a second suit is instituted between the same parties on an infringement for which the plaintiff has already recovered a judgment against the defendant.¹ A judg-

³ That no release is valid unless the releasor had at the time the legal right to grant it, see *Goodyear v. McBurney* (1853), 3 Blatch. 32.

That where in a suit by a patentee on behalf of a licensee the defendant sets up a release from the patentee, it will not avail him if the license was granted before the release, and this fact will be sufficient upon replication, see *Goodyear v. McBurney* (1853), 3 Blatch. 32.

That a fraudulent release is invalid, see 2 Pars. Cont. 715.

That an infringer, taking a release from one owner of a patent, receives it with notice of, and subject to, the equities of the other owners, see *Kearney v. Lehigh Valley R. R. Co.* (1886), 27 Fed. Rep. 699.

That a conditional release is no defence unless the conditions have been performed, see 2 Pars. Cont. 714.

⁴ That a release destroys the cause

of action and prevents the application of the remedy, see 2 Pars. Cont. 713.

§ 983. ¹ That a former recovery is a bar to a new suit for the same cause of action, see *Lyon v. Perin & Gaff Mfg. Co.* (1888), 43 O. G. 983; *Puetz v. Bransford*, (1887), 41 O. G. 353; 32 Fed. Rep. 318; *Cromwell v. County of Sac* (1876), 94 U. S. 351.

For the effect of a recovery against one joint infringer, see § 948, note 3, *ante*.

That the wrongful sale of an invention is a tort for which the plaintiff can recover in a tort action, or by waiving the tort in assumpsit for the price received; and in the latter case no one could at any time be sued, if recovery were once had against the seller, see *Steam Stone Cutter Co. v. Sheldons* (1883), 15 Fed. Rep. 608; 24 O. G. 703; 21 Blatch. 260.

That a recovery from a maker is no

ment in favor of the defendant in a suit for an infringement is equally conclusive on the rights of the parties, and estops the plaintiff from any subsequent assertion of his claim.² The judgments in both these cases must have been final judgments, rendered on the merits, and covering the same issue of infringement.³ Interlocutory decisions and judgments in

defence to the vendee unless the judgment against the maker has been satisfied, and included the article sold to the vendee, and a plea not alleging such satisfaction discloses no defence, see *Fisher v. Consolidated Amador Mine* (1885), 25 Fed. Rep. 201 ; 11 Sawyer, 190.

That a judgment and payment of nominal damages by one defendant, in a suit brought by the patentee without joining his licensee, for making and selling one machine are no bar to a suit by the patentee and licensee, for the benefit of the licensee, against the vendee of such defendant for using the same machine, see *Birdsell v. Shaliol* (1884), 112 U. S. 485 ; 30 O. G. 261.

² That a decree of invalidity in the Federal courts is conclusive on the parties, see *Hawks v. Swett* (1875), 4 Hun, 146 ; 6 Thomp. & C. 529.

That a former judgment on the same title may be a bar if specially pleaded, though some of the parties are different, see *Richardson v. Lockwood* (1870), 4 Clifford, 128.

That a final decision in an interference is conclusive between the parties until reversed or affected by equity proceedings under Sec. 4915, Rev. Stat., see *Peck v. Collins* (1877), 70 N. Y. 376.

That a decree by consent on an issue of title is *res adjudicata* as to all the parties, see *Tomkinson v. Willets Mfg. Co.* (1884), 31 O. G. 918 ; 23 Fed. Rep. 895 ; 32 O. G. 382 ; *Ex parte Pentlarge* (1879), 17 Blatch. 306 ; 4 Bann. & A. 607.

That a decree by consent in a former

suit between the plaintiff's assignor and the present defendant is *res adjudicata*, see *United States Metallic Packing Co. v. Tripp* (1887), 39 O. G. 1554 ; 31 Fed. Rep. 350.

That a judgment works an estoppel only as to the matters controverted and decided, see *Steam Gauge & Lantern Co. v. Meyrose* (1886), 36 O. G. 1477 ; 27 Fed. Rep. 213.

That the judgment of a State court as to the contract relations of the parties is not *res adjudicata* on questions of title in the Federal courts, see *Oliver v. Rumsford Chemical Works* (1883), 109 U. S. 75 ; 25 O. G. 784.

³ That a judgment of non-infringement is no bar to another action between the same parties for a different infringing act, see *Steam Gauge & Lantern Co. v. Meyrose* (1886), 27 Fed. Rep. 213 ; 36 O. G. 1477.

That though the Supreme Court has decided that a machine does not infringe an original patent it may still be an infringement of the re-issue, see *Wells v. Jacques* (1874), 5 O. G. 364 ; 1 Bann. & A. 60.

That a judgment is not conclusive on a plaintiff in favor of a licensee under his victorious rival, when afterward sued by him, if the license were granted before the judgment was rendered, see *Ingersoll v. Jewett* (1879), 16 Blatch. 378 ; 4 Bann. & A. 361.

That a judgment between two patentees on the question of priority affects the title of the junior patentee, but a judgment that the senior patentee was not the first inventor of an invention not claimed by the junior patent, does not

collateral proceedings, although disposing of the suit then pending, do not fall within the reason or the definition of this doctrine, and cannot be available as a defence on the main issues of the suit.⁴

§ 984. Defendant may Employ all his Defences unless Estopped.

Any or all of the foregoing defences may be set up by the defendant in an action for infringement, unless he is himself estopped from urging them.¹ The defendant is bound by his prior conduct equally with the plaintiff, and is not permitted to assume positions inconsistent with those which he has previously occupied and on which the plaintiff has relied in the direction of his own affairs.² Thus a former owner of the patent, through whom the plaintiff's title was derived, cannot deny its validity when sued for its infringement, although it is

affect the latter patent, nor bar the senior from suing the licensee of the junior if the license were taken after the first suit was commenced, and with knowledge of its pendency, although the invention of the junior cannot be made without using that of the senior, see *Brush v. Naugatuck R. R. Co.* (1885), 24 Fed. Rep. 371; 23 Blatch. 277; 32 O. G. 894.

⁴ That no action short of final judgment on the merits, can be pleaded in bar, see *Allen v. Blunt* (1846), 2 W. & M. 121; 2 Robb, 530.

That whether an interlocutory decree, *pro confesso*, followed by a release of profits, etc., is *res adjudicata* and an estoppel is doubtful, and being doubtful should not bind, see *Roemer v. Neumann* (1886), 26 Fed. Rep. 332.

That a suit dismissed for want of prosecution is no bar to another one for the same cause of action, see *American Diamond Rock Boring Co. v. Sheldon* (1879), 17 Blatch. 208; 4 Bann. & A. 551.

That the pendency of a suit in one district is no bar to a suit in another,

though a recovery may be, see *Wheeler v. McCormick* (1873), 4 O. G. 692; 6 Fisher, 551; 11 Blatch. 334.

See further as to *Res Adjudicata* in patent cases, §§ 1017, 1048, 1175-1184, and notes, *post*.

§ 984. ¹ That the same defences are applicable to a patent granted on a renewed application, as if granted on an original one, see *Lindsay v. Stein* (1882), 10 Fed. Rep. 907; 21 O. G. 613; 20 Blatch. 370; *United States Rifle & Cartridge Co. v. Whitney Arms Co.* (1877), 11 O. G. 373; 14 Blatch. 94; 2 Bann. & A. 493.

² That a defendant is estopped from setting up his defence to the same extent that a plaintiff may be estopped from bringing his action, see 1 Chitty on Pleading, 603.

That one who knowingly permits another to take out a patent for an invention, and then himself takes a patent for a different invention, is estopped to claim that he was the inventor of the former invention, see *Fraim v. Keen* (1885), 34 O. G. 1048; 25 Fed. Rep. 820.

invalid as against all others.³ A licensee cannot attack the existence of the patent, nor the exclusive privilege which it creates, unless he first repudiates his license, although he may deny that the invention he employs is identical with that which it protects.⁴ A defendant, who, without authority, has extensively practised a patented invention, cannot allege in his defence that it has no utility, especially if he has proclaimed its value to the public.⁵ A fraudulent patentee, who has procured his patent knowing or believing that the inven-

³ That a patentee is estopped from denying the validity of the patent in a suit for infringement brought by his assignee, see *Underwood v. Warren* (1884), 21 Fed. Rep. 573; *Many v. Jagger* (1848), 1 Blatch. 372; and cases cited in § 981, note 12, *ante*.

That a patentee is estopped from denying the validity of the patent or its re-issues in a suit against him by his assignee, although the re-issues were granted after the assignment, and the assignee ought to have known that they were void, see *Burdsall v. Curran* (1887), 31 Fed. Rep. 918; 42 O. G. 1167.

That where a member of an infringing firm was formerly a part-owner of the patent he is estopped from denying its validity, unless he conveyed his interest to the plaintiff without consideration, see *Parker v. McKee* (1885), 32 O. G. 137.

That an assignor is estopped from purchasing a prior patent and setting it up against his assignee, see *Curran v. Burdsall* (1883), 27 O. G. 1319.

That a defendant is estopped by a decree by consent in a suit where he was defendant and the present plaintiff's assignor was plaintiff, see *United States Metallic Packing Co. v. Tripp* (1887), 39 O. G. 1554; 31 Fed. Rep. 350.

See also as to estoppel of assignor, §§ 787, 981, and notes, *ante*.

⁴ That a licensee, having covenanted not to deny the validity of the patent or the licensor's title, cannot defend against

an action while the license is in force, except on the ground that the license is not exceeded, see *Pope Mfg. Co. v. Owsley* (1886), 27 Fed. Rep. 100; 37 O. G. 781.

That a licensee having repudiated the license may deny validity, see *Brown v. Lapham* (1886), 23 Blatch. 475; 37 O. G. 676; 27 Fed. Rep. 77.

That a licensee who has paid large license fees and built up an extensive business under cover of a patent, though not technically estopped from denying its validity, urges such defence with every presumption against him, and if the rest of the public have acquiesced in the patent, he must produce the strongest of proof against it, see *Hobbie v. Smith* (1886), 27 Fed. Rep. 656.

That a defendant who is treated in the bill as an ordinary infringer may avail himself of any defence open to infringers, though he is only a licensee, see *Pelham v. Edelmeyer* (1883), 15 Fed. Rep. 262; 25 O. G. 292; 21 Blatch. 188.

That if a plaintiff sues in infringement instead of for royalties, a purchaser from the licensee is not estopped to deny the validity of the patent, see *Baltimore Car-Wheel Co. v. North Baltimore Passenger R. R. Co.* (1884), 21 Fed. Rep. 47.

Also see § 820 and notes, *ante*, and §§ 1251, 1252, and notes, *post*.

⁵ That a defendant who has used and advertised an invention as of great

tion was not patentable or that he was not its first and true inventor, cannot dispute the patentability of the invention when sued by a rival *bona fide* patentee, although it may be evident that this defence would prove successful on behalf of any other defendant.⁶ A *bona fide* patentee, however, even when defeated on an interference, may afterward deny the patentability of the invention in a suit brought against him by his rival.⁷ A defendant is not estopped from setting up the invalidity of the patent by the fact that he once owned an

value thereby admits its utility, see *Stanley v. Whipple* (1839), 2 McLean, 35; 2 Robb, 1.

That a defendant who infringes both the patent for the original and that for the improvement cannot set up the former as anticipating the latter, see *Cantrell v. Wallick* (1886), 117 U. S. 689; 35 O. G. 871.

⁶ That one who has fraudulently endeavored to patent an invention is estopped from defending against a prior patent on the ground that the invention was then open to the public, see *Greenwood v. Bracher* (1880), 17 O. G. 1151; 1 Fed. Rep. 856; 5 Bann. & A. 302.

⁷ In *Greenwood v. Bracher* (1880), 1 Fed. Rep. 856, Nixon, J.: (858) "A new question is thus presented, and one by no means unimportant. Will the court allow a patentee, who has lost his rights to the protection of the law in consequence of proof that his alleged invention was anticipated by others, to protect himself in the continued use of the patented improvements by showing that neither he nor the other party was the first inventor? In other words, whether the issuing of a patent estops the patentee from proving that the invention claimed therein is not novel. I think the answer depends entirely upon the fact whether the party has acted in good faith in the matter. Every one making application for letters-patent is obliged to file therewith

an oath that he believes himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement, for which he solicits the patent. Sec. 4892 of Rev. Stat. This is often done honestly, and yet untruthfully, owing to the ignorance on the part of the applicant of the state of the art. I can perceive no satisfactory reason why any one should not be permitted, after he has discovered his mistake, to set up the defence of want of novelty against another party who claims an exclusive right to patented improvements which, in truth, belong to the public. But if one with a knowledge of the state of the arts surreptitiously attempts to appropriate to himself what he knows does not belong to him, he should be estopped when his fraud is found out, from interposing such a defence, especially against a person whom the Patent Office has decided, as against his claim, to be the original and first inventor." 17 O. G. 1151 (1151); 5 Bann. & A. 302 (304).

See also *Shuter v. Davis* (1883), 24 O. G. 303; 16 Fed. Rep. 564; *Smith v. Halkyard* (1883), 23 O. G. 1833; 13 Fed. Rep. 414.

That a defeated party to an interference, denying the novelty of the invention, must clearly prove it, if he had knowledge of the state of the art when he made his own application, see *Smith v. Halkyard* (1883), 16 Fed. Rep. 414; 23 O. G. 1833.

interest therein, if there is no privity of title between him and the plaintiff.⁸ Nor can he be prevented from denying the identity between his own device and that protected by the patent by an agreement not to make the former, unless he also has conceded it to be the same in its essential characteristics as the latter.⁹ When there are several defendants an estoppel operating against one does not bind the others, unless they are in privity with him in reference to the subject-matter to which the estoppel appertains.¹⁰

§ 985. Separate Defences Allowed against Each Patent and Each Claim in Controversy.

Where several patents constitute the basis of a single suit, each may be separately attacked by any of the methods of defence herein described.¹ A patent which embraces several Claims, whether for the same or different inventions, stands in this respect on the same ground as if each Claim were embodied in a separate patent; and every Claim is, therefore, open to all those defences which do not relate solely to the patent as a whole.² Re-issued patents, and patents granted on renewed applications, may be met with the same objections as to invalidity and the want of patentability in the invention

⁸ That a defendant with whom there is no privity of title in the plaintiff is not estopped to deny the validity of the patent, see *Baltimore Car-Wheel Co. v. North Baltimore Passenger R. R. Co.* (1884), 21 Fed. Rep. 47.

⁹ That a defendant agreeing not to manufacture a device is not estopped by the agreement unless that device is conceded to be identical with the one patented, see *Roemer v. Simon* (1877), 95 U. S. 214; 12 O. G. 796.

¹⁰ That a defendant is not estopped by the conduct or relations of other persons unless privity of title exists between them, see *Baltimore Car-Wheel Co. v. North Baltimore Passenger R. R. Co.* (1884), 21 Fed. Rep. 47.

That an estoppel by conduct is avail-

able at law, see *Concord v. Norton* (1883), 16 Fed. Rep. 477.

§ 985. ¹ That each patent in suit may be made the subject of separate defences if the defendant so elects, see *Kelleher v. Darling* (1878), 4 Clifford, 424; 14 O. G. 673; 3 Bann. & A. 438; *Bates v. Coe* (1878), 98 U. S. 31; 15 O. G. 337.

That each patent in suit may be defended against on the grounds of prior invention and prior use, see *Parks v. Booth* (1880), 102 U. S. 96; 17 O. G. 1089.

² That some Claims of a patent may be infringed and not others, and each may be defended against, like a separate patent, see *Kelleher v. Darling* (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438.

as are admissible against original patents and patents granted on original applications.³

§ 986. **Forms of Pleading Required for These Defences, a Matter of Dispute.**

In reference to the form in which these various defences should be pleaded, the conflict of authorities appears irreconcilable, — some holding that the greater number may be urged under the general issue, others requiring for nearly all a notice or a special plea. Recurring to first principles for light upon this subject, it is evident that in an action on the case at common law the general issue was sufficient to cover all possible defences, the point in controversy being not whether a cause of action once existed in favor of the plaintiff, but whether at the time of pleading he ought in justice and good conscience to recover judgment against the defendant.¹ Under this issue such special matters of avoidance as a license, or release, or an accord and satisfaction, could be claimed and proved by the defendant.² Thus in an action for the infringement of a patent all the defences heretofore enumerated, except the Statute of Limitations, were admissible under the usual plea of not guilty, and the practice in the English courts in patent cases was in conformity with this position until the change in the rules of pleading in the 5 & 6 W. IV. (1833) and the special act regulating the pleas in patent causes of 6 W. IV. (1835).³ By this change in the rules of pleading the scope of the general issue in an action on the case was limited to a denial of the wrongful act on which the suit was based, and any matter in bar or in avoidance of any other averment in the declaration must be made the subject of a special plea. By the special act referred to, the defendant in an action for infringement is required to file with his plea a notice of all objections on which

³ That patents on renewed applications under the act of 1870, Sec. 35, are open to all defences, see § 984, note 1, *ante*.

§ 986. ¹ Gould on Pleading, ch. vi. §§ 54, 55.

² Gould on Pleading, ch. vi. § 55.

³ Thus Godson : (177) "The usual plea is *not guilty*, which, putting in issue the whole of the declaration, forces the plaintiff to support the grant in all its parts, and gives to the defendant the greatest latitude for evidence."

he intends to rely at the trial.⁴ Thus under the English practice the mode of pleading in patent cases has always been clear and imperative, — before the change the general issue only, and since the change a special plea or notice for all defences, except the single one of non-infringement. At the time of the creation of our patent system, the common law mode of pleading prevailed also in this country. It remained unaffected by the changes introduced into the English practice, and in the absence of statutory provisions of our own would still permit the defendant to avail himself of all his defences under the general issue. In each of the principal acts of Congress on which our patent jurisprudence rests it has, however, been prescribed that the defendant shall set up certain of these defences only under a notice connected with the general issue, or, what the courts have uniformly regarded as its equivalent, under a special plea. The defences thus distinguished are few in number, and have not, in all the acts of Congress, been the same. Some of them are analogous to others not included in the words of this requirement, and suggest that if the former should be specially set forth, the latter should be also. Thence have arisen doubts and difficulties in our practice which can perhaps be removed only by a new act that, like the English statutes, shall cover the entire field of pleading. If any other solution of the questions can be reached, it must be by a careful scrutiny of the provisions out of which they have arisen, in view of the spirit and intent of the law in which they were incorporated.

§ 987. Pleadings under the Act of 1790.

The first appearance of this requirement is in the patent act of 1790, the earliest enactment of Congress in reference

⁴ Thus Coryton: (272) "Formerly in an action for infringement the defendant could plead only the general issue. To provide against the surprise which was constantly occurring from the ignorance in which parties were left as to the real point intended to be urged against them at the trial, it is now required (Stat. 5 & 6 Will. IV.) that the

plaintiff in an action for infringement shall deliver, with his declaration, particulars of the breaches he complains of. Similarly, the defendant to the action . . . must deliver with his pleas, . . . the particulars of the objections he is prepared to urge to the validity of the patent. No evidence is admissible in these respects on the trial which is not

to patents for inventions. The structure of this act is peculiar, but it is clearly consistent with itself; and each of its provisions if interpreted in connection with the others is appropriate and intelligible. The first section provides for the granting of a patent to the inventor of a new art or article upon his petition therefor, if the officers of the government deem the invention sufficiently useful and important. The second section requires the patentee to file with the Secretary of State, at the time of the granting of the patent, a written specification, with drawings and a model when admissible, sufficiently complete and exact to distinguish the invention from all other matters before known and to enable a person skilled in the art to practise the invention, to the end that the public may have the full benefit thereof after the expiration of the patent. The fourth section prohibits all other persons from employing the patented invention without the written permission of the owner of the patent under penalty of forfeiting such a sum of money as a jury might assess as damages, and also the thing made, used, or sold in violation of the patent, to be recovered in an action on the case based on the statute. The sixth section provides that in all such actions the patent and specification shall be *prima facie* evidence that the patentee was the true and first inventor of the invention therein described, and that the description given was correct; but that nevertheless the defendant might plead the general issue and give the statute in evidence, and also, upon due notice to the plaintiff, any other special matter tending to prove that the specification, by the concealment of part of the invention or the addition of more than was necessary to produce the effect described, was intended to mislead the public, or did so mislead them that the effect described could not be produced by the means specified, and that if this fact were established by the proof the defendant should prevail.¹ The

contained in such particulars." These particulars are notices, not pleadings, and form no part of the record. See p. 276.

§ 987. ¹ Particular importance attaches to the fact that according to this act of 1790, the defendant might give

the statute itself in evidence under the general issue. As the validity of the patent, the title of the patentee, and the liability of the defendant, were all dependent upon this statute, this provision set the whole case at issue under this common law plea, with the

extent of the departure of this statute from the common law and the English practice is at once perceptible. At common law the remedy for an infringement was an action on the case for compensatory damages merely, the general issue was a sufficient plea to put the plaintiff upon proof of all the facts on which his right to a recovery was based, and this proof must consist of testimony outside of the patent, upon all points except those of the issue of the patent and the title of the patentee. By our act of 1790 the remedy was an action on the statute for the recovery not only of damages but of one or more articles of personal property; the general issue did not permit the defendant to attack the sufficiency of the disclosure of the invention to the public without a notice to the plaintiff; and the patent was made *prima facie* evidence that the patentee was entitled to a patent and had complied with all the conditions imposed upon him by the law. Passing the first divergence as throwing no light on this question, since the form of action was still trespass on the case, it must be noticed that the other two departures do not affect the rules of pleading, but the rules of evidence. The statute did not require any other plea than the general issue, whatever defence the infringer might desire to present, following in this respect the common law; but it prohibited him from making one particular defence under the general issue unless he previously notified the plaintiff of his intention so to do. This notice has never been regarded as a plea.² Our courts have held that a special plea, setting up the same matters and served under the same conditions, might be substituted for the notice; but the notice itself, when given, formed no part of the pleadings in the action, was served upon the plaintiff instead of being filed in court, and has uniformly been considered as fulfilling its purpose when it put the plaintiff on his guard concerning the nature of the proposed attack upon his patent. Regarded simply as changes in the rules of evidence, the

single exception of the claim of concealment or redundancy in the description of the invention, which could not be made without a special notice. See *Corning v. Burden* (1853), 15 How. 252.

² That the notice of special matter is not a plea, see *Cottier v. Stimson* (1884), 20 Fed. Rep. 906; 10 Sawyer, 212.

effect of these two departures from the common law is obvious. To the validity of a patent three things were necessary: that the invention should be patentable; that the patentee should be its first and true inventor; that he should place his invention fully within the knowledge of the public. Under the common law the burden of proof rested upon the plaintiff, notwithstanding his patent, as to each of these essential conditions; and the defendant was at liberty to controvert either or all of them without other notice to the plaintiff than was implied in his plea of not guilty. Our statute made the patent itself *prima facie* evidence of these three facts. It left the defendant free to dispute the first two under the general issue without previous notice to the plaintiff, but required him to give such notice if he desired under that issue to avail himself of a denial of the third. The entire effect of these changes was, therefore, the introduction into our law of the doctrine that the grant of the patent raises a presumption of its validity which will prevail unless rebutted by opposing evidence, and the establishment of the rule that no opposing evidence shall be offered in reference to the sufficiency of the disclosure, unless the plaintiff has been forewarned that such an attack upon his patent will be made. The reason for requiring a notice upon this particular point and not upon the others readily suggests itself. The patentability of the invention and its original production by the patentee are indispensable conditions of his right to any patent whatever. They are facts which the patentee affirms by applying for the patent, and which he must at all times be ready to establish when his right to the patent is attacked. They are also existing and unalterable facts, not depending on human judgment nor subject to the tests of human insight and comprehension, but supported or denied by the positive, direct, and permanent evidence of the human senses. When our statute made the patent *prima facie* evidence of these facts, and threw upon the defendant the duty of opening the controversy concerning them, it was not deemed important to compel him to inform the plaintiff that he intended to deny what the plaintiff must have expected to become the subject of attack as the defendant's only mode of justifying his own

practice of the patented invention; and the act, therefore, permitted the defendant to make these defences in the same manner as at common law. The third condition was of a wholly different character. A failure to fulfil this condition did not affect the true inventor's right to a patent, but merely the validity of the patent which he had received, and though before the amendment of a patent was allowed the practical result to the patentee was the same as in the other cases, the difference between them in principle and in theory was fundamental. Justice then as now required that this difference should be recognized in jurisprudence, and that defects in statement, if not intended to deceive, should not invoke the same disastrous consequences to the patentee as want of patentability in the invention or the anticipation of his inventive act by that of a prior rival inventor. The fulfilment of this condition was also a fact which could not be evidenced by ordinary proof, but which must have been tested by human judgment and determined by experience. Until the specification was published and submitted to those skilled in the art, the patentee himself could not have known whether his disclosure was sufficient, and if it was intended to be a complete and exact description of his invention, he might safely assume it to be such until the contrary was alleged. To require him to be prepared at all times to meet attack on this ground would compel him to keep himself informed of the extent to which those skilled in the art had endeavored to practise the patented invention and of their success or failure in the attempt, and thus impose upon him a burden productive of no other benefit to himself than the ability to prove the sufficiency of his specification if it should ever chance to be denied. It was, therefore, with the utmost propriety that our law relieved the patentee from the necessity of investigating and accumulating evidence upon this point until notified by a defendant that such a denial would be made. The effect of the first Patent Act of the United States upon the rules of pleading and of evidence is evidently this: that the general issue still remained, as at common law, the proper plea in all cases without reference to the nature of the defence, but that in order to introduce testimony showing the insufficiency of

the specification, whether fraudulent or unintentional, the defendant must have previously notified the plaintiff and have thus afforded him an opportunity to prepare to sustain it.

§ 988. Pleadings under the Act of 1793.

The act of 1793, which superseded that of 1790, carried still further these alterations in the law. It changed the measure of damages to be recovered by the plaintiff, but left the form and statutory basis of the action undisturbed. In reference to the pleadings, it employed the same language as the prior act, but increased the number of defences upon which the defendant was forbidden to offer evidence without a previous notice to the plaintiff. It omitted the provision that the patent should be *prima facie* evidence of the right of the patentee to the patent and of the sufficiency of the description, and inserted a requirement that the patentee, before the patent issued, should make oath that he believed himself to be the first and true inventor of the art or article described. And it extended the effect of a judgment for the defendant upon any of the defences of which it required previous notice, so that not only was the defendant relieved from liability, but the patent itself was declared void. These changes indicate a different spirit and intention in the law from that embodied in the act of 1790. No attempt is made to modify the rules of pleading, the general issue being evidently deemed the proper mode of introducing all defences upon which an alleged infringer can rely. But an endeavor was apparent to make a suit for infringement serve a double purpose, — to vindicate the rights of the patentee if the patent were valid, and to operate as a repeal of the patent if it were void. To meet this latter object the rules of evidence were radically changed. The plaintiff was relegated to his common-law position in reference to the mode of proving his case, the patent being no longer *prima facie* evidence in his favor, and was compelled to assume the burden upon all defences except those on which the repeal or confirmation of his patent was to turn. Of these last defences there were four: a fraudulent specification; prior use; prior publication; and a surreptitious

patent obtained for the discovery of another person. Of these the defendant was required to give notice thirty days before the trial if he desired to offer evidence thereon either for his own deliverance or in the effort to destroy the patent. The reasons of the legislature for selecting these four as the grounds on which a judgment of repeal might be awarded are easily discerned. In a fraudulent specification the attempt to deceive the public is the real defect, and this attempt forfeits the right of the inventor to protection, however meritorious in other respects he may have been. The surreptitious application for, and reception of, a patent for another's invention is also an act which, if not wilfully fraudulent, has the effect of fraud and cannot be sustained or permitted to result in injury to the true inventor or the public by casting a cloud upon the title of the one, or unduly limiting the privileges of the other. An invention which has been in actual use or has been described in a public work before the patentee invented it is certainly not new and original with him, and independently of all other questions as to its patentability cannot become the subject-matter of a valid patent in his favor. These are defects necessarily fatal. They are proved, if provable at all, by clear and direct testimony as to past conditions and transactions. And if the attempt to introduce this new feature of repeal into a suit for infringement was practicable and expedient, the selection of these grounds for it and of this mode of procedure was commendable. But the provisions made for this purpose are not to be confounded with those existing in the act of 1790, where the sole object was to regulate the private controversy between the plaintiff and defendant, nor with those of later statutes which do not contemplate a judgment affecting the existence of the patent.¹

§ 988. ¹ In *Grant v. Raymond* (1832), 6 Peters, 218, Marshall, C. J., clearly recognizes this great distinction between the acts of 1790 and 1793, and refers to the failure of the courts to separate the two purposes which the latter act was intended to accomplish.

In *Kneass v. Schuylkill Bank*, (1820)

4 Wash. 9, the defendant pleaded the general issue without notice. The attention of the court was particularly directed to the provisions of the act of 1793, now under discussion, and the case was argued by distinguished counsel. The following questions were treated as matters of fact to be decided

§ 989. Pleadings under the Act of 1836.

The act of 1836 returned to the purpose and, to a great extent, to the methods of the act of 1790. The attempt to combine proceedings in repeal with an action for infringement was abandoned, and the defendant was permitted only to urge objections in his own behalf. The rules of pleading remained unchanged, and the general issue was allowed to cover every defence which the defendant might desire to raise against the several averments of the declaration, although a notice to the plaintiff was required when evidence on certain subjects was to be presented. In view of the fact that the alterations in the English practice, confining the general issue in all actions on the case to a denial of the wrongful act alleged and compelling the defendant to plead specially all other defences, were introduced three years before the passage of this statute, and that the Act 5 & 6 W. IV., providing that in all suits for infringement the defendant must file with his plea a particular statement of all the defences on which he purposed to rely, took effect only the year before, of both which changes in the English law Congress must be presumed to have had knowledge, the repetition in our statute of the common law rule of pleading is of the highest significance.¹ If it had not been the intention of Congress that the general issue should retain its ancient

under the pleadings: Whether the alleged invention belonged to either of the patentable classes; whether it possessed utility; whether it was a means or an effect; whether the specification so disclosed the invention as to enable persons skilled in the art to practise it. The learned judge also stated that under the general issue other questions might be determined, instancing the absence of a specification; that the patent is broader than the discovery; that the improvement is not distinguished from the original; that the patent does not contain the necessary recitals, etc. He further says that evidence of special matter cannot be given other than such as is particularly mentioned "unless it can be admitted upon general principles

of law, as included in the general issue," thus recognizing the general issue in patent cases as equally comprehensive with the same plea in other cases, except when coupled with the requirement of notice.

That Sec. 6, act of 1793, as to notice, does not include all defences which the defendant may make, see *Evans v. Hettick* (1822), 7 Wheaton, 453; 1 Robb, 417.

That on a general issue without notice the defendant cannot give in evidence any of the matters named in Sec. 6, act of 1793, see *Kneass v. Schuylkill Bank* (1820), 4 Wash. 9; 1 Robb, 303.

§ 989. ¹ See 1 Chitty on Pleading, 512.

comprehensiveness, it would certainly have been restricted by this statute, and other modes have been provided for the assertion of special matters in avoidance or in bar. The section of the act of 1836 which prescribes the mode of pleading and notice, therefore, so far from extending the defendant's common law rights of defence, imposes upon them a limitation, not affecting his right to plead but his right to offer evidence of a certain character under his plea, and restricts the latter right by making previous notice a condition of its exercise. The correctness of this interpretation of that section is established by the decisions of the courts concerning the propriety and method of substituting a special plea for the notice thus required. Such substitution is regarded as legitimate, provided the plea possesses the necessary attributes of the notice as to completeness of statement and time and mode of service, but not otherwise, — showing conclusively that it is not only as a plea putting matters in issue, but as a notice warning the plaintiff of the objections to be urged against his patent, that even a special plea must be employed. Thus there can be no doubt that the same practice prescribed by the act of 1790 in relation to the pleadings was revived and confirmed by the act of 1836. The changes in the rules of evidence consisted in an increase in the number, and some modification in the character, of the defences of which notice was required. Under the act of 1836 these were: a fraudulent specification; prior invention by another than the patentee; prior publication; abandonment by public use or sale; a surreptitious patent obtained for the invention of another; the failure of an alien patentee to put his patented invention on the market. None of these defences were identical with that of insufficient specification, for which a notice was essential under the act of 1790. Those mentioned in the act of 1793, however, are all represented, — prior invention covering the defence of prior use; and two are added, — abandonment by public use or sale, and the misconduct of an alien patentee in withholding his invention from the public. The reasons for retaining the four earlier defences under this rule are the same as those which made it proper in the first place to include them in its operation. The extension of the rule to the two additional

defences was equally justifiable. Both these defences were forms of abandonment. The public use or sale of the invention with the knowledge and consent of the inventor before his application for a patent destroyed his right to obtain a patent, and if he had obtained it rendered the patent void. The neglect of an alien patentee to put his invention into the hands of the public, within the period then limited by law, in the same manner forfeited his right to the patent and rendered the patent void. And as the law in all cases presumed against abandonment and permitted the patentee to rely on that presumption, it consistently required a defendant, who purposed to set up in his defence facts which the law regarded as conclusive evidence of an abandonment, to give the plaintiff a fair opportunity to meet and overthrow them.

§ 990. Pleadings under the Act of 1870 and the Revised Statutes.

The act of 1870, in the paragraph now forming Section 4920 of the Revised Statutes, repeats the provisions of the act of 1836 with even greater clearness and precision. It enacts that in any action for infringement the defendant may plead the general issue, and having given the required notice, may prove on trial any one or more of certain special matters.¹ There are but two ways of construing this enactment. Either it means that under the general issue the defendant may make all his defences as at common law, but that in reference to some he must give notice to the plaintiff as a condition precedent to offering evidence thereon, or it means that under the general issue he can make no defence except those of which notice is required. The latter interpretation is, of course, absurd.² The former harmonizes with all preceding statutes and with the doctrine and the practice under the common law, and hence must be the correct statement of the rule. The special matters of which notice is essential under this act are

§ 990. ¹ That a defendant, upon filing the statutory notice, may give the special defences named in the act in evidence under the general issue, see *Bates v. Coe* (1878), 98 U. S. 31; 15 O. G. 337.

² Such a rule would forbid the defence of non-infringement, except under a special plea.

the same in substance as those mentioned in the act of 1836. To prior publication, prior patent is added as being a defence of the same nature and included in the spirit of the former. Abandonment by public use or sale is extended to embrace all modes of dedication to the public, and the failure of an alien patentee to practise his invention is omitted, that duty being no longer imposed on him by law.

§ 991. Summary of the Law concerning Pleadings in Actions for Infringement from 1790 to 1874.

As the result of this investigation and comparison of the various provisions of our Patent Laws concerning the form in which the defendant may present his different defences, the following propositions may be stated: (1) That no attempt has ever been made by Congress to change the rules of pleading in actions for infringement as they stood at common law when our patent system was inaugurated in 1790; (2) That at that period, and ever since, the general issue has been the proper form of pleading as to all defences which deny the existence of the plaintiff's right of action at the date of the filing of the plea; (3) That the rule requiring notice when certain defences are to be presented is a rule of evidence, intended not to provide a mode of raising issues but to protect the plaintiff against surprise; (4) That this rule has been and must be varied from time to time, as justice to the plaintiff may demand, but that such variations do not affect the attitude of either party before the court, or change the burden of proof, or impose any other obligation or disability upon the defendant than is contained in the simple duty of giving the prescribed notice to the plaintiff.

§ 992. General Issue, with or without Notice, a Sufficient Plea in all Defences except the Statute of Limitations.

Applying these propositions to the solution of the question now under consideration, it will be evident that the general issue is a sufficient plea for all defences which deny the existence of a cause of action in the plaintiff. Every defence which puts in issue any averment of the declaration comes within this description, whether it controverts the patent-

bility of the invention, or the right of the patentee to the monopoly, or the existence or validity of the patent, or the title of the plaintiff, or the practice of the invention by the defendant without due authority. Every defence which, admitting the former existence of a cause of action, claims that it has been extinguished either by release or by estoppel or by a former judgment belongs in the same class.¹ The only remaining defence is that of the Statute of Limitations which recognizes a subsisting cause of action, but avers that by his laches the plaintiff has lost the right to any legal remedy. This defence requires a special plea.² But while the general issue is permitted in the foregoing cases it is not incumbent on the defendant to employ it. He may plead specially any or all of his defences except that which denies his performance of the infringing act, and this is always his proper course when he desires to tender a specific issue to be simply traversed by the plaintiff.³ If in such special plea he sets up any fact of which notice to the plaintiff is required, the plea must not only be duly filed, as a plea, but served on the plaintiff as a notice in the mode provided by the statute.⁴ The same matter cannot be presented both in a special plea and by a notice under the general issue.⁵ When the defendant pleads

§ 992. ¹ Gould on Pleading, ch. vi. § 55.

² That the Statute of Limitations must be specially pleaded at common law, see 1 Chitty on Pleading, 479.

³ For a discussion of the relation of special pleas to the general issue, see *Hubbell v. De Land* (1882), 14 Fed. Rep. 471; 11 Bissell, 382; 22 O. G. 1883.

That the five special defences under Sec. 4920, Rev. Stat., may be made by special pleas with the general issue, and that other defences may be pleaded specially, with or without the general issue, see *Cottier v. Stimson* (1883), 9 Sawyer, 435; 18 Fed. Rep. 689.

That matter may be shown in special pleas or in the general issue with notice, see *Root v. Ball* (1846), 4 McLean, 177; 2 Robb, 513.

That the defendant may plead specially matters which are proper under the general issue, see *Day v. New England Car-Spring Co.* (1854), 3 Blatch. 179.

That the general issue with special plea of license, but no notice of special matter, is a good plea, see *Day v. New England Car-Spring Co.* (1854), 3 Blatch. 179.

That matters not admissible under a general issue and notice may be specially pleaded, see *Wilder v. Gayler* (1850), 1 Blatch. 597.

⁴ That where the special plea covers matter of which notice is required, it must be served like a notice, see *Cottier v. Stimson* (1884), 20 Fed. Rep. 906; 10 Sawyer, 212.

⁵ That the defendant cannot plead the general issue with notice and set up the same matter in a special plea in bar,

the general issue, whether with or without a notice, the plaintiff closes the pleadings with a *similiter*. If the defendant pleads specially, the plaintiff may either demur or traverse, or reply with new matter, as in other common-law actions, and thence the pleadings may proceed until an issue of law or fact is reached.⁶

see *Read v. Miller* (1867), 3 Fisher, 310; 2 Bissell, 12.

⁶ This question of pleadings is further complicated by Sec. 914, Rev. Stat., which provides that "the practice, pleadings, and forms and mode of proceeding in civil causes other than equity and admiralty causes, in the circuit and district courts, shall conform, as near as may be, to the practice, pleadings, and forms and modes of proceeding existing at the time in like causes in the courts of record of the State within which such circuit or district courts are held," etc. It has been claimed and decided that this provision applies to patent cases as well as others, see *Celluloid Mfg. Co. v. American Zylonite Co.* (1888), 34 Fed. Rep. 744; *Hayden v. Oriental Mills* (1883), 15 Fed. Rep. 605; 24 O. G. 601; *Cottier v. Stimson* (1883), 9 Sawyer, 435; 18 Fed. Rep. 689.

The reasons against this position are numerous and forcible. In the first place, the language of the rule does not include patent causes. It prescribes the adoption of local practice and procedure only so far as it exists *in like causes* in the State tribunals. Now, there are no *like causes* in reference to cases arising under the Patent Laws. In these cases the right, the wrong, and the remedy are *sui generis*, and require, as they have always had, a proceeding equally peculiar, which has ever been recognized as properly prescribed by Federal law alone.

In the second place, the complete destruction of that uniformity of procedure which is so essential to the de-

velopment of Patent Law must inevitably follow upon this application of the rule. That development depends largely upon the existence in this country of a body of trained patent lawyers, whose practice is unlimited by State boundaries, and whose learning, experience, and wisdom are thus rendered advantageous to the whole nation. The imposition upon this body of lawyers of the duty of acquainting themselves with the local practice of each State, and of changing their own methods as they pass from one area of conflict to another, can only be justified by greater necessities and clearer statutory enactments than have thus far appeared.

In the third place, this position contradicts the specific requirements of the Patent Law itself. Sec. 4919, Rev. Stat., expressly provides that the action at law for infringement shall be an action on the case. Sec. 4920, bestows on the defendant the privilege of pleading the general issue, *i. e.*, the *common law* general issue. As these sections are of equal authority with Sec. 914, all must be construed together, and no construction, saving all, is possible, except that which excludes patent cases from the operation of Sec. 914.

In the fourth place, it has been repeatedly decided that Sec. 914 does not apply to cases where Congress has legislated, nor include constructions placed upon common law remedies in the State courts, nor repeal by implication any previous act of Congress, providing a particular mode of proceeding. (See *Desty*, pp. 499, 500.) Hence it

§ 993. General Issue : when Notice also Required.

When the defendant pleads the general issue, he must also give a written notice to the plaintiff in any case where he desires to offer evidence tending to prove either of the five following states of fact: (1) That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect; (2) That the patentee had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; (3) That the invention had been patented or described in some printed publication prior to his supposed invention or discovery thereof; (4) That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; (5) That the invention had been in public use or on sale in this country for more than two years before his application for a patent or had been abandoned to the public.¹ The relation of these states of fact to the defences already enumerated demands attention in order that the cases in which notice is required may be more easily distinguished.

§ 994. Notice Required where the Defence rests on an Alleged Fraudulent Specification.

The first of these states of fact is identical with that which constitutes the eleventh defence. It exists where the specification actually misleads the public, and was intended so to

is evident that so far as the substance of the proceedings in actions at law for infringement are concerned, the Federal statutes and the common law rules of pleading, as recognized in these statutes, still form the guide of the pleader and the court, however widely the local customs may lead to a departure in minor matters not relative to the essence of the cause.

The foregoing reasons, though not

all that might be urged, are at least sufficient to warrant a dissent from the position taken in the cases first cited, until a higher authority endorses it, or it is fully accepted and acted on by the profession at large.

See also *Read v. Miller* (1867), 3 Fisher, 310; 2 Bissell, 12; *Goodyear v. Providence Rubber Co.* (1864), 2 Fisher, 499; 2 Clifford, 351.

§ 993. ¹ Sec. 4920, Rev. Stat.

do, by concealing some essential part of the invention, or by declaring some superfluous action or device to be necessary to its successful operation. A merely insufficient specification, as distinguished from a fraudulent one, although it fails to put the invention into the possession of the public, is not embraced in this state of facts, and may, therefore, be urged as a defence under the general issue without notice.¹

§ 995. Notice Required where the Defence rests on the Allegation that the Patentee or his Assignor is not a True Inventor or was not the First Inventor.

The second state of facts is of less definite limitations, and whether it embraces the second defence only, or the third defence only, or both defences, is rendered doubtful by the variations which have taken place in the language of the statutes in reference to these defences. The act of 1793 required a notice where the invention was not originally discovered by the patentee but had been in use anterior to his supposed discovery; and under this provision it was held that evidence of any practical use, however slight and temporary, was sufficient to sustain this defence and defeat the patent. As the inventive act of the true discoverer could not be complete without such practical use, and as at that time the idea that diligence in reduction to practice causes the complete inventive act to relate back to the time of conception had not been incorporated into our law, it would appear that this clause of the act of 1793 referred to cases of prior rival invention, and prescribed a notice whenever the defendant, though conceding that the plaintiff was a true inventor, desired to show that he had been anticipated in his discovery by the previous performance of an entire inventive act. Then followed the clause requiring notice of the defence that the patentee had surreptitiously obtained a patent for the discovery of another person. This could not be interpreted as a

§ 994. ¹ That no notice need be given where the defence rests on a merely defective but not fraudulent specification, see *Kneass v. Schuylkill Bank* (1820), 4 Wash. 9; 1 Robb, 303.

That whether a defective but not fraudulent specification is a defence, see § 970 and notes, *ante*.

mere repetition of the preceding proposition. The language was widely different. It spoke of a surreptitious or fraudulent act by which the discovery of another was appropriated to the patentee. In view of its connection, as well as phraseology, this clause could, therefore, refer only to a case where an imitator had obtained a monopoly for the results of another's inventive skill. In passing from the act of 1793 to the act of 1836 these clauses were materially changed, and the radical distinctions between these two cases were obscured. The interim had witnessed the development of the doctrine that the first inventor, if diligent in reduction, was the rightful patentee, although prior to his reduction a later conceiver had completed his inventive act; and frequent cases had made it evident that proof of prior conception on the part of another than the patentee was essential to sustain either the second or the third defence. As the law then stood, according to the decisions, an imitator, who had appropriated the conception of another, and a true inventor, who had himself conceived the principle of the invention after another had conceived it and while that other was using reasonable diligence in reduction, were equally unable to obtain a patent or to vindicate it if obtained. The act of 1836 in one clause required a notice that "the patentee was not the original and first inventor or discoverer;" and in a separate clause "that he had surreptitiously or unjustly obtained the patent for that which was in fact invented or discovered by another who was using reasonable diligence in adapting and perfecting the same." If the latter clause had stood alone, and if the words "surreptitiously," etc., had not led the mind back to the provisions of the act of 1793, no doubt would have arisen but that this clause referred entirely to cases where a later but true conceiver had procured a patent, although another inventor by a prior conception and a diligent but subsequent reduction was the party actually entitled thereto; while the former clause referred to cases where the defendant claimed that the patentee was anticipated as to the entire inventive act, including both conception and reduction, by his rival,¹ and to cases where

§ 995. ¹ To a correct understanding of relations of rival inventors to each other, this discussion, a clear recollection of the under the law, is essential. Rival in-

a mere imitator who of course could not be "the original and first discoverer" had obtained a patent; thus giving to these clauses, taken together, a construction covering all cases in which the patentee was alleged to be no inventor, or not the first to complete the inventive act, or not the first to conceive the idea of the invention. If this be the correct interpretation of the statute, as it probably is, the change which distinguishes the act of 1836 from that of 1793 consists in the transfer of the words "surreptitiously," etc., from the imitation of another's discovery to the wrongful appropriation by a subsequent inventor of that which had been previously

inventors may assume toward each other three distinct attitudes. The first conceiver may reduce to practice before reduction by the second conceiver; in which case the first conceiver is the only inventor whom the law can under any circumstances recognize. Or the second conceiver may reduce to practice before reduction by the first conceiver, although the first conceiver is employing reasonable diligence in that direction; in which case, also, the law regards the first conceiver as the only rightful patentee. Or the second conceiver may reduce to practice before reduction by the first conceiver, while the first conceiver is negligent in perfecting the invention; in which case, if the second conceiver obtains the prior patent, he is entitled to the monopoly against the first but negligent conceiver. Now, if the patent of the second conceiver were to be attacked by a defendant on the ground that the inventive act of the first conceiver had been first completed by reduction, it is obvious that the question of diligence would be immaterial. The second conceiver would occupy no better position than a mere imitator, since the law conclusively presumes that every invention, which has been in practical use to any extent whatever, is known to all alleged later inventors, and thus must have been simply copied by them. In such a

case the proper notice would be that described in this former clause, "that the patentee was not the original and first inventor or discoverer," etc., no mention being needed of the exercise of diligence on the part of the real inventor. But if the second conceiver had first reduced to practice and obtained a patent, an entirely different defence must be presented. The question would no longer be whether the inventive act of the patentee preceded that of his rival, for as a completed act it is conceded that it must have anticipated his. The issue raised is whether the diligence of the later reducer so connects his reduction with his conception that, although completed after that of the patentee, it does in law precede it and so confers on him the title to the patent. If this issue is decided in the negative the patent of the second conceiver stands; if in the affirmative, it falls. A notice under the former clause would, therefore, give no warning to the patentee of the real nature of the defence and might mislead him into a reliance on his earlier reduction as sufficient to sustain his patent. To avoid this surprise the second clause was inserted, requiring the defendant to forewarn him of the special inquiry into the causes to which the later reduction of his rival might be due.

conceived and was being diligently reduced to practice by another, leaving the mere imitator to forfeit his patent whether his imitation were fraudulent or not, and making the issue of a patent to the earliest completer of an inventive act "unjust" and "surreptitious" when a prior conceiver was exerting due diligence in reducing his idea to practice.² This view of the nature of the change in the statutes will be fully sustained by an examination of that current of decisions by means of which the alteration in the doctrine and consequently in the language of the law was gradually effected. These clauses of the act of 1836 are repeated in the act of 1870 and the Revised Statutes, and in the light of the foregoing considerations it appears that the notice "that the patentee had surreptitiously or unjustly obtained the patent for that which was in fact invented by another who was using reasonable diligence in adapting and perfecting the same" is required only in reference to a portion of the third defence, and is not applicable to the second, — the second being included in the fourth state of facts as previously enumerated.

§ 996. Notice Required where the Defence Rests on the Allegation of Prior Patent or Publication.

The third state of facts embraces two of the three conditions under which the patent must be void for want of legal novelty in the invention. The other condition is covered, with other matters, by the description of the fourth state of facts hereafter to be considered. A prior publication was made the subject of a notice in the acts of 1793 and 1836, and the provision was extended to a prior patent by the act of 1870.¹ Under our present law, therefore, the defendant must give notice whenever he desires to dispute the legal novelty of the invention by proving that it had been patented or described in some printed publication prior to its alleged invention by the patentee.²

² See §§ 960, 961, and notes, *ante*.

§ 996. ¹ Sec. 6, act of 1793; Sec. 15, act of 1836; Sec. 61, act of 1870; *Stevenson v. Magowan* (1887), 31 Fed. Rep. 824; 42 O. G. 1063.

notice or answer may be offered to show the date of the patented articles already in evidence, see *Atlantic Works v. Brady* (1883), 107 U. S. 192; 23 O. G. 1330.

² That a patent not set up in the

That unless notice is given of a prior

§ 997. Notice Required where the Defence Rests on the Allegation of Prior Use.

The fourth state of facts embraces a field of wide extent, and covers several different defences. Its relation to prior invention and to mere imitation of the discovery of another person has already been sufficiently discussed.¹ It also includes that third condition of the want of legal novelty, in which, although the performance of the original inventive act cannot be traced to any definite individual, the use and knowledge of the invention by others in this country, prior to the date of its alleged invention by the patentee, proves that it could not have then been new. All the Principal Patent Acts, except that of 1790, have, under varied forms of phrasology, contained the substance of this provision.² The act of 1793 required a notice when the defendant wished to show that the patented invention "was not originally discovered by the patentee but had been in use" anterior thereto.³ The act of 1836 made notice necessary when the defence was based upon the fact "that the patentee was not the original and first inventor or discoverer of the thing patented or of a substantial and material part thereof claimed as new."⁴ The act of 1870 and the corresponding clause in the Revised Statutes prescribe notice when the defendant claims that the patentee "was not the original and first inventor or discoverer of some material and substantial part of the thing patented."⁵ These clauses were intended to cover all cases of alleged prior use or knowledge of the invention under whatever form. The act of 1793

patent it will be disregarded by the court though referred to in the argument, see *Odiorne v. Denney* (1878), 13 O. G. 965; 3 Bann. & A. 287.

That a prior publication cannot be offered to prove a want of novelty unless due notice has been given, see *Silsby v. Foote* (1862), 14 How. 218.

That if the notice of publication is given only by special plea, and this is struck out by the court, the publication cannot be read, see *Foote v. Silsby* (1849), 1 Blatch. 445.

That a publication is not admissible

to show that the author had prior knowledge at a certain place unless due notice was given, see *Silsby v. Foote* (1862), 14 How. 218.

§ 997. ¹ See § 995 and notes, *ante*.

² The act of 1790 provided a method for the repeal of a patent on the ground that the patentee was not the first and true inventor, and allowed the same fact to be urged in defence to a suit for infringement under the general issue.

³ Sec. 6, act of 1793.

⁴ Sec. 15, act of 1836.

⁵ Sec. 61, act of 1870.

mentions such use in terms as equivalent to want of original discovery by the patentee. The later acts do not insert the word "use" in these clauses, but that it is included in the phrase they do employ is obvious from the subsequent requirement concerning the disclosure of the names and residences of those by whom the defendant claims that such use was made. As the provision stands in the acts now in force, it comprises every instance where the invention has been known or used in the United States before the date of the patentee's alleged inventive act, as well as where the origin of the invention in a prior rival, or prior sole inventor, can be definitely ascertained.⁶ The second defence, with part of the third, and one of the three branches of the fifth are thus comprehended in this provision.

§ 998. Notice Required where the Defence Rests on an Allegation of Abandonment to the Public.

The fifth state of facts includes those which constitute the defence of abandonment in both its forms, — that which consists in acts affording a conclusive presumption of an intention to surrender the invention to the public, and that in which the general conduct of the inventor manifests the same determination. Under the earlier acts no notice was required to admit evidence of abandonment in any form. It was first prescribed in the act of 1836, in reference to abandonment by public use and sale or by the failure of an alien patentee to place his invention within reach of the public. The act of 1870 extended the requirement to all cases of abandonment, and thus made notice essential whenever the seventh defence is to be urged.¹

⁶ That the defendant cannot set up prior knowledge, invention, or use unless the thirty days notice has been given, see *Roemer v. Simon* (1877), 95 U. S. 214 ; 12 O. G. 796 ; *Pickering v. Phillips* (1876), 10 O. G. 420 ; 4 Clifford, 383 ; 2 Bann. & A. 417.

That evidence of a prior use not referred to in the notice can only be considered upon the question of the

state of the art, see *Geier v. Goetinger* (1874), 7 O. G. 563 ; 1 Bann. & A. 553.

§ 998. ¹ That evidence of abandonment cannot be admitted without notice given, see *Bates v. Coe* (1878), 98 U. S. 31 ; 15 O. G. 337.

That upon due notice the defendant may show two years public use and sale before application, see *Bates v. Coe*

§ 999. Defences Available under the General Issue without Notice.

As the result of this examination of the rules governing notice in actions for infringement, it appears that of the twenty-five ordinary defences open to defendants in such actions nineteen may be set up and proved under the general issue, without notice or special plea.¹ These are: (1) That the alleged invention is not the product of inventive skill; (2) That it does not fall within either of the protected classes of inventions; (3) That it is not useful; (4) That no such patent as the one declared upon has ever existed; (5) That the plaintiff's patent was issued contrary to law; (6) That the invention described in the patent is neither an art, a machine, a manufacture, a composition of matter, a design, or an improvement; (7) That the specification is ambiguous; (8) That the Claim is excessive and has not been cured within reasonable time by a disclaimer; (9) That the Claim is ambiguous; (10) That the patent in force at the date of the infringement has been surrendered; (11) That the patent declared on has been repealed; (12) That the plaintiff has no such title to the patent as enables him to sue at law; (13) That the invention practised by the defendant is not identical with the one covered by the patent; (14) That the acts of the defendant in reference to the patented invention were not acts

(1878), 98 U. S. 31; 15 O. G. 337.

That public use and want of novelty as shown by prior use, &c., are two distinct defences, and require distinct and special notices, see *Myers v. Busby* (1887), 32 Fed. Rep. 670.

§ 999. ¹ Herein the reader will perceive one of the marked distinctions between the pleadings at law and in equity. In his answer in a court of equity, as will hereafter appear (§§ 1114-1117), the defendant must specially set forth every defence of which he would avail himself, and is regarded as admitting whatever of the plaintiff's claims he does not thus traverse or avoid. As the answer in equity em-

braces both pleadings and notice, and as many of the requisites of the answer, as they are commonly referred to by the courts, are stated generally and not confined to the answer as a pleading, it might by the incautious reader be supposed that the law of notice extended to every defence which can be urged whether at equity or law. Traces of error arising from this source may be seen in various declarations, in court opinions and text-writers, concerning the necessity of special pleadings in order to admit defences, many of which have been admissible under the general issue alone ever since the patent system was established.

of making, use, or sale; (15) That the practice of the invention by the defendant occurred before the issue of the patent or after it had expired; (16) That the practice of the invention by the defendant was in pursuance of his lawful rights; (17) That the plaintiff is estopped by his own conduct from pursuing his action against the defendant; (18) That the plaintiff's right of action against the defendant has been duly released; (19) That the plaintiff's right of action against the defendant has been extinguished by, or merged in, a judgment.² One defence must be made by special plea, the Stat-

² If the pleadings in all the earlier patent cases were conveniently accessible much light upon this question might be easily obtained by collecting instances in which these various defences have been made without objection under the general issue without notice. At present the result would scarcely justify the labor. Mr. Curtis, on the general authority of the common law, and the causes then decided, affirms that no notice is required in order to show that the invention is not patentable subject-matter (except upon the point of novelty); that it is not useful; that the patent was unlawfully issued; that the specification is defective; that the plaintiff has no title; and that the defendant does not infringe. These cover the defences enumerated in this sentence of the text, omitting the 10th, 11th, 17th, 18th, and 19th. He regards a special plea as proper in order to set up a surrender after the cause of action arose, though whether he deems it necessary is doubtful from the language used. As to the mode of pleading a repeal, an estoppel, a release, and a former judgment, he is silent. The recognition by this distinguished jurist, whose work has so long been referred to by our courts as reliable authority on nearly every question of Patent Law, of the general issue without notice as the proper form of pleading, except in the special cases

prescribed in the statute, must be of great weight in this discussion, even though no judgments could be found sustaining his position.

That the plea of not guilty puts the novelty of the invention in issue, see *Blanchard v. Putnam* (1869), 8 Wall. 420.

That a defendant may raise the issue whether the thing patented is a patentable invention without statutory permission, see *Gardner v. Herz* (1886), 118 U. S. 180; 35 O. G. 999; *Mahn v. Harwood* (1884), 112 U. S. 354; 30 O. G. 657.

That the invention is not of one of the patentable classes may be shown on the general issue, see *Guidet v. Barber* (1873), 5 O. G. 149.

That an answer in equity need not set up that the patented invention was not of one of the patentable classes, see *Hendy v. Golden State & Miners Iron Works* (1888), 127 U. S. 370; 43 O. G. 1117.

That the invalidity of the patent on the ground that the inventor's representative substantially amended the application without a new oath may be urged without stating it in the pleadings, see *Eagleton Mfg. Co. v. West, Bradley, & Carey Mfg. Co.* (1884), 111 U. S. 490; 27 O. G. 1237.

That no notice is needed to admit evidence of non-infringement, see *Evans v. Hettick* (1822), 7 Wheaton, 453; 1 Robb, 417.

ute of Limitations. Five can be introduced under the general issue only after due notice: (1) That the inventive act resulting in the invention was not performed by the patentee, and that his patent was thus surreptitiously and unjustly obtained for the discovery of another; (2) That the patentee, though a true inventor, was not the first to perform the inventive act; (3) That the patented invention is not legally new; (4) That it has been abandoned to the public; (5) That the specification fraudulently misrepresents the scope of the invention or the mode of rendering it available in practice. Or the defendant may, if he prefers it, plead specially either or all of these five defences, and plead the general issue as to all the others except the Statute of Limitations.³ When he does this, however, his special pleas must possess all the requisites which the law prescribes for notices under the general issue.

§ 1000. Form and Service of Notice.

The purpose of the law in requiring notice to be given to the plaintiff in reference to these defences is to secure to him an opportunity to prepare himself to meet them, and to guard him against unwarrantable surprise. The rules governing the form, the particularity, and the service of the notice have been framed with the same intent, and must be complied with unless waived by the plaintiff. The notice must be in writing,¹ and must be complete and precise enough to answer the end in view, giving to the plaintiff such information as to events, persons, places, and dates as will enable him to acquaint himself with the truth of the matters thus alleged.² If the first

³ That the special matters which may be given in evidence under the general issue may be pleaded specially, see *Cottier v. Stimson* (1884), 20 Fed. Rep. 906; 10 Sawyer, 212; *Cottier v. Stimson* (1883), 9 Sawyer, 435; 18 Fed. Rep. 689.

§ 1000. ¹ That the notice must be in writing, see *New York Pharnical Co. v. Tilden* (1883), 21 Blatch. 191; 14 Fed. Rep. 740; 23 O. G. 272; *Judson v. Bradford* (1878), 16 O. G. 171; 3 Bann. & A. 539.

² In *Silshy v. Foote* (1852), 14 How. 218, Curtis, J.: (223) "The act does not attempt to prescribe the particulars which such a notice shall contain. It simply requires notice. But the least effect which can be allowed to this requirement is that the notice should be so full and particular as reasonably to answer the end in view. This end was not merely to put the patentee on inquiry, but to relieve him from the necessity of making useless inquiries and researches, and enable

notice is defective, another properly constructed may be substituted.³ The notice is not to be pleaded, but must be served on the plaintiff or his attorney at least thirty days before the opening of the term at which the cause is to be tried, and a failure to make such service is good ground for a continuance of the case to the succeeding term.⁴ In equity the notice is given in the answer, and by amendment, under the permission of the court, the stringency of this rule as to service is sometimes avoided.⁵

him to fix with precision upon what is relied on by the defendants, and to prepare himself to meet it at the trial. This highly salutary object should be kept in view, and a corresponding disclosure exacted from the defendant of all those particulars which he must be presumed to know, and which he may safely be required to state, without exposing him to any risk of losing his rights. Less than this would not be reasonable notice, and therefore would not be such a notice as the act must be presumed to have intended."

That it is enough if the sources of the defendant's proofs are indicated with such certainty that the plaintiff can resort to and identify them, see *Smith v. Frazer* (1872), 5 Fisher, 543; 2 O. G. 175.

³ That the notice may be repeated if at first insufficient, see *Teese v. Huntingdon* (1859), 23 How. 2.

⁴ That the notice of special matters of defence is not to be pleaded but served as a notice on the plaintiff, see *Cottier v. Stimson* (1884), 20 Fed. Rep. 906; 10 Sawyer, 212.

That the notice may be given without an order of court, see *Teese v. Huntingdon* (1859), 23 How. 2.

That the thirty days of notice means thirty days before the beginning of the term of trial, see *Westlake v. Cartter* (1873), 6 Fisher, 519; 4 O. G. 636.

That notice of special matter must

be given thirty days before the term opens, not before trial merely, see *Westlake v. Cartter* (1873), 4 O. G. 636; 6 Fisher, 519.

That unless the notice is given thirty days before the trial, the evidence cannot be offered, see *Judson v. Bradford* (1878), 16 O. G. 171; 3 Bann. & A. 539; *Cammeyer v. Newton* (1876), 94 U. S. 225; 11 O. G. 287; *Teese v. Huntingdon* (1859), 23 How. 2.

That the notice may be given after depositions have been taken and the depositions may then be admitted if pertinent, see *Teese v. Huntingdon* (1859), 23 How. 2.

That unless the notice or its equivalent plea or answer is filed thirty days before the term the plaintiff is entitled to a continuance, see *Phillips v. Combstock* (1849), 4 McLean, 525; 2 Robb, 724.

⁵ That in equity the special defences are to be set up in the answer, not by plea or notice, see *Carrick v. McKesson* (1881), 19 Blatch. 369; 8 Fed. Rep. 807; *Bates v. Coe* (1878), 98 U. S. 31; 15 O. G. 337; *Pickering v. Phillips* (1876), 2 Bann. & A. 417; 10 O. G. 420; 4 Clifford, 383; *Doughty v. West* (1865), 2 Fisher, 553; *Pitts v. Edmonds* (1857), 2 Fisher, 52; 1 Bissell, 168.

See also §§ 1116, 1120, and notes, *post*, concerning notice in equity and its amendment when necessary.

§ 1001. **Notice of Fraudulent Specification : its Requisites.**

The notice of a fraudulent specification must point out the concealment or redundancy on which the defendant relies, and aver specifically that it originated in an intention to deceive the public.¹ A general statement that the specification was fraudulently made too comprehensive or too narrow is not sufficient.² An allegation that the Description is vague and ambiguous, or contains superfluous matter, or that the Claim is frivolous, without asserting an intention to deceive, is equally defective.³ The plaintiff must be forewarned both of the particular errors in his specification and of the defendant's claim that they were committed in pursuance of a design to mislead the public. Otherwise the notice merely gives information of such matters as the defendant might prove, under the defence of ambiguity in the specification, without notice, and compels him to rely for his defence, not on the fraudulent want of correspondence between the specification and the invention, but on the failure of the specification to disclose the invention to persons skilled in the art in a practical and operative form.

§ 1002. **Notice that the Patentee or his Assignor, though a True Inventor, Surreptitiously Obtained the Patent for the Invention while a Prior Inventor was Diligently Reducing to Practice.**

The notice that the plaintiff surreptitiously and unjustly obtained the patent for that which was in fact the invention of another, who was using reasonable diligence in adapting and perfecting it, should, in analogy to the requirements of

§ 1001. ¹ That where the defendant wishes to set up fraud or false representation in the patent, he must give notice thereof, see *Blake v. Stafford* (1868), 3 *Fisher*, 294 ; 6 *Blatch*. 195.

² That an allegation that "the claim is fraudulently and falsely made broader and more general and comprehensive than his invention," does not present any question of fact or allege fraud, see *Blake v. Stafford* (1868), 3 *Fisher*, 294 ; 6 *Blatch*. 195.

³ That allegations that the specification "is vague, ambiguous and uncertain, and does not sufficiently describe the invention," or that "it contains more than is necessary," or that "the Claim is frivolous," or that "for divers other reasons the patent is void," do not raise questions of fact except whether the invention is so described that any one could make it, see *Blake v. Stafford* (1868), 3 *Fisher*, 294 ; 6 *Blatch*. 195.

the notice of prior knowledge or use, give the name and residence of the prior inventor, the date of his conception of the idea of means, the date of its conception by the patentee, and aver that the former was employing due diligence in reducing it to practice.¹ No allegations of fraud or wilful wrong are necessary, — the defence being complete if the facts already stated are established, whatever may have been the motive or opinion of the patentee.

§ 1003. **Notice of Prior Patent or Publication : its Requisites.**

The notice of a prior patent must give the name of the patentee, and the date of his patent, and allege it to be prior to the date of the patent in suit.¹ The notice of prior publication must set forth its title and date of publication, and mention the particular arts or articles described therein which are now claimed to be identical with the patented invention, and name the volume and page of the publication in which such description is to be found.² No earlier date can be

§ 1002. ¹ That notice of prior invention must give the name and residence of the prior inventor, see *Kelleher v. Darling* (1878), 14 O. G. 673 ; 4 Clifford, 424 ; 3 Bann. & A. 438.

That a notice alleging that the prior conceiver was not the first inventor need not state that he abandoned the invention, see *Pennsylvania Diamond Drill Co. v. Simpson* (1886), 29 Fed. Rep. 288 ; 37 O. G. 218.

§ 1003. ¹ That a notice of prior patent must give the name of the patentee and date of the patent, see *Judson v. Bradford* (1878), 16 O. G. 171 ; 3 Bann. & A. 539 ; *Kelleher v. Darling* (1878), 14 O. G. 673 ; 4 Clifford, 424 ; 3 Bann. & A. 438 ; *Roemer v. Simon* (1877), 95 U. S. 214 ; 12 O. G. 796.

That a notice of prior patent must allege its date as being prior to the date of the patent in suit, see *Kelleher v. Darling* (1878), 14 O. G. 673 ; 4 Clifford, 424 ; 3 Bann. & A. 438.

² In *Silsby v. Foote* (1852), 14 How.

218, Curtis, J. : (223) “ Now we do not perceive that the defendants would be exposed to the risk of losing any right, by requiring them to indicate, in their notice, what particular things described in the printed publication they intended to aver were substantially the same as the thing patented. This they might have done either by reference to pages or titles, and perhaps in other ways, for the particular manner in which the things referred to are to be identified must depend much upon the contents of the volume and their arrangement.”

In *Foote v. Silsby* (1849), 1 Blatch. 445, Nelson, J. : (462) “ The notice should have specified the page or heading in the public work in which the invention had been previously described, so as to enable the patentee to turn to the article without searching through the entire volume. There can be no difficulty in giving a particular reference to the part of the book intended to be relied on, as the defendant is pre-

ascribed either to a patent or a publication than its actual date of issue.³ A printed publication or a patent, not properly set out in the notice, cannot be used as evidence to show that the author or the patentee had prior knowledge of the invention; nor is defective notice of a prior publication aided by the evidence of experts that they would know where to look in it for a description of the patented invention.⁴

§ 1004. Notice of Prior Use : its Requisites.

The notice of prior invention varies according to the nature of the defence which is to be supported by the evidence. When the defendant alleges that the patentee has imitated and appropriated the invention of another person, the notice should disclose the name and residence of the true inventor, with the date of his inventive act, and aver that the patentee obtained his own ideas of the invention from the art or article thus produced.¹ If the defendant admits that the patentee is a true inventor, but claims that a rival inventor first conceived the idea and first reduced it to practice, he must state the name and residence of the prior inventor, with the date of his inventive act, as well as that of the inventive act of the patentee.² But when the defendant denies the legal

sumed to have examined the article and to be familiar with it and with the page or heading where it may be found. A general reference to the work is calculated to mislead and embarrass the party, and ought not to be sanctioned, especially as there can be no difficulty in giving a more specific one."

That the notice of a prior publication, if it be a large book, must give the page or heading, see *Silby v. Foote* (1852), 14 How. 218; *Foote v. Silby* (1849), 1 Blatch. 445.

³ That the date given by the notice to a patent or publication must not be earlier than its true issue, see *Kelleher v. Darling* (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438.

⁴ That a defective description of a publication is not aided by offering it

to show the prior knowledge of the author of the book, nor by the evidence of experts and others that they should know where to find the description in the book, see *Foote v. Silby* (1849), 1 Blatch. 445.

§ 1004. ¹ This rule in regard to notice is here stated on the supposition that the law still requires some notice to be given in such cases under the fourth state of facts, though the specific defence, as it stood in the act of 1793, has disappeared from the statutes. If notice is necessary, the requisites of such notice cannot be less or other than those mentioned in the text. See *Kelleher v. Darling* (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438.

² That notice of prior invention must give the names and residences of the

novelty of the invention on the ground of prior use, his notice must be of an entirely different character. It is immaterial to the defence of prior use whether the first inventor of the art or article is known or unknown, — the fact that the invention itself was known or used before the patentee invented it being fatal to his patent. Here the notice must state the names and residences of the persons who had knowledge of the invention, or who used it, before the patentee invented it, and the localities in which it was used.³ It being the object of this notice to save the plaintiff from useless inquiries, and not merely to put him upon inquiry, the defendant must give such detailed information as he possesses, and can fairly impart without prejudicing his own rights. The notice is sufficient when the plaintiff can readily identify the persons and places therein named, and resort to them for further knowledge.⁴ The persons to be named are not the witnesses by whom a prior knowledge or use is now to be proved, but

persons who invented it, see *Kelleher v. Darling* (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438.

³ That notice of prior knowledge or use must give the names and residences of the persons having such knowledge, and state where and by whom it had been used, see *Searls v. Bouton* (1882), 12 Fed. Rep. 140; 21 O. G. 1784; 20 Blatch. 426; *Allis v. Buckstaff* (1882), 22 O. G. 1705; 13 Fed. Rep. 879; *Judson v. Bradford* (1878), 16 O. G. 171; 3 Bann. & A. 539; *Kelleher v. Darling* (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438; *Roemer v. Simon* (1877), 95 U. S. 214; 12 O. G. 796; *Earl v. Dexter* (1874), 6 O. G. 729; Holmes, 412; 1 Bann. & A. 400; *Union Paper Bag Mach. Co. v. Newell* (1874), 11 Blatch. 549; 1 Bann. & A. 113; 5 O. G. 459; *Decker v. Grote* (1873), 3 O. G. 65; 10 Blatch. 331; 6 Fisher, 143; *Seymour v. Osborne* (1870), 11 Wall. 516; *Graham v. Mason* (1869), 5 Fisher, 1; 4 Clifford, 88; *Agawam Co. v. Jordan* (1868), 7 Wall. 583; *Judson v. Cope* (1860), 1 Fisher, 615; 1 Bond, 327;

Hays v. Sulsor (1859), 1 Fisher, 532; 1 Bond, 279.

That under Sec. 6, act of 1793, upon notice of use by A and others the defendant might prove a use by others as well as A, see *Treadwell v. Bladen* (1827), 4 Wash. 703; 1 Robb, 531; *Evans v. Kremer* (1816), Peters C. C. 215; 1 Robb, 66.

That due notice having been given, coupled with a statement that others, then unknown, had knowledge and used, and asking that when their names are discovered they might be added, such additions were allowed, no objection being made, and further notice is thus waived, see *Roemer v. Simon* (1877), 95 U. S. 214; 12 O. G. 796.

That where one person was named as having prior knowledge and was not examined, another person not named might be called to prove the former's knowledge, see *Many v. Jagger* (1848), 1 Blatch. 372.

⁴ In *Smith v. Frazer* (1872), 2 O. G. 175, McKennan, J.: (177) "The act was designed to secure the disclosure of

the individuals who had such knowledge or made such use of the invention before it was invented by the patentee, — any person, though not named in the notice, being a competent witness to prove such prior knowledge or use on the part of those actually named.⁵ The notice may or may not mention

specific facts, presumptively without the complainant's knowledge, so that the patentee might be informed of the exact nature of the defence set up, and might be enabled to obtain full knowledge of all the facts and circumstances pertaining to it. Where prior knowledge and use are alleged, he must be informed of the name and residence of the person possessing such knowledge, and of the place where such use occurred. But it was not intended to dispense with the necessity of inquiry and research on the part of the patentee. The notice is only a guide to the sources of the defendant's proofs. If they are indicated with such distinctness that the complainant can readily identify and resort to them, the purpose of the law is answered." 5 Fisher, 543 (547).

In *Wise v. Allen* (1869), 9 Wall. 737, Miller, J. : (740) "Nor do we think that the party giving notice is bound to be so specific as to relieve the other from all inquiry or effort to investigate the facts. If he fairly puts his adversary in the way that he may ascertain all that is necessary to his defence or answer, it is all that can be required, and he is not bound by his notice to impose an unnecessary and embarrassing restriction on his own right of producing proof of what he asserts. We are all, therefore, of opinion, that when, in addition to the particular town or city in which such large objects as millstones are used, the name and residence of the witness by whom that use is to be proved is also given, there is sufficient precision and certainty in the notice."

⁵ In *Allis v. Buckstaff* (1882), 13 Fed. Rep. 879, Dyer, J. : (884) "There are

reported cases to the effect that the names of the witnesses, by whom it is expected to prove the alleged prior use, should be stated in the answer. Such is the intimation, if not the positive ruling, in *Richardson v. Lockwood*, 6 Fisher, 454. But all cases in which it has been so held are overruled by *Roemer v. Simon*, 95 U. S. 219, and *Planing Machine Co. v. Keith*, 101 U. S. 479, wherein it is held that only the names of those who had invented or used the anticipating machine or improvement, and not of those who are to testify touching its invention or use, are required to be set forth." 22 O. G. 1705 (1706).

See also *Sutro v. Moll* (1881), 19 Blatch. 89 ; 8 Fed. Rep. 909 ; *Woodbury Patent Planing Mach. Co. v. Keith* (1879), 101 U. S. 479 ; 17 O. G. 1031 ; *Planing Mach. Co. v. Keith* (1879), 4 Bann. & A. 100 ; *Roemer v. Simon* (1877), 95 U. S. 214 ; 12 O. G. 796 ; *Wilton v. Railroads* (1847), 1 Wall. Jr. 192 ; 2 Robb, 641.

For cases in which it was stated that the names of the witnesses must be given, see *Wise v. Allen* (1869), 9 Wall. 737 ; *Judson v. Cope* (1860), 1 Fisher, 615 ; 1 Bond, 327.

Other cases recognize the same doctrine indirectly. See *La Baw v. Hawkins* (1874), 6 O. G. 724 ; 1 Bann. & A. 428 ; *Richardson v. Lockwood* (1873), 4 O. G. 398 ; 6 Fisher, 454.

It is easy to see the origin of this error. As the witnesses called to prove prior use or knowledge were frequently the very persons who had used or known the invention before the plaintiff's inventive act, the name "witnesses" was applied to them in the latter capacity as

the name and residence of the original inventor.⁶ The locality in which the prior use of the invention was made must be alleged with reasonable certainty. It is not sufficient to describe it as occurring in a given county.⁷ The mention of certain mining or manufacturing establishments within the county as the places of its use is, however, equally definite with that of towns or villages, and complies with this requirement of the law.⁸ The statement of the residences of the persons using does not dispense with that of the places of the use, although the two localities may be the same. The notice must not only point out the places *of* which the users were inhabitants but those *at* which they employed the invention.⁹ This is necessary in order to enable the plaintiff to inquire into the fact of use and the nature of the invention used, as well as concerning the persons by whom the use is claimed to have been made. The date of such knowledge and use need not be stated except by the general averment that it preceded the inventive act of the patentee.¹⁰ The allegations of the notice must not be limited to one or more of the elements of which the patented art or article consists, but must extend to the entire invention claimed.¹¹ The want of such a notice

well as in that of individuals giving testimony before the court. By "witness," in most of the cases where notice of "the names and residences of witnesses" is spoken of, is evidently meant not the mere testifier, but the testifier to his own prior use or prior knowledge. Thence the transition to the idea that the witness, as a testifier generally, was the person to be named was natural.

⁶ That notice of prior use need not name the original inventor, see *Evans v. Kremer* (1816), Peters C. C. 215; 1 Robb, 66.

⁷ That to give the name of a county as the place of knowledge or use is not sufficiently definite, see *Hays v. Sulsor* (1859), 1 Fisher, 532; 1 Bond, 279.

⁸ That it is enough to name certain mining establishments in a certain county as the places of use, see *Smith v. Frazer* (1872), 5 Fisher, 543; 2 O. G. 175.

That under Sec. 6, act of 1793, notice of prior use in some places admits evidence of it in other places not named, see *Evans v. Eaton* (1818), 3 Wheaton, 454; 1 Robb, 243.

That under Sec. 6, act of 1793, when the notice named certain mills where the invention was used evidence as to other mills might be given, see *Evans v. Eaton* (1816), Peters C. C. 322; 1 Robb, 68.

⁹ That a notice naming persons using as *of* a certain place but not *at* any place is not sufficient, see *Searls v. Bouton* (1882), 21 O. G. 1784; 12 Fed. Rep. 140; 20 Blatch. 426.

¹⁰ That the notice need not mention the time when the witness knew or used, but only his name and residence and the place of use, see *Phillips v. Page* (1860), 24 How. 164.

¹¹ That the notice of prior use must

cannot be supplied by any form in which the evidence may be presented.¹² Neither a prior publication, nor a patent, nor a rejected application, can be offered to prove use or knowledge by the author, patentee, or applicant, unless preceded by the proper warning to the plaintiff.¹³ Where the plaintiff or his licensee was himself the prior user, and is now endeavoring to enforce a patent obtained by one whom his own acts have anticipated no notice of such prior use is necessary.¹⁴

§ 1005. Notice of Abandonment to the Public: its Requisites.

The notice of abandonment also differs according to the nature of the evidence to be adduced. Abandonment by public use or sale and abandonment by general conduct, though

apply to the whole invention as patented, see *Parks v. Booth* (1879), 102 U. S. 96; 17 O. G. 1089.

That the notice need not specify the particular portion of the letters-patent to which the evidence will relate, see *Westlake v. Cartter* (1873), 4 O. G. 636; 6 Fisher, 519.

¹² That no evidence of any form against the novelty of the invention can be admitted unless the proper notice is given, see *Marks v. Fox* (1880), 6 Fed. Rep. 727; 18 Blatch. 502; *American Saddle Co. v. Hogg* (1872), 2 O. G. 595; 6 Fisher, 67; *Holmes*, 177; *Railroad Co. v. Dubois* (1870), 12 Wall. 47.

That the witness cannot be examined unless the notice is given as the law requires, see *Philadelphia & Trenton R. R. Co. v. Stimpson* (1840), 14 Peters, 448; 2 Robb, 46.

That if the evidence be received without notice and against objection the Supreme Court will reverse the judgment, though the appeal were based on different grounds, see *Blanchard v. Putnam* (1869), 8 Wall. 420.

¹³ That in the absence of a notice of prior use, foreign patents and other evidence showing knowledge in this country are not admissible, see *Earl v. Dexter*

(1874), 6 O. G. 729; *Holmes*, 412; 1 Bann. & A. 400.

That the existence of the alleged prior devices cannot be shown without proper notice of prior use, see *Howe v. Williams* (1863), 2 Fisher, 395; 2 Clifford, 245.

That without notice of prior use the rejected application of a third person cannot be proved, see *Union Paper Bag Mach. Co. v. Pultz & Walkley Co.* (1878), 15 O. G. 423; 15 Blatch. 160; 3 Bann. & A. 403.

That a notice stating that a certain person made a prior application, not naming his residence, does not warrant the admission of his testimony as to his prior knowledge or use, see *Decker v. Grote* (1872), 3 O. G. 65; 10 Blatch. 331; 6 Fisher, 143.

¹⁴ That notice need not be given of the time, place, and person of prior use when the person is the plaintiff himself or his licensee, see *American Hide & Leather Splitting & Dressing Mach. Co. v. American Tool & Machine Co.* (1870), 4 Fisher, 284; *Holmes*, 503. This proposition really belongs under the doctrine of public use, as the case cited shows, but is equally true of prior use when occurring as stated in the text.

not distinct defences, are widely separated from each other by the conclusive presumption attaching to the acts which constitute the former, and the defendant is required in his notice to specifically point out which of these two methods of abandonment he intends to prove.¹ If he relies on both, they must be set forth in separate allegations.² The notice of simple abandonment by general conduct is sufficient when it states that fact without particulars. The notice of abandonment by public use or sale must aver that such sale or use occurred more than two years before the application for a patent.³ A notice of such use or sale more than two years before the invention was made by the patentee is insufficient, no such defence being known to the law.⁴ Under a notice of public use or sale in proper form, evidence of prior use is inadmissible.⁵

§ 1006. Evidence as to the State of the Art Admissible without Notice.

No notice is required in order to admit evidence concerning the state of the art at the date when the inventive act of the patentee is claimed to have been performed.¹ The primary

§ 1005. ¹ That abandonment by public use and sale rests on different principles from abandonment by general conduct, see *Jones v. Sewall* (1873), 6 Fisher, 343 ; 3 O. G. 630 ; 3 Clifford, 563.

² That if both modes of abandonment are to be urged, they must be separately noticed, see *Jones v. Sewall* (1873), 6 Fisher, 343 ; 3 O. G. 630 ; 3 Clifford, 563.

That abandonment by public use must be specially alleged, see *Bates v. Coe* (1878), 98 U. S. 31 ; 15 O. G. 337 ; *Wyeth v. Stone* (1840), 1 Story, 273 ; 2 Robb, 23.

³ That the allegation of public use or sale must aver it to have been more than two years before the application, see *Agawam Co. v. Jordan* (1868), 7 Wall. 583 ; *Root v. Ball* (1846), 4 McLean, 177 ; 2 Robb, 513.

That the consent of the inventor to the public use need not now be alleged, see *Campbell v. City of New York* (1888), 35 Fed. Rep. 504.

⁴ That notice of public use or sale two years before the plaintiff's *invention* is improper, see *Kelleher v. Darling* (1878), 4 Clifford, 424 ; 14 O. G. 673 ; 3 Bann. & A. 438.

⁵ That prior use cannot be shown under a notice of public use, see *Kelleher v. Darling*, (1878), 4 Clifford, 424 ; 14 O. G. 673 ; 3 Bann. & A. 438.

§ 1006. ¹ That evidence of the state of the art is admissible without notice, see *Stevenson v. Magowan* (1887), 31 Fed. Rep. 809 ; 42 O. G. 1063 ; *Eachus v. Broomall* (1885), 115 U. S. 429 ; 33 O. G. 1265 ; *Brown v. Piper* (1875), 91 U. S. 37 ; 10 O. G. 417 ; *La Baw v. Hawkins* (1874), 6

purpose of such evidence is to define the exact scope of the alleged invention by comparing the point to which the art had attained before the invention was made with that to which it was carried by the invention. Such evidence may actually disclose an entire want of legal novelty in the alleged invention, but this constitutes no reason for excluding it, although the court will not permit the defendant to derive any advantage from it upon that defence.² Thus patents issued before the date of the invention, the use of instruments of similar character by different persons, and the existence of articles resembling or identical with that covered by the patent, may be proved by the defendant, without notice, in all cases where they tend to throw light upon the art to which the patented invention appertains.³ Evidence not having this effect, though offered for this purpose, is not admissible unless the proper notice has been served.⁴

O. G. 724 ; 1 Bann. & A. 428 ; Richardson v. Lockwood (1873), 4 O. G. 398 ; 6 Fisher, 454 ; American Saddle Co. v. Hogg (1872), 5 Fisher, 353 ; 2 O. G. 59 ; Holmes, 133 ; Vance v. Campbell (1861), 1 Black, 427.

² That evidence admissible only to show the state of the art must be confined thereto, though it also shows prior use, see Zane v. Soffe (1880), 2 Fed. Rep. 229 ; 5 Bann. & A. 284 ; Geier v. Goettinger (1874), 7 O. G. 563 ; 1 Bann. & A. 553.

³ That prior patents may be offered without notice to show the state of the art and the proper construction of the present patent, see Grier v. Wilt (1887), 120 U. S. 412 ; 38 O. G. 1365 ; Westlake v. Cartter (1873), 4 O. G. 636 ; 6 Fisher, 519.

That a patent not set up in the answer cannot be admitted to show priority, but only the state of the art, see American Saddle Co. v. Hogg (1872), 2 O. G. 59 ; Holmes, 133 ; 5 Fisher, 353 ; Railroad Co. v. Dubois (1870), 12 Wall. 47.

That the existence and use of an

article may be proved without notice to show the state of the art, but not to show prior use, and must be confined thereto, see Zane v. Soffe (1880), 2 Fed. Rep. 229 ; 5 Bann. & A. 284.

That evidence as to the existence of certain improvements at the date of the plaintiff's invention is admissible without notice, see Vance v. Campbell (1861), 1 Black, 427.

That the date of a patent not set up in the answer may be shown as evidence of the existence at that time of a device otherwise shown to be in actual use, see Atlantic Works v. Brady (1882), 107 U. S. 192 ; 23 O. G. 1330.

That prior publications cannot be offered to show the state of the art, see Westlake v. Cartter (1873), 4 O. G. 636 ; 6 Fisher, 519.

⁴ That when a patent not mentioned in the notice could only show that plaintiff's patent was anticipated, it is not admissible to prove the state of the art, see American Saddle Co. v. Hogg (1872), 5 Fisher, 353 ; 2 O. G. 59 ; Holmes, 133.

§ 1007. Evidence in Actions at Law for Infringement Governed by the Usual Rules.

The rules of evidence in actions for infringement are, in their general character, identical with those by which the Federal courts are guided in other suits at law. The various issues which arise in patent litigation differ so widely, however, from those which are presented by any controversy concerning other rights and wrongs that in their details, as developed and applied by judicial decision, those rules now constitute a peculiar and distinct department of our practical jurisprudence. In their discussion in these pages, such of their features as are derived from the common law of evidence may properly be passed over without special consideration, our attention being directed chiefly to those particular precepts and provisions which distinguish them as members of the body of our Patent Law.

§ 1008. Rules of Evidence in the Federal Courts Identical with Those in Force in the Local Courts.

The Judiciary Act of 1789, according to the interpretation given to it by the Supreme Court of the United States, provided that the rules of evidence prevailing in each State should be applied in actions at common law in the Federal courts held within that State, except when otherwise required by the Constitution, treaties, or statutes of the United States.¹ The act of 1862, affirming in this respect the Judiciary Act, enacted that the laws of the State in which the court is held should determine the competency of witnesses in trials at law in the Federal courts. Later acts removed from witnesses all incompetency on account of color, or of interest in the issue to be tried. Subject, therefore, to the modifications which are now to be considered the rules of evidence in actions for infringement, whether relating to the competency of witnesses on any other ground than that of color or interest, or to the production and effect of testimony, are those recog-

¹ That the rules of evidence in common law cases in the Federal Courts correspond with those in the State courts, except where modified by acts of Congress, according to the act of 1789, see Curtis, Jurisdiction and Practice of U. S. Courts, 227.

nized and followed by the courts of the State in which the Federal court is held.²

§ 1009. Facts of which the Federal Courts in Actions at Law for Infringement Take Judicial Notice.

All courts of common law jurisdiction take judicial notice of six classes of facts, concerning which no evidence is required from either party. These are: (1) Political facts, such as the existence of other nations, their flags and seals, the law of nations, the territorial divisions and political constitution of the State, the public matters which affect the State, its elections and general legislative meetings, its weights and measures, coins and other circulating medium, and its public and special fasts and festivals; (2) Legal facts, including the public laws of the State, its various courts with their jurisdiction and rules of practice, their officers and seals, the names and persons of their judges, the general customs of trade, and such other matters relating to law and usage as are equally well known to all citizens; (3) Official facts, embracing the names and functions of the President, senators, representatives, ambassadors, marshals, sheriffs, and all who hold office in the State by virtue of public election or appointment, the signatures of the President, marshals, and sheriffs, and the signatures and seals of notaries; (4) Public history, including the facts which constitute the political, social, and topographical development of the State and which are generally known and regarded as true; (5) Natural history, comprising such facts in nature as are permanent and uniform, and do not require special investigation in order to discover them, such as the number of days in a given month, the succession of the seasons, and the coincidence of week-days with certain days of the month and year; (6) The vernacular language, or the meaning of all common English words, and of such terms of art as are in common use.¹ As a general rule the Federal courts, in the trial of actions at law for infringe-

² Sec. 858, Rev. Stat.

§ 1009. ¹ See 1 Greenleaf Ev. §§ 4-6; Robinson, Elementary Law, § 293.

That courts take judicial notice of all

other nations and their seals of State, but not of their inferior departments and seals, see *Schoerken v. Swift & Courtney & Beecher Mfg. Co.* (1881),

ment, accept these six classes of facts as established, without the production of any testimony, and a judge may refer to any source of recognized authority in order to refresh his memory concerning them.² They also take judicial notice of all objects in common use in the arts, and of all matters of ordinary knowledge, including matters of science, but not of the substantial differences between the successive conditions of the same material in the various stages of its manufacture.³

19 O. G. 1493 ; 7 Fed. Rep. 469 ; 19 Blatch. 209.

That a French patent, certified by the Director of the Conservatoire National des Arts et Metiers de France, under seal of that Department, verified by the Minister of Agriculture and Commerce and the Minister of Foreign Affairs under their seals, is duly authenticated and admissible, see *Schoerken v. Swift & Courtney & Beecher Mfg. Co.* (1881), 19 O. G. 1493 ; 7 Fed. Rep. 469 ; 19 Blatch. 209.

² That matters of public notoriety, affecting the right of the applicant to a patent, will be taken notice of judicially, see *Anson v. Woodbury* (1877), 12 O. G. 1.

That courts may refresh their recollections by any safe means, see *Brown v. Piper* (1875), 91 U. S. 37 ; 10 O. G. 417.

³ That a court will take judicial notice of all things in common use and of all matters of common knowledge, see *Kaolatype Engraving Co. v. Hoke* (1887), 30 Fed. Rep. 444 ; 39 O. G. 589 ; *Reed v. Lawrence* (1886), 29 Fed. Rep. 915 ; *King v. Gallun* (1883), 109 U. S. 99 ; 25 O. G. 980 ; *McCloskey v. Du Bois* (1881), 19 O. G. 1286 ; 20 O. G. 371 ; 8 Fed. Rep. 710 ; 19 Blatch. 205 ; *Terhune v. Phillips* (1878), 99 U. S. 592.

That courts will judicially notice whatever is generally known, including matters of science, see *Slawson v. Grand St., Prospect Park, & Flatbush R. R.*

Co. (1883), 107 U. S. 649 ; 24 O. G. 99 ; *Brown v. Piper* (1875), 91 U. S. 37 ; 10 O. G. 417.

That courts will take judicial notice of mechanical devices of common knowledge, see *Aron v. Manhattan Ry. Co.* (1886), 26 Fed. Rep. 314 ; 34 O. G. 1508 ; *Knapp v. Benedict* (1886), 26 Fed. Rep. 627 ; 35 O. G. 1226.

That the court may avail itself of common knowledge of things to aid it in defining the scope of a patent, see *Knapp v. Benedict* (1886), 35 O. G. 1226 ; 26 Fed. Rep. 627.

That where, on a demurrer in equity, the facts of which the court must take judicial notice, show that the invention is not patentable, the bill may be dismissed, see *West v. Rae* (1887), 33 Fed. Rep. 45 ; *Kaolatype Engraving Co. v. Hoke* (1887), 30 Fed. Rep. 444 ; 39 O. G. 589.

That a court will not dismiss on demurrer for non-patentability unless the case is perfectly clear, see *Eclipse Mfg. Co. v. Adkins* (1888), 36 Fed. Rep. 554 ; *Blessing v. Copper Works* (1888), 34 Fed. Rep. 753.

That where a patent is manifestly void it is the duty of the court to charge the jury to render a verdict for the defendant, see *Torrent & Arms Lumber Co. v. Rodgers* (1884), 112 U. S. 659 ; 30 O. G. 449.

That courts do not take judicial notice of the contents of encyclopedias, etc., unless they are within the knowledge of persons in general, see *Kaola-*

§ 1010. Competency of Witnesses.

Any person of sufficient age and mental capacity is a competent witness in an action for infringement, unless the laws of the State in which the court is held exclude him on some other ground than that of interest or color.¹ In judging of the credibility of a witness, however, the jury may consider his interest in the cause, as a motive operating upon his disposition to disclose the truth, and in this point of view the rules by which the existence and degree of his interest were formerly determined as a test of competency are still important.² The ancient rules were founded upon sound reason and long experience, and in departing from them under the exigencies of modern jurisprudence, the legislatures and the courts have not intended to put interested and disinterested parties on an equal footing as witnesses to controverted facts. The interest which formerly disqualified altogether still weakens the effect of testimony, and ought to exercise a potent influence on the judgment of a jury when evidence proceeding from individuals once incompetent to testify is contradicted by evidence to which no corresponding imputation is attached. The interest which under the earlier rule rendered a witness incompetent was either that of a party to the suit, or that arising from the certainty that he must either gain or lose by the direct legal operation and effect of the judgment or that the record would be legal evidence for or against him in some other action. An interest in the question to be decided, or a remote and contingent interest in the cause itself, was not sufficient to disqualify.³ This distinction is of great consequence in patent cases, where one question—the validity of the patent—may form the only real issue in numerous suits against different infringers, all of whom are, therefore, interested in the question to be decided in each case, though not

type Engraving Co. v. Hoke (1887), 30 Fed. Rep. 444; 39 O. G. 589.

That courts do not take judicial notice of substantial differences between the different states of materials, such as lead, &c., see McCloskey v. Du Bois (1881), 19 O. G. 1286; 20 O. G. 371; 8 Fed. Rep. 710; 19 Blatch. 205.

§ 1010. ¹ Sec. 858, Rev. Stat.

² That the defendant's witnesses are infringers or employees of infringers may be shown to affect their evidence, see Wetherell v. Keith (1886), 27 Fed. Rep. 364; 37 O. G. 337.

³ See 1 Greenleaf, Ev., § 389-397.

in the judgment to be rendered for or against the individual defendant. Thus, while the ancient rule was still in force, a witness was competent although another suit was pending against him for the infringement of the same patent, or though he was conceded to have used devices resembling those belonging to the plaintiff.⁴ Persons who claimed exclusive privileges under the same patent, such as grantees of other sectional interests or the assignor of the defendant when not bound by a covenant of warranty, and persons whose sole connection with the suit consisted in the pecuniary aid which they afforded to the parties litigant, were also competent to testify.⁵ In all these and in similar cases the jury are to pass upon the credibility of the witness on the ordinary grounds of interest and bias, uninfluenced by that presumption of a want of credibility which exists when he possesses such an interest as would formerly have excluded him from offering any evidence whatever.

§ 1011. Credibility of Witnesses.

The credibility of a witness is measured by his ability as well as his disposition to disclose the truth. His ability to disclose the truth depends upon the accuracy of his perceptions, the retentiveness of his memory, and his power to embody his recollections in suitable expressions. Perceptions are more or less accurate according to the familiarity of the witness with the object perceived, and the degree of attention which he devotes to its examination. The retentiveness of his memory is determined by his natural or acquired capacity

⁴ That a witness is competent though he is defendant in another action for infringement, see *Evans v. Hettich* (1822), 7 Wheaton, 453 ; 1 Robb, 417.

That a witness who uses a device like the plaintiff's is competent, since the judgment cannot affect him, see *Evans v. Eaton* (1818), 3 Wash. 443 ; 1 Robb, 193.

⁵ That a grantee of a different sectional interest from the plaintiff is a competent witness, the verdict not being evidence against him, see *Buck v. Hermance* (1848), 1 Blatch. 322.

That the assignor of an alleged prior patent to the defendant is a competent witness, having no interest in the event of the suit, see *Treadwell v. Bladen* (1827), 4 Wash. 703 ; 1 Robb, 531.

That a person who contributes to a fund to pay the expenses of witnesses in attending court is a competent witness, as the verdict could not affect him, see *Evans v. Hettick* (1818), 3 Wash. 408 ; 1 Robb, 166.

of recollection, and the occasion he has had to keep the controverted fact in mind. His power to represent the fact, as he remembers it, in words is governed by his ordinary command of language, and by his knowledge or ignorance of the terms in which the characteristics of the fact remembered are commonly described. Among honest and unbiassed witnesses there may thus be vast differences of credibility, arising solely from the differences in their ability to perceive, remember, and narrate the truth. This is particularly the case in testimony relating to inventions, the proper understanding of which so often demands extensive prior knowledge and the most careful and exact investigation, while their distinctive characteristics easily escape the memory unless it is constantly refreshed by re-investigation, and even when clearly recollected can be adequately described only in technical language which the most intelligent jury must fail to comprehend.¹ No question presents a greater difficulty, in this respect, than that of prior use, where the art or article by which the patented invention

§ 1011. ¹ In *Hayden v. Suffolk Mfg. Co.* (1862), 4 Fisher, 86, Sprague, J. : (96) "Two things are to be regarded in weighing the testimony of all who testify, — the ability of the witness to tell the truth, and his disposition to tell the truth. These do not always go together. The ability to tell the truth as to past transactions, or those events that have transpired, may depend, in the first place, upon the accuracy of the observation, and in the accuracy of the knowledge at the time; then upon the occasion that the party has had to keep it in his mind and memory since; and in the tenacity of his memory is his ability. His disposition, his moral integrity, or freedom from bias, may lead him to testify one way or the other. Now, the accuracy of knowledge at the time, as well as the ability of the man to testify the truth, depend very much upon the subject-matter. Some things that men have a full, clear, and perfect knowledge of at the time they transpire,

may not be of that interesting character that they retain them in their memory. There are other things of which their knowledge at the time may not be perfect; and when you come to the question of machinery, a question of structure, the question whether the person had a full knowledge at the time may depend upon his habit of accurate observation, and his opportunity of observing the particular structure or machine, and his intelligence or understanding of it. For if he had not a clear idea at the time, of course he cannot have immediately afterward a very clear idea to communicate to others. You will consider, therefore, in weighing the evidence as to what it is that the witnesses undertake to describe, how far you can rely upon their memory in undertaking now to say what that was; so that you can ascertain the instrument, the operations, and effects, so as to compare that with the plaintiff's machine."

is claimed to have been anticipated has passed out of existence, and remains only in the memories of those who saw or used it. Unless the invention were so simple or so universal as to become a matter of ordinary knowledge, or were so fully understood and carefully examined by witnesses whose recollection cannot be impeached that it can be substantially reproduced from their description, it is evident that no great reliance can be placed on any impressions they may have concerning its identity with that which forms the subject of the patent.² Courts, therefore, are frequently called upon to caution juries against undue dependence upon such uncertain evidence, and to disparage witnesses whose disposition to disclose the truth is undeniable.

§ 1012. Expert Witnesses.

The uncertainty which, on this account, attaches to the testimony of an ordinary witness, in cases where the character and identity of inventions are in controversy, has led to the employment of a special class of witnesses, whose previous training and accurate habits of observation fit them to perceive, remember, and explain the essential attributes of the inventions submitted to their judgment.¹ Notwithstanding the strictures passed upon expert testimony by many jurists on each side of the Atlantic, and the truth of the assertions by which these censures have been justified, it is still certain

² That evidence from long recollection is often delusive, see *Parker v. Hulme* (1849), 1 Fisher, 44.

That evidence of witnesses as to events occurring thirty years before is not of great weight when unsupported by exhibits, and not consistent with admitted facts, see *Seibert Cylinder Oil Cup Co. v. Nightingale* (1887), 32 Fed. Rep. 171; 41 O. G. 1041.

That evidence of prior use when the thing used is not produced is of little weight, after a long interval, as to its identity with the patented invention, see *Adams & Westlake Mfg. Co. v. Rathbone* (1886), 26 Fed. Rep. 262; *Wetherell v. Keith* (1886), 27 Fed. Rep. 364;

37 O. G. 337; and other cases cited under § 1026, *post*, in reference to evidence of prior use.

That evidence of prior use is to be weighed in view of the lapse of time since the alleged use, see *Yale Lock Mfg. Co. v. Berkshire Nat. Bank* (1885), 26 Fed. Rep. 104.

§ 1012. ¹ That the opinions of experts are admitted, contrary to the general rule that witnesses must testify to facts, see *Conover v. Rapp* (1859), 4 Fisher, 57.

That no person is an expert unless skilled in the science involved, see *Allen v. Hunter* (1855), 6 McLean, 303.

that in most patent cases expert evidence is, and must always be, indispensable.² That the expert is consulted before he is summoned as a witness; that when his opinion is unfavorable to the party who consults him he is not produced in court, at least on that side of the case; that when called as a witness his testimony is expected to support, and generally does support, the claims of the litigant on whose behalf he is presented,—are no doubt true; but this is only what occurs in every other trial where counsel have properly prepared their case.³ The error lies with those who ascribe judicial functions to the patent-expert, and demand of him such freedom from partisanship as the exercise of judicial power requires. That there are experts in other departments of affairs upon whose opinion the court is forced to rely as the foundation of its own judgments, because incapable of forming an opinion for itself, and that such experts consequently fill the places of judges and should be beyond the influence and control of parties, must be conceded. But such is not the case with patent-experts, whose opinion is received in evidence only in connection with the reasons on which it is based, and is to be accepted or rejected by the jury according to their own view of its fallacy or truth.⁴ The patent-expert, considered in his real

² That expert evidence is of little value, see *American Middlings Purifier Co. v. Christian* (1877), 4 Dillon, 448; 3 Bann. & A. 42; *King v. Louisville Cement Co.* (1873), 6 Fisher, 336; 4 O. G. 181.

That *ex parte* affidavits of experts are not valuable, see *Sargent v. Carter* (1857), 1 Fisher, 277.

³ That experts usually agree where the data are the same, see *Sargent v. Carter* (1857), 1 Fisher, 277.

⁴ In *Conover v. Roach* (1857), 4 Fisher, 12, Hall, J. : (27) "In reference to these opinions, it happens as it usually does in patent cases, that the opinions of the two experts on one side are apparently, if not actually, diametrically opposed to the opinions of the two experts on the other side. Indeed,

it may be assumed in this and in most other patent cases, that neither party would have called the experts on his own side, unless he had supposed that their opinions, in reference to the straining point of the case, would be directly opposed to the opinions which he supposes will be expressed by the experts of his adversary. Their well considered and deliberately formed opinions are asked in advance, and if they are found to be adverse to the party who seeks such opinion, that expert is not called on his part. I do not say this, gentlemen, to impeach the integrity or fairness of the experts, or to convey the impression that they are wanting in intelligence or mechanical knowledge, for few experts possess any of these qualities in a higher degree than those called in this

character, is an explorer, gifted with unusual powers of discernment and apprehension; a chronicler, trained to preserve the recollection of the essential attributes of things; an expositor, fitted to embody those essential attributes in accurate and intelligible language; a monitor, able to suggest the conclusions which follow from the premises he has described. His relation to the jury is not unlike that which counsel sustain to the court, as guides to a correct decision of the issues severally confided to their judgment,—the one pointing out facts and applying them in support of the claims advanced by his employer, as the other produces his authorities and applies them to the maintenance of his claims of law.⁵ As no wise judge would undervalue the assistance which industrious and learned advocates afford him, on the ground that each was wedded to his own side of the cause, so no tribunal engaged in the examination of inventions can safely reject the light which the skill and experience of expert witnesses, though manifestly partisans, enable them to throw upon the nature and scope of an invention and its essential identity with, or diversity from, other inventions by which it is asserted to have been anticipated or to be infringed.⁶ Their statements of fact are simply to be weighed, like those of all

case; but to show you that upon these questions of mechanical equivalents, of substantial identity, and substantial difference of organization and mode of operation, these *opinions* are to be regarded by you as *opinions* merely, and that you must decide which opinions are correct, after carefully considering such opinions, and the reasons upon which the experts have told you they are based, in connection with the other evidence in the case and that furnished by your own senses in the examination of the models which have been given in evidence. In no other way can you decide between the conflicting opinions of these experts, and it is your opinions and judgments, and not the opinions of the experts which must, in the end, determine the questions of substantial identity and equivalents litigated in the

case. In that you are to consider the evidence, the opinions of the experts, the reasons they have given for their opinions, to look and consider the models, to deliberately exercise your own judgments, and then decide.”

⁵ That a patent-expert is an “auxiliary counsellor” who argues upon the law and the facts, see *Steam Gauge & Lantern Co. v. Ham Mfg. Co.* (1886), 28 Fed. Rep. 618.

⁶ That expert evidence is of great value in patent cases, see *Potter v. Muller* (1864), 2 Fisher, 465; *Morris v. Barrett* (1859), 1 Bond, 254; 1 Fisher, 461; *Carr v. Rice* (1856), 1 Fisher, 198; *French v. Rogers* (1851), 1 Fisher, 133; *Parker v. Stiles* (1849), 5 McLean, 44; *Allen v. Blunt* (1845), 3 Story, 742; 2 Robb, 288; *Brooks v. Jenkins* (1844), 3 McLean, 432.

other witnesses, by their ability and disposition to disclose the truth; and their opinions are to be followed when, in the judgment of the jury, they are supported by the facts from which they are deduced.⁷

§ 1013. **Classes of Expert Witnesses: their Distinctions.**

Patent-experts are of two classes, — scientific experts and mechanical experts. A scientific expert is a witness who has made himself familiar, by study or experiments, with the principles of any science, and has thereby become qualified to understand, distinguish, and explain the properties of the objects to which such science appertains. A mechanical expert is a witness who, by practical training in an art, has acquired a degree of skill in its rules and manipulations which enables him to comprehend and apply its various instruments and methods.¹ The spheres of these two classes of experts are entirely distinct. The former brings to the examination of

⁷ That expert evidence is not conclusive on the jury, see *Many v. Sizer* (1849), 1 Fisher, 17.

That expert evidence is judged by the same standards as ordinary evidence, see *May v. County of Fond du Lac* (1886), 27 Fed. Rep. 691; *Carter v. Baker* (1871), 4 Fisher, 404; 1 *Sawyer*, 512; *Page v. Ferry* (1857), 1 Fisher, 298.

That the jury are to give such weight to expert evidence as they see fit, according to its credibility, see *Johnson v. Root* (1858), 1 Fisher, 351; *Allen v. Hunter* (1855), 6 McLean, 303; *Brooks v. Jenkins* (1844), 3 McLean, 432.

That the evidence of experts usually varies, and their value depends on their skill, not their number, see *Brooks v. Bicknell* (1845), 4 McLean, 70.

That the value of expert opinions is measured by their reasons, see *Parham v. American Buttonhole, Overseaming & Sewing Mach. Co.* (1871), 4 Fisher, 468; *Jordan v. Dobson* (1870), 4 Fisher, 232; 7 *Phila.* 533; 2 *Abbott*, 398;

Johnson v. Root (1858), 1 Fisher, 351; *Whipple v. Baldwin Mfg. Co.* (1858), 4 Fisher, 29; *United States Annunciator & Bell Telegraph Mfg. Co. v. Sanderson* (1854), 3 Blatch. 184.

That when experts disagree the court will make an examination and decide for itself, see *La Baw v. Hawkins* (1874), 6 O. G. 724; 1 *Bann. & A.* 428.

That in a conflict of scientific evidence the court may employ an independent expert to give advice as to the judgment, see *Anilin v. Levinstein* (1883), L. R. 24 Ch. D. 156.

That the evidence of an expert based on facts prevails over that of another based on mere theories, see *Béné v. Jeantet* (1889), 129 U. S. 685.

§ 1013. ¹ That one "skilled in the art," a practical operator, not a scientific theorist, is an expert, see *Page v. Ferry* (1857), 1 Fisher, 298.

See for a description of these two classes of experts, *Curtis on Patents*, §§ 479-481.

an invention a broad and general knowledge of the fundamental truths of science, of the properties of matter, of the laws of chemistry and physics, of the progress of the arts, of the field open to inventors at any given period of time, and of the tests by which ideas of means can be distinguished from each other. His services become available whenever the character of an invention is to be determined, or its apparent scope is to be limited by the condition of the art at the date of its production, or the line is to be drawn between it and similar but independent triumphs of inventive skill.² Thus the evidence of scientific experts is admissible upon the following questions: (1) Whether the alleged invention is or is not the result of an inventive act; (2) Whether the elements described in the patent as constituting the invention, or included in its practical embodiment, are all essential to the expression of its idea of means; (3) Whether a given invention embraces or excludes a different invention; (4) Whether a given invention is substantially the same in principle, in function, or in effect, with any other invention. The mechanical expert, on the other hand, represents the skilled workman in his art, and brings to his examination of an invention the practical knowledge which enables him to pass upon its usefulness, and on his own ability or that of other artisans to reproduce it from the disclosure made by its inventors. His evidence is important in the following cases: (1) Where, on a defence of want of novelty, a prior patent or publication has been offered, as to the sufficiency of whose description of the invention a dispute has arisen; (2) Where the defence is

² That expert evidence is admissible to prove that the principle of two inventions is the same, see *Tillotson v. Ramsay* (1878), 51 Vt. 309; *Tucker v. Spaulding* (1871), 13 Wall. 453; 1 O. G. 144; 5 Fisher, 297; *Page v. Ferry* (1857), 1 Fisher, 298.

That experts are admitted to testify on questions of mechanical difference, and if qualified and unbiassed, their opinions are entitled to great respect, see *Morris v. Barrett* (1859), 1 Fisher, 461; 1 Bond, 254.

That whether one thing is the equivalent of another is a question of fact on the evidence of experts on an inspection of the inventions, see *Foss v. Herbert* (1856), 2 Fisher, 31; 1 Bissell, 121.

That an expert cannot testify, from his investigation of books and otherwise, that the invention was well known before the application, this being matter of fact and not opinion, see *McMahon v. Tyng* (1867), 14 Allen, 167.

based on the alleged inutility of the invention ; (3) Where the defendant claims that the description in the specification of the patent is ambiguous, and does not furnish to those skilled in the art the necessary guidance in the practice of the invention. The wide diversity between these spheres of expert evidence, and between the qualifications of the witnesses in each, does not, however, forbid the same person from appearing and testifying in both capacities, if he possesses the required skill and knowledge.

§ 1014. Expert Testimony: when Admissible.

The opinions of experts, with their reasons, are admissible in reference to questions which are to be decided by the court, as well as upon those which are to be submitted to the jury, provided the subject-matter of the question is one to which such evidence can be properly applied. The construction of a patent lies within the province of the judge, whose duty it is to determine, from the specification of the patent, what the invention is, and whose interpretation of the patent thus furnishes the standard with which all alleged infringing or anticipating inventions are to be compared.¹ Whether a prior patent covers the same invention as the patent in dispute, and whether a re-issue departs from its original, are also questions settled by the court, which construes each of the related patents, and judges their inventions to be identical, or distinct, or one inclusive of the other. In the performance of this duty of construction, the court is at liberty to avail itself of expert evidence to such an extent as it deems expedient.² Neither party has a right to offer it, nor is it error in the judge to refuse to admit or consider it.³ On the contrary, if

§ 1014. ¹ That the evidence of experts is useful to show the operation of devices, but they cannot tell what the patent is for (this being the province of the court), nor whether it has been infringed (this being for the court and jury), see *Waterbury Brass Co. v. N. Y. & Brooklyn Brass Co.* (1858), 3 Fisher, 43.

That the opinion of a witness as to

whether a patent is for a process or a machine is not admissible, see *Corning v. Burden* (1853), 15 How. 252.

² That experts may aid the court in construing a patent, see *Day v. Stellman* (1859), 1 Fisher, 487 ; *Winans v. N. Y. & Erie R. R. Co.* (1858), 21 How. 88.

³ That the judge cannot be compelled to receive expert evidence to aid

an inspection of the invention practised by the defendant, in connection with the one described and claimed in the patent, satisfies the court that there has been no infringement, or if its interpretation of the present and a prior patent proves the former void for want of novelty, or if it is apparent that a re-issue cannot legitimately bear a construction which will enable it to be regarded as an amendment of its original, there is no occasion for extraneous evidence, and the court should direct the jury to return a verdict for the defendant without further inquiry.⁴ In any doubtful case, however, the

in construing a patent, but may call on experts if he desires it, see *Winans v. N. Y. & Erie R. R. Co.* (1858), 21 How. 88.

⁴ In *Bischoff v. Wethered* (1869), 9 Wall. 812, Bradley, J. : (814) "It is undoubtedly the common practice of the United States Circuit Courts, in actions at law, on questions of priority of invention, where a patent under consideration is attempted to be invalidated by a prior patent, to take the evidence of experts as to the nature of the various mechanisms or manufactures described in the different patents produced, and as to the identity or diversity between them; and to submit all the evidence to the jury under general instructions as to the rules by which they are to consider the evidence. A case may sometimes be so clear that the court may feel no need of an expert to explain the terms of art or the descriptions contained in the respective patents, and may therefore feel authorized to leave the question of identity to the jury, under such general instructions as the nature of the documents seems to require. And in such plain cases the court would probably feel authorized to set aside a verdict unsatisfactory to itself, as against the weight of evidence. But in all such cases the question would still be treated as a question of fact for the jury, and not as a question of law for the court. And

under this rule of practice, counsel would not have the right to require the court, as matter of law, to pronounce upon the identity or diversity of the several inventions described in the patents produced. Such, we think, has been the prevailing rule in this country, and we see no sufficient reason for changing it. The control which the courts can always exercise over unsatisfactory verdicts will enable them to prevent any wrong or injustice arising from the action of juries; whereas, if the courts themselves were compellable to decide on these often recondite and difficult questions, without the aid of scientific persons familiar with the subjects of the inventions in question, they might be led into irremediable errors which would produce great injustice to suitors. We are disposed to think that the practice adopted by our courts is, on the whole, the safest and most conducive to justice. It may be objected to this view that it is the province of the court, and not the jury, to construe the meaning of documentary evidence. This is true. But the specifications of patents for inventions are documents of a peculiar kind. They profess to describe mechanisms and complicated machinery, chemical compositions, and other manufactured products which have their existence *in pais*, outside of the documents themselves, and which are commonly described by terms

courts accept the aid of experts, and when their opinions are supported by sufficient reasons, attach to them great value and importance. But neither a court nor a jury are permitted to follow the guidance of any expert in defiance of the results of practical operation and experiment, nor against conclusions derived by necessary inferences from established facts.⁵

of the art or mystery to which they respectively belong ; and these descriptions and terms of art often require peculiar knowledge and education to understand them aright ; and slight verbal variations, scarcely noticeable to a common reader, would be detected by an expert in the art, as indicating an important variation in the invention. Indeed, the whole subject-matter of a patent is an embodied conception outside of the patent itself, which, to the mind of those expert in the art, stands out in clear and distinct relief, whilst it is often unperceived, or but dimly perceived, by the uninitiated. This outward embodiment of the terms contained in the patent is the thing invented, and is to be properly sought, like the explanation of all latent ambiguities arising from the description of external things, by evidence *in pais*."

In *Ely v. Monson & Brimfield Mfg. Co.* (1860), 4 Fisher, 64, Sprague, J. : (78) "It will not follow that because experts have expressed an opinion that Whipple's patent is like a preceding patent, the court will consider that as evidence to go to a jury. The court must look at it itself. It might be urged, I know, that this is evidence, and that, therefore, it is a matter to be weighed by a jury. That is not always true of opinions of experts. We must see how much the opinions of experts embody questions of law as well as of

fact, or whether they embrace in them any question of law. When a question of law is involved in the opinion of experts, that is not to be left to a jury ; and when the fact stated involves, in effect, the construction of a patent, that fact is founded on a question of law, and is of no force except as it embraces a question of law. Consequently the opinion of the experts contains nothing to go to a jury and in fact nothing on which they can sustain themselves."

See also § 1019 note 2, *post*.

⁵ That the opinions of experts cannot prevail over established facts, see *Tilghman v. Werk* (1862), 2 Fisher, 229 ; 1 Bond, 511.

That expert opinions are outweighed by practical operation and experiment, see *Hudson v. Draper* (1870), 4 Fisher, 256 ; 4 Clifford, 178.

That the opinion of experts that a device is impracticable does not weigh much against evidence that it succeeds in actual use, see *Seymour v. Marsh* (1872), 2 O. G. 675 ; 6 Fisher, 115 ; 9 Phila. 380.

That for the purpose of an injunction *ex parte* affidavits and opinions of experts, contradicted by equal evidence, prove neither the validity of the plaintiff's patent nor an infringement, see *Pullman Palace Car Co. v. Baltimore & Ohio R. R. Co.* (1881), 19 O. G. 224 ; 4 Hughes, 236 ; 5 Fed. Rep. 72.

§ 1015. **Documentary Evidence in Actions at Law for Infringement.**

The principal documentary evidence available in actions for infringement is drawn from the files and records of the Patent Office, and from the private agreements of the parties. The patent in dispute is admissible, if regular on its face, though it contains no recital that the prerequisites have been fulfilled.¹ Other patents, whether foreign or domestic, when duly verified by the appropriate officers according to the law of the government from which they issue, are also admissible when relevant to the matter in controversy.² The specifications, drawings, and models annexed to or connected with such patents are likewise proper evidence if legally authenticated.³ Assignments, grants, and licenses are competent to show the title to the patented invention, and the authority conferred on the defendant to make, or use, or sell it.⁴ A caveat may be offered to prove the claims of the caveator

§ 1015. ¹ That a patent is admissible though it contains no recital that the prerequisites were fulfilled, see *Philadelphia & Trenton R. R. Co. v. Stimpson* (1840), 14 Peters, 448 ; 2 Robb, 46.

That a patent not properly signed is not evidence nor can copies of the record of the patent as complete be admitted, see *Marsh v. Nichols* (1888), 128 U. S. 605 ; *Marsh v. Nichols* (1883), 24 O. G. 901 ; 15 Fed. Rep. 914.

² That foreign patents duly authenticated are admissible when relevant, see *Schoerken v. Swift & Courtney & Beecher Mfg. Co.* (1881), 19 O. G. 1493 ; 7 Fed. Rep. 469 ; 19 Blatch. 209.

³ That specifications annexed to or connected with their applications are admissible, see *Schoerken v. Swift & Courtney & Beecher Mfg. Co.* (1881), 19 O. G. 1493 ; 7 Fed. Rep. 469 ; 19 Blatch. 209 ; *Northwestern Fire Extinguisher Co. v. Phila. Fire Extinguisher Co.* (1874), 10 Phila. 227 ; 1 Bann. & A. 177 ; 6 O. G. 34 ; *Davis v. Gray* (1867), 17 Ohio St. 330 ; *Winans v. Schenectady & Troy R. R. Co.* (1851), 2 Blatch.

279 ; *Peck v. Farrington* (1832), 9 Wend. 44.

That drawings may be shown in evidence, see *Tinker v. Wilbers Eureka Mower & Reaper Mfg. Co.* (1880), 1 Fed. Rep. 138 ; 5 Bann. & A. 92 ; *Winans v. Schenectady & Troy R. R. Co.* (1851), 2 Blatch. 279.

That models may be admitted, see *Everet v. Thatcher* (1878), 2 Flippin, 234 ; 3 Bann. & A. 435 ; 16 O. G. 1046 ; *Johnsen v. Beard* (1875), 2 Bann. & A. 50 ; 8 O. G. 435 ; *Carter v. Baker* (1871), 1 Sawyer, 512 ; 4 Fisher, 404 ; *Swift v. Whisen* (1867), 2 Bond, 115 ; 3 Fisher, 343 ; *Blanchard v. Puttman* (1867), 2 Bond, 84 ; 3 Fisher, 186.

⁴ That an assignment may be offered in evidence, see *Dederick v. Whitman Agricultural Co.* (1886), 26 Fed. Rep. 763 ; 36 O. G. 570 ; *New York Pharmaceutical Association v. Tilden* (1883), 21 Blatch. 190 ; 23 O. G. 272 ; 14 Fed. Rep. 740 ; *Lee v. Blandy* (1860), 2 Fisher, 89 ; 1 Bond, 361 ; *Pitts v. Whitman* (1843), 2 Story, 609 ; 2 Robb, 189.

concerning the invention at the date of its transmission to the Patent Office, and the existence in his mind of the ideas therein described, but not that the invention was then wholly or in part perfected.⁵ A disclaimer is appropriate evidence upon the question of abandonment, or to limit the scope of the invention to which it refers, and is admissible if signed and filed by the patentee.⁶ The application for the patent, and the correspondence of the applicant with the Patent Office in explanation or assertion of his rights, may be produced as declarations accompanying an act, and as tending to define the nature of the patented invention and the relations toward it of the applicant and patentee.⁷ Preliminary papers filed by third parties are generally inadmissible, being *res inter alios acta*, and mere hearsay evidence;⁸ but are some-

⁵ That a caveat surreptitiously placed on file is admissible for what it is worth, although the attorney who placed it there has been disbarred, see *Campbell v. James* (1879), 18 O. G. 979; 17 Blatch. 42; 4 Bann. & A. 456. See also § 446 and notes, *ante*.

⁶ That a disclaimer is not admissible unless proved to be signed by the patentee, and shown to be either an original or a certified copy, see *Foote v. Silsby* (1849), 1 Blatch. 445.

⁷ That the application of the patentee is admissible, see *Toohey v. Harding* (1880), 1 Fed. Rep. 174; 4 Hughes, 253; 5 Bann. & A. 195.

That the correspondence with the Patent Office is admissible as a declaration accompanying an act or *res gestæ*, see *Allen v. Blunt* (1846), 2 W. & M. 121; 2 Robb, 530.

That the file-wrapper and contents are admissible to show the transactions between the inventor and the Patent Office, see *Sutter v. Robinson* (1886), 119 U. S. 530; 38 O. G. 230.

That the file-wrapper and correspondence between the patentee and the Office are admissible to aid in the interpretation of the patent, see *Wirt v. Brown* (1887), 32 Fed. Rep. 283.

That the preliminary statement filed in interference proceedings is admissible evidence in the courts, see *Detroit Lubricator Co. v. Lunkenheimer* (1886), 30 Fed. Rep. 190; 38 O. G. 331.

That evidence of what passed in the Patent Office pending the examination of an application is admissible, see *Ewart Mfg. Co. v. Bridgeport Malleable Iron Co.* (1887), 31 Fed. Rep. 149.

That the correspondence between the Patent Office and the inventor is admissible to show what the latter said his Claims meant, see *Pike v. Potter* (1859), 3 Fisher, 55.

That letters of the plaintiff to the Secretary of State containing the application and specification and certified under seal as papers in that department are admissible, see *Pettibone v. Derringer* (1818), 4 Wash. 215; 1 Robb, 152.

⁸ That preliminary papers filed in the Patent Office by strangers to the litigated patent are mere declarations of third parties and are hearsay, see *Howes v. McNeal* (1880), 17 O. G. 799; 17 Blatch. 396; 4 Fed. Rep. 151; 5 Bann. & A. 77.

times received to fix a date or to describe more clearly the attributes of an invention whose existence has been otherwise established.⁹ Of all these documents written or printed copies, authenticated by the seal of the Patent Office and certified by the Commissioner or Assistant Commissioner, are by statute made evidence of equal weight and pertinency with the originals.¹⁰ The admissibility of private writings, includ-

⁹ In *Northwestern Fire Extinguisher Co. v. Phila. Fire Extinguisher Co.* (1874), 6 O. G. 34, McKennan, J.: (37) "But it does not follow that a rejected specification and drawings are, under all circumstances, inadmissible as evidence. By themselves they are inconsequential, but when the inventor's idea is perfected by a practical adaptation of it, in the form of mechanism, they are valuable guides in ascertaining the date of the invention, the design of the inventor, and the principle, intended functions, and mode of operation of his mechanism, and they must, therefore, necessarily be considered in connection with it." 10 Phila. 227 (231); 1 Bann. & A. 177 (186).

That the contents of a re-issue file may be examined in order to determine the scope of the re-issue, see *Hopkins & Dickinson Mfg. Co. v. Corbin* (1881), 103 U. S. 786; 20 O. G. 297.

¹⁰ That the statute renders admissible copies of records, &c., in the Patent Office and patents duly authenticated in the United States, and copies duly certified of the specifications of foreign patents, and makes them *prima facie* evidence, see *Schoerken v. Swift & Courtney & Beecher Mfg. Co.* (1881), 19 O. G. 1493; 7 Fed. Rep. 469; 19 Blatch. 209; *Brooks v. Jenkins* (1844), 3 McLean, 432; *Peck v. Farrington* (1832), 9 Wend. 44.

That the copies of foreign patents deposited in the Patent Office sufficiently show their dates and numbers, see *Ex parte Trotter* (1885), 32 O. G. 1603.

That a copy of a drawing filed under Sec. 1, act of 1837, where the original had none, is admissible, and with the original patent and specification is *prima facie* evidence of the particulars of the invention, see *Winans v. Schenectady & Troy R. R. Co.* (1851), 2 Blatch. 279.

That a copy of a second drawing, filed to amend one which was filed to supply one burnt in 1837, is admissible, see *Emerson v. Hogg* (1845), 2 Blatch. 1.

That a certified and sealed copy of the specifications not accompanied by a copy of the patent to which they belong is not evidence of the existence or contents of the patent, see *Davis v. Gray* (1867), 17 Ohio St. 330.

That certified copies of papers in the Patent Office, such as applications, letters, waivers, &c., may be admitted in proper cases, see *Toohy v. Harding* (1880), 1 Fed. Rep. 174; 4 Hughes, 253; 5 Bann. & A. 195.

That certified copies of assignments, &c., are admissible, see *Dederick v. Whitman Agricultural Co.* (1886), 26 Fed. Rep. 763; 36 O. G. 570; *Lee v. Blandy* (1860), 2 Fisher, 89; 1 Bond, 361; *Brooks v. Jenkins* (1844), 3 McLean, 432.

That an incorrect transcript from the Patent Office may be corrected by a new transcript, see *Brooks v. Jenkins* (1844), 3 McLean, 432.

That a clerk in the Patent Office is a proper witness to prove what documents are on record or on file in the Patent Office, see *Sone v. Palmer* (1859), 28 Mo. 539.

ing contracts, books kept in the usual course of business, and entries against interest, as well as that of parol evidence to supply defects and correct errors in the written, are governed by the same rules as in ordinary actions.¹¹

§ 1016. The Patent as Evidence.

A patent, regular on its face, is *prima facie* evidence of all the facts which are essential to its own validity.¹ This rule appeared as an express provision in the act of 1790; and though omitted from subsequent statutes, and discarded by

¹¹ That pleadings in avoidance are not evidence, but are to be supported by evidence, see *Howe v. Williams* (1863), 2 Clifford, 245; 2 Fisher, 395.

That records of companies of which the plaintiff is not a member cannot be offered by the defendant, see *Pennock v. Dialogue* (1825), 4 Wash. 538; 1 Robb, 466.

That records showing that a certain company acknowledged the plaintiffs as inventors of an art cannot be read, the defendant not being a member of the company and not claiming that the company invented it, see *Pennock v. Dialogue* (1825), 4 Wash. 538; 1 Robb, 466.

That parol proof of lost memoranda, containing a list of persons to whom the patentee has sold rights and showing a sale to the defendant's assignors is inadmissible, such right not being capable of proof by parol, see *Baldwin v. Sibley* (1858), 1 Clifford, 150.

§ 1016. ¹ That the patent is *prima facie* evidence of its own validity, and can be overcome only by clear evidence, see *Frankfort Whiskey Process Co. v. Mill Creek Distilling Co.* (1889), 37 Fed. Rep. 533; *Vulcanite Paving Co. v. American Artificial Stone Paving Co.* (1887), 42 O. G. 828; *Comstock v. Sandusky Seat Co.* (1878), 3 Bann. & A. 188; 13 O. G. 230; *Kelleher v. Darling* (1878), 14 O. G.

673; 4 Clifford, 424; 3 Bann. & A. 438; *Storrs v. Howe* (1876), 10 O. G. 421; 4 Clifford, 388; 2 Bann. & A. 420; *Brady v. Atlantic Works* (1876), 10 O. G. 702; 4 Clifford, 408; 2 Bann. & A. 436; *Smith v. Woodruff* (1873), 6 Fisher, 476; 4 O. G. 635; 1 MacArthur, 459; *Westlake v. Cartter* (1873), 6 Fisher, 519; 4 O. G. 636; *Hoffheins v. Brandt* (1867), 3 Fisher, 218; *Wing v. Richardson* (1865), 2 Clifford, 449; 2 Fisher, 535; *Potter v. Holland* (1858), 1 Fisher, 382; 4 Blatch. 238; *Allen v. Hunter* (1855), 6 McLean, 303; *Heinrich v. Luther* (1855), 6 McLean, 345; *Brooks v. Jenkins* (1844), 3 McLean, 432; *Philadelphia & Trenton R. R. Co. v. Stimpson* (1840), 14 Peters, 448; 2 Robb, 46.

That whenever the evidence is doubtful the patent will prevail, see *American Bell Telephone Co. v. People's Telephone Co.* (1884), 22 Fed. Rep. 309; 22 Blatch. 531; 29 O. G. 1029; *Crouch v. Speer* (1874), 6 O. G. 187; 1 Bann. & A. 145; *Agawam Co. v. Jordan* (1868), 7 Wall. 583.

That in order to defeat the patent the evidence must remove all reasonable doubt, see *Campbell v. Mayor of New York* (1881), 9 Fed. Rep. 500; 20 O. G. 1817; 20 Blatch. 67; *Shirley v. Sanderson* (1881), 8 Fed. Rep. 905.

That the issue of a patent is not conclusive proof of its validity, see *Andrews v. Hovey* (1888), 42 O. G. 1235.

the courts until after the reconstruction of the patent system by the act of 1836, it has ever since the latter date been recognized as an established doctrine of our law. Thus, until contradicted, the patent proves that the alleged invention is the result of an inventive act; that the patentee or his assignor was its first and true inventor; that the invention is patentable subject-matter; that it is new and useful; and has not been abandoned to the public. It also demonstrates that the patent was lawfully issued to the proper patentee; if a re-issue, that it corresponds with the original; if an extension, that the requirements of the law have been obeyed; that the invention described therein differs essentially from all other inventions described and claimed in any prior patent; that its specification is without fraud and free from ambiguity; that its Claims are not excessive and clearly define the actual invention; and that the patent has neither been surrendered nor repealed.² When the plaintiff is the patentee it

² In *Poppenhusen v. New York Gutta Percha Comb Co.* (1858), 2 Fisher, 62, Ingersoll, J.: (67) "And the law is that the patent, when produced in evidence, is *prima facie* evidence that the patentee was the inventor; that the thing patented was new and useful; and that in the specification there is contained a description in such full, clear, and exact terms as will enable any one skilled in the art to which it appertains to put it in practice from the description contained in the specification."

In *Potter v. Holland* (1858), 1 Fisher, 382, Ingersoll, J.: (387) "The patent is *prima facie* evidence that the several grants of right contained in it were valid, that the several things, methods, and devices granted were new, that they were useful, that they required invention, and that they were the invention of Wilson. And this *prima facie* evidence must have full effect, unless it is rebutted by countervailing evidence." 4 Blatch. 238 (241).

In *Parker v. Stiles* (1849), 5 McLean,

44, Leavitt, J.: (60) "The patent, however, raises the presumption of the novelty and utility of the plaintiff's invention. Before a patent can issue, the person applying for it is required to make oath that he is, as he verily believes, 'the original and first inventor or discoverer' of the improvement or invention for which he seeks a patent. And it has been held that this oath, constituting as it does a part of the letters-patent, and being in evidence to the jury, forms a legal ground for the presumption of the novelty and originality of the patentees' claim, until the contrary be proved. Upon this inquiry the burden of proof is thrown upon the defendant; it being the province of the court to decide what constitutes novelty, and of the jury to determine from the evidence adduced whether the patentees' invention is new. The same remarks apply also to the subject of the utility of the invention."

That a patent is *prima facie* evidence that the invention has been made, that the patentee is the inventor, that the

is, in like manner, *prima facie* evidence of his legal title to the patented invention, and of his right to maintain an action for its infringement.³ The weight of a patent as *prima facie* evidence is increased by its re-issue, by the success of the patentee in an interference proceeding, by its extension, and by the long and continuous recognition of its validity on the part of the public.⁴ A patent granted to or owned by a de-

invention is new and useful, and that the patent has been lawfully issued, see *Byerly v. Cleveland Linseed Oil Works* (1887), 31 Fed. Rep. 73.

That a patent affords *prima facie* evidence of the patentee's right to all matters contained in it, see *Johnson v. Root* (1858), 1 Fisher, 351.

That a patent and a certified copy of the record thereof, and of its drawings are, under the act of Mar. 3, 1837, *prima facie* proof of the particulars patented, see *Winans v. N. Y. & Erie R. R. Co.* (1856), 1 Fisher, 213.

That the patent is *prima facie* evidence of novelty, see *Shaver v. Skinner Mfg. Co.* (1887), 30 Fed. Rep. 68; 41 O. G. 232; *Vulcanite Paving Co. v. American Artificial Stone Paving Co.* (1887), 42 O. G. 828; *Dean v. Hodge* (1886), 35 Minn. 146; *Lehnbeuter v. Holthaus* (1881), 105 U. S. 94; 21 O. G. 1783; *Miller v. Smith* (1880), 18 O. G. 1047; 5 Fed. Rep. 359; *Crouch v. Speer* (1874), 6 O. G. 187; 1 Bann. & A. 145; *Roberts v. Dickey* (1871), 4 Brews. (Pa.) 260; 4 Fisher, 532; 1 O. G. 4; *Tompkins v. Gage* (1865), 2 Fisher, 577; 5 Blatch. 268.

That the patent is *prima facie* evidence of utility, see *Kirk v. DuBois* (1887), 33 Fed. Rep. 252; *Dean v. Hodge* (1886), 35 Minn. 146; *Lehnbeuter v. Holthaus* (1881), 105 U. S. 94; 21 O. G. 1783.

See also as to each issue, §§ 1022-1040, and notes, *post*.

That where the state of the art has been shown, the question of patent-

ability is open, without any presumption arising from the patent, see *Adams v. Bellaire Stamping Co.* (1886), 28 Fed. Rep. 360; 36 O. G. 567.

³ That the patent is *prima facie* evidence of the title of the patentee, see *Fischer v. Neil* (1881), 6 Fed. Rep. 89; 19 O. G. 603.

That a patent gives the patentee a *prima facie* right to recover from every infringer, see *Celluloid Mfg. Co. v. Goodyear Dental Vulcanite Co.* (1876), 10 O. G. 41; 13 Blatch. 375; 2 Bann. & A. 334.

⁴ That a re-issue increases the weight of a patent as *prima facie* evidence, see *Tyler v. Crane* (1880), 7 Fed. Rep. 775; 19 O. G. 128; *La Baw v. Hawkins* (1874), 6 O. G. 724; 1 Bann. & A. 428.

That a recovery in interference aids the force of the patent, see *Ayling v. Hull* (1865), 2 Clifford, 494.

That an extension increases the weight of a patent as *prima facie* evidence, see *Tyler v. Crane* (1880), 7 Fed. Rep. 775; 19 O. G. 128; *La Baw v. Hawkins* (1874), 6 O. G. 724; 1 Bann. & A. 428; *Cook v. Ernest* (1872), 5 Fisher, 396; 2 O. G. 89; *Whitney v. Mowry* (1867), 3 Fisher, 157; 2 Bond, 45; *Swift v. Whisen* (1867), 3 Fisher, 343; 2 Bond, 115; *Ransom v. Mayor of New York* (1856), 1 Fisher, 252.

That long admitted validity is a strong support to a patent, see *Tyler v. Crane* (1880), 7 Fed. Rep. 775; 19 O. G. 129. See also §§ 1185-1188, and notes, *post*.

defendant or his licensor enjoys the same rank as evidence, and raises the same presumptions, as one issued to the plaintiff.⁵ An extension or a re-issue represents its expired or surrendered original, and is *prima facie* evidence of all the facts necessary to the validity of either.⁶ A patent furnishes no evidence, however, that the defendant has been guilty of infringement.⁷

§ 1017. Records of Former Judgments as Evidence.

The records of former judgments are admissible, not only as matters of estoppel, but for various purposes connected with the interpretation of the patent, the patentability of the invention, and the identity of the defendant's process or device with that protected by the patent. A judgment between the same parties, on the same issues, by the same or a superior tribunal, is conclusive against the defeated litigant and his privies, as well as against all who so participated in the suit as to control the conduct of the action.¹ Judgments on the same points between the same parties in co-ordinate or inferior tribunals are of more or less weight according to the nature of the points decided, and the consideration to which the tribunal may be legally entitled. Such judgments cannot be departed from in any manner which simply revives the former controversy and gives the defeated party a new trial on the merits of the decided cause, except in an appellate court

⁵ That the defendant's patent raises the same presumptions of novelty, &c., see *Smith v. Woodruff* (1873), 6 Fisher, 476; 4 O. G. 635; 1 MacArthur, 459; *Blanchard v. Puttman* (1867), 3 Fisher, 186; 2 Bond, 84; *House v. Young* (1867), 3 Fisher, 335.

⁶ That a re-issue has the same effect as evidence as the original, see *Serrell v. Collins* (1857), 1 Fisher, 289.

⁷ That the patent is not *prima facie* evidence of infringement, see *Hayden v. Suffolk Mfg. Co.* (1862), 4 Fisher, 86.

§ 1017. ¹ That all persons who are interested in the subject-matter of a suit and have a right to make defence,

control the proceedings, or produce evidence are bound by a decree, if they have knowledge of the suit, whether or not they appear to protect their rights, but all other persons are strangers to the cause, see *American Bell Telephone Co. v. National Improved Telephone Co.* (1886), 27 Fed. Rep. 663.

That a judgment is not *res adjudicata* except as to the exact points in controversy, see *Brush v. Naugatuck R. R. Co.* (1885), 23 Blatch. 277; 24 Fed. Rep. 371; 32 O. G. 894.

That a judgment is of no weight except upon the questions raised at the trial, see *Celluloid Mfg. Co. v. Tower* (1885), 26 Fed. Rep. 451.

to which the case is taken by due course of law. But these judgments, like those rendered in suits between other parties in the same or different tribunals, are often of great value upon questions relating to the construction of the patent, the identity and patentability of inventions, and other matters which must present the same aspects by whomsoever and wheresoever the questions may be raised; and in all such cases the records of these judgments, with the opinions of the court, are proper subjects for consideration, and may either be submitted in the form of evidence or cited as authorities bearing upon the issues in the case at bar.²

² That decisions of co-ordinate courts are of great weight and will usually be followed in order to preserve uniformity in the legal position of the patent, see *Celluloid Mfg. Co. v. Zylonite Brush & Comb Co.* (1886), 27 Fed. Rep. 291; 35 O. G. 1228.

That former judgments on the same patent will be followed where there is no new evidence, see *American Bell Telephone Co. v. Wallace Electric Co.* (1889), 37 Fed. Rep. 672.

That a judgment between other parties though not conclusive is entitled to great weight, see *Asmus v. Alden* (1886), 27 Fed. Rep. 684; 36 O. G. 231.

That a judgment is of greater weight against a person who was familiar with the suit and might have aided the defendant by suggestions, etc., than against one ignorant of it, see *Cary v. Lovell Mfg. Co.* (1885), 24 Fed. Rep. 141; 32 O. G. 1009.

That where a patent has been held invalid in one circuit, for not embracing patentable matter, no future bill will be entertained in that circuit on the same facts, see *McCloskey v. Hamill* (1883), 15 Fed. Rep. 750; 23 O. G. 2122.

That a concurrent line of decisions for years, in favor of a patent, are not conclusive in another circuit on other

states of fact, see *United Nickel Co. v. California Electrical Works* (1885), 25 Fed. Rep. 475; 11 Sawyer, 251.

That a judgment after a long contest covering all ordinary defences is almost conclusive upon the question of validity, see *Cary v. Domestic Spring-Bed Co.* (1885), 27 Fed. Rep. 299.

That no judgment can be a precedent unless rendered after full argument, see *Celluloid Mfg. Co. v. Tower* (1885), 26 Fed. Rep. 451.

That a former judgment sustaining the patent is of no weight where the present objections raise questions not before considered, see *Lockwood v. Faber* (1886), 27 Fed. Rep. 63.

That where the validity of a re-issue has been fully considered and decided in a former case, and an appeal is pending in the Supreme Court, no opinion will be expressed thereon, see *Green v. French* (1882), 11 Fed. Rep. 591; 21 O. G. 1351.

That the rejection of an application by the Patent Office is not *res adjudicata*, see *Mathews v. Flower* (1885), 25 Fed. Rep. 830; 33 O. G. 887.

That judgments of the Patent Office are *prima facie* not conclusive, see *Wilson v. Barnum* (1849), 2 Fisher, 635; 1 Wall. Jr. 347; 2 Robb, 749.

That the judgment of a State court for damages will not be enforced against

§ 1018. Burden of Proof.

Where the pleadings in an action for infringement are closed upon the general issue, either with or without notice, the burden of proof is upon the plaintiff in reference to all the averments in his declaration. He must offer evidence to show the patentability of the invention, the validity of the patent, his own legal title, the infringement by the defendant, and the damages he has sustained.¹ The exhibition of his patent, or a certified copy thereof, makes out a *prima facie* case upon the first and second of these points, and if he is the patentee, upon the third also.² If he is an assignee or grantee, the instruments of conveyance, or duly authenticated copies, are sufficient evidence of his right to sue.³ His averments of infringement, and of damages if he would recover

the patent in the United States courts, see *Ryan v. Lee* (1882), 10 Fed. Rep. 917.

On this subject of former judgments and their effect as estoppels or precedents, see §§ 1175-1184, and notes, *post*.

§ 1018. ¹ In *Reckendorfer v. Faber* (1875), 92 U. S. 347, Hunt, J. : (350) "Looking at this section alone it may be safely said no one is entitled to a patent unless (1) he has discovered or invented an art, machine, or manufacture; (2) which art, machine, or manufacture is new; (3) which is also useful; (4) which is not known or patented as therein mentioned. It is not sufficient that it is alleged, or supposed, or even adjudged by some officer to possess these requisites. It must in fact possess them; and that it does possess them the claimant must be prepared to establish in the mode in which all other claims are established, to wit, before the judicial tribunals of the country." 10 O. G. 71 (72).

That the burden of proof rests upon the plaintiff to show the validity of his patent, see *Miller v. Smith* (1880), 5 Fed. Rep. 359; 18 O. G. 1047;

Kelleher v. Darling (1878), 14 O. G. 678; 4 Clifford, 424; 3 Bann. & A. 438; *Storrs v. Howe* (1876), 10 O. G. 421; 4 Clifford, 388; 2 Bann. & A. 420; *Brady v. Atlantic Works* (1876), 10 O. G. 702; 4 Clifford, 408; 2 Bann. & A. 436.

That the burden of proof as to infringement is on the plaintiff, see *Rogers v. Beecher* (1880), 18 O. G. 793; 5 Bann. & A. 619; 3 Fed. Rep. 639.

See also § 1041 and notes, *post*.

That the burden as to damages is on the plaintiff, see *National Car Brake Shoe Co. v. Terre Haute Car & Mfg. Co.* (1884), 19 Fed. Rep. 514; 28 O. G. 1007; *Fitch v. Bragg* (1883), 16 Fed. Rep. 243; 21 Blatch. 302.

See also § 1071 and notes, *post*.

² That the patent is *prima facie* evidence of patentability, validity, and the title of the patentee, see § 1016 and notes, *ante*.

³ That the production of duly authenticated instruments of assignment or grant satisfies the burden as to title, see *Brooks v. Jenkins* (1844), 3 McLean, 432.

See also § 1040 and notes, *post*.

more than nominal damages, must be supported by proper testimony.⁴ On the last two issues the burden of proof remains upon him during the entire progress of the cause. On the first three it shifts to the defendant upon the exhibition of the patent and the muniments of title, and he must overcome the presumptions of patentability, validity, and ownership thus created, by clear and satisfactory evidence, removing every reasonable doubt.⁵ Where the defendant files a special plea the burden rests on the party having the affirmative upon the pleadings as they are finally closed; but in this case also the patent satisfies the burden in reference to all the matters of which it is *prima facie* evidence, and imposes upon the defendant the task of overcoming its presumptions by conclusive proof.⁶

§ 1019. Evidence concerning the Nature of the Patented Invention Limited by the Interpretation given to the Patent by the Court.

A patent covers the invention or inventions which the court, in construing its provisions, decides that it describes and claims.¹ By this decision the parties and the jury are

⁴ That the patent is not *prima facie* evidence of infringement, see *Hayden v. Suffolk Mfg. Co.* (1862), 4 Fisher, 86.

⁵ That the patent being in evidence, and infringement shown by the plaintiff, the burden of proof rests on the defendant to show that the patent is invalid, unless it is defective on its face, see *Roemer v. Simon* (1877), 95 U. S. 214; 12 O. G. 796; *Hoffheins v. Brandt* (1867), 3 Fisher, 218.

That unless the defendant by conclusive evidence overcomes the *prima facie* evidence of the patent, the novelty, and utility of the invention, its result from an inventive act, its invention by the patentee as the first and true inventor, and the validity of the patent, will be regarded as established, see *American Bell Telephone Co. v. People's Telephone Co.* (1884), 22 Fed. Rep. 309; 22 Blatch. 531; 29 O. G.

1029; *Cushman v. Parham* (1876), 9 O. G. 1108; *Smith v. Woodruff* (1873), 6 Fisher, 476; 4 O. G. 635; 1 MacArthur, 459.

That where the evidence leaves a question in doubt the burden of proof is not satisfied, see *Hayden v. Suffolk Mfg. Co.* (1862), 4 Fisher, 86.

That where the burden of proof is on the defendant and the evidence is conflicting the plaintiff will prevail, see *Patterson v. Duff* (1884), 20 Fed. Rep. 641.

⁶ That the burden of proof is on the defendant to sustain his plea or answer and support all his defences, see *Collender v. Came* (1876), 10 O. G. 467; 4 Clifford, 393; 2 Bann. & A. 412; *Crouch v. Speer* (1874), 6 O. G. 187; 1 Bann. & A. 145.

§ 1019. ¹ That the patent grants what the court construes it to grant and

bound, and the former must present their cause, and the latter must determine it, upon the hypothesis that the invention really is what the court has thus interpreted it to be. Evidence offered under any other view of the patent is inadmissible, and a verdict based on any other construction is contrary to law and will be set aside and a new trial granted.² This rule applies to patents introduced by the defendant as well as to those on which the plaintiff's case depends. In its interpretation of a patent the court may have recourse to any testimony to explain the meaning of its language, or to expert evidence to ascertain the essential characteristics of the described invention and the differences between it and other patented inventions, or to papers in the Patent Office which are connected with the patent or whose contents were known to the inventor at the date of his application, to show the significance which he attached to the terms that he employed.³ But of whatever aid the courts avail themselves, their interpretation must be based upon the patent as it stands, and when its scope is once fairly apparent it can neither be limited nor extended by extraneous evidence.⁴

the jury are so to take it, see *Johnson v. Root* (1858), 1 Fisher, 351; *Serrell v. Collins* (1857), 1 Fisher, 289; *Page v. Ferry* (1857), 1 Fisher, 298.

See also §§ 731-751, and notes, *ante*.

² That unless the jury follow the instructions of the court as to the meaning and effect of a patent the verdict will be set aside and a new trial granted, see *Johnson v. Root* (1862), 2 Clifford, 80; 2 Fisher, 291.

That patents offered in evidence by the defendant are to be construed by the court, and if as thus construed they do not support the issue they are inadmissible, see *Cahoon v. Ring* (1861), 1 Clifford, 592.

That the construction of a patent offered as evidence of prior invention is for the court, see *Clark Patent Steam & Fire Regulator Co. v. Copeland* (1862), 2 Fisher, 221.

That patents offered by defendant to defeat plaintiff's patent cannot be rendered admissible by extraneous evidence, see *Cahoon v. Ring* (1861), 1 Clifford, 592.

That the court may determine that the specification of the patent in question does not cover the same invention as a preceding patent, and the jury are bound by this decision, see *Serrell v. Collins* (1857), 1 Fisher, 289.

³ That evidence is admissible to show the meaning of terms used in the patent, see *Loom Co. v. Higgins* (1882), 105 U. S. 580; 21 O. G. 2031.

See also § 1015 and notes, *post*.

⁴ That the file-wrapper and contents are not admissible to limit the construction of the patent, see *Westlake v. Cartter* (1873), 6 Fisher, 519; 4 O. G. 636.

That correspondence with and proceedings in the Patent Office are not

§ 1020. Evidence Concerning the State of the Art at the Date of the Invention.

Evidence as to the state of the art at the date of the conception of an invention is always admissible for the purpose of showing what was then known, of distinguishing the new features of the invention from the old, and of thus enabling the court to perceive the precise limits of the inventive act.¹ Such evidence requires no previous notice to either party.² It may consist of printed or written documents, of the oral testimony of witnesses then familiar with the art, or of specimens and exhibits of the devices then employed. Evidence offered for this purpose, though in its nature applicable to one or more of the defences to which notice is essential, cannot be considered by the jury as bearing upon such defences unless the necessary notice has been given.³

admissible to vary or enlarge the Claims of a patent, see *Goodyear Dental Vulcanite Co. v. Gardiner* (1871), 3 Clifford, 408 ; 4 Fisher, 224.

See also § 1015 and notes, *ante*.

That the model and rejected application of a third person are admissible to show the circumstances of the invention, in connection with evidence that the patentee knew of them, and so give construction to the patent, see *Union Paper Bag Mach. Co. v. Pultz & Walkley Co.* (1878), 15 O. G. 423 ; 15 Blatch. 160 ; 3 Bann. & A. 403.

§ 1020. ¹ That evidence is admissible to show the state of the art at the date of the invention in order to enable the jury or court to understand the invention, see *Loom Co. v. Higgins* (1882), 105 U. S. 580 ; 21 O. G. 2031.

That the state of the art is proof of what was old and in general use at the date of the invention, see *Brown v. Piper* (1875), 91 U. S. 37 ; 10 O. G. 417.

That the state of the art is provable for three purposes : (1) To show what was then old ; (2) To distinguish what was then new ; (3) To aid the court in construing the patent, — see *Brown v.*

Piper (1875), 91 U. S. 37 ; 10 O. G. 417.

That evidence as to the state of the art, though it may not show prior use, may narrow the field of invention and limit the range of inquiry, see *Washburn & Moen Mfg. Co. v. Haish* (1880), 19 O. G. 173 ; 4 Fed. Rep. 900 ; 10 Bissell, 65.

That an earlier English provisional specification may show the state of the art and thus negative invention, see *McNab & Harlem Mfg. Co. v. Nathan Mfg. Co.* (1887), 40 O. G. 1240 ; 32 Fed. Rep. 155.

² That evidence of the state of the art is admissible without notice or mention in the answer, see *Brown v. Piper* (1875), 91 U. S. 37 ; 10 O. G. 417.

See also § 1006 and notes, *ante*.

³ That proof of the state of the art may aid the court in construing the patent, but cannot be permitted to defeat the suit by anticipating the invention unless that issue is raised by the pleadings, see *Middletown Tool Co. v. Judd* (1867), 3 Fisher, 141.

That evidence given as to prior use

§ 1021. Evidence Excluded on the Ground of Estoppel.

Evidence otherwise admissible may be excluded on the ground that the witness through whom it must be presented is estopped, by matter of record or *in pais*, from claiming these facts against the adverse party. A party is not permitted to deny the truth of documents or of assertions either by word or conduct, by means of which he has induced the other party to act in such a manner as might now be prejudicial to his interests if these documents or assertions could be contradicted.¹ Thus a patentee is not allowed to set up, as against his own assignee, that the patented invention is worthless or was abandoned, or that for any other cause the patent is invalid.² A disclaimer debars the disclaimant from asserting that the part disclaimed was actually embraced in the invention.³ Admissions by a patentee in his application or description that any element of an invention is covered by a prior patent estop him from denying its validity.⁴ An inventor, having obtained a patent for his invention, is thereby precluded from claiming that the same invention is protected under a prior patent, or that a subsequent patent for the same invention can be valid.⁵ Joint patentees are estopped from averring that the invention was sole as long as the joint patent is in force, and sole patentees are in like manner dis-

by parties not named in the answer can only be considered in reference to the state of the art at the date of the invention, and the same rule applies to publications, see *Geier v. Goetinger* (1874), 7 O. G. 563 ; 1 Bann. & A. 553 ; *La Baw v. Hawkins* (1874), 6 O. G. 724 ; 1 Bann. & A. 428 ; *Richardson v. Lockwood* (1873), 4 O. G. 398 ; 6 Fisher, 454.

See also § 1006 and notes, *ante*.

§ 1021. ¹ That a witness may be estopped from giving evidence to defeat rights which he has previously induced the plaintiff to acquire, see 1 Greenleaf, Ev., § 383, etc.; and notes to § 981, *ante*.

² That an assignor cannot testify against his assignee in denial of the

validity of the patent, see *Many v. Jagger* (1848), 1 Blatch. 372.

³ That a disclaimer in the defendant's patent of the devices found in the plaintiff's prior patent, referring thereto, admits the validity of the plaintiff's patent, see *Waterbury Brass Co. v. N. Y. & Brooklyn Brass Co.* (1858), 3 Fisher, 43.

⁴ That the patentee's admission in his application or specification cannot be afterwards contradicted by him, see *Moffitt v. Rogers* (1881), 8 Fed. Rep. 147.

⁵ That a patentee cannot claim that he was not the first inventor of the patented invention, see *American Paper Barrel Co. v. Laraway* (1886), 28 Fed. Rep. 141 ; 37 O. G. 674.

bled from alleging that the inventive act was joint. The assignor of a patented invention cannot urge against his assignee that his own title was defective, and that the title of his assignee must, therefore, fail. These various estoppels rest upon the ordinary rule, that no person shall be permitted to deceive another by causing him to believe in the existence of a fact and afterwards attempting to disprove it.

§ 1022. **Evidence under the First Defence: Origin of the Alleged Invention in an Inventive Act.**

The evidence applicable to each of the several defences which may be offered to an action of infringement is governed by rules deduced from the foregoing general principles in connection with the nature of the particular defence. The first defence raises the question whether inventive skill was involved in the production of the alleged invention. This is a question for the jury in view of the state of the art at the date of the supposed inventive act and of the result attained,¹ unless it is apparent on the face of the patent that the art or article required no inventive skill, when the court will take judicial notice of that fact and declare the patent invalid.² The burden of proof upon this question rests upon the plaintiff, but is satisfied by the introduction of the patent, and the defendant must then overcome the presumptions arising therefrom.³ He may prove, if he is able, by the testimony of com-

§ 1022. ¹ That inventive skill is a question of evidence in view of the condition of the art and the result accomplished, see *In re Pennock* (1874), 1 MacArthur, 531 ; 5 O. G. 668.

² That if the want of inventive skill is apparent from the description in the patent, the court may declare the patent invalid, see *Slawson v. Grand St., Prospect Park, & Flatbush R. R. Co.* (1883), 107 U. S. 649 ; 24 O. G. 99.

³ That the patent itself is *prima facie* evidence that the alleged invention is the result of an inventive act, see *Smith v. Woodruff* (1873), 6 Fish-

er, 476 ; 4 O. G. 635 ; 1 MacArthur, 459 ; *Potter v. Holland* (1858), 1 Fisher, 382 ; 4 Blatch. 238.

That the patent is *prima facie* evidence that the invention had been made when the application was filed, see *Jones v. Sewall* (1873), 3 Clifford, 563 ; 3 O. G. 630 ; 6 Fisher, 343 ; *Wing v. Richardson* (1865), 2 Fisher, 535 ; 2 Clifford, 449 ; *White v. Allen* (1863), 2 Fisher, 440 ; 2 Clifford, 224 ; *Johnson v. Root* (1862), 2 Fisher, 291 ; 2 Clifford, 108.

That reduction to practice need be shown only by the specifications and drawings, when the invention as thus

petent witnesses, either lay or expert, that the idea embodied in the invention was sufficiently suggested by then existing appliances to enable any person skilled in the art to construct and use it. He may show that the alleged inventor has not discovered either a new capability in the force employed or a new susceptibility in the object acted on, or a new mode of connecting the force and object with each other, but has merely re-arranged, or varied in constructive details, an invention which had been already known. He may attack the idea conceived by the inventor and prove that it is not a true idea of means but only of a force or function or effect. He may deny that it had ever passed beyond the mental conception of the inventor, and the verbal or graphical descriptions of the patents, into a tangible and practical embodiment. In opposition to this evidence the plaintiff may, in his rebuttal, demonstrate by proper testimony, that the idea expressed in his invention is an idea of means, and that it was reduced to practice before his application for a patent.⁴ That inventive skill was necessary to its production he may prove by the evidence of experts and others skilled in the art. He may show its great utility and general acceptance by the public as the basis of an inference that if mechanical skill could have derived it from existing arts or articles it would have long before been given to mankind.⁵ He may disclose its essential

disclosed is evidently practical, see *Starr v. Farmer* (1883), 23 O. G. 2327.

That where an original patent and the re-issue agree, the specification of the re-issue may be conclusive evidence that the invention was made and the means invented, as described in the original, but if they differ in substance it is not such evidence, see *Sickels v. Evans* (1863), 2 Clifford, 203; 2 Fisher, 417.

⁴ That reduction to practice may be shown by actual use, see *Coffin v. Ogden* (1869), 3 Fisher, 640; 7 Blatch. 61.

See also as to reduction, §§ 125, 126, and notes, *ante*.

⁵ That the great utility of the de-

vice may be shown to prove that if known it must have been in general use, see *In re Pennock* (1874), 1 MacArthur, 531; 5 O. G. 668; *Sayles v. Chicago & Northwestern Railway Co.* (1871), 4 Fisher, 584; 3 Bissell, 52; *Judson v. Moore* (1860), 1 Fisher, 544; 1 Bond, 285.

That the superior working of the plaintiff's invention is competent evidence of its novelty, see *Judson v. Cope* (1860), 1 Fisher, 615; 1 Bond, 327.

That the general acceptance and use of a device indicates that it is the result of an inventive act, see *Washburn & Moen Mfg. Co. v. Haish* (1880), 4 Fed. Rep. 900; 19 O. G. 173; 10 Bissell,

diversity from all other inventions before known, to indicate that inventive genius could alone have taken the forward step that resulted in its conception and development. If upon the entire oral testimony the jury entertain a reasonable doubt as to the exercise of inventive skill by the inventor, the *prima facie* evidence of the patent must prevail, and the issue must be found in favor of the plaintiff.

§ 1023. Evidence under the Second Defence: Performance of the Inventive Act by the Alleged Inventor.

The second defence presents the question whether the patentee or his assignor has himself performed the inventive act resulting in the alleged invention, or has unlawfully appropriated and obtained a patent for what was in fact the invention of another. Upon this question the patent affords *prima facie* evidence in favor of the plaintiff.¹ To overthrow this evidence the defendant must prove by conclusive testimony that the patented invention was conceived by some specific person other than the alleged inventor, that the alleged inventor in some manner obtained a knowledge of the invention thus conceived, and falsely claiming it to be the result of his own creative skill, procured a patent for it to be issued to himself.² The inventive act of the true inventor may be shown by his

65; *Strobridge v. Lindsay* (1880), 18 O. G. 62; 2 Fed. Rep. 692; 5 Bann. & A. 411; *Judson v. Moore* (1860), 1 Fisher, 544; 1 Bond, 285.

That success is not conclusive evidence of novelty, for the old may not have become widely known, see *Crandall v. Richardson* (1881), 8 Fed. Rep. 808; 19 O. G. 1628.

That where a pressing want has existed strong evidence is necessary to show that an old device would have filled it, see *Howe v. Morton* (1860), 1 Fisher, 586.

For a more complete discussion of inventive skill and its indications, see §§ 78-124, and notes, *ante*.

§ 1023. ¹ That the patent is *prima facie* evidence that the patentee was a

true inventor, see *Potter v. Holland* (1858), 1 Fisher, 382; 4 Blatch. 238.

² That on the defence that the plaintiff derived his idea of the invention from a third party, the burden of proof is on the defendant, and any doubt is fatal to him, see *Locke v. Lane & Bodley Co.* (1888), 35 Fed. Rep. 289; *Duffy v. Reynolds* (1885), 24 Fed. Rep. 855; 33 O. G. 621; *McMillin v. Barclay* (1871), 4 Brews. (Pa.) 275; 5 Fisher, 189.

That an allegation that the defendant received the information from a government employee who was the true inventor and used it for the United States must be affirmatively proved, see *Brady v. Atlantic Works* (1876), 4 Clifford, 408; 10 O. G. 702; 2 Bann. & A. 436.

own testimony, if he is accessible as a witness, or by the evidence of persons acquainted with the facts, or by any descriptions or models embodying the invention which can be identified as original with him. That the patentee or his assignor did not perform the inventive act may be established by his own admissions, by the declarations of others within his knowledge and uncontradicted by him, or by proof of his unsuccessful attempts in the same direction until he learned of the result accomplished by the true inventor and of his immediate adoption of that result as the product of his own inventive faculties.³ No evidence of actual bad faith or intentional piracy is necessary; it is sufficient that there has been piracy in fact. In rebutting this testimony of the defendant, the plaintiff may introduce the person described in his patent as the inventor to detail the steps by which he reached the art or article in question, and thus demonstrate that it originated in his own mind, and was not imitated by him from the invention of another. The testimony of other persons who were cognizant of his experiments and successes, his own descriptions given before the conception of the alleged actual inventor had been sufficiently disclosed to communicate all its essential attributes, and any evidence tending to show his non-acquaintance with the achievements of the one to whose inventive genius the defendant ascribes the invention, are also admissible for the same purpose.⁴ If doubt exists upon the entire testimony offered, the plaintiff is entitled to a verdict on this issue in his favor.⁵

³ That the records of a company of which the plaintiff was a member, and which claimed the invention, are admissible to show that the plaintiff did not invent it, see *Pennock v. Dialogue* (1825), 4 Wash. 538; 1 Robb, 466.

⁴ Upon this issue any evidence proper to show an inventive act in either of the alleged inventors and the date of such act, as well as the relations between them, and the borrowing or opportunity to borrow the conceptions of each other are admissible.

See as to the Inventive Act, §§ 99,

100, 376-379, and notes, *ante*; Suggestions of others, §§ 84, 393-395, and notes, *ante*; Date of Inventive Act, §§ 132, 380-386, 400, and notes, *ante*, and 1024, 1026, and notes, *post*.

See also *Union Paper Collar Co. v. Van Deusen* (1874), 23 Wall. 530; 7 O. G. 919; *Alden v. Dewey* (1840), 1 Story, 336; 2 Robb, 17.

⁵ As to the value of this second defence, and the facts necessary to be proved thereunder, see also § 960 and notes, *ante*.

§ 1024. Evidence under the Third Defence: Priority of the Inventive Act of the Alleged Inventor.

The third defence raises the question whether the inventive act performed by the patentee, or his assignor, preceded or followed that of a rival inventor who has produced the same invention. Here, also, the patent makes out a *prima facie* case for the plaintiff, and being offered in evidence throws on the defendant the burden of proof.¹ To satisfy this burden

§ 1024. ¹ That the patent is *prima facie* evidence that the patentee is the first inventor, see *Maurice v. Devol* (1883), 23 W. Va. 247; *Corvallis Fruit Co. v. Curran* (1881), 8 Fed. Rep. 150; 7 Sawyer, 270; *Rogers v. Beecher* (1880), 18 O. G. 793; 5 Bann. & A. 619; 3 Fed. Rep. 639; *Miller v. Smith* (1880), 18 O. G. 1047; 5 Fed. Rep. 359; *Hoe v. Cottrell* (1880), 18 O. G. 59; 17 Blatch. 546; 1 Fed. Rep. 597; 5 Bann. & A. 256; *Haskell v. Shoe Machinery Mfg. Co.* (1878), 15 O. G. 509; 3 Bann. & A. 553; *Cahill v. Brown* (1878), 15 O. G. 697; 3 Bann. & A. 580; *Judson v. Bradford* (1878), 16 O. G. 171; 3 Bann. & A. 539; *Roemer v. Simon* (1877), 95 U. S. 214; 12 O. G. 796; *Crouch v. Roemer* (1877), 11 O. G. 1112; 2 Bann. & A. 637; *Smith v. Goodyear Dental Vulcanite Co.* (1876), 93 U. S. 486; 11 O. G. 246; *Cammeyer v. Newton* (1876), 94 U. S. 225; 11 O. G. 287; *Tucker v. Tucker Mfg. Co.* (1876), 10 O. G. 464; 4 Clifford, 397; 2 Bann. & A. 401; *Needham v. Washburn* (1874), 7 O. G. 649; 4 Clifford, 254; 1 Bann. & A. 537; *Smith v. Woodruff* (1873), 6 Fisher, 476; 4 O. G. 635; 1 MacArthur, 459; *Goodyear Dental Vulcanite Co. v. Gardner* (1870), 4 Fisher, 224; 3 Clifford, 408; *Seymour v. Osborne* (1870), 11 Wall. 516; *Sands v. Wardwell* (1869), 3 Clifford, 277; *Hoffheins v. Brandt* (1867), 3 Fisher, 218; *Brodie v. Ophir Silver Mining Co.* (1867), 4 Fisher, 137; 5 Sawyer, 608; *Johnson v. Root* (1862), 2 Fisher, 291;

2 Clifford, 108; *Cahoon v. Ring* (1859), 1 Fisher, 397; 1 Clifford, 592; *Potter v. Holland* (1858), 1 Fisher, 382; 4 Blatch. 238; *Poppenhusen v. N. Y. Gutta Percha Comb Co.* (1858), 2 Fisher, 62; *Wayne v. Holmes* (1856), 2 Fisher, 20; 1 Bond, 27; *Philadelphia & Trenton R. R. Co. v. Stimpson* (1840), 14 Peters, 448; 2 Robb, 46; *Knight v. Baltimore & Ohio R. R. Co.* (1840), Taney, 106; 3 Fisher, 1.

That the patent, including its specification and drawings, is *prima facie* evidence that the patentee is the original inventor of the described improvements, and the burden of proof is on the defendant to show prior invention, see *Cahoon v. Ring* (1859), 1 Fisher, 397; 1 Clifford, 592.

That a re-issued patent is *prima facie* evidence that the patentee was the first inventor and can be overcome only by clear proof, see *Herring v. Nelson* (1877), 12 O. G. 753; 14 Blatch. 293; 3 Bann. & A. 55.

That the presumption that the patentee is the original inventor arises only at the grant of the patent, and does not relate back beyond the filing of the application, see *Wing v. Richardson* (1865), 2 Clifford, 449; 2 Fisher, 535.

That the patent being in evidence the burden of proof is on the defendant to show that the patentee was not the first inventor, see *American Bell Telephone Co. v. People's Telephone Co.* (1884), 29 O. G. 1029; 22 Fed. Rep. 309:

the defendant must show that the alleged rival inventor conceived the invention before the idea of means which it embodies was generated in the mind of the inventor named in the patent, and that he either first reduced it to practice or exercised reasonable diligence in the endeavor so to do.² The date of the conception of the invention by the plaintiff's inventor is, at this stage of the case, assumed to be that of the patent itself, or if the application is referred to in the patent, to be that of the filing of the application.³ The date of its conception by the alleged rival inventor may be shown by his own testimony, or by contemporaneous models or descriptions indicating that the idea was then present in his mind.⁴ The date of his reduction to practice may be fixed by

22 Blatch. 531; Worswick Mfg. Co. v. City of Buffalo (1884), 20 Fed. Rep. 126; 27 O. G. 1239; 22 Blatch. 157; Putnam v. Hollender (1881), 6 Fed. Rep. 882; 19 O. G. 1423; 19 Blatch. 48; Rogers v. Beecher (1880), 18 O. G. 793; 5 Bann. & A. 619; 3 Fed. Rep. 639; Crouch v. Roemer (1877), 11 O. G. 1112; 2 Bann. & A. 637; Taylor v. Wood (1874), 8 O. G. 90; 1 Bann. & A. 270; 12 Blatch. 110; Doherty v. Haynes (1874), 6 O. G. 118; 1 Bann. & A. 289; 4 Clifford, 291; McMillin v. Barclay (1871), 4 Brews. (Pa.) 275; 5 Fisher, 189; Sands v. Wardwell (1869), 3 Clifford, 277; Hoffheins v. Brandt (1867), 3 Fisher, 218; Brodie v. Ophir Silver Mining Co. (1867), 4 Fisher, 137; 5 Sawyer, 608; Wayne v. Holmes (1856), 2 Fisher, 20; 1 Bond, 27; Pitts v. Hall (1851), 2 Blatch. 229; Knight v. Baltimore & Ohio R. R. Co. (1840), Taney, 106; 3 Fisher, 1.

That the defence of prior invention rests upon evidence controlled by the party asserting it, and must be proved beyond reasonable doubt, see Thayer v. Hart (1884), 28 O. G. 542; 20 Fed. Rep. 693; 22 Blatch. 229.

That the preliminary statement filed in interference proceedings is admissible in evidence on the question of

priority in rebuttal of the claimant's testimony, see Detroit Lubricator Co. v. Lunkenheimer (1886), 30 Fed. Rep. 190; 38 O. G. 331.

² That the defendant must show that the date of the prior invention was earlier than the plaintiff's could have been, according to the evidence adduced, see United States Stamping Co. v. Jewett (1880), 18 Blatch. 469; 18 O. G. 1529; 7 Fed. Rep. 869.

³ That the date of the patent is *prima facie* the date of the invention, see Webster Loom Co. v. Higgins (1879), 16 O. G. 675; 15 Blatch. 446; 4 Bann. & A. 88.

That if the application is referred to in the patent the date when it was filed is *prima facie* that of the inventive act, see § 1026, note 15, *post*.

⁴ That descriptions of the invention, given by the alleged inventor to others, may be shown for the purpose of proving that he had then invented it, as no one but himself can otherwise become aware of that fact, see Sayles v. Hapgood (1869), 3 Fisher, 632; 2 Bissell, 189; Philadelphia & Trenton R. R. Co. v. Stimpson (1840), 14 Peters, 448; 2 Robb, 46; Evans v. Hettick (1818), 3 Wash. 408; 1 Robb, 166.

witnesses who knew of his production of the art or article in a form available for immediate practical use.⁵ His diligence in perfecting the invention may be proved by any evidence establishing his perseverance in the effort to render it available as far as his health, his means, and his command of his own time and energies reasonably permitted.⁶ The plaintiff, in rebutter, may show that the date of the inventive act performed by his inventor preceded that of his patent or his application, and was in fact earlier than its performance by his rival, offering for this purpose the same class of evidence by which the date of his rival's inventive act might have been established.⁷ Or failing in this he may attack the diligence of his rival by testimony proving that his opportunities for perfecting the invention were unreasonably neglected, and that his rights as first conceiver were thereby forfeited in favor of the prompt reducer to whom the patent has been issued. Where this question of priority of invention has already been decided in an interference proceeding, the record of that judgment is admissible in favor of the then successful party, and though not conclusive on the jury is entitled to grave consideration.⁸ But the defendant must establish his position be-

⁵ That actual use proves reduction to practice, see *Coffin v. Ogden* (1869), 3 Fisher, 640 ; 7 Blatch. 61.

⁶ For rules concerning diligence in reduction, see §§ 383-387, and notes, *ante*.

That if the patentee temporarily abandoned his efforts and then resumed them after another inventor had applied for a patent, he cannot show that he invented before the date of his resumption, see *Johnson v. Root* (1862), 2 Fisher, 291 ; 2 Clifford, 108.

That where the later inventor first reduced to practice and applied for and obtained a patent, and the earlier inventor applied for a patent before he had reduced to practice, and was not diligent, the later inventor does not infringe the earlier inventor's patent, see *Electric R. R. Signal Co. v. Hall R. R. Signal Co.* (1881), 6 Fed. Rep. 603.

⁷ That when the defendant proves that he invented the device before the plaintiff filed his application, the burden is on the plaintiff to show that he invented before the defendant did, see *Thayer v. Hart* (1884), 20 Fed. Rep. 693 ; 28 O. G. 542 ; 22 Blatch. 229.

That a foreign inventor cannot carry the date of his invention back by showing acts done in a foreign country, see *Boulton v. Illingworth* (1888), 43 O. G. 508.

That the fact that an alleged prior inventor, though patenting other kindred inventions, did not patent this one is competent evidence against his invention of it, see *Frink v. Petry* (1874), 11 Blatch. 422 ; 1 Bann. & A. 1 ; 5 O. G. 201.

⁸ That a patent is increased in weight as *prima facie* evidence of priority by the success of the patentee in interference

yond reasonable doubt; otherwise the presumption arising in favor of the patentee from his own oath as to priority, confirmed by the issue of the patent, will prevail.⁹ The question involved in this defence sometimes presents itself in a modified form, as where the plaintiff's inventor was the first conceiver of the invention but is alleged by the defendant to have forfeited his right to a patent in favor of a later inventor, by his unreasonable delay in its reduction. The attitude of the parties toward certain of the issues raised by this defence are thus reversed, the defendant now attacking and the plaintiff supporting the diligence of the first conceiver; but the evidence applicable to these issues remains the same, and the burden of proof still rests on the defendant to overcome the presumptions created by the plaintiff's patent. This burden is not removed by the fact that the defendant has himself received a subsequent patent for the same invention.¹⁰

proceedings, see *Ayling v. Hull* (1865), 2 Clifford, 494.

That the burden of proof as to priority rests on him to whom the decision of the Patent Office on an interference is adverse, see *Wire Book Sewing Mach. Co. v. Stevenson* (1882), 11 Fed. Rep. 155.

That the decisions of the Commissioner as to priority are not conclusive, though entitled to very great weight, see *Gloucester Isinglass & Glue Co. v. Brooks* (1884), 19 Fed. Rep. 426.

⁹ That the defendant's evidence of prior invention must remove all reasonable doubt, see *Donoughe v. Hubbard* (1886), 27 Fed. Rep. 742; 35 O. G. 1561; *Worswick Mfg. Co. v. City of Buffalo* (1884), 20 Fed. Rep. 126; 22 Blatch. 157; 27 O. G. 1239; *Gottfried v. Phillip Best Brewing Co.* (1879), 17 O. G. 675; 5 Bann. & A. 4.

That the presumption that the patentee is the first inventor arises from his oath, and remains till the contrary is proved, see *Elizabeth v. Pavement Co.* (1877), 97 U. S. 126; *Union Sugar Refinery v. Matthiesson* (1865), 2 Fisher, 600; 3 Clifford, 639; *Bartholo-*

mew v. Sawyer (1859), 1 Fisher, 516; 4 Blatch. 347.

¹⁰ That the introduction of the defendant's subsequent patent does not change the burden of proof as to priority of invention, see *Goodyear Dental Vulcanite Co. v. Gardner* (1870), 4 Fisher, 224; 3 Clifford, 408.

That when the plaintiff first applied for a patent and the defendant obtained his by disclaiming the plaintiff's invention, but after the plaintiff's patent was granted re-issued his to cover the matter before disclaimed, the burden of proof is on him to show that his inventive act was the earliest, see *Smith v. Allen* (1865), 2 Fisher, 572.

That the testimony of a defendant that he was the first inventor of the article is overcome by proof that after the date of his alleged invention he applied for a patent relating to the same subject but based on an essentially different principle, see *Lanison Cash Railway Co. v. Osgood Cash Car Co.* (1886), 29 Fed. Rep. 210; 38 O. G. 1490.

That inferences drawn by the court

§ 1025. Evidence under the Fourth Defence: the Alleged Invention not within the Protected Classes.

The fourth defence raises the question whether the patented invention is embraced within either of those six classes of inventions which are made patentable by the Acts of Congress. Though this is a question for the jury, the court may take judicial notice that the invention is not among those thus protected, when that fact is evident from the patent, and may then, without testimony, direct a verdict on this issue for the defendant.¹ The plaintiff's patent furnishes *prima facie* evidence that the invention described and claimed therein is patentable.² The defendant may contradict this evidence by expert and other testimony that the alleged invention does not possess the essential characteristics either of an art, a machine, a manufacture, a composition of matter, a design, or an improvement. If the alleged invention purports to be a combination, he may prove by similar evidence that its elements do not co-operate for the production of a unitary result, and that it is, therefore, a simple aggregation. In his rebutter, the plaintiff offers evidence of the same nature to

from the conduct of a party may outweigh the direct testimony of any number of witnesses, see the Telephone Cases (1888), 126 U. S. 1 ; 43 O. G. 377.

That the fact that one who now claims to have been the first inventor made no protest against the use of the invention or against the claims of another to be its inventor, but patented an improvement on it without attempting to cover the original, is strong proof against his present claims, see Hutchinson v. Everett (1885), 35 O. G. 1110 ; 26 Fed. Rep. 531.

Upon the subject of priority as between rival inventors, see §§ 370-391, 961, and notes, *ante*.

§ 1025. ¹ That the court may order a verdict for the defendant if it is apparent on the face of the patent that the invention is not within the protected classes, see Blessing v. Copper Works (1888), 34 Fed. Rep. 753 ; West

v. Rae (1887), 33 Fed. Rep. 45 ; Slawson v. Grand St., Prospect Park, & Flatbush R. R. Co. (1882), 107 U. S. 649 ; 24 O. G. 99 ; Everett v. Thatcher (1878), 16 O. G. 1046 ; 2 Flippin, 234 ; 3 Bann. & A. 435. These were cases in equity, but the same principles there applied would compel the court to protect the defendant against an adverse verdict at law. See also § 962, and notes, *ante*.

² That the patent is *prima facie* evidence of the patentability of the invention, see Fraim v. Keen (1885), 25 Fed. Rep. 820 ; 34 O. G. 1048 ; Strobridge v. Lindsay (1880), 18 O. G. 62 ; 2 Fed. Rep. 692 ; 5 Bann. & A. 411.

That the presumption of patentability arising from the patent is not repelled when the device, though needed, is not shown to have been in use before, see Patterson v. Duff (1884), 20 Fed. Rep. 641.

controvert these positions of the defendant. The effect of such evidence, on either side, must be confined to the conformity of the invention claimed in the patent with the legal definition of these patentable classes of inventions. What the necessary attributes of the patented invention are is settled by the court through its construction of the patent, and cannot be affected by extraneous evidence.³ What the essential characteristics of each of the six classes of patentable inventions are is matter of determinate law, and equally beyond the sphere of testimony.⁴ Evidence is admissible to show that the attributes of the invention, as ascertained by the court, correspond with the essentials of a patentable art or article as defined by the law; but this evidence must consist almost entirely of the opinions of persons skilled in the detection of resemblances and differences, rather than of observers and narrators of specific facts. In many cases, indeed, the field of evidence is so narrow that the whole question must be practically treated as a question of law, the jury being required to follow the instruction of the court in reference to its decision.

§ 1026. Evidence under the Fifth Defence: Novelty of the Patented Invention: Prior Use.

The fifth defence raises an issue as to the legal novelty of the patented invention. This issue embraces three questions: (1) Whether the invention had been used in such a manner in this country as to render it accessible to the public at the date of its alleged invention by the patentee or his assignor; (2) Whether it had been patented anteriorly to that date; (3) Whether it had been described in any printed publication which, before that date, had been placed within reach of the public. An affirmative answer to either of these three questions is equivalent to a denial of the legal novelty of the pat-

³ That the patented invention is what the court construes the patent to cover and cannot be varied by other evidence, see §§ 731, 1019, and notes, *ante*.

⁴ For the essential attributes of each

class of inventions, see §§ 159-220, and notes, *ante*.

For the characteristics of a patentable combination, see §§ 153-156, and notes, *ante*.

ented invention, and, therefore, of the validity of the patent in which it is described and claimed.¹ The patent answers all these questions in the negative, and thus throws upon the defendant the burden of proving the affirmative, in reference to at least one of them, beyond a reasonable doubt in order to maintain this defence.² The question of prior use is

§ 1026. ¹ That if the defence of want of legal novelty is satisfactorily proved, it must avail, see *Miller v. Smith* (1880), 5 Fed. Rep. 359; 18 O. G. 1047.

As to the scope of this defence, see § 963, and notes, *ante*.

That legal novelty cannot exist where there was either prior use, prior patent, or prior publication, see §§ 113, 123, 222, 315, 316, and notes, *ante*.

² That the patent itself is *prima facie* evidence of the novelty of the invention, see *Byerly v. Cleveland Linseed Oil Works* (1887), 31 Fed. Rep. 73; *Shaver v. Skinner Mfg. Co.* (1887), 30 Fed. Rep. 68; 41 O. G. 232; *Deane v. Hodge* (1886), 35 Minn. 146; *Lehnbeuter v. Holthaus* (1881), 105 U. S. 94; 21 O. G. 1783; *Corvallis Fruit Co. v. Curran* (1881), 8 Fed. Rep. 150; 7 Sawyer, 270; *Rogers v. Beecher* (1880), 18 O. G. 793; 3 Fed. Rep. 639; 5 Bann. & A. 619; *Thomas v. Shoe Machinery Mfg. Co.* (1878), 16 O. G. 541; 3 Bann. & A. 557; *Miller & Peters Mfg. Co. v. Du Brul* (1877), 12 O. G. 351; 2 Bann. & A. 618; *Needham v. Washburn* (1874), 7 O. G. 649; 4 Clifford, 254; 1 Bann. & A. 537; *Smith v. Woodruff* (1873), 6 Fisher, 476; 4 O. G. 635; 1 MacArthur, 459; *Roberts v. Dickey* (1871), 4 Brews. (Pa.) 260; 4 Fisher, 532; 1 O. G. 4; *Whitney v. Mowry* (1867), 3 Fisher, 157; 2 Bond, 45; *Blanchard v. Puttman* (1867), 3 Fisher, 186; 2 Bond, 84; *Swift v. Whisen* (1867), 3 Fisher, 343; 2 Bond, 115; *Poppenhusen v. N. Y. Gutta Percha Comb Co.* (1858), 2 Fisher, 62; *Potter v. Holland* (1858),

1 Fisher, 382; 4 Blatch. 238; *Wayne v. Holmes* (1856), 2 Fisher, 20; 1 Bond, 27; *Ransom v. Mayor of New York* (1856), 1 Fisher, 252; *Teese v. Phelps* (1855), 1 McAllister, 48; *Parker v. Stiles* (1849), 5 McLean, 44.

That a patent for a combination of old elements is *prima facie* evidence that it is new, see *Shaver v. Skinner Mfg. Co.* (1887), 30 Fed. Rep. 68; 41 O. G. 232.

That a re-issued patent is evidence that the invention was new, see *Serrell v. Collins* (1857), 1 Fisher, 289.

That an extension after a hearing is strong evidence of novelty, see *Black v. Thorne* (1872), 2 O. G. 388; 5 Fisher, 550; 10 Blatch. 66; *Whitney v. Mowry* (1867), 3 Fisher, 157; 2 Bond, 45; *Swift v. Whisen* (1867), 2 Fisher, 343; 2 Bond, 115.

That a British patent under the great seal proves itself, but is only *prima facie* evidence that the invention is new and useful and of some probable value, see *Gatling v. Newell* (1857), 9 Ind. 572.

That the weight of a patent as *prima facie* evidence of novelty may be aided by showing that the invention was subjected to rigid scrutiny and comparison with previous patents in the Patent Office, see *Shaver v. Skinner Mfg. Co.* (1887), 30 Fed. Rep. 68; 41 O. G. 232.

That the patent being in evidence the burden of proof rests on the defendant to show want of novelty, see *Vulcanite Paving Co. v. American Artificial Stone Pavement Co.* (1887), 42 O. G. 828; *Bostock v. Goodrich* (1884), 21 Fed. Rep. 316; 29 O. G. 278; *Double-*

further divisible into two others: (1) Whether the art or article alleged to have been previously used was identical with the patented invention; (2) Whether the use alleged was such as to have rendered the invention accessible to the public at the date of its conception by the plaintiff's inventor.³

day v. Beatty (1882), 11 Fed. Rep. 729; 22 O. G. 859; Green v. French (1882), 11 Fed. Rep. 591; 21 O. G. 1351; Woven Wire Mattress Co. v. Wire-Web Bed Co. (1881), 8 Fed. Rep. 87; Miller v. Smith (1880), 18 O. G. 1047; 5 Fed. Rep. 359; Gear v. Grosvenor (1873), 6 Fisher, 314; 3 O. G. 380; Holmes, 215; Clark v. Scott (1872), 2 O. G. 4; 9 Blatch. 301; 5 Fisher, 245; Baldwin v. Schultz (1871), 2 O. G. 315; 9 Blatch. 494; 5 Fisher, 75; Roberts v. Dickey (1871), 1 O. G. 4; 4 Brews. (Pa.) 260; 4 Fisher, 532; Howes v. Nute (1870), 4 Fisher, 263; 4 Clifford, 173; Tompkins v. Gage (1865), 2 Fisher, 577; 5 Blatch. 268; Union Sugar Refinery v. Matthiesson (1865), 2 Fisher, 600; 3 Clifford, 639; Allen v. Blunt (1846), 2 W. & M. 121; 2 Robb, 530.

That the defendant must prove want of novelty beyond reasonable doubt, see American Bell Telephone Co. v. Globe Telephone Co. (1887), 31 Fed. Rep. 729; Cary v. Lovell Mfg. Co. (1887), 31 Fed. Rep. 344; 40 O. G. 1239; Cohansey Glass Mfg. Co. v. Wharton (1886), 28 Fed. Rep. 189; 36 O. G. 343; Doubleday v. Beatty (1882), 11 Fed. Rep. 729; 22 O. G. 859; Crouch v. Speer (1874), 6 O. G. 187; 1 Bann. & A. 145; Wood v. Cleveland Rolling Mill Co. (1871), 4 Fisher, 550; Tompkins v. Gage (1865), 2 Fisher, 577; 5 Blatch. 268.

That although the defendant has received a patent and introduces it, the burden of proof on the question of novelty still rests on him, see Goodyear Dental Vulcanite Co. v. Gardner (1870), 4 Fisher, 224; 3 Clifford, 408.

³ That proof of actual prior use does overcome the presumption arising from the patent, see Judson v. Bradford (1878), 16 O. G. 171; 3 Bann. & A. 539.

That prior use is a question of fact, see Fisk v. Church (1872), 1 O. G. 634; 5 Fisher, 540.

That where the prior invention was identical with the one patented, was complete, capable of producing some result, and was known in this country, the defence will prevail, see Stitt v. Eastern R. R. Co. (1884), 22 Fed. Rep. 649.

That the *prima facie* evidence of novelty afforded by the patent is not overcome unless true anticipating inventions are definitely proved to have been in prior use, see Butler v. Bainbridge (1886), 29 Fed. Rep. 142; 37 O. G. 1124.

That evidence showing the existence of practical operative devices, before their conception by the patentee, invalidates the patent, see American Bell Telephone Co. v. People's Telephone Co. (1884), 29 O. G. 1029; 22 Blatch. 531; 22 Fed. Rep. 309.

That what would infringe, if later, anticipates, if earlier, see Peters v. Active Mfg. Co. (1884), 28 O. G. 1102; 21 Fed. Rep. 319.

That prior use of articles, less perfect but identical in principle, invalidates the patent, see Magin v. McKay (1885), 32 O. G. 1237; 24 Fed. Rep. 743.

That a prior use of similar but not identical devices cannot defeat the patent, though they may show the state of the art and thus limit the patent, see McFarland v. Spencer (1885), 32 O. G.

Upon both of these points the defendant's evidence must be conclusive.⁴ The identity of the prior art or article with the patented invention may be established by any kind of relevant testimony.⁵ If the invention is an article, specimens in exist-

893; 23 Fed. Rep. 150; 23 Blatch. 155.

That a small device may show prior use, see *Peters v. Active Mfg. Co.* (1889), 129 U. S. 530.

That courts cannot pronounce a patent void for prior use unless the evidence shows that the same principles were before employed, see *Case v. Morey* (1818), 1 N. H. 347.

That a defence to a patent for a combination as a whole must apply to the entire combination and not to separate parts, see *Bates v. Coe* (1878), 98 U. S. 31; 15 O. G. 337.

⁴ That the burden of proof rests upon the defendant to show the existence of the identical invention before the grant of the plaintiff's patent, see *Hayden v. Suffolk Mfg. Co.* (1862), 4 Fisher, 86.

That a defendant has the burden of proof on the question of prior use, see *Thayer v. Spaulding* (1886), 27 Fed. Rep. 66; 36 O. G. 1044; *Cantrell v. Wallick* (1886), 117 U. S. 689; 35 O. G. 871; *Dreyfus v. Schneider* (1885), 25 Fed. Rep. 481; *Worswick Mfg. Co. v. City of Buffalo* (1884), 27 O. G. 1239; 20 Fed. Rep. 126; 22 Blatch. 157; *Parker v. Remhoff* (1879), 17 Blatch. 206; 14 O. G. 601; 3 Bann. & A. 550; *Webster Loom Co. v. Higgins* (1879), 16 O. G. 675; 15 Blatch. 446; 4 Bann. & A. 88; *Fisk v. Church* (1872), 1 O. G. 634; 5 Fisher, 540; *Baldwin v. Schultz* (1871), 5 Fisher, 75; 2 O. G. 315; 9 Blatch. 494; *Magic Ruffle Co. v. Douglass* (1863), 2 Fisher, 330; *Wayne v. Holmes* (1856), 2 Fisher, 20; 1 Bond, 27.

That prior use must be proved beyond reasonable doubt, see *Osborne v. Glazier* (1887), 40 O. G. 1137; 31 Fed.

Rep. 402; *Cluett v. Claffin* (1887), 30 Fed. Rep. 921; 41 O. G. 1042; *Wetherill v. Keith* (1886), 27 Fed. Rep. 364; 37 O. G. 337; *Cantrell v. Wallick* (1886), 117 U. S. 689; 35 O. G. 871; *Thayer v. Spaulding* (1886), 27 Fed. Rep. 66; 36 O. G. 1044; *Dreyfus v. Schneider* (1885), 25 Fed. Rep. 481; *Everest v. Buffalo Lubricating Oil Co.* (1884), 20 Fed. Rep. 848; 28 O. G. 1101; *American Bell Telephone Co. v. People's Telephone Co.* (1884), 22 Fed. Rep. 309; 29 O. G. 1029; 22 Blatch. 531; *Thayer v. Hart* (1884), 20 Fed. Rep. 693; 22 Blatch. 229; 28 O. G. 542; *Campbell v. James* (1879), 18 O. G. 979; 4 Bann. & A. 456; 17 Blatch. 42; *Hawes v. Antisdel* (1875), 8 O. G. 685; 2 Bann. & A. 10; *Coffin v. Ogden* (1873), 18 Wall. 120; 5 O. G. 270; *Magic Ruffle Co. v. Douglass* (1863), 2 Fisher, 330; *Washburn v. Gould* (1844), 3 Story, 122; 2 Robb. 206.

That every reasonable doubt in regard to prior use must be resolved in favor of the plaintiff, see *Washburn & Moen Mfg. Co. v. Haish* (1880), 4 Fed. Rep. 900; 19 O. G. 173; 10 Bissell, 65; *Hawes v. Antisdel* (1875), 8 O. G. 685; 2 Bann. & A. 10; *Coffin v. Ogden* (1873), 18 Wall. 120; 5 O. G. 270; *Parham v. American Buttonhole Overseaming & Sewing Mach. Co.* (1871), 4 Fisher, 468; *Washburn v. Gould* (1844), 3 Story, 122; 2 Robb. 206.

That mere preponderance of evidence cannot establish anticipations twenty years before, see *Smith v. Fay* (1873), 6 Fisher, 446.

⁵ In *Stitt v. Eastern R. R. Co.* (1884), 22 Fed. Rep. 649, Colt, J.: (651) "The primary inquiry is one of identity between

ence before the date of the plaintiff's patent may be produced and compared with the patented invention, with or without the aid of expert evidence.⁶ Descriptions of the invention, written or printed, whether in private papers or in prior patents, applications, or other documents in the Patent Office, may be introduced to show its essential characteristics and its correspondence with the patented invention.⁷ The testimony of

two things. If the identity can only be known by actual use, such use should be proved. If the identity is apparent on inspection, it is not necessary to prove actual use. If there is a reasonable doubt as to identity, want of novelty is not made out. Walk. Pat. § 72. By the weight of authority and of reason, it would seem that if the prior invention was the same as that described in the patent; if it was complete, and capable of producing the same result, and was known in this country, it is sufficient to sustain the defence of want of novelty."

In *Hayden v. Suffolk Mfg. Co.* (1862), 4 Fisher, 86, Sprague, J.: (102) "Gentlemen, this is, as I have already mentioned to you, a question of what existed some seventeen years ago. Now, I think it proper to say to you, that where an invention of any useful machine or structure, or improvement in any machine, is shown to have been made, and it is sought to be invalidated by an old machine made years ago, the jury should examine the testimony and the evidence with care and caution, so as to be satisfied that that which is said to have existed was actually and substantially the same. The rule of law is a reasonable one, at all events it is a rule of law, that a party who sets up such an old instrument, that has passed away, has upon him the burden of satisfying the jury upon a preponderance of evidence that it is substantially the same as what has taken place, before they will set aside the patent. If they are so satisfied by the evidence, that it was

substantially the same and known before, then it is their duty so to say when considering the patent."

⁶ That whether one thing is identical with or the "equivalent" of another is a question of fact on the evidence of experts on an inspection of the inventions, see *Foss v. Herbert* (1856), 2 Fisher, 31; 1 Bissell, 121.

That prior machines are admissible to show that if defendant copies them he does not infringe, or if he does infringe, then the patent is void for prior use, see *Whipple v. Baldwin Mfg. Co.* (1858), 4 Fisher, 29.

That in attacking novelty specimens of the anticipating invention itself should be offered, not specimens since made from the descriptions given by those who saw the old, see *Theberath v. Rubber & Celluloid Harness Trimming Co.* (1883), 15 Fed. Rep. 246; 23 O. G. 1121.

That prior use is proved if a sample of the article used is produced and verified by several witnesses whose character for truth is not impeached, see *Miller v. Foree* (1885), 116 U. S. 22; 33 O. G. 1496.

⁷ That an application which fully describes an invention is conclusive evidence that the invention was made before the application was filed, see *Kearney v. Lehigh Valley R. R. Co.* (1887), 32 Fed. Rep. 320.

That the record of a rejected application to the Patent Office with its specification, models, etc., is admissible to establish prior invention, in connection with other proof that a working machine

persons who saw the article, or observed the practice of the art, may also be received for the same purpose. Of these three forms of evidence, that of existing specimens is, of course, the most reliable; and when they do exist, and are under the control of the defendant, his failure to present them raises a strong presumption against their identity with the article protected by the plaintiff's patent.⁸ The evidence of witnesses who speak from personal recollection only is of comparatively little value, its weight being diminished in proportion to the remoteness of their observation, and the intricacy of the invention which they endeavor to recall.⁹ To merit any consideration it must be positive and specific, not conjectural and indefinite.¹⁰ Identity cannot be inferred from

embodying the invention was made, and that successful experiments with it were performed in public, see *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.* (1874), 6 O. G. 34; 10 Phila. 227; 1 Bann. & A. 177.

That a prior application without evidence of reduction to practice cannot show prior use, see *Adams v. Howard* (1884), 26 O. G. 825; 19 Fed. Rep. 317.

⁸ That machines as shown by their models are evidence of the highest class, see *Morris v. Barrett* (1859), 1 Fisher, 461; 1 Bond, 254.

That doubtful evidence as to prior use becomes still more doubtful if the defendant fails to produce specimens of the devices used, see *Chase v. Wesson* (1873), 6 Fisher, 517; 4 O. G. 476; *Holmes*, 274.

That if the defendant has possession of an alleged prior article and does not produce it, the presumption will be strong against him, see *Bailey Washing & Wringing Mach. Co. v. Lincoln* (1871), 4 Fisher, 379.

⁹ That evidence concerning anticipation must be weighed in view of the lapse of time since the alleged prior use, see *Yale Lock Mfg. Co. v. Berkshire Nat. Bank* (1885), 26 Fed. Rep. 104.

That recollections, after many years, of devices, none of which are produced in court, are not reliable testimony, see *Adams & Westlake Mfg. Co. v. Rathbone* (1886), 26 Fed. Rep. 262.

That the memory of a witness as to an article he saw twenty-one years before is not very reliable, see *Ely v. Monson & Brimfield Mfg. Co.* (1860), 4 Fisher, 64.

That the patent will not be set aside on the testimony of a single witness that many years ago he saw an article like the one claimed, see *La Baw v. Hawkins* (1874), 6 O. G. 724; 1 Bann. & A. 428.

That the unreliability of the memory as to dates, the delay of an alleged prior inventor in utilizing or patenting the invention, &c., tend to prevent the evidence from removing reasonable doubt, see *Osborne v. Glazier* (1887), 31 Fed. Rep. 402; 40 O. G. 1137.

¹⁰ That indefinite recollections of a use twenty years past, no models being produced, is not sufficient proof of prior use, see *Wetherell v. Keith* (1886), 27 Fed. Rep. 364; 37 O. G. 337.

That testimony of witnesses who say they saw the device in use many years before, but who are contradicted by others, is not sufficient when the de-

the opinion of a witness that the alleged anticipating device might have been altered to become the patented invention, or might have been employed to perform its functions, or that a product then existing might have resulted from a process similar to that claimed by the plaintiff in his patent.¹¹ Even when positive and specific, such evidence is easily overcome by acts or testimony inconsistent with its truth. The silence of the maker of the prior article, if present in court in the interest of the defendant but not examined on this subject, outweighs the declarations of numerous observers.¹² The oral statement of a patentee that his invention, as originally produced, possessed the characteristic features of the plaintiff's, is negatived by their absence from the description in his patent.¹³ The asseveration of a workman that he used the same invention in his employers' business, is contradicted by the fact that at a later period they sought the invention elsewhere.¹⁴ Still,

vices are not produced, see *Wetherell v. Keith* (1886), 27 Fed. Rep. 364; 37 O. G. 337; *Washburn & Moen Mfg. Co. v. Haish* (1880), 19 O. G. 173; 4 Fed. Rep. 900; 10 Bissell, 65; *Smith v. Fay* (1873), 6 Fisher, 446.

¹¹ That on the issue of novelty evidence as to what might have been done with prior machines, or that these could have been altered into the one patented, is not admissible, see *Cook v. Ernest* (1872), 2 O. G. 89; 5 Fisher, 396; *Livingston v. Jones* (1859), 1 Fisher 521.

That evidence as to what might have been done with prior machines is mere speculation and avails nothing, see *Judson v. Cope* (1860), 1 Fisher, 615; 1 Bond, 327.

That evidence that a witness had seen an article which might have been made by a device like the plaintiff's before his invention, cannot outweigh the patent unless the jury are satisfied that it was made by this device, see *Treadwell v. Bladen* (1827), 4 Wash. 703; 1 Robb, 531.

¹² That the maker of an alleged prior

machine is present but is not examined is to be considered in estimating the value of other evidence, see *Wood v. Cleveland Rolling Mill Co.* (1871), 4 Fisher, 550.

¹³ That the oral testimony of a patentee that he made the device, when his own patent does not show it, and the device is not produced, is not sufficient, see *Woven Wire Mattress Co. v. Wire-Web Bed Co.* (1881), 8 Fed. Rep. 87.

¹⁴ That a witness swearing to prior use is rendered unreliable by evidence that his employers, after having the benefit of his skill, sought the right elsewhere, see *St. Louis Stamping Co. v. Quinby* (1879), 16 O. G. 135; 4 Bann. & A. 192.

That testimony of prior use is overthrown by evidence that the witnesses accepted and operated under a license from the patentee, see *Lockwood v. Hooper* (1885), 25 Fed. Rep. 910.

That the plaintiff may show that the defendant offered a large sum for the patent, and then took out patents for similar devices, this being inconsistent

with all its necessary infirmities, this species of evidence is admissible and may be sufficient to convince a jury, even without specimens or contemporaneous descriptions, that the prior art or article was identical with the patented invention. Identity being thus established, the defendant must further prove that the art or article in question was used in such a manner as to render the invention accessible to the public at the date of its conception by the plaintiff's inventor. Here, as elsewhere, the date of the inventive act of the plaintiff's inventor is assumed to be that of his patent or his application; and it is sufficient for the defendant to show that the use of the invention was prior to that date, in order to throw upon the plaintiff the burden of proving that his conception of the invention preceded not merely the date of his own application but also that of the use shown by the defendant.¹⁵ However,

with his claim of want of novelty, see *Bostock v. Goodrich* (1884), 21 Fed. Rep. 316; 29 O. G. 278.

That a circular published by a person claiming that the invention was then new outweighs his parol evidence that it had previously existed, see *Masury v. Tiemann* (1871), 4 Fisher, 524; 8 Blatch. 426.

¹⁵ That the date of the plaintiff's patent is *prima facie* the date of his inventive act, see *Eagleton Mfg. Co. v. West, Bradley, & Cary Mfg. Co.* (1880), 2 Fed. Rep. 774; 17 O. G. 1504; 18 Blatch. 218; 5 Bann. & A. 475.

That the invention claimed in a re-issue is presumed to have been made at the date of the original, see *House v. Young* (1867), 3 Fisher, 335.

That if the application accompanies the patent, the date of the application is *prima facie* the date of the inventive act, see *Eagleton Mfg. Co. v. West, Bradley, & Cary Mfg. Co.* (1880), 17 O. G. 1504; 2 Fed. Rep. 774; 18 Blatch. 218; 5 Bann. & A. 475; *Wing v. Richardson* (1865), 2 Fisher, 535; 2 Clifford, 449.

That on a question of prior use the

patent relates back to the date of the original discovery, see *Consolidated Bunting Apparatus Co. v. Woerle* (1887), 29 Fed. Rep. 449; 38 O. G. 1015.

That the date of filing the application cannot be shown by parol but by the records of the Patent Office, see *Wayne v. Winter* (1855), 6 McLean, 344.

That if the defendant shows knowledge or use prior to the application, or patent if the application be not in evidence, the burden shifts to the plaintiff to prove that his inventive act preceded such knowledge or use, see *Eagleton Mfg. Co. v. West, Bradley, & Cary Mfg. Co.* (1880), 17 O. G. 1504; 18 Blatch. 218; 2 Fed. Rep. 774; 5 Bann. & A. 475; *Webster Loom Co. v. Higgins* (1879), 16 O. G. 675; 4 Bann. & A. 88; 15 Blatch. 446; *Hazelip v. Richardson* (1876), 10 O. G. 747; *Jones v. Sewall* (1873), 6 Fisher, 343; 3 O. G. 630; 3 Clifford, 563; *Wing v. Richardson* (1865), 2 Fisher, 535; 2 Clifford, 449; *Union Sugar Refinery v. Matthiesson* (1865), 2 Fisher, 600; 3 Clifford, 639.

That the burden of proof is on the

as the defendant is not allowed to reproduce his evidence of prior use after the rebuttal of the plaintiff, it is incumbent on him, when making his defence, to exhaust his testimony as to the remoteness of such use, and fix its date as early as his evidence permits.¹⁶ The use of an invention renders it accessible to the public only when the invention is complete and operative, and when it is practically used in such a manner as to disclose its character, construction, and mode of operation to the public.¹⁷ That an invention was complete and operative may be shown by specimens, if any still exist, or by the testimony of witnesses having personal knowledge of its condition. Descriptions, printed or written, sketches and drawings, are not sufficient of themselves to prove that the invention was operative, or was practically used.¹⁸ The evidence of practical use must be derived from witnesses who actually used the invention or had knowledge of its use by others. Such use must have been in public, not in secret, and in the practical application of the invention to industrial purposes.¹⁹

patentee to show that he made the invention before the date of filing his application, and he must show that it was before that time reduced to practice, see *Johnson v. Root* (1862), 2 Fisher, 291 ; 2 Clifford, 108.

¹⁶ That new evidence for the defendant is not allowed after the plaintiff's rebuttal, see *Ames v. Howard* (1833), 1 Sumner, 482 ; 1 Robb, 689.

¹⁷ That prior use is not proved by the existence of a device capable of such use, it must have been practically used, see *Piper v. Brown* (1870), Holmes, 20 ; 4 Fisher, 175 ; *Pennock v. Dialogue* (1825), 4 Wash. 538 ; 1 Robb, 466.

That sufficient prior use must be shown to prove that the device will accomplish what is claimed, see *Sayles v. Chicago & Northwestern Railway Co.* (1871), 4 Fisher, 584 ; 3 Bissell, 52.

¹⁸ That a rejected application is not evidence that the invention was completed or in use, see *Howes v. McNeal* (1878), 15 O. G. 608 ; 15 Blatch. 103 ; 3 Bann. & A. 376 ; *Rubber Step Mfg.*

Co. v. Metropolitan R. R. Co. (1878), 13 O. G. 549 ; 3 Bann. & A. 252.

That file-wrappers, &c., are not evidence to show the reduction to practice of inventions claimed to be prior to the one patented, being only hearsay evidence and declarations of third parties, see *Howes v. McNeal* (1880), 4 Fed. Rep. 151 ; 17 O. G. 799 ; 17 Blatch. 396 ; 5 Bann. & A. 77.

That a prior patent does not show a use earlier than the date of the patent, see *Howes v. McNeal* (1880), 17 O. G. 799 ; 17 Blatch. 396 ; 4 Fed. Rep. 151 ; 5 Bann. & A. 77 ; *Kelleher v. Darling* (1878), 4 Clifford, 424 ; 14 O. G. 673 ; 3 Bann. & A. 438.

That a caveat is not conclusive evidence that an invention is not perfected, see *Johnson v. Root* (1858), 1 Fisher, 851.

That catalogues, etc., may be offered to show prior use, see *Forschner v. Baumgarten* (1886), 26 Fed. Rep. 858 ; 35 O. G. 137.

¹⁹ That to overcome the presumption

A single instance of such use being established the defence is complete without proof of continued user, except in cases where the use was so remote that the knowledge thus communicated to the public was extinguished, and the invention had become a lost art, at the date of its conception by the plaintiff's inventor.²⁰ It has been held that proof of actual use is not essential when the invention in its complete and operative state fully disclosed its character and mode of operation without practical employment, and was known in that condition to the public.²¹ This cannot be true of an art, since an art can be perceived only while in process of employment, nor of articles whose qualities are manifested only during their practical application. Other articles, disclosing their essential attributes to mere inspection, if shown to have been subject to public observation, may, however, become known by the public without actual use, and in such cases evidence of knowledge without use may be sufficient. Under all other circumstances actual use must be established. Such use must have occurred in the United States, — a use abroad, though known to persons in this country, not impairing the validity of a domestic patent.²² Even a foreign use of the invention,

arising from the grant of the patent the evidence must show such prior knowledge as gave the public a right to use the invention, see *Crouch v. Speer* (1874), 6 O. G. 187; 1 Bann. & A. 145.

²⁰ That prior use may be proved though the use has been abandoned, see *Shoup v. Henrici* (1872), 9 O. G. 1162; 2 Bann. & A. 249; *Evans v. Hettick* (1818), 3 Wash. 408; 1 Robb, 166.

That a device was in use twenty-five years ago does not warrant a finding that it is still in operation, see *Seymour v. McCormick* (1856), 19 How. 96.

²¹ That both prior knowledge and use need not be proved, for the use may or may not be the sole evidence of identity and knowledge, see *Stitt v. Eastern R. R. Co.* (1884), 22 Fed. Rep. 649.

That evidence of prior use is sufficient if it shows that the invention was

complete and capable of working and was known to a number of persons and had been in use, see *Judson v. Bradford* (1878), 16 O. G. 171; 3 Bann. & A. 539; *Coffin v. Ogden* (1873), 18 Wall. 120; 5 O. G. 270.

²² That evidence of reduction to practice abroad prior to invention in the United States is inadmissible, see *Bell v. Brooks* (1881), 19 O. G. 290.

That evidence of use abroad is not admissible, see *Doyle v. Spaulding* (1884), 27 O. G. 300; *Schillinger v. Greenway Brewing Co.* (1883), 24 O. G. 495; 21 Blatch. 383; 17 Fed. Rep. 244; *Judson v. Cope* (1860), 1 Fisher, 615; 1 Bond, 327.

That a prior foreign patent is not admissible to prove prior use, see *Cornely v. Marckwald* (1883), 17 Fed. Rep. 83; 24 O. G. 498; 21 Blatch. 367.

That foreign machines not arriving in

of which the plaintiff's inventor was cognizant when he made oath to his application, does not disprove the legal novelty of the invention, although the fraud and falsehood of the applicant would invalidate the patent.²³ The testimony of witnesses as to the fact of use and the completeness and availability of the invention is not open to the same suspicion as their evidence concerning its identity with the patented invention. The recollection of an honest witness as to the operativeness and actual employment of an art or article, whose existence is conceded or established, may in all ordinary cases be regarded as reliable. But where his statements are inconsistent with the general current of events, or where the use to which he testifies must have been observed, if it occurred, by others who deny all knowledge of such use, his evidence is wanting in the conclusiveness and credibility which it must possess in order to overcome the presumptions arising from the patent, and satisfy that burden of proof which the law throws upon the defendant.²⁴ The plaintiff in rebutting the defendant's evidence of prior use may attack either the identity or the use of the prior art or article. He may disprove its identity by evidence of the same species as that by which the

this country until after the date of the plaintiff's inventive act, have no bearing on the question of novelty, see *Weston Dynamo Electric Mach. Co. v. Arnoux* (1884), 28 O. G. 285; 20 Fed. Rep. 112.

That the issue of an American patent, in the case of a foreign invention, does not prove an introduction into common use, without other evidence, see *Weston v. White* (1876), 9 O. G. 1196; 13 Blatch. 364; 2 Bann. & A. 321.

²³ That the oath of the patentee, that he believed himself to be the first inventor, is not contradicted by proof of foreign prior use, see *Bartholomew v. Sawyer* (1859), 4 Blatch. 347; 1 Fisher, 516; *Furbush v. Cook* (1857), 2 Fisher, 668.

²⁴ That the testimony of witnesses as to a reduction to practice is incredible, when the devices themselves will

not operate, see *American Bell Telephone Co. v. People's Telephone Co.* (1885), 25 Fed. Rep. 725; 34 O. G. 561.

That the patent is not overcome by the testimony of a single witness that the device was in use twenty years before in a large town, where, if it were so, many must have known it, and when no model or machine is now in existence, and there is no evidence of a general use though the device must have been of great utility, see *Blake v. Eagle Works Mfg. Co.* (1871), 4 Fisher, 591; 3 Bissell, 77.

That the evidence must be very clear in order to show that an old patent on an article well known and constantly used is invalid for a prior use occurring twenty-three years before the prior use was known, see *Zane v. Peck Bros.* (1881), 9 Fed. Rep. 101.

defendant has attempted to affirm it. In addition thereto, he may show the superior utility of either invention to the other as the basis of an inference that differences of such extent in the effect could only proceed from a substantial difference of means.²⁵ This superior utility may be established by comparing the two inventions, or their practical operation, or their acceptance by the public; the commercial success of one invention and the failure of the other being regarded as an indication of greater usefulness, and consequently of essential differences, in the former.²⁶ In attacking the alleged use of the invention the plaintiff may endeavor to show either that the invention was not complete and operative, or that it was not practically used in public, or that its use did not anticipate the inventive act of his own inventor. Upon the first point, positive evidence of any kind tending to show that the invention was inoperative and incomplete, until the date of its conception by the inventor from whom he derives it, is admissible. Besides this, he may prove that the prior article or art, after the use referred to by the defendant's witnesses, was abandoned by its inventor as an unsuccessful experiment, and such abandonment may be inferred from the cessation of its use where the invention, if successful, would have been of great utility and would have satisfied a recognized public want.²⁷ Upon the second point, where he cannot impeach the

²⁵ That where novelty or *modus operandi* are in question it is proper to show what the effect of the invention is, see *Klein v. Russell* (1873), 19 Wall. 433.

²⁶ That superior utility shows want of identity, see §§ 116-121, 344, and notes, *ante*.

²⁷ In *Hayden v. Suffolk Mfg. Co.* (1862), 4 Fisher, 86, Sprague, J. : (102) "If there were experiments made, gentlemen, and they tend to a certain point, and there is no certainty to what extent they went, then the subsequent conduct of the parties who made experiments, and were interested in it, may aid you in forming an opinion of what they accomplished. If they preserved

it as a thing valuable, it has a weight in one direction as showing that they had accomplished something. If they did not preserve it but abandoned it, the evidence is to be weighed whether it was abandoned or not; whether a success has been obtained in anything that was worthy of preservation, or could accomplish a practical and useful purpose; and the weight of this you will probably know is in proportion to the importance of the thing. There may be an invention, gentlemen, of so unimportant a character, that although it be really an invention, something of practical use, it may be in relation to a subject-matter of so little importance, or of transient interest, that the occa-

testimony of the witnesses who claim to have used the invention or to have knowledge of its use, he may attempt to prove that the invention became a lost art, and passed from the knowledge of the public, and that it was discovered and again bestowed upon them by his own inventor.²⁸ The negative evidence of witnesses, who would have been acquainted with the invention if it had been practically used and known, is here of great importance, and may be offered to contradict the fact of use, as well as its continuance and publicity, and the accessibility of the invention to the public at the date of its conception by the inventor named in the patent.²⁹ Upon the third point, it is only necessary for the plaintiff to carry back the date of the inventive act of his inventor to a period anterior to the earliest practical use in public which has been already proved by the defendant. If such use did not precede the filing of the application for a patent, a certified copy of the application from the Patent Office with the date of its reception is sufficient. If the use occurred before the application, evidence of the earlier conception of the invention may be offered, consisting either of specimens made or descriptions framed before the alleged use, or of the testimony of witnesses

sion may pass by and it may be laid aside and never used afterward, because there was no occasion for it. . . . On the other hand, if the invention be of something which can be of great practical importance, an enduring importance, then you will consider how much stronger will be the incentive to success in perfecting that which would have been of importance; and the greater the importance of the invention, the less probable that if achieved it would have been laid aside and not extended itself to others interested in its use."

²⁸ That the existence of an invention which became a lost art before the inventive act of the patentee does not show prior use, see §§ 321-324, and notes, *ante*.

²⁹ That negative evidence is important, such as non-attack upon patent,

non-publication in books, etc., non-acquaintance of those skilled in the art, etc., see *Parker v. Hulme* (1842), 1 Fisher, 44.

That the evidence of a witness that at a particular time the plaintiff made a device which the witness never before saw or heard of is admissible, see *Pennock v. Dialogue* (1825), 4 Wash. 538; 1 Robb, 466.

That silence raises a stronger presumption than the evidence of witnesses, see *Smith v. Fay* (1873), 6 Fisher, 446.

That intangible presumptions must yield to positive proof, see *Bliss v. Merrill* (1837), 42 O. G. 97.

That positive evidence of witnesses as to the existence of prior devices must outweigh merely negative proof, see *Sayles v. Chicago & Northwestern Railway Co.* (1871), 4 Fisher, 584; 3 Bissell, 52.

who, prior to such use, saw the invention which he had produced, or in some other way derived from him a knowledge of its essential characteristics.⁸⁰ The burden of proof, on this point, shifts to the plaintiff when the defendant proves a use anterior to the date of the application, especially where the existence of the invention is evidenced by a patent issued before the patent of the plaintiff. With this exception, the burden on the entire issue of prior use rests upon the defendant, and though when proved it is destructive to the patent, yet if his testimony falls short of removing every reasonable doubt, and leaves a mere preponderance in his favor, the *prima facie* evidence of the patent is not overcome and the novelty of the invention remains unimpeached.⁸¹ This issue of prior use may be raised by the defendant in reference to several distinct inventions, each of which he claims as an anticipation of, the one covered by the plaintiff's patent. In such a case each stands alone as to the questions of identity and actual use, and must not only be separately considered by the jury but also distinguished in their verdict, unless the issue is found alike on all in favor of the plaintiff.⁸² The same

⁸⁰ In *Philadelphia & Trenton R. R. Co. v. Stimpson* (1840), 14 Peters, 448, Story, J. : (462) "The conversations and declarations of a patentee, merely affirming that at some former period he invented that particular machine, might well be objected to. But his conversations and declarations, stating that he had made an invention, and describing its details and explaining its operations, are properly to be deemed an assertion of his right, at that time, as an inventor to the extent of the facts and details which he then makes known ; although not their existence at an antecedent time." 2 Robb, 46 (69).

That the plaintiff in rebutting the evidence attacking the novelty of his invention, may show the date of his inventive act by sketches and drawings, see *Kneeland v. Sheriff* (1880), 18 O. G. 242 ; 2 Fed. Rep. 901 ; 5 Bann. & A. 482 ; *Draper v. Potomska Mills Co.*

(1878), 13 O. G. 276 ; 3 Bann. & A. 214 ; *Reeves v. Keystone Bridge Co.* (1872), 1 O. G. 466 ; 5 Fisher, 456 ; 9 Phila. 368.

That the plaintiff may show that alleged prior users subsequently became his licensees, see *Evans v. Eaton* (1818), 3 Wheaton, 454 ; 1 Robb, 243.

That the former testimony of the plaintiff that he had invented does not constitute invention, see *Pennsylvania Diamond Drill Co. v. Simpson* (1886), 37 O. G. 218 ; 29 Fed. Rep. 288.

⁸¹ That the court will presume against prior knowledge or use in case of doubt, see note 4, *ante*.

That when the defendant's evidence is fully up to the standard, the novelty is successfully impugned, see *Doubleday v. Beatty* (1882), 11 Fed. Rep. 729 ; 22 O. G. 859.

⁸² That where several prior inventions are offered to defeat a patent each

rule applies where several prior patents or publications are set up by the defendant.

§ 1027. Evidence under the Fifth Defence: Novelty of the Patented Invention: Prior Patent.

When the defendant denies the novelty of the invention on the ground of a prior patent, two questions, similar to those involved in the defence of prior use, also arise: (1) Whether the invention described and claimed in the plaintiff's patent is identical with or included in the invention described and claimed by the alleged prior patent; (2) Whether the prior patent was duly issued before the conception of the invention by the plaintiff's inventor. The plaintiff's patent is *prima facie* evidence that the invention described and claimed therein is essentially distinct from all inventions covered by preceding patents.¹ The defendant must, therefore, affirmatively prove that the prior patent embraced the invention of the plaintiff. His evidence on this point is the prior patent itself, construed by the court in connection with the plaintiff's patent.² Other testimony is unnecessary on either side, unless the court de-

stands alone as to evidence and verdict, and the jury must agree on each separately, and if they find for the defendant on one of them they must agree on that one, see *Waterman v. Thomson* (1863), 2 Fisher, 461.

That when a patent claims three inventions the plaintiff must prove a right to each, see *Heinrich v. Luther* (1855), 8 McLean, 345.

§ 1027. ¹ That the grant of a patent is a decision by the Commissioner that the invention is not covered by prior patents, see *Putnam v. Keystone Bottle-Stopper Co.* (1889), 38 Fed. Rep. 234; *Serrell v. Collins* (1857), 1 Fisher, 289.

That the patent is *prima facie* evidence that the thing patented differs from every other patented invention and from anything described in any specification of any patent, see *Poppenhusen v. N. Y. Gutta-Percha Comb Co.* (1858), 2 Fisher, 62.

That a patent for a later machine is strong *prima facie* evidence of its essential difference from an earlier patented machine, especially if the later patent has been re-issued and extended, see *La Baw v. Hawkins* (1874), 6 O. G. 724; 1 Bann. & A. 428.

² That a defendant may offer in evidence his own patent, see *Corning v. Burden* (1853), 15 How. 252.

That the defendant's patent is *prima facie* proof of the novelty and utility of his invention, see *Worswick Mfg. Co. v. City of Kansas* (1889), 38 Fed. Rep. 239.

That a defendant who infringes both the patent for the original and that for the improvement, cannot set up the former patent as anticipating the latter, see *Cantrell v. Wallick* (1886), 117 U. S. 689; 35 O. G. 871.

sires the aid of experts in explaining and comparing the claims and descriptions of the patents.³ Upon the second question the defendant also has the burden of proof. To satisfy it he must show that the alleged prior patent is a public document, that it was made accessible to the public before the conception of the invention by the plaintiff's inventor, and that its description of the invention is sufficiently precise and complete to enable persons skilled in the art to practise it without the exercise of their own inventive faculties.⁴ Whether or not a prior patent is a public document depends upon the provisions of the law under which it issues. A patent granted by the United States is always of that character, but in some foreign countries patents are public or secret as the government in each case may determine. It is incumbent on the defendant to show that the patent which he offers as anticipating that of the plaintiff is a public patent according to the law of the place in which it has been granted.⁵ He must also prove that it was issued to the public before the date of the inventive act under which the plaintiff claims. The date of the prior patent is regarded as the earliest date at which it could have been given to the public, and evidence of its preceding publication or existence is inadmissible.⁶ The date of

³ That the prior patent is to be submitted to the jury with the evidence of experts as to identity, see *Tucker v. Spalding* (1871), 13 Wall. 453; 1 O. G. 144; 5 Fisher, 297.

⁴ For the requisites of a prior patent, see §§ 331-337, and notes, *ante*.

That the defence of prior patent is not established where the original prior patent did not cover the invention, and has been re-issued to embrace it since the date of the patent in dispute, see *Vogler v. Semple* (1877), 11 O. G. 923; 7 Bissell, 382; 2 Bann. & A. 556.

⁵ That French patents, being some private, some public, the defendant must show which they are, see *Brooks v. Norcross* (1857), 2 Fisher, 661.

That although some French patents are secret, yet one verified after the manner of public records is to be re-

garded as a public one, see *Schoerken v. Swift & Courtney & Beecher Mfg. Co.* (1881), 19 O. G. 1493; 7 Fed. Rep. 469; 19 Blatch. 209.

That copies of specifications and drawings without the patent do not show that an invention was patented, see *Brooks v. Norcross* (1851), 2 Fisher, 661.

⁶ That patents cited as anticipating the plaintiff's invention are regarded only as public grants, and nothing from the Patent Office is admissible to show an earlier date than that of the patent, see *Howes v. McNeal* (1880), 17 O. G. 799; 17 Blatch. 396; 4 Fed. Rep. 151; 5 Bann. & A. 77; *Bates v. Coe* (1878), 98 U. S. 31; 15 O. G. 337.

That a patent issued upon an application filed before the date of a conflicting patent is presumed to have priority

the patent itself is not, however, evidence that it then became accessible to the public. Under our own system, the issue of the patent and its publication are substantially contemporaneous, but under other systems the grant of the monopoly may be awarded before the full disclosure of the invention to the public is required. In such cases the patent takes effect as a prior and anticipating patent only at the time when its completed specification is filed and published, and the defendant must, therefore, fix by his evidence the date of this disclosure as the date from which his prior patent operates against all subsequent inventors.⁷ Such proof is generally furnished by the certified copies of the specifications and drawings of the patent, which are by statute made *prima facie* evidence of the existence of the patent and of its date and contents.⁸ Where these are unobtainable, the date of publication may be proved by any other competent and accessible testimony. If the date thus fixed by the defendant as that of the publication of the alleged prior patent is anterior to the date of the plaintiff's patent, it becomes the duty of the plaintiff to prove that the invention was conceived by his inventor before the prior patent had been given to the public.⁹ His evidence upon this

unless the contrary appears, see *Kearney v. Lehigh Valley R. R. Co.* (1887), 32 Fed. Rep. 320.

That file-wrappers, contents, and drawings of a patent set up in defence do not show that the invention was made at the date of the oath or was then reduced to practice, see *Howes v. McNeal* (1880), 17 O. G. 799; 17 Blatch. 396; 4 Fed. Rep. 151; 5 Bann. & A. 77.

⁷ That under Sec. 4920, Rev. Stat., an English patent is not issued until a complete specification is filed, see *Coburn v. Schroeder* (1882), 22 O. G. 419; 11 Fed. Rep. 425; 20 Blatch. 392.

That an English patent is effective as an anticipation only from the date of its sealing, see *Bliss v. Merrill* (1887), 42 O. G. 97.

That an earlier English provisional specification may show the state of the

art and thus negative invention, see *McNab & Harlow Mfg. Co. v. Nathan Mfg. Co.* (1887), 40 O. G. 1240; 32 Fed. Rep. 155.

⁸ That copies of domestic or foreign patents from the Patent Office, duly authenticated, are sufficient evidence of their issue and date, see §§ 1015, 1016, and notes, *ante*.

⁹ That the defence of prior patent is sustained when the date of the patent is earlier than that of the patent in suit, and the plaintiff must then carry his date back beyond it by the application or by some other evidence, see *Kelleher v. Darling* (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438.

That a prior patent is held prior if its date is prior to the one in suit, unless the latter is accompanied by its application, or the parol proof shows that its patentee invented before the

point is the same as that required whenever the date of an inventive act is to be ascertained. In proving that the prior patent disclosed the invention with sufficient completeness and precision to enable any person skilled in the art to practise it, the defendant must rely upon the testimony of persons who have actually constructed and used it under the guidance of the prior patent, or on that of experts and practical workmen that the invention could be practised, from the descriptions and directions in the patent, by skilled artisans without the exercise of their own inventive powers. To this evidence the plaintiff may reply with testimony of the same character, and the credibility and weight to be attached to the antagonistic proof must be determined by the jury from their own general acquaintance with the subject and from the apparent ability and integrity of the witnesses produced.¹⁰ In case of doubt the plaintiff must prevail.

§ 1028. Evidence under the Fifth Defence : Novelty of the Patented Invention : Prior Publication.

A denial of the novelty of the patented invention on the ground of a prior publication also embraces two questions: (1) Whether the invention patented is identical with or included in the one described in the alleged publication; (2) Whether the alleged publication constitutes such a disclosure of the invention to the public as is by law made fatal to the patent. The burden of proof on both points rests on the defendant after the patent of the plaintiff has been introduced. The identity of the two inventions may be shown by comparing the descriptions, with or without the aid of experts, or by the examination of specimens proved to have been made

date of the rival patent, see *Bates v. Coe* (1878), 98 U. S. 31; 15 O. G. 337.

That the defendant may offer his own re-issue of a patent earlier than the plaintiff's, and if the evidence rests there, he will prevail, see *House v. Young* (1867), 3 Fisher, 335.

That the patentee may prove that he invented and reduced to practice before

the date of a foreign patent which was granted before he filed his application, see *White v. Allen* (1863), 2 Fisher, 440; 2 Clifford, 224.

¹⁰ That if a foreign patent is offered to anticipate the plaintiff's patent he may show that the device therein described is inoperative and worthless, see *Harwood v. Mill River Woollen Mfg. Co.* (1869), 3 Fisher, 526.

under the sole direction of the publication and without a knowledge of the invention of the plaintiff. Counter-evidence of the same class may be offered for the plaintiff in rebuttal. The legal sufficiency of the publication to invalidate the plaintiff's patent depends on its possession of the following requisites: (1) It must be in its nature a public work; (2) It must describe the invention in such a manner that any person skilled in the art can practise it without further directions; (3) It must have been made accessible to the public before the conception of the invention by the plaintiff's inventor.¹ That the publication is a public work may appear from its general contents, from the source whence it proceeds, or from the persons for whom it is evidently intended. The printing of a book or document for unrestricted circulation, or for the use of all who may require it, or for any extensive class of persons, is sufficient to give the work the necessary public character.² These facts may be established by an inspection of the work itself, or may be proved by any witness acquainted with its origin and purpose. That the description renders the invention clear to competent workmen, and enables them to practise it, is shown or contradicted by the testimony of experts and practical mechanics, and of those artisans who have succeeded or failed in their endeavors to construct or use it in obedience to the directions given. To prove that the printed book or document has been made accessible to the public, evidence of actual presentation to the public, in some form, must be offered. If the work has been placed in a public library and duly catalogued, or otherwise brought within the reach of those who may be interested in its contents, or if it has been publicly exposed for sale, or gratuitously distributed to the community, or lodged in some governmental office where it may be consulted or copies of its statements may be obtained on application, it is regarded as communicating to the public

§ 1028. ¹ For the general requisites of a prior publication, see §§ 325-330 and notes, *ante*.

² That a report to a hose company describing the invention is not a public work and cannot be read by the defend-

ant, see *Pennock v. Dialogue* (1825), 4 Wash. 538; 1 Robb, 466.

That catalogues, etc., may be admitted as prior publications if notice of them as such has been given, see *Forschner v. Baumgarten* (1886), 26 Fed. Rep. 858; 35 O. G. 187.

whatever information it contains.³ Either or all of these acts, and others of a similar character, may be proved by the defendant by any testimony, oral or written, that may be available. This evidence must also show that the act of publication occurred before the date of the conception of the invention by the plaintiff's inventor. The latter date is *prima facie* that of the plaintiff's patent or his application, but inasmuch as in rebuttal he may anticipate that date by the usual evidence of an earlier inventive act, the defendant must establish for the act of publication a date anterior to any which the plaintiff can maintain, or the issue will eventually be found against him.⁴ For the purpose of fixing the date of publication, the imprint of the work is not sufficient.⁵ Extraneous evidence showing the fact of presentation to the public on or before a given day is necessary, there being no presumption that a book or document was placed in circulation at or near the period mentioned in its pages. Much of the testimony on the several points involved in this defence of prior publication is ordinarily derived from the printed book or document itself, which is produced in court and submitted to the examination of the witnesses and jury. Where the defendant is unable to obtain a copy for production, and satisfactorily accounts for its absence, he is permitted to prove by parol not only the

³ See as to the fact of publication § 827 and notes, *ante*.

That the evidence of the prior publication is proof of the fact of publication only, see *Seymour v. McCormick* (1856), 19 How. 96.

That under Sec. 61, act of 1870, a defence of previous publication by an English provisional specification must be clearly proved, see *Cohn v. United States Corset Co.* (1874), 6 O. G. 259; 12 Blatch. 225; 1 Bann. & A. 340.

⁴ That if a complete description was published before the date of the patent in controversy, the defendant has sustained his defence until the plaintiff proves that his own inventive act was earlier, see *Kelleher v. Darling* (1878), 14 O. G. 678; 4 Clifford, 424; 3 Bann. & A. 438.

⁵ In *Reeves v. Keystone Bridge Co.* (1872), 1 O. G. 466, McKennan, J.: (471) "It is not shown that the work was published before the date of the complainant's patent. This must be directly proved. It is not deducible from the imprint on the title-page. That the work was then printed may be inferred from this imprint; but when it was put in circulation or offered to the public is a distinct fact, which must be proved independently. The intended circulation of a book of a public nature may be presumed from its being put into print; but it does not follow that a work such as the one in question was made accessible to the public as soon as it was printed, or that it was actually published at all." 9 Phila. 868 (374); 5 Fisher, 456 (467).

fact and date of publication, but the contents of the work in reference to the invention.⁶ Such evidence is, however, always subject to serious infirmities arising from faulty recollection and unintentional misstatement, and is entitled to slight consideration when opposed by other testimony.

§ 1029. Evidence under the Sixth Defence: Utility of the Patented Invention.

The sixth defence denies the utility of the patented invention. The patent is *prima facie* evidence in favor of the plaintiff on this issue, and the defendant must therefore prove the uselessness of the invention beyond reasonable doubt.¹ The testimony ordinarily available for this purpose is that of experts whose inspection of the invention has satisfied them of its inutility, and that of practical mechanics who

⁶ That the date and contents of a publication may, in some extreme cases, be shown by parol, see *Allen v. Hunter* (1855), 6 McLean, 303.

§ 1029. ¹ That the patent is *prima facie* evidence of utility, see *Kirk v. Du Bois* (1887), 33 Fed. Rep. 252; *Deane v. Hodge* (1886), 35 Minn. 146; *Lehnbeuter v. Holthaus* (1881), 105 U. S. 94; 21 O. G. 1783; *Corvallis Fruit Co. v. Curran* (1881), 8 Fed. Rep. 150; 7 Sawyer, 270; *Thomas v. Shoe Mach. Mfg. Co.* (1878), 16 O. G. 541; 3 Bann. & A. 557; *Miller & Peters Mfg. Co. v. Du Brul* (1877), 12 O. G. 351; 2 Bann. & A. 618; *Smith v. Woodruff* (1873), 6 Fisher, 476; 4 O. G. 635; 1 MacArthur, 459; *Whitney v. Mowry* (1867), 3 Fisher, 157; 2 Bond, 45; *Blanchard v. Puttman* (1867), 3 Fisher, 186; 2 Bond, 84; *Swift v. Whisen* (1867), 3 Fisher, 343; 2 Bond, 115; *Bell v. Daniels* (1858), 1 Fisher, 372; 1 Bond, 212; *Poppenhusen v. N. Y. Gutta Percha Comb Co.* (1858), 2 Fisher, 62; *Ransom v. Mayor of N. Y.* (1856), 1 Fisher, 252; *Parker v. Stiles* (1849), 5 McLean, 44.

That the patent is *prima facie* evi-

dence of utility although the invention be very simple and not the best mode of effecting the result, see *Bell v. Daniels* (1858), 1 Fisher, 372; 1 Bond, 212.

That courts do not usually reverse the decision of the Patent Office that an invention is useful, however slight the utility, see *Doherty v. Haynes* (1874), 6 O. G. 118; 4 Clifford, 291; 1 Bann. & A. 289.

That a patent, whether an original or a re-issue, is *prima facie* evidence that the invention is useful, see *Serrell v. Collins* (1857), 1 Fisher, 289.

That the patent is only *prima facie* evidence of utility, see *Green v. Stuart* (1874), 7 Baxter (Tenn.), 418.

That the patent being in evidence the burden of proof rests on the defendant to show want of utility, see *Vance v. Campbell* (1859), 1 Fisher, 483; *Parker v. Stiles* (1844), 5 McLean, 44.

That the defence of want of utility can prevail only when there is no reasonable doubt, see *Kearney v. Lehigh Valley R. R. Co.* (1887), 32 Fed. Rep. 320; *Whitney v. Mowry* (1867), 2 Bond, 45; 3 Fisher, 157; *Tilghman v. Werk* (1862), 1 Bond, 511; 2 Fisher, 229.

have attempted to employ it and have found it worthless. If this testimony demonstrates that the invention is either mischievous or frivolous, the defence will be sustained.² The plaintiff may rebut the evidence of the defendant by introducing experts who have formed opposite opinions, and practical mechanics who have had a contrary experience. He may prove its extensive use, its general effect upon the state of the art, or its commercial success, from either of which facts its utility may be inferred.³ The very contest of the parties over the invention affords some indication of its value.⁴ A defendant who is shown to have actually used the invention, whether wrongfully or under a license from the patentee, or who has obtained a patent covering substantially the same art or article, is estopped from denying its utility.⁵

² As to utility in general, see §§ 338-344, and notes, *ante*.

As to want of utility as a defence, see § 964, and notes, *ante*.

³ That the effect of the invention may indicate its utility, see *Klein v. Russell* (1873), 19 Wall. 433.

That success and practical results are evidence of utility, see *Judson v. Moore* (1860), 1 Fisher, 544; 1 Bond, 285.

That utility is shown by extensive use, see *Turrill v. Spaeth* (1878), 3 Bann. & A. 458; 14 O. G. 377; *Adams v. Edwards* (1848), 1 Fisher, 1.

⁴ That the very contest of the parties over the patent is some evidence of utility, see *Middletown Tool Co. v. Judd* (1867), 3 Fisher, 141.

⁵ That a defendant who has used the invention cannot deny its utility, see *La Rue v. Western Electric Co.* (1887), 31 Fed. Rep. 80; 40 O. G. 576; *Newbury v. Fowler* (1886), 28 Fed. Rep. 454; 36 O. G. 817; *Palmer v. United States* (1884), 19 Ct. of Claims, 669; *Bliss v. City of Brooklyn* (1871), 8 Blatch. 533; 4 Fisher, 596; *Lee v. Blandy* (1860), 2 Fisher, 89; 1 Bond, 361; *Haya v. Sulzor* (1859), 1 Bond, 279; 1 Fisher, 532; *Simpson v. Mad River R. R. Co.* (1855), 6 McLean, 608;

Kneass v. Schuylkill Bank (1820), 4 Wash. 9; 1 Robb, 303.

That use by defendant is strong evidence of utility, see *Kearney v. Lehigh Valley R. R. Co.* (1887), 32 Fed. Rep. 320; *Adams & Westlake Mfg. Co. v. Rathbone* (1886), 26 Fed. Rep. 262; *Niles Tool Works v. Betts Mach. Co.* (1886), 27 Fed. Rep. 301; *Phillips v. Carroll* (1885), 23 Fed. Rep. 249; 31 O. G. 265; *Hancock Inspirator Co. v. Jenks* (1884), 21 Fed. Rep. 911; *Foye v. Nichols* (1882), 8 Sawyer, 201; 22 O. G. 2243; 13 Fed. Rep. 125; *Tyler v. Crane* (1880), 7 Fed. Rep. 775; 19 O. G. 129; *Smith v. Glendale Elastic Fabrics Co.* (1874), Holmes, 340; 5 O. G. 429; 1 Bann. & A. 58; *Turrill v. Illinois Central R. R. Co.* (1867), 3 Fisher, 330; 3 Bissell, 66; *Mabie v. Haskell* (1865), 2 Clifford, 507.

That every doubt as to utility is resolved against a defendant who used the invention, see *Phillips v. Carroll* (1885), 31 O. G. 265; *Whitney v. Mowry* (1870), 4 Fisher, 207.

That a former license to the defendant to use the invention is evidence of its utility, see *Lee v. Blandy* (1860), 2 Fisher, 89; 1 Bond, 361.

That features claimed to be useful in

§ 1030. Evidence under the Seventh Defence: Abandonment of the Patented Invention to the Public.

The seventh defence asserts that the invention was abandoned and passed into the possession of the public before the date of the infringement. An invention may be abandoned either before the application for a patent, or by or during the pendency of the application, or after the patent has been granted. The patent itself is *prima facie* evidence that there has been no abandonment at any time, and the defendant must overcome this evidence by conclusive proof of dedication to the public.¹ No abandonment can take place unless the invention is complete and operative, and available for immediate public use. The certainty and weight of evidence required to prove abandonment varies according to the period at which it is alleged to have occurred, — the presumption against it being stronger after than before the application, and strongest after the issue of the patent.² Abandonment before the application may be shown by evidence of any acts or declarations of the inventor, manifesting an intention to abandon. His mere omission to practise the invention or to make application for a patent is not sufficient;³ but proof

the defendant's machine must be useful also in the plaintiff's, see *Foye v. Nichols* (1882), 22 O. G. 2243; 13 Fed. Rep. 125; 8 Sawyer, 201.

§ 1030. ¹ As to abandonment as a defence, see § 965 and notes, *ante*.

That the patent is *prima facie* evidence that there has been no abandonment by public use or otherwise, see *United States Rifle & Cartridge Co. v. Whitney Arms Co.* (1877), 11 O. G. 373; 14 Blatch. 94; 2 Bann. & A. 493; *Brown v. Whittemore* (1872), 5 Fisher, 524; 2 O. G. 248; *Johnsen v. Fassman* (1872), 5 Fisher, 471; 2 O. G. 94; 1 Woods, 138.

That the burden of proof rests on the defendant to shew that the invention was in public use or on sale two years before the application, see *American Hide & Leather Splitting & Dressing Mach. Co. v. American Tool & Machine*

Co. (1870), 4 Fisher, 284; *Holmes*, 508; *Hussey v. Bradley* (1863), 2 Fisher, 362; 5 Blatch. 134; *Knight v. Baltimore & Ohio R. R. Co.* (1840), Taney, 106; 3 Fisher, 1.

That the evidence of abandonment must be conclusive, see *Pitts v. Hall* (1851) 2 Blatch. 229; *McCormick v. Seymour* (1851), 2 Blatch. 240.

² That evidence that the plaintiff has abandoned his patent is admissible, see *Wayne v. Holmes* (1856), 2 Fisher, 20; 1 Bond, 27.

That the evidence of abandonment after patent must be very strong, see *Bell v. Daniels* (1858), 1 Fisher, 372; 1 Bond, 212.

³ The present condition of the authorities renders this doctrine doubtful, however strongly it may have been asserted in past decisions. See §§ 357, 388-390, and notes, *ante*.

that he has voluntarily destroyed the finished article without intending to rebuild it, or that he has distributed it to others asserting that no effort would be made to patent it, or has permitted its universal public use without objection or the expression of his intention to protect his rights, will, if uncontradicted, justify the jury in finding this issue for the defendant.⁴ In replying to this evidence the plaintiff may offer testimony contradicting the statements of the defendant's witnesses, or showing other acts and declarations of the inventor from which a contrary intention is to be inferred. The filing of the application for the patent proves irrefutably that the inventor did not then intend to abandon, and is of greater weight than any doubtful acts of prior dedication.⁵ Declarations of the inventor that it was not his purpose to forego his rights cannot, however, overcome those inferences concerning his intention which necessarily arise from his admitted conduct.⁶ Abandonment before the application may be also shown by evidence of any public use or sale of the invention, with the acquiescence of the inventor, more than two years before the application was filed. The proof of a single instance of such sale or use conclusively establishes abandonment and invalidates the patent. The evidence on this point must disclose a practical use for business purposes, either by the public or subject to their observation, or a sale

⁴ That the abandonment of an unpatented invention may be shown by its being broken up without intent to reconstruct it, see *Johnson v. Root* (1862), 2 Clifford, 108 ; 2 Fisher, 291.

That a machine was abandoned shows it to have been an unsuccessful experiment, see *Hayden v. Suffolk Mfg. Co.* (1862), 4 Fisher, 86. See also §§ 318, 351, and notes, *ante*.

⁶ That the filing of an application is conclusive evidence that the inventor did not then intend to abandon the invention, but does not prove the want of subsequent intention, see *United States Rifle & Cartridge Co. v. Whitney Arms Co.* (1877), 11 O. G. 373 ; 14 Blatch. 94 ; 2 Bann. & A. 493.

That to rebut a claim of abandonment the plaintiff may show the filing of drawings or any other act in assertion of his rights, see *Emerson v. Hogg* (1845), 2 Blatch. 1.

⁶ That where the acts of the inventor show abandonment, his statement that he did not intend to abandon is of little weight, see *Bevin v. East Hampton Bell Co.* (1871), 5 Fisher, 23 ; 9 Blatch. 50.

That a mere averment in the bill alleging non-abandonment does not avail against facts showing it, see *Marsh v. Sayles* (1872), 5 Fisher, 610 ; 2 O. G. 340.

untrammelled by conditions which still retain the invention under the control of the inventor. This evidence may be produced by witnesses who participated in or had knowledge of the transactions to which it relates.⁷ The acquiescence of the inventor in such use or sale may be inferred from words or actions indicating his intelligent consent, or from his failure when acquainted with such use or sale to protest or seek the interference of the Patent Office or the courts for his protection.⁸ Tortious uses and sales without his knowledge, and uses or sales under the authority of unknown rival inventors, even though these have obtained patents, are not proof of abandonment by him.⁹ The plaintiff may rebut the evidence of public use or sale by testimony which denies the fact of use or sale, or shows the use to have been experimental or in secret, or the sale to have been conditional, or either use or sale to have been without the inventor's knowledge. An abandonment by application may consist in a specific disclaimer of the invention, or in describing but omitting to insert it in the Claim.¹⁰ The first form of abandonment is proved by a certified copy of the application in which the disclaimer is contained. This evidence is usually conclusive on the plaintiff, though where no rival claimant exists, and the disclaimer was inserted by mistake and was corrected within reasonable time after the discovery of the error, or reasonable time for its correction has not yet elapsed, the plaintiff may be properly allowed to show the truth, and either escape the conse-

⁷ As to public use or sale and their requisites, see §§ 354-360, and notes, *ante*.

That under the defence of public use the defendant must show two years' sale or use before the application with the consent of the inventor, see *Jones v. Sewall* (1873), 6 *Fisher*, 343; 3 *O. G.* 630; 3 *Clifford*, 563.

⁸ That the evidence of abandonment by public use or sale must be clear and conclusive, see *Campbell v. James* (1879), 18 *O. G.* 979; 17 *Blatch.* 42; 4 *Bann. & A.* 456.

That where a two years' public use is proved the burden is on the plaintiff

to show that it was experimental, see *Smith & Griggs Mfg. Co. v. Sprague* (1887), 123 *U. S.* 249; 41 *O. G.* 1037.

⁹ That tortious uses or sales are piracies and no public use grows out of them, see *Jones v. Sewall* (1873), 6 *Fisher*, 343; 3 *O. G.* 630; 3 *Clifford*, 563; see also § 357 and notes, *ante*.

¹⁰ As to abandonment by application, see §§ 352, 506, 690-692, and notes, *ante*.

That abandonment may be shown by the absence of the invention from the model or caveat, see *Johnson v. Root* (1862), 2 *Clifford*, 108; 2 *Fisher*, 291.

quences of his former inadvertence or secure an opportunity for the amendment of his patent.¹¹ The omission to claim an invention which is fully disclosed in the description is regarded as conclusively establishing a dedication to the public, unless the omitted invention is embraced in a new application, or in an amendment of the former specification, within a reasonable time.¹² The evidence in reference to this form of abandonment must be adapted to the circumstances under which the issue has arisen. When the suit is based on the original patent, in which the description and Claim of the application are now embodied, their construction by the court simply shows that the omitted invention is not covered by the patent, and leaves no room for any question of fact or issue of abandonment. If the suit is based on a re-issue in which the original defect has been supplied, the issue arises, not under the defence of abandonment, but on the validity of the re-issue under the ninth defence. Thus this form of abandonment seems to be available as a subdivision of the present seventh defence only in an action founded on a new patent containing matter described, but not claimed, in a former patent to the same inventor. This new patent, though otherwise impregnable, is invalid on the ground of abandonment, if the invention which it covers was disclosed to the public but not claimed by the inventor in the application for the former patent, and his application for the new patent has been unreasonably delayed. In proving such abandonment, the former patent, or a certified copy thereof, may be offered by the defendant to exhibit the variance between its Claim and

¹¹ That a mistaken disclaimer is not conclusive when there are no private adverse interests, see *Hussey v. Bradley* (1863), 2 Fisher, 362; 5 Blatch. 134. See also § 689, and notes, *ante*.

¹² That omission to claim a fully described invention is abandonment unless the error be at once corrected, see *Parker & Whipple Co. v. Yale Lock Co.* (1887), 123 U. S. 87; 41 O. G. 811; *Wollensak v. Reiher* (1885), 115 U. S. 96; 31 O. G. 1301. See also § 690, and notes, *ante*.

That a description of the invention in a prior patent to the same inventor is no bar to a patent and does not show abandonment, see *Vulcanite Paving Co. v. American Artificial Stone Pavement Co.* (1887), 42 O. G. 828.

That a re-issue, unless fraudulent, is *prima facie* evidence that there has been no abandonment, and that all necessary prerequisites were complied with, see *Hoffheins v. Brandt* (1867), 3 Fisher, 218.

its description. If this discrepancy is not apparent on the face of the patent, the record of a judicial interpretation, if it has received one, may be introduced, or any evidence concerning the state of the art or the nature of the invention, which tends to show that the inventor must have known of the divergence between his description and his Claim.¹³ His unreasonable delay in securing a new patent, after such knowledge was acquired, may appear from evidence of his ability and opportunity to do so at a period of time substantially earlier than the one in which it was accomplished. An error of this character, evident on the face of his former patent, demands instant correction, in order that the public may not be misled, and any avoidable delay is unreasonable if the rights of other innocent parties or of the public intervene; but in cases where the error is ascertained only by the result of litigation, or after a more intimate acquaintance with the art, a wider latitude is permitted to the inventor, though still within such limits as preserve the just and equitable privileges of others.¹⁴ The evidence must, in both these cases, show that the inventor could have applied for the new patent sooner than he did after the necessity therefor became known to him, and that he either acquiesced in the disclosure of his unprotected invention for a period too long to be consistent with an original intention on his part to claim it, or while he had such knowledge of its appropriation by others as now estops him from averring that he did not then intend to dedicate it to the public.¹⁵ The plaintiff, in replying to this evidence, is confined to the question of unreasonable delay except in cases where his knowledge of the insufficiency of his Claim is said to be derived from other sources than the language of his patent or its interpretation by the courts. His cognizance of an evident discrepancy, or of a defect revealed by the decision of the court of last resort, he cannot be permitted to deny. But where his knowledge is inferred from extraneous facts,

¹³ That the patentee's knowledge of the defect may appear from the face of the patent, see *Wollensak v. Reiher* (1885), 115 U. S. 96; 31 O. G. 1301; and other cases cited in § 690, note 2, *ante*.

¹⁴ That an apparent defect must be immediately corrected, see § 690 and notes, *ante*.

¹⁵ As to unreasonable delay in re-issue, see §§ 690-692, and notes, *ante*.

he may contradict both facts and inference by any evidence which shows that no such notice of the error had been given him as to charge him with the duty of correcting it. Upon the question of unreasonable delay he may prove any circumstances in his own condition which rendered it impracticable for him to make an earlier effort for his protection, or may show that his avoidable delay has not misled the public or made his late assertion of his rights a cause of injury to others. An abandonment during the pendency of the application can occur by an amendment or disclaimer which excludes the invention from the application as one already in possession of the public. Such an exclusion is a solemn admission on the part of the inventor that the excluded matter is not patentable, and even when made at the demand of the examiner, and as a condition of the allowance of the patent, it cannot be recalled, unless in certain cases of gross mistake and where the recall would prejudice no other interests.¹⁶ While the amendment or disclaimer remains in force it is sufficient proof of the abandonment. It may be shown by certified copies of the papers in the Patent Office, and cannot be rebutted. An abandonment after the patent is granted may be effected by overt acts or express declarations, or even by neglect to act when action is evidently required. Every presumption is against such an abandonment, however, and the proof must, therefore, be of the strongest and most conclusive character. Mere non-user of the invention, whatever be its duration, is of no significance on this point, but long continued acquiescence in its use by others, or an entire neglect to claim its advantages for himself when it had proved to be of great commercial value and had been widely accepted by the community, may satisfy the jury, as well as positive conduct or assertions, of his intention to relinquish all exclusive privileges and finally confer the invention on the public.¹⁷ Evidence of such acts, or declarations, or

¹⁶ As to the effect of disclaimer in the Patent Office, see §§ 688, 689, and notes, *ante*.

As to the effect of an amendment excluding patentable matter from the application, see § 689 and notes, *ante*.

¹⁷ That abandonment after patent may be shown by acts of surrender or relinquishment to the public, see *Bell v. Daniels* (1858), 1 Fisher, 372; 1 Bond, 212.

That proof of the abandonment of

omissions may be drawn from any source of testimony which is able to supply it, and counter-evidence of the same character may be offered by the plaintiff in reply.

§ 1031. Evidence under the Eighth Defence: Non-existence of the Letters-Patent.

The eighth defence denies the existence of the patent described in the declaration. The plaintiff's evidence on this point, as well as that of the defendant, is the patent itself. If it corresponds substantially with the averments in the declaration, the issue must be found for the plaintiff. If a substantial variance appears, the defendant is entitled to a judgment. It is sufficient that the patent and its description agree in such formal parts as are essential to distinguish it from every other patent, such as its date, title, number, and grantee, and in the general tenor of its statements concerning the nature of the patented invention. Thus the averment of a patent for several distinct inventions is supported by the production of a re-issue in an equal number of divisions, the whole relating back to one original, and constituting substantially but a single patent.¹

§ 1032. Evidence under the Ninth Defence: Illegality of the Letters-Patent.

The ninth defence asserts that the grant of the patent was unlawful, either because certain essential prerequisites were not fulfilled, or because the grant, as made, exceeded the jurisdiction of the Patent Office. When it appears from the patent itself that the formal requirements of the law have not been heeded, no other evidence is necessary.¹ Where the

some less important part of an invention does not show that the entire invention was abandoned, see *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.* (1883), 18 Fed. Rep. 638; 25 O. G. 1076; 21 Blatch. 519.

§ 1031. ¹ That a declaration that a patent was granted for one principal and three minor improvements is supported by evidence of a re-issue in four divisions, one for each, these re-issues

relating back to the original, see *Read v. Bowman* (1864), 2 Wall. 591.

See also § 966 and notes, *ante*.

§ 1032. ¹ See as to this defence in general § 967 and notes, *ante*.

The omission of formal requirements can appear from the patent only when the patent affirmatively declares that they have been omitted. Mere absence of statement shows nothing. See note 3, *post*.

patent asserts that they have been complied with, no contrary testimony can be offered, unless the defendant claims that a fraud has been committed against the Patent Office and the public.² When the patent is silent upon this point, its issue creates a presumption that all prerequisites have been observed, and throws the burden of proving the contrary upon the defendant. The chief defects, of which the law allows notice to be taken in an action for infringement, are the absence from the patent of the necessary official signatures, and falsehood in the oath accompanying the application. The absence of the necessary signatures is apparent on the face of the patent, and is a fatal defect of which no further evidence is required.³ The entire omission of the oath, or its improper form, is a fault which the Patent Office can condone, as it can overlook nearly all other formal defects, but

² That the averments of the patent concerning the fulfilment of prerequisites are conclusive in the absence of fraud, see *Hancock Inspirator Co. v. Jenks* (1884), 21 Fed. Rep. 911.

That the decision of the Commissioner on matters within his exclusive jurisdiction, such as the sufficiency of formal acts, etc., is final, see *U. S. Rifle & Cartridge Co. v. Whitney Arms Co.* (1877), 11 O. G. 373; 14 Blatch. 94; 2 Bann. & A. 493.

That the decision of the Commissioner that the application is properly made cannot be collaterally attacked, see *Hoe v. Cottrell* (1880), 18 O. G. 59; 17 Blatch. 546; 5 Bann. & A. 256; 1 Fed. Rep. 597.

That the decision of the Commissioner as to the abandonment of the application is not conclusive, see *Planing Mach. Co. v. Keith* (1879), 101 U. S. 479; 17 O. G. 1031.

That the decision of the Commissioner allowing an extension is conclusive evidence as to all the facts he is required to find, see *Jordan v. Dobson* (1870), 4 Fisher, 282; 2 Abbott, 398; 7 Phila. 533.

That the issue of a patent is a judgment that all the facts entitling the patentee to the patent do exist, and constitutes *prima facie* evidence thereof, see *Wooster v. Muser* (1884), 28 O. G. 286; 20 Fed. Rep. 162; *Konold v. Klein* (1878), 3 Bann. & A. 226.

That patents, being issued upon an adjudication of a public officer, are presumed correct, see *Sands v. Wardwell* (1869), 3 Clifford, 277.

That a patent cannot be objected to on account of matters not appearing on its face concerning the power of the Commissioner or Assistant Commissioner to issue it, see *Woodworth v. Hall* (1846), 1 W. & M. 389; 2 Robb, 517.

³ That the signatures of the Secretary and Commissioner are essential to a patent and if omitted cannot be supplied by their successors, nor is the defect aided by a copy of the record in which the signatures appear, see *Marsh v. Nichols* (1888), 128 U. S. 605; *Marsh v. Nichols* (1883), 24 O. G. 901; 15 Fed. Rep. 914.

a wilful false oath is a fraud which forfeits all the rights of the inventor.⁴ It is immaterial whether the falsehood relates to some matter which affects the allowance of the patent, or to one which simply enlarges the privileges thereby conferred; in either case the attempt to deceive may be shown by proper evidence, and when established will defeat the patent.⁵ The oath made by the applicant is proved by a certified copy of the jurat from the records of the Patent Office; its falsehood by evidence disclosing the true state of the facts concerning which it speaks; the intention to deceive, by testimony from which the applicant's knowledge of the truth may be inferred.⁶ The plaintiff may contradict this evidence by any relevant testimony concerning the existence of the facts deposed, or the knowledge and intent of the deponent. The

⁴ That a patent cannot be attacked on the ground that the application oath was omitted, see *Crompton v. Belknap Mills* (1869), 3 Fisher, 536; and § 458 and notes, *ante*.

That a patent can be attacked on the ground that the application oath was wilfully false, see § 456 and notes, *ante*. But see *Tonduer v. Chambers* (1889), 37 Fed. Rep. 333.

That the issue of a patent on an application amended by the inventor's representative without a new oath is invalid, and a defence on this ground need not be set up in the pleadings, see *Eagleton Mfg. Co. v. West, Bradley, & Cary Mfg. Co.* (1884), 111 U. S. 490; 27 O. G. 1237.

That in the absence of fraud the patent recitals are conclusive evidence that proper oaths were taken, see *Seymour v. Osborne* (1870), 11 Wall. 516.

That a patent issued on an amended application, which recites that the patentee has made oath to his application, is conclusive in the absence of fraud, on an infringement suit, that the necessary oath was taken, see *Hancock Inspirator Co. v. Jenks* (1884), 21 Fed. Rep. 911.

⁵ That the nature of the falsehood

sworn to is unimportant if the false oath were material and wilful, see *Child v. Adams* (1854), 8 Wall. Jr. 20; 1 Fisher, 189.

⁶ That the defendant may show prior use abroad as having been known to the plaintiff in rebutting his oath that he believed himself to be the first inventor, see *Furbush v. Cook* (1857), 2 Fisher, 668.

That proof that a patentee made an improper oath in form on his application must also show that he made no other oath or it is immaterial, see *Hoe v. Kahler* (1885), 23 Blatch. 354; 34 O. G. 127; 25 Fed. Rep. 271; *Hoe v. Kahler* (1882), 20 Blatch. 430; 12 Fed. Rep. 111.

That the discovery among the papers of an unfilled blank form of oath does not overcome the *prima facie* proof arising from the recital that the oath was taken, see *Crompton v. Belknap Mills* (1869), 3 Fisher, 536.

That while the presence of papers in a file-wrapper from the Patent Office proves their existence, their absence does not show that they did not exist, see *Hoe v. Kahler* (1885), 23 Blatch. 354; 34 O. G. 127; 25 Fed. Rep. 271.

principal cases, in which the grant exceeds the jurisdiction of the Patent Office, are the issue of letters-patent to sole patentees for joint inventions, or the contrary, and the allowance of re-issues which include new inventions or inventions intentionally excluded from the original patent. A joint patent for a sole invention, and a sole patent for a joint invention, are alike void.⁷ *Prima facie*, the patent as it stands is correct and valid, and the defendant can overcome it only by the clearest and most reliable testimony.⁸ The existence of a prior foreign patent in favor of the same inventor or inventors, but directly opposed to the domestic patent in its statements concerning the joint or several origin of the invention, does not change the burden of proof, — the American patent not only outweighing the foreign patent, but in the absence of conclusive extraneous evidence determining the issue for the plaintiff.⁹ As the patent

⁷ That a joint patent for a sole invention is void, see *Stewart v. Tenk* (1887), 41 O. G. 1502; and § 402, note 3, *ante*.

That a sole patent for a joint invention is void, see *Slemmer's Appeal* (1868), 58 Pa. St. 155; and § 402, note 2, *ante*.

That this latter position is modified in cases where the sole patentee can in equity be treated as trustee for his co-inventor, see § 402 and notes, *ante*.

⁸ That a sole patent is *prima facie* evidence that the patentee was a sole inventor, see *Puetz v. Bransford* (1887), 31 Fed. Rep. 458; 39 O. G. 1083.

That a joint application for a patent raises a presumption that the applicants are joint inventors, which can only be overcome by proof, see *Consolidated Bunging Apparatus Co. v. Woerle* (1887), 29 Fed. Rep. 449; 38 O. G. 1015.

That the defence that joint patentees were not joint inventors is not favored unless the conduct of the patentees was disingenuous or misled the defendant, see *Consolidated Bunging Apparatus Co. v. Woerle* (1887), 29 Fed. Rep.

449; 38 O. G. 1015; *Butler v. Bainbridge* (1886), 29 Fed. Rep. 142; 37 O. G. 1124.

That the burden of proof rests on the defendant to show that a sole patentee was a joint inventor, see *Hoe v. Cottrell* (1880), 18 O. G. 59; 17 Blatch. 546; 1 Fed. Rep. 597; 5 Bann. & A. 256; *Ashcroft v. Cutler* (1869), 6 Blatch. 511.

That the burden of proof rests on the defendant to show by clear and unequivocal evidence that an invention applied for, sworn to, and patented as a joint invention, was a several one, see *Worden v. Fisher* (1882), 11 Fed. Rep. 505; 21 O. G. 1957; *Hoe v. Cottrell* (1880), 18 O. G. 59; 17 Blatch. 546; 1 Fed. Rep. 597; 5 Bann. & A. 256; *Gottfried v. Phillip Best Brewing Co.* (1879), 17 O. G. 675; 5 Bann. & A. 4.

⁹ That the burden of proof rests on the defendant to show that the patentee is not the sole inventor, though there is a prior joint foreign patent to him and others, see *Hoe v. Cottrell* (1880), 1 Fed. Rep. 597; 18 O. G. 59; 17 Blatch. 546; 5 Bann. & A. 256.

That where there is a joint foreign

shows to whom it has been granted, the defendant sustains his position if he proves that the inventive act was joint or sole, contrary to the assertions of the patent. An inventive act is joint when the conception of the idea of means has been evolved by the mutual consultations, suggestions, and experiments of the inventors. It is sole when the conception has arisen and been developed by the operation of one mind, though aided by the advice or achievements of others.¹⁰ That the inventive act was sole may be established by evidence which proves that it existed, complete and ready for reduction to practice, in the mind of the sole inventor before his connection with the alleged joint inventor. Such evidence may consist in his contemporaneous descriptions, drawings, or models of the invention or in his own testimony detailing the steps by which the invention was produced. Evidence that the inventive act was joint may be found in the absence of any memorandum or communication of the complete idea before the inventors met in consultation, as well as in the efforts which they jointly made and in the joint successes they attained. The defendant introduces such of this testimony as supports his claims. The plaintiff, in rebuttal, offers the contrary evidence. In most cases, where any unity of endeavor has existed, it is difficult, if not impossible, to ascertain how much of the result is due to either party, and the law, therefore, is inclined to recognize the merits of both and regard them as joint inventors. But where this question has been once decided by the issue of a patent, the presumption in its favor overcomes all doubts, and can be counteracted only by the most conclusive proof. The jurisdiction of the Patent Office over the subject of re-issues was conferred solely for the purpose of enabling an inventor to correct a defective patent, and thereby cause it to protect, with greater certainty, the invention which he had attempted to secure by the original. It was

patent to A and B and a sole American patent to B, and A swears that the invention was joint and B swears it was sole and there is no other evidence, the American patent will prevail, see *Hoe v. Cottrell* (1880), 18 O. G. 59; 17

Blatch. 546; 1 Fed. Rep. 597; 5 Bann. & A. 256.

¹⁰ For the characteristics of a joint inventive act, the legal presumptions regarding it, and the facts by which its joint nature is indicated, see §§ 396-402 and notes, *ante*.

never intended as a method of extending an existing patent to cover new inventions, or old inventions which had been intentionally omitted from the original patent. Hence, while the invention claimed in the re-issue must be found in the original description, the Claims of the re-issue must also be confined to inventions which were not advertently excluded from the original Claims.¹¹ Such an exclusion occurs where an invention fully disclosed in the original description is not embraced within the original Claims, and no amendment of these Claims is attempted within a reasonable time.¹² The departure of the re-issue from the original is shown by comparing the two patents.¹³ The defendant must introduce the original patent and from it satisfactorily establish either that the re-issue includes new inventions or inventions which though embraced in the original description are not contained in the original Claims.¹⁴ In this comparison he may avail himself of expert evidence to point out the differences between the inventions claimed in the respective patents, and may offer copies of the files, and models from the Patent Office to

¹¹ As to the purpose and scope of re-issues, see §§ 633-635, 653-659, and notes, *ante*.

¹² As to abandonment by describing and not claiming or amending within reasonable time, see §§ 352, 506, 690, 691, 1030, and notes, *ante*.

That a re-issue may be defended against as departing from the original, see *Parker & Whipple Co. v. Yale Lock Co.* (1887), 123 U. S. 87; 41 O. G. 811; *Newton v. Furst & Bradley Mfg. Co.* (1882), 14 Fed. Rep. 465; 11 Bissell, 405.

That a delay in a re-issue is fatal unless the plaintiff proves original inadvertence, see *Newton v. Furst & Bradley Mfg. Co.* (1882), 14 Fed. Rep. 465; 11 Bissell, 405.

¹³ That the want of identity between an original and a re-issue must be shown by comparing them, see *Doherty v. Haynes* (1874), 6 O. G. 118; 4 Clifford, 291; 1 Bann. & A. 289.

¹⁴ That when the validity of a re-issue is in dispute the original patent must be put in evidence by the defendant, or the validity of the re-issue will be presumed, see *Knapp v. Shaw* (1883), 15 Fed. Rep. 115; 23 O. G. 2236; *National Pump Cylinder Co. v. Simons Hardware Co.* (1883), 5 McClary, 592; 18 Fed. Rep. 324; *Searls v. Bouton* (1881), 21 O. G. 1784; 12 Fed. Rep. 140; 20 Blatch. 426; *Doherty v. Haynes* (1874); 4 Clifford, 291; 6 O. G. 118; 1 Bann. & A. 289; *Seymour v. Osborne* (1870), 11 Wall. 516.

That on a defence that the re-issue is not the same as the original, the plaintiff is not obliged to introduce the original in evidence, and the defence does not avail in the Supreme Court unless the original is apparent on the record, see *Bates v. Coe* (1878), 98 U. S. 31; 15 O. G. 337.

demonstrate more fully the nature of the invention which the original and re-issue were intended to protect.¹⁵ If he succeeds in showing that the re-issue covers new matter the fault must be cured by disclaimer or the suit will fail.¹⁶ If he proves that matter, disclosed but not protected by the original, has now been claimed in the re-issue, the question of intentional exclusion arises, and further evidence must be produced to show that after the insufficiency of his Claims became known to the inventor he omitted to apply for their amendment within reasonable time. This question is similar to that raised under the seventh defence, on abandonment by the application; and the testimony of the defendant in support of the intention to exclude and of the plaintiff in denial are substantially the same.¹⁷ If it appears that the inventions which the Claims of the re-issue were extended to embrace had been designedly omitted from the original patent, a disclaimer alone can save the re-issued patent and the suit. The decision of the Commissioner allowing the re-issue is of great weight with the court on all these controverted points, since all are presumed to have been fully considered and adjudged by him.¹⁸

¹⁵ That if the re-issued patent is in evidence, with a different drawing from the original, and a model is then introduced conforming to the changed drawing, the defendant may show the condition of the model when it was filed in the Patent Office, and at the date of the original patent, and the case will be re-opened to receive such proof if newly discovered, see *Johnsen v. Beard* (1875), 8 O. G. 435; 2 Bann. & A. 50.

That evidence of what passed in the Patent Office pending the application for the original is admissible on the question of identity in the re-issue, see *McCormick v. Graham* (1889), 129 U. S. 1; *Ewart Mfg. Co. v. Bridgeport Malleable Iron Co.* (1887), 31 Fed. Rep. 149.

¹⁶ That a claim of new matter in the re-issue may be cured by disclaimer, see *Torrent v. Duluth Lumber Co.* (1887), 30 Fed. Rep. 830; 39 O. G.

1425; *Schillinger v. Cranford* (1885), 4 Mackey, 450; 37 O. G. 1349; *Schillinger v. Gunther* (1879), 16 O. G. 905; 17 Blatch. 66; 4 Bann. & A. 479.

That if the suit can be sustained only by extending the scope of the re-issue beyond the original invention, the defendant will prevail, see *Covell v. Pratt* (1880), 18 O. G. 301; 18 Blatch. 126; 2 Fed. Rep. 359; 5 Bann. & A. 380.

¹⁷ See § 1030 and notes, *ante*.

¹⁸ That a re-issued patent is *prima facie* evidence that the re-issue is legal, see *Spaeth v. Barney* (1885), 30 O. G. 997; 22 Fed. Rep. 828.

That the decision of the Commissioner on the identity of the re-issue with the original is of great weight with the court, see *Hussey v. Bradley* (1863), 2 Fisher, 362; 5 Blatch. 134.

That technical objections to patents are to be strictly construed, see *Wood-*

§ 1033. Evidence under the Tenth Defence: The Patented Invention not Embraced in the Protected Classes.

The tenth defence denies that the invention claimed in the patent is embraced in any one of the six classes protected by the Acts of Congress. This defence is identical with the fourth, except that it attacks the patent instead of the actual invention. The evidence is also mainly the same with that available under the fourth defence.¹ The patent raises a presumption that the claimed invention is patentable subject-matter, which the defendant must rebut.² The questions here arising are principally, and sometimes entirely, questions of law relating to the construction of the patent and the definitions of the classes of privileged inventions, on which the court will either decide without a jury or direct a verdict for the party who is legally entitled to obtain it.³

§ 1034. Evidence under the Eleventh Defence: Fraudulent Specification.

The eleventh defence alleges that the specification of the patent was made to contain less than the whole truth relative to the invention, or more than is necessary to produce the desired effect, for the purpose of deceiving the public. Two points are put in issue: (1) The concealment or redundancy; (2) The intent to deceive. On both these points the patent is *prima facie* evidence in favor of the plaintiff and the burden of proof rests on the defendant.¹ The evidence as to the first point

worth *v.* Hall (1846), 1 W. & M. 248; 2 Robb, 495.

§ 1033. ¹ See §§ 968, 1025, and notes, *ante*.

² That the decision of the Patent Office on a question of patentable invention will not be departed from by the courts except upon clear proof, see *Fraim v. Keen* (1885), 25 Fed. Rep. 820; 34 O. G. 1048.

³ That where the patent discloses a want of patentable subject-matter the court may take judicial notice thereof, and order a verdict for the defendant, see *Slawson v. Grand St., Prospect Park, and Flatbush R. R. Co.* (1882), 107

U. S. 649; 24 O. G. 99; and § 1025, note 1.

§ 1034. ¹ That the patent is *prima facie* evidence of the correctness of the specification, see *Westlake v. Cartter* (1873), 4 O. G. 636; 6 Fisher, 519; *Poppenhusen v. N. Y. Gutta Percha Comb Co.* (1858), 2 Fisher, 62.

That the intent to deceive must be proved to the satisfaction of the jury, see *Celluloid Mfg. Co. v. Russell* (1889), 37 Fed. Rep. 676; *Grant v. Raymond* (1832), 6 Peters, 218; 1 Robb, 604; *Lowell v. Lewis* (1817), 1 Mason, 182; 1 Robb, 131; *Gray v. James* (1817), Peters, C. C. 394; 1 Robb, 120; *Whittemore v.*

consists of the testimony of experts, or of practical mechanics acquainted with the actual invention. If it appears from this evidence that a person skilled in the art could not practise the invention from the disclosure contained in the specification, the alleged concealment is established.² If it is proved that those who follow the directions of the specification are compelled to incur greater expense, or employ more numerous or less effective appliances, or surmount more formidable difficulties, than are necessary in order to secure the best results from the invention, the redundancy is manifest. Upon the second point positive evidence, however desirable, is not essential and can rarely be obtained. The intention to deceive must be inferred from circumstances.³ If the facts concealed are so important that the inventor must have known that no mechanic could construct and use the invention from the description given, or if the invention, as practised by himself at or before the filing of his specification, was relieved from the steps or appliances now shown to be unnecessary and burdensome, it is a fair presumption that he intended to mislead the public.⁴ The same intention may be proved by his contemporaneous declarations, by secret instructions given to his licensees concerning better modes of using the invention, or by any other acts relating to the invention which manifest a fraudulent purpose to put the public at a disadvantage when the term of the patent shall have expired.⁵ The plaintiff, in reply, may contradict or explain the circumstances, or deny the inference. The entire question is for the jury, who must find that both elements of the defence are clearly proved, or award the issue to the plaintiff.⁶

Cutter (1813), 1 Gallison, 429 ; 1 Robb, 28 ; Park v. Little (1813), 3 Wash. 196 ; 1 Robb, 17 ; Reutgen v. Kanowrs (1804), 1 Wash. 168 ; 1 Robb, 1.

² That if a mechanic, after the patent has expired, could not practise the invention from the specification alone the concealment is material, see Reutgen v. Kanowrs (1804), 1 Wash. 168 ; 1 Robb, 1.

³ That an intent to deceive can rarely be proved directly but must be inferred

from other facts, see Gray v. James (1817), Peters, C. C. 394 ; 1 Robb, 120.

⁴ That if the patentee knew of better methods when he framed his description, it is evidence of fraud, see Bovill v. Moore (1816), 1 Abb. P. C. 231 ; Dav. P. C. 361 ; Turner v. Winter (1787), 1 Abb. P. C. 43 ; 1 Web. 77.

⁵ That secret instructions to licensees show fraud, see Dyson v. Danforth (1865), 4 Fisher, 133.

⁶ That the degree of evidence neces-

§ 1035. Evidence under the Twelfth Defence: Ambiguity of the Description.

The twelfth defence avers the ambiguity of the description. It raises the issue whether the disclosure of the invention is sufficient to enable persons skilled in the art to practise it without the exercise of their own inventive faculties. The patent makes a *prima facie* case for the plaintiff on this issue, and the defendant must contradict it by satisfactory evidence.¹ The testimony most pertinent and convincing is that of practical mechanics, who have endeavored to construct and use the invention by following the directions given in the patent.² The evidence of scientific experts on this point is also proper. A single instance of success or failure in the endeavor of a practical mechanic to employ the invention is, however, of more weight and value than numerous opinions to the contrary. No question as to the intention of the inventor arises under this defence, and evidence indicating the existence of a fraudulent purpose is, therefore, inadmissible.³

§ 1036. Evidence under the Thirteenth Defence: Excessive Claims.

The thirteenth defence asserts that the Claim of the patent is excessive and has not been cured within a reasonable time by a disclaimer. Whether the Claim is excessive is a mixed

sary to show fraudulent intent is for the jury to decide, see *Gray v. James* (1817), *Peters*, C. C. 894 ; 1 *Robb*, 120.

See also as to this subject §§ 494, 969, and notes, *ante*.

§ 1035. ¹ That the patent is *prima facie* evidence that the specification is sufficient, see *Poppenhusen v. New York Gutta Percha Comb Co.* (1858), 2 *Fisher*, 62.

That the burden of proof as to the uncertainty of the patent rests on the defendant, see *Westlake v. Cartter* (1873), 4 O. G. 636 ; 6 *Fisher*, 519.

² That the jury are to say on the evidence of persons skilled in the art whether the description is clear enough to enable them to make the invention,

see *Wood v. Underhill* (1847), 5 *How.* 1 ; 2 *Robb*, 588.

That the claim of ambiguity in the description is rebutted by the testimony of competent mechanics that they could construct the device from it, see *Wayne v. Holmes* (1856), 2 *Fisher*, 20 ; 1 *Bond*, 27.

³ That the defendant need not prove that the plaintiff intended to deceive by his erroneous specification, see *Grant v. Raymond* (1832), 6 *Peters*, 218 ; 1 *Robb*, 604.

As to the sufficiency of the description, see §§ 490-493, and notes, *ante*.

As to this defence in general, see § 970 and notes, *ante*.

question of law and fact. The court is to construe the Claim as matter of law and instruct the jury as to the nature of the invention which it purports to embrace.¹ The jury are to decide from the evidence whether the Claim as thus interpreted includes more than the actual invention.² Upon this point of the defence the patent is *prima facie* evidence of the correctness of the Claim. The defendant must, therefore, prove the essential characteristics of the true invention and show that it does not comprise all the substantial features covered by the Claim. The evidence on both sides consists of specimens, drawings, or descriptions of the actual invention, illustrated and explained by expert witnesses. Upon the question whether an excessive Claim has been cured by a disclaimer within reasonable time, the patent furnishes no evidence. The burden of proof properly falls upon the plaintiff, and he should be prepared to show either that he has filed the disclaimer without unreasonable delay, or that a reasonable time for filing it has not elapsed since he became aware of the existence of his error. An inventor is not chargeable with notice that his Claim is excessive until it has received judicial interpretation in the court of last resort, except in cases where the excess is evident upon its face.³ The reasonableness or unreasonableness of the delay is matter of law for the court upon the facts disclosed by the evidence.⁴ If the amendment is made immediately upon the discovery of its necessity, there is no delay. When the delay is unavoidable it cannot be unreasonable.⁵ Although avoidable, it will not be unreasonable unless protracted to an extreme degree, where no other interests are at stake and the public are not liable to be misled.⁶

§ 1036. ¹ That the Claims of a patent are construed by the court as matter of law, see §§ 732, 733, and notes, *ante*.

² That the jury are to decide whether the Claims set forth the actual invention, see *Teese v. Phelps* (1855), 1 McAllister, 48; *Orr v. Burwell* (1849), 15 Ala. 378.

³ That no duty to disclaim arises until the plaintiff becomes chargeable with knowledge of the excess, see *Kittle*

v. Hall (1887), 30 Fed. Rep. 239; and cases cited in notes to § 646, *ante*.

⁴ That the court must decide as to reasonable delay, see § 646 and notes, and § 690, notes 5 and 8, *ante*.

⁵ That an unavoidable delay is not unreasonable, see *Hartshorn v. Eagle Shade Roller Co.* (1883), 18 Fed. Rep. 90; 25 O. G. 1191.

⁶ That the effect of a delay upon other parties may show whether or not it is unreasonable, see *Stutz v. Arm-*

If the plaintiff maintains that a disclaimer has been filed, it may be proved by a certified copy from the Patent Office. The evidence in reference to delay must show when the inventor first discovered that his Claim embraced more than the actual invention, and the circumstances which compelled him to postpone the amendment of his patent. Upon this portion of the issue the defendant may produce any testimony tending to fix an earlier date for the discovery of the error, or to prove that the delay of the inventor was unjustifiable in view of his own condition or that of others interested in the invention. When this defence applies to more than one Claim in the patent, evidence appropriate to each must be introduced.⁷

§ 1037. Evidence under the Fourteenth Defence: Ambiguity of the Claim.

The fourteenth defence asserts the ambiguity of the Claim. This defence raises a question of law for the court, and except in certain rare cases presents no issue for the jury. A Claim is ambiguous when the court is unable to ascertain from it what the patentee intended to protect as his invention.¹ The allowance of the patent by the Patent Office is a decision that its Claims are not ambiguous, and this decision is *prima facie* correct. The courts, however, in the discharge of their duty in construing the patent must encounter this question and settle it, though every presumption is in favor of the plaintiff, and the patent will, if possible, be sustained. For this purpose not only the Claim itself, with the Description and drawings, will be considered, but extraneous evidence may be offered to show the meaning of technical terms, or any other facts generally known in the art by which its obscure phrase-

strong (1884), 28 O. G. 367; 20 Fed. Rep. 843; and cases cited in note 7, § 690, *ante*.

⁷ That each Claim of the patent may be contested on the ground of excess, see 537, note 4, *ante*.

See on the matter of excessive Claims §§ 537, 643, 971, and notes, *ante*.

On the matter of disclaimer, see §§ 640-652, and notes, *ante*.

§ 1037. ¹ For ambiguity of Claim, see §§ 512-515, 537, 972, and notes, *ante*.

That whether the Claims are ambiguous is a question of law for the court, see *Wayne v. Holmes* (1856), 2 Fisher, 20; 1 Bond, 27.

ology may be rendered intelligible.² The introduction of such evidence by the parties is not a matter of right, but of judicial discretion.³ It consists principally of the testimony of experts, and of persons practically acquainted with the art, or of copies of papers in the Patent Office relating to the invention.⁴ When the Claim itself refers to facts, the existence and character of which must be determined before the Claim can be construed, evidence concerning these facts may be submitted to the jury, whose finding thereon thus enters into and becomes an element in the interpretation of the Claim.⁵

§ 1038. Evidence under the Fifteenth Defence: Surrender of the Letters-Patent.

The fifteenth defence alleges that the patent described in the declaration has been surrendered to the government. The production of the patent by the plaintiff is *prima facie* evidence that it is still in force, and the defendant must therefore prove the contrary. His evidence consists of certified copies from the records of the Patent Office showing the fact of surrender, the ownership of the patent by the parties who surrendered it, and its cancellation or the re-issue of an amended patent in its stead.¹

§ 1039. Evidence under the Sixteenth Defence: Repeal of the Letters-Patent.

The sixteenth defence avers that the patent described in the declaration has either been repealed *in toto* by a judgment

² That the court in construing a Claim may resort to extraneous evidence, see §§ 739-741, and notes, *ante*.

³ That evidence is not admissible, as a matter of right, to aid the court in construing the Claim, see § 732, and notes, *ante*.

⁴ That the court may avail itself of expert testimony, see *Day v. Stellman* (1859), 1 Fisher, 487.

That a drawing may be used in evidence to interpret an ambiguous specification, but cannot supply the entire want of any part of a specification or Claim, see *Tinker v. Wilbers Eureka*

Mower & Reaper Mfg. Co. (1880), 1 Fed. Rep. 188; 5 Bann. & A. 92.

⁵ That the jury apply the construction given by the court to the facts, and if the construction given is conditioned on the existence of extraneous facts, the jury are to find such facts and then apply the Claim as interpreted by the court, see *Silsby v. Foote* (1852), 14 How. 218; *Emerson v. Hogg* (1845), 2 Blatch. 1.

§ 1038. ¹ For a statement of the requisites and mode of a surrender, see §§ 696-699, and notes, *ante*.

See as to this defence § 973 and notes, *ante*.

in favor of the United States against the owner of the patent, or has been annulled in whole or in part in a proceeding instituted or defended by some person interested in an interfering patent. On both these issues the patent is *prima facie* evidence for the plaintiff. The defendant may show its repeal by a properly authenticated copy of the judgment, or where the patent, in pursuance of this judgment, has been returned to the Patent Office and been cancelled he may produce a certified copy of the record of such cancellation.¹ In proving that the patent has been annulled, the fact and scope of the judgment of avoidance may be evidenced by a copy from the records of the court, while copies of the record title in the Patent Office disclose that the plaintiff or his assignor was the party against whose interest in the patent such judgment was rendered.²

§ 1040. Evidence under the Seventeenth Defence: Want of Title in the Plaintiff.

The seventeenth defence denies the legal title of the plaintiff to the patent. When the plaintiff is the patentee, the patent is *prima facie* evidence upon this point in his favor, and the defendant must sustain his denial by satisfactory proof.¹ But where the plaintiff is an assignee or grantee, the burden rests upon him to establish the conveyances by which he claims to have derived his title from the patentee. The original assignment or grant is admissible for this purpose, though not recorded before the action was commenced, and is sufficient if in writing and executed in conformity with the local law.² In the absence of the original instruments, certi-

§ 1039. ¹ As to the repeal of patents see §§ 725-730, and notes, *ante*.

² As to the annulling of patents, see §§ 721-724, and notes, *ante*.

See as to this defence § 974 and notes, *ante*.

§ 1040. ¹ That the patent is *prima facie* evidence that the patentee owns the patented invention unless the contrary is proved, see *Fischer v. Neil* (1881), 6 Fed. Rep. 89; 19 O. G. 603.

As to this defence see §§ 937, 975, and notes, *ante*.

² That an assignment may be offered in evidence, whether recorded before or after suit, see *Pitts v. Whitman* (1843), 2 Story, 609; 2 Robb, 189.

That the assignment of a patent duly acknowledged before a notary may be put in evidence in New York, and the signatures of the assignors need not be proved, such assignment being valid by the laws of that State, see *New York Pharmaceutical Association v. Tilden* (1883), 21 Blatch. 190; 23 O. G. 272; 14 Fed. Rep. 740.

fied copies from the records of the Patent Office may be offered, and these not only prove the contents of the records, but are also *prima facie* evidence of the genuineness of their originals.⁸ The defendant, in reply, may attack either the existence or the validity of the alleged conveyances, or set up a legal title in himself acquired for valuable consideration, without notice, after the three months for recording the plaintiff's conveyance had elapsed.

§ 1041. Evidence under the Eighteenth Defence: Diversity of the Alleged Infringing Art or Article from the Invention Covered by the Patent.

The eighteenth defence denies that the invention practised by the defendant is identical with or is included in the patented invention. Upon this question, as upon all others embraced in the issue of infringement, the patent raises no presumption in favor of the plaintiff.¹ The burden rests upon him to show by extraneous evidence that the defendant has made, used, or sold the patented invention in violation of the patent, and if the testimony is of equal weight on either of these points the defendant must prevail.² When the plaintiff has made out a

⁸ That copies of records of assignments are evidence, see *Brooks v. Jenkins* (1844), 3 McLean, 432.

That a certified copy from the Patent Office of an assignment is *prima facie* evidence of the genuineness of the original and may be read in evidence to the jury, see *Lee v. Blandy* (1860), 2 Fishb., 89; 1 Bond, 361.

That a certified copy of a recorded but unacknowledged instrument purporting to be an assignment is sufficient evidence of its execution, unless met by opposing testimony, see *Dederick v. Whitman Agricultural Co.* (1886), 26 Fed. Rep. 763; 36 O. G. 570.

That in the absence of all other proof as to the date of an assignment, the date of the patent will be taken as the date of the application and also of the assignment if before patent, see *Worley v. Loker Tobacco Co.* (1882), 104 U. S. 340; 21 O. G. 559.

§ 1041. ¹ That the patent is not *prima facie* evidence of the infringement, but the plaintiff must prove it by other evidence, see *Hayden v. Suffolk Mfg. Co.* (1862), 4 Fisher, 86.

² In *Brooks v. Bicknell* (1844), 3 McLean, 432, McLean, J.: (459) "The proof here devolves on the plaintiffs. They allege that the defendants have infringed their rights, and to obtain your verdict they must show it. Doubts under this head will incline you favorably to the defendants, as they are not to be deprived of a right which is common to every citizen, unless it shall clearly appear that their machine is substantially like the one claimed by *Woodworth*."

Further, that the burden of proof rests upon the plaintiff to show the infringement by the defendant, see *Hayes v. Bickelhaupt* (1885), 23 Fed. Rep. 183; 32 O. G. 135; *Mallory Mfg. Co.*

prima facie case, however, the defendant must answer it by evidence, not by mere assertion in his pleadings; but he is not compelled to go beyond the contradiction of the evidence already offered, since the plaintiff cannot, in his rebuttal, strengthen his case upon the issue of infringement to the surprise or injury of the defendant.³ The identity of the patented invention with that employed by the defendant depends upon the same principles and is settled by reference to the same standards, as when the question of identity arises under the defence of prior use or prior patent.⁴ Though novelty and

v. Hickok (1885), 34 O. G. 923; 25 Fed. Rep. 827; *Royer v. Chicago Mfg. Co.* (1884), 20 Fed. Rep. 853; *Price v. Kelly* (1881), 20 O. G. 1452; *Miller v. Smith* (1880), 5 Fed. Rep. 359; 18 O. G. 1047; *Rogers v. Beecher* (1880), 18 O. G. 793; 3 Fed. Rep. 639; 5 Bann. & A. 619; *Bates v. Coe* (1878), 98 U. S. 31; 15 O. G. 337; *Kelleher v. Darling* (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438; *Roemer v. Simon* (1877), 95 U. S. 214; 12 O. G. 796; *Fuller v. Yentzer* (1876), 94 U. S. 299; 11 O. G. 597; *Storrs v. Howe* (1876), 10 O. G. 421; 4 Clifford, 388; 2 Bann. & A. 420; *Brady v. Atlantic Works* (1876), 10 O. G. 702; 4 Clifford, 408; 2 Bann. & A. 436; *Francis v. Mellor* (1871), 8 Phila. 157; 5 Fisher, 153; 1 O. G. 48; *Hudson v. Draper* (1870), 4 Fisher, 256; 4 Clifford, 178; *Howes v. Nute* (1870), 4 Clifford, 173; 4 Fisher, 263; *Sands v. Wardwell* (1869), 3 Clifford, 277; *Graham v. Mason* (1869), 5 Fisher, 1; 4 Clifford, 88; *Hodge v. Hudson River R. R. Co.* (1868), 3 Fisher, 410; 6 Blatch. 85; *Whitney v. Mowry* (1867), 3 Fisher, 157; 2 Bond, 45; *Union Sugar Refinery v. Matthiesson* (1865), 2 Fisher, 600; 3 Clifford, 639; *Hayden v. Suffolk Mfg. Co.* (1862), 4 Fisher, 86; *Parker v. Stiles* (1849), 5 McLean, 44; *Brown v. Jenkins* (1844), 3 McLean, 432; *Dixon v. Moyer* (1821), 4 Wash. 68; 1 Robb, 324.

³ That if the plaintiff offers any evidence of infringement the defendant must overcome it, see *Bennett v. Fowler* (1869), 8 Wall. 445.

⁴ In *Parker v. Stiles* (1849), 5 McLean, 44, Leavitt, J.: (62) "On the question of infringement, the burden of proof is with the plaintiff. He must make it appear, to the satisfaction of the jury, that the defendant has violated the exclusive right granted by his patent. And in order to make out the fact of infringement, the plaintiff must prove that the defendant has used his invention, either in the precise form in which it is constructed under the patent, or in a form and on principles substantially the same. To constitute this identity, and to make out the fact of infringement, it is not necessary that the structure or machine used by the defendant should be the same in appearance, form, or proportions, as that invented and patented by the plaintiff. It has been well said by a distinguished judge in this country, that 'simply changing the form or proportion of a machine shall not be deemed a new discovery.' If the operative principle of the two machines be the same, the substantial identity contemplated by the Patent Law is established."

As to the indications of identity, see §§ 229-236, 892-896, 963, 1026, and notes, *ante*.

infringement present distinct issues, and the former must be proved before the latter can be considered, yet in each case the patented invention is compared with some other instrument or operation for the purpose of determining their substantial similarity or difference, and the mode of this comparison, as well as the evidence admissible in connection therewith, is in both cases the same.⁵ Where the invention practised by the defendant is covered by a separate patent, under which the defendant acts, the identity of the two inventions is ascertained by the court by comparing the Claims of the patents, with such aid from expert or other witnesses as it may deem desirable.⁶ If the defendant acts without the shelter of a patent, the identity between the invention which he uses and the patented invention is best shown by the actual inspection of the two inventions, or of models exhibiting their essential attributes, either with or without the explanations of expert witnesses.⁷ This is especially true where the inventions are designs, which in many instances manifest their identity or diversity to any careful observer.⁸ When such inspection is insufficient to determine the question, the inventions may be examined while in actual use, if this is practicable.⁹ Or without recourse to either of these methods, the

⁵ That novelty and infringement do not raise the same issues, see *Union Sugar Refinery v. Matthiesson* (1865), 2 Fisher, 600; 3 Clifford, 639.

As the identity of two inventions, for whatever purpose they may be compared, must rest on the same essential characteristics in each, the evidence by which identity is proved or denied must be in all cases the same.

⁶ That the identity of two patented inventions is shown by comparing their Claims, see *McMillan v. Rees* (1880), 1 Fed. Rep. 722; 17 O. G. 1222; 5 Bann. & A. 269.

⁷ That a comparison of the devices of the plaintiff and the defendant is the best evidence on the question of infringement, see *Bates v. Coe* (1878), 98 U. S. 31; 15 O. G. 337; *Fuller v. Yentzer* (1876), 94 U. S. 288; 11 O. G. 551;

Hudson v. Draper (1870), 4 Fisher, 256; 4 Clifford, 178; *Seymour v. Osborne* (1870), 11 Wall. 516; *Cahoon v. Ring* (1861), 1 Clifford, 592; 1 Fisher, 397.

That a court of equity may order an inspection of the defendant's device on a question of identity, see *Wilson v. Keely* (1888), 43 O. G. 511.

That the jury are to determine from the models and other evidence whether the defendant infringes, see *Smith v. Pearce* (1840), 2 McLean, 176; 2 Robb, 13.

⁸ That designs may be compared by the court in some cases to show identity, no other evidence being needed, see *Jennings v. Kibbe* (1882), 10 Fed. Rep. 669; 20 Blatch. 353; 22 O. G. 331.

⁹ That a machine effecting the same end by the same means is an infringement, and the jury are to examine both

testimony of experts familiar with the defendant's invention may be offered to disclose its characteristics and their agreement or disagreement with those found in the patented invention.¹⁰ Where the defendant conceals the art or article he uses, and declines to produce it for inspection, there is a strong presumption that it is identical with the one covered by the plaintiff's patent, particularly when from other evidence it is apparent that he intends to imitate it as closely as he can without detection.¹¹ The amount of proof required from the plaintiff on this issue is measured by the quantity which the defendant can present. The uncontradicted evidence of a single witness that the defendant employed a device substantially like that of the plaintiff is sufficient, but in case of contradiction the jury must find for the defendant unless a clear preponderance of evidence supports the plaintiff's declaration.¹² When the invention used by the defendant is not

and see how they work and what they do, see *Cahoon v. Ring* (1861), 1 Clifford, 592; 1 Fisher, 397.

¹⁰ That experts may be examined and their evidence taken as to the identity of the plaintiff's and defendant's devices, see *Hudson v. Draper* (1870), 4 Fisher, 256; 4 Clifford, 178; *Page v. Ferry* (1857), 1 Fisher, 298.

That expert evidence is not necessary, see *Hayes v. Bickelhaupt* (1885), 23 Fed. Rep. 183; 32 O. G. 135.

That the opinion of experts is not for the jury if it involves a question of law or the construction of the patent, see *Ely v. Monson & Brimfield Mfg. Co.* (1860), 4 Fisher, 64.

That if the court can say on inspection that the defendant's device does not infringe the plaintiff's, there is no room for expert evidence or jury action, see *Ely v. Monson & Brimfield Mfg. Co.* (1860), 4 Fisher, 64.

That a prior judgment finding that a given device infringes a patent is of weight to show that similar devices are also infringements, see *Steam Gauge & Lantern Co. v. Myers Mfg. Co.* (1886), 28 Fed. Rep. 624.

¹¹ That the refusal of a defendant to exhibit his device raises a presumption of infringement, see *Piper v. Brown* (1873), Holmes, 196; 6 Fisher, 240; 3 O. G. 97.

That if the defendant comes as near the plaintiff's method as he can, this tends to show infringement, see *Turrill v. Illinois Central R. R. Co.* (1873), 5 Bissell, 344.

That a defendant denying access to his machine, and failing to show its model, drawing, product, or patent, cannot expect much weight to be attached to his denials of identity, or much favor to be shown him in case of doubt, see *Union Paper Bag Mach. Co. v. Binney* (1871), 5 Fisher, 166.

That a party who tries to suppress truth has all the presumptions against him, while one who freely discloses it has no presumption either way, see *National Car Brake Shoe Co. v. Terre Haute Car & Mfg. Co.* (1884), 28 O. G. 1007; 19 Fed. Rep. 514.

¹² That the uncontradicted evidence of a single witness that the defendant used machines substantially like the plaintiff's is enough to prove infringe-

intended for the same purpose as that of the plaintiff, and the infringement is, therefore, collateral or accidental, the proof of identity must be so conclusive as to leave no room for any other reasonable construction.¹³ The plaintiff, under all circumstances, must abide by the Claims and descriptions contained in his own patent, neither adding nor discarding anything in order to bring his invention into correspondence with that of the defendant.¹⁴ The defendant may show that notwithstanding any resemblances between his processes, effects, or products, and those of the plaintiff, the means he uses are essentially different.¹⁵ He may offer evidence of the substantial superiority of his art or device, as the basis of an inference that a distinct idea is therein expressed.¹⁶ He may also prove that the invention which he practises is identical with one in use before the date of the inventive act of the plaintiff or his inventor, since if the plaintiff's invention be actually new, it cannot in this case be the same with that of the defendant. Whether a later patent, obtained by the defendant or his assignor, grantor, or licensor, could be produced in evidence on his behalf was formerly disputed.¹⁷ It is now admitted for two purposes: (1) To show the good faith of the defendant, which may become material in view of the power of the court to increase the damages awarded by

ment, see *Spring v. Domestic Sewing Mach. Co.* (1881), 21 O. G. 633; 9 Fed. Rep. 505; *Gear v. Fitch* (1878), 16 O. G. 1231; 3 Bann. & A. 573; *Goodyear v. Berry* (1868), 3 Fisher, 439; 2 Bond, 189.

That the evidence of a witness that he saw the infringing device in the defendant's possession may be sufficient proof, see *Gear v. Fitch* (1878), 16 O. G. 1231; 3 Bann. & A. 573.

¹³ That where the defendant's device was not intended to evade a patent but for a different purpose, and the infringement is thus purely accidental, the evidence of it must be so clear as to leave no other reasonable construction, see *National Car Brake Shoe Co. v. D., L., & N. R. R. Co.* (1880), 4 Fed. Rep. 224.

¹⁴ That the plaintiff is limited to the Claims of his patent, see § 505 and notes, *ante*.

¹⁵ That in a suit for infringement the defendant may show that his machine differs though the process is the same, see *Corning v. Burden* (1853), 15 How. 252.

¹⁶ That the superior utility of the defendant's device or process may show its substantial diversity from the plaintiff's, see §§ 116-121, 344, and notes, *ante*.

¹⁷ That it was formerly doubted whether the defendant's patent was admissible at all, and though it is now admitted it does not materially affect the question of infringement, see *Goodyear Dental Vulcanite Co. v. Gardner* (1870), 4 Fisher, 224; 3 Clifford, 408.

the jury; (2) To show that the expert examiners in the Patent Office regarded the invention which it covers as essentially distinct from that protected in the earlier patent of the plaintiff.¹⁸ Such a decision in the Patent Office is strong evidence in favor of the defendant on this question of identity, and must be properly considered by the jury, though it cannot control their verdict.¹⁹ Its weight is increased by a re-issue or extension of the defendant's patent.²⁰ But where the defendant originally secured his patent by disclaiming the plaintiff's invention, and after the plaintiff's patent had been granted re-issued his own to cover the invention, his defence must rest upon the priority of his inventive act, not on an absence of identity between the two inventions.²¹

§ 1042. Evidence under the Nineteenth Defence: Non-commission of the Infringing Acts by the Defendant.

The nineteenth defence denies that the defendant has made, used, or sold, the invention which the plaintiff claims to be

¹⁸ That where the defendant acts in good faith under a later patent the court will refuse to inflict punitive damages, see *Buerk v. Imhaeuser* (1876), 14 Blatch. 19; 10 O. G. 907; 2 Bann. & A. 452.

That the defendant's patent is entitled to the same presumptions of novelty and utility as the plaintiff's, see *Smith v. Woodruff* (1873), 6 Fisher, 476; 4 O. G. 635; 1 MacArthur, 459; *Blanchard v. Puttman* (1867), 3 Fisher, 186; 2 Bond, 84; *House v. Young* (1867), 3 Fisher, 335.

¹⁹ That the defendant may offer in evidence the later patent of his licensor to show that the inventions are not the same, see *Blanchard v. Puttman* (1867), 3 Fisher, 186; 2 Bond, 84.

That the grant of a patent is a decision by the Commissioner that the invention is not covered by prior patents, see *Putnam v. Keystone Bottle Stopper Co.* (1889), 38 Fed. Rep. 234; *Serrell v. Collins* (1857), 1 Fisher, 289.

That the validity of the defendant's patent is not in issue, see *Larabee v. Courtlan* (1851), Taney, 180.

That patents granted pending a prior application for the patent in issue are no protection to an infringer, see *Johnson v. Fassman* (1872), 2 O. G. 94; 1 Woods, 138; 5 Fisher, 471.

That at law no comparison can be made between the defendant's machine and prior machines, but only between them and the plaintiff's upon the question of novelty, see *Judson v. Cope* (1860), 1 Fisher, 615; 1 Bond, 327.

²⁰ That a re-issue or extension increases the weight of a patent on the question of novelty, see *Whitney v. Mowry* (1867), 2 Bond, 45; 3 Fisher, 157.

²¹ See § 1024, note 10, *ante*.

That where the plaintiff obtained his patent on the defendant's refusal to submit to arbitration under Sec. 9, act of 1793, and afterward the defendant obtained a patent, this is not conclusive proof that the latter was issued on false suggestion, see *Stearns v. Barrett* (1816), 1 Mason, 153; 1 Robb, 97.

As to this defence in general, see § 976 and notes, *ante*.

identical with his own. The plaintiff must prove these acts of the defendant to the satisfaction of the jury, but inasmuch as direct testimony upon this point is often unobtainable, and the entire matter lies within the knowledge of the defendant who can explain his conduct if he chooses, the jury are allowed to base their verdict upon the indications afforded by circumstances not amounting to specific acts of making, use, or sale. Thus, although to make and to use the invention are distinct injuries, the proof of use or sale, coupled with evidence tending to show that the defendant did not elsewhere procure the articles sold or used, may establish an averment that he made them.¹ The testimony of a witness that he saw the invention in the defendant's factory or in his possession, if not denied or explained, is sufficient ground for the conclusion that he used it.² The evidence of a workman that he was employed by the defendant under a contract which, as read to him, required him to make use of the patented invention, will, if uncontradicted, also warrant a finding for the plaintiff.³ The fact that the defendant advertised the patented articles for sale is likewise admissible as tending to prove actual making, use, or sale, according to the other circumstances shown.⁴ The refusal of the defendant to allow his

§ 1042. ¹ See as to this defence §§ 903-905, 977, and notes, *ante*.

That proof of use alone sustains the allegation of making and using, see *Locomotive Engine Safety Truck Co. v. Erie R. R. Co.* (1872), 3 O. G. 93 ; 10 Blatch. 292 ; 6 Fisher, 187.

That though a sale to the patentee is not an infringement it may be evidence of infringement by sale to others, see *De Florez v. Reynolds* (1878), 14 Blatch. 505 ; 3 Bann. & A. 292.

That the sale of the device to an agent of the patentee employed by him to buy it is not *per se* infringement, but may be evidence of it, see *Byam v. Bullard* (1852), 1 Curtis, 100.

That where a declaration limits the period of infringement the evidence must be confined to that time, see

Creamer v. Bowers (1888), 35 Fed. Rep. 206.

² That where a witness saw the infringing device in the defendant's possession, and the defendant does not deny the infringement explicitly, it is regarded as proved, see *Gear v. Fitch* (1878), 16 O. G. 1231 ; 3 Bann. & A. 573.

³ That where a workman testifies without contradiction that a certain written contract was read to him as a contract for putting down the plaintiff's device, and the contract not being produced parol evidence is given of its contents, the evidence is conclusive as to infringement, see *Andrews v. Creegan* (1881), 19 O. G. 1140 ; 19 Blatch. 113 ; 7 Fed. Rep. 477.

⁴ That although an advertisement of

processes or products to be inspected, and even his failure to deny the alleged infringing acts when evidenced by any probable testimony, are matters which may weigh against him with the jury.⁶ The sources of evidence upon this question, for both the plaintiff and defendant, are the same as those in any other controversy where acts of manufacture, use, or sale are involved, — the testimony consisting of the statements of witnesses who personally know the facts which they narrate. If the defendant, not denying the alleged acts of making, use, or sale, disclaims his own liability for them on the ground that he was acting under orders and not of his own volition, he must sustain this position by sufficient evidence. Such evidence must disclose the name of the principal or employer under whom he acts, and establish the existence of such authority in him over the defendant as not only renders him responsible for the acts of the defendant in reference to the invention, but excludes the defendant's voluntary choice from the operative causes of the infringement.⁶

§ 1043. Evidence under the Twentieth Defence: Non-commission of the Infringing Acts During the Life of the Patent.

The twentieth defence denies that the acts of infringement were committed while the patent was in force. The date of the patent, and the term which it purports to cover, appear upon the face of the instrument, and afford *prima facie* evidence that the patent was in force during the entire period described. The plaintiff must prove acts of infringement within that period by such evidence as is suggested in the foregoing paragraph, and this evidence may be contradicted or explained by the defendant without attacking the correctness

the infringing device may not be an infringement and violate an injunction, it is strong evidence thereof and to be overcome by positive proof to the contrary, see *Allis v. Stowell* (1881), 19 O. G. 727.

⁶ That the refusal of the defendant to allow his articles or processes to be inspected is evidence of infringement,

see *Union Paper Bag Mach. Co. v. Binney* (1871), 5 Fisher, 166.

⁶ That a defence of agency must disclose the principal, see *American Cotton Tie Supply Co. v. McCready* (1879), 17 Blatch. 291; 4 Bann. & A. 588; 17 O. G. 565; *Morse v. Davis* (1862), 5 Blatch. 42.

of the patent in this particular. If, however, he asserts that the patent, though apparently in force when these acts were committed, had previously expired, he assumes the burden of proof, and must show either that the patent had been then surrendered or repealed or that its term is erroneously stated in the instrument itself. The method of proving a surrender or repeal has been already considered under those defences.¹ If the term stated in the patent is greater than the seventeen years permitted by the statutes, it is incorrect upon its face and the patent will be held valid only for the lawful period.² If the term named in the patent is the one limited by law, a defendant, who claims that it should be restricted on account of a prior foreign patent to the same inventor, must produce the foreign patent covering the invention, or a certified copy thereof from the Patent Office, and establish by sufficient evidence the connection of the plaintiff or his assignor with its prior issue.³ When the names of the two patentees are identical, the evidence outside the patents must show the identity of the persons named. When the foreign patentee is a different person, the relations between himself and the American patentee, whom he represents, must also be disclosed by evidence of their contracts, correspondence, co-operation in business, participation in profits or expenses, or of any other facts tending to show that the foreign patent issued in the interest of the domestic patentee.⁴ This evidence may be contradicted or explained by the plaintiff in the usual manner.

§ 1043. ¹ See §§ 907, 908, 978, 1038, 1039, and notes, *ante*.

² That where the term as stated in the patent is greater than the law allows, the patent will be in force only during the lawful period, see *Bate Refrigerating Co. v. Hammond* (1889), 129 U. S. 151; *De Florez v. Reynolds* (1880), 17 O. G. 503; 8 Fed. Rep. 434; 17 Blatch. 436; 5 Bann. & A. 140; and § 622 and notes, *ante*.

³ That the burden of proof is on him who seeks to limit the term of the patent by a foreign patent, and he must show the facts which limit it, see *American Diamond Rock Boring Co.*

v. Sheldon (1879), 17 Blatch. 303; 4 Bann. & A. 603.

That where an objection to a patent is based on the taking out of a prior foreign patent the evidence must connect the plaintiff with its issue, see *Goodyear Dental Vulcanite Co. v. Willis* (1874), 1 Flippin, 388; 1 Bann. & A. 568; 7 O. G. 41.

That the plaintiff's patent expired with certain foreign patents is matter for original defence and cannot be introduced in rebuttal, see *American Paper Barrel Co. v. Laraway* (1886), 28 Fed. Rep. 141; 37 O. G. 674.

⁴ That the foreign patent must have

§ 1044. Evidence under the Twenty-First Defence: Co-ownership or License.

The twenty-first defence asserts that the acts of the defendant, in making, using, and selling the patented invention, were performed under, and not in violation of, the plaintiff's patent. Upon this defence the plaintiff has the burden of proof and must make out a *prima facie* case. Slight evidence is, however, sufficient for this purpose, such, for example, as his own denial of authority, the defendant having the means at his disposal to clearly prove his right if it exists. When the defendant claims to be a part-owner, assignee, or grantee under the patent, his title must be shown by the written instruments of conveyance or a certified copy from the records in the Patent Office.¹ If he is a licensee under an express written license, the license must be produced, or its absence must be satisfactorily accounted for and parol evidence of its contents given.² An absolute license in the possession of the defendant will be presumed to have been

issued to the same inventor, or by his authority, see *Edison Electric Light Co. v. United States Electric Lighting Co.* (1888), 35 Fed. Rep. 134; *Kendrick v. Emmons* (1875), 2 Bann. & A. 208; 9 O. G. 201.

§ 1044. ¹ See as to this defence §§ 797, 913-917, 979, and notes, *ante*.

That a title to the patent must be proved by the proper instruments or certified copies thereof, see § 1040 and notes, *ante*.

² That a plea of license must be sustained by proof that a license was actually granted, see *Tilghman v. Hartell* (1876), 11 Phila. 500; 9 O. G. 886; 2 Bann. & A. 260.

That negotiations for a license do not prove an actual license, see *Tilghman v. Hartell* (1876), 9 O. G. 886; 11 Phila. 500; 2 Bann. & A. 260.

That a plea of license must be proved as a completed contract, and if proved it ends the case, since the Federal courts

cannot inquire into the contract relations of the parties if they are once proved to exist, see *Tilghman v. Hartell* (1876), 9 O. G. 886; 11 Phila. 500; 2 Bann. & A. 260.

That on a suit for infringement the Federal courts may determine whether or not there is a subsisting license, see *Hammacher v. Wilson* (1886), 26 Fed. Rep. 239; 36 O. G. 233.

That on a suit for infringement against a licensee, who has failed to pay royalties as agreed, an excuse for his failure does not raise the question whether his license should be rescinded but whether it still exists, see *Hammacher v. Wilson* (1886), 26 Fed. Rep. 239; 36 O. G. 233.

That if a license is conditional the defendant must perform the conditions, and if he justifies under the license he must show that its conditions were performed, see *Brooks v. Stolley* (1845), 3 McLean, 523; 2 Robb, 281.

regularly executed and delivered, until the contrary appears.³ An oral license may be proved by any proper testimony. The defendant must also show that his acts were performed by him as such licensee, and not in antagonism to the patent nor under a license derived from a different patent.⁴ If the defendant justifies under an implied license he must prove the facts from which the license arises. A license to make may be implied from an express license to use or sell, when the latter rights could not be reasonably enjoyed without the former.⁵ A license to use or sell may be implied in like manner from an express license to make, when the power to manufacture would otherwise be without benefit to the licensee.⁶ A license to use or sell a specific article may be implied from its sale without restrictions by any person having authority under the patent thus to sell it.⁷ A license to employ a specific process arises from the sale, by the owner of the patent for the process, of a device whose sole utility is in connection with that process.⁸ In any of these cases the nature and sources of the defendant's evidence are suggested by the facts from which his license is implied. The defendant, having thus offered evidence tending to prove his right to

³ That an absolute license from the plaintiff, when produced by the defendant, throws on the plaintiff the burden of proving that it was delivered as an escrow, see *Mellon v. D. L. & W. R. R. Co.* (1882), 21 O. G. 1616; 12 Fed. Rep. 640.

⁴ That no evidence that the defendant is licensee or owner under a different patent is an excuse for an infringement which appears by comparing his device with the plaintiff's patent, see *Blanchard v. Putnam* (1869), 8 Wall. 420.

That a license given as part of the settlement of a suit is not evidence against a stranger, see *Gottfried v. Crescent Brewing Co.* (1884), 22 Fed. Rep. 433; 30 O. G. 892.

⁵ That an express license to use or sell may carry the right to make, see §§ 812, 813, and notes, *ante*.

⁶ That an express license to make may carry the right to use or sell, see § 811 and notes, *ante*.

⁷ That a lawful sale without restrictions carries the right to use, and sometimes also to sell, see §§ 824-827, and notes, *ante*.

⁸ That the purchaser of a machine from the patentee of a process which consists in the operation of the machine may defend against the patent on the ground of license to use the machine and process both, see *Downton v. Yaeger Milling Co.* (1880), 17 O. G. 906; 1 Fed. Rep. 199; 1 McCrary, 26; 5 Bann. & A. 112.

That where the licensed device can be used only in connection with other patented inventions belonging to the same licensor, it may be used in that way, see *Roosevelt v. Western Electric Co.* (1884), 20 Fed. Rep. 724; 28 O. G. 812.

practise the invention, the plaintiff must rebut it, either by denying the existence of the alleged authority on counter evidence, or by showing that the acts of the defendant are not within the scope of the authority conferred. A licensee is an infringer if he assumes a right which his license does not bestow, and even an owner of the patent may violate the monopoly by making, using, or selling an invention which, though not identical with the patented invention, embraces and employs it.⁹ It is for the plaintiff to prove that these departures from the lawful use of the invention have been made by the defendant, and to separate his acts of infringement from those which he has properly performed; and this proof may be met and answered by the defendant by showing a wider scope for his authority or a correspondence of his acts with the authority bestowed.¹⁰

§ 1045. Evidence under the Twenty-Second Defence: Statute of Limitations.

The twenty-second defence is based upon the Statute of Limitations.¹ This defence must be specially pleaded, and the burden of proof on the issues created by such plea rests on the defendant. The nature of the evidence to be adduced depends upon the provisions of the statute. If the period within which actions may be brought commences at the date of the infringement, the testimony concerning the acts of infringement, taken in connection with the record date of

⁹ That the part owner of a patent can sue his co-owner for infringement committed by using an infringing device, but not for using the patented one, see *Herring v. Gas Consumers Association* (1878), 9 Fed. Rep. 556; 21 O. G. 203; 13 O. G. 637; 3 McCrary, 206; 3 Bann. & A. 253.

¹⁰ That it is for the plaintiff to show that the defendant's use is numerically in excess of his license and amounts to an infringement, see *Hodge v. Hudson River R. R. Co.* (1868), 3 Fisher, 410; 6 Blatch. 85.

That a defendant claiming license

has the burden of proof to show that the articles were made and sold under the license, see *Searls v. Bouton* (1882), 12 Fed. Rep. 140; 21 O. G. 1784; 20 Blatch. 426.

That where a defendant sets up a license which is shown to have been violated and revoked before the infringement, the defence will be overruled, and the defendant permitted to defend like other infringers, see *Wooster v. Singer Mfg. Co.* (1883), 23 O. G. 2513.

§ 1045. ¹ See as to this defence § 980 and notes, *ante*.

the institution of the suit, will disclose whether the actions were commenced within the time proscribed. If the statute begins to run at the expiration of the patent, the date of such expiration is determined by the statements of the instrument, or by the records of its surrender or repeal, or by the evidence of a prior patent limiting its term, while the files in the action show the date of the commencement of the suit. When the statute contains exceptions preventing its operation in certain cases, the evidence concerning these must correspond on both sides with the issues thus presented.

§ 1046. Evidence under the Twenty-Third Defence : Estoppel.

The twenty-third defence alleges that the plaintiff is estopped, either by matter of record or *in pais*, from maintaining his suit against the defendant. The burden of proof is on the defendant. If the estoppel claimed arises from any written instrument the document itself must clearly exhibit the statements out of which the estoppel flows; and when the plaintiff and defendant are not parties to the instrument, their respective privity to its parties must be shown.¹ An estoppel *in pais* is implied from the actions or omissions of the plaintiff, and when asserted by the defendant he must prove the circumstances on which it is based, and his reliance on the facts thereby suggested as a guide for his own conduct in the use of the invention. The evidence in each case must be suited to the facts alleged. When the defendant claims an estoppel against the plaintiff on the ground that his patented articles were put upon the market without a proper stamp, he may produce the unstamped articles or packages and prove that they were in the market in that condition, or he may show the same state of affairs by evidence from those who know the fact. The plaintiff may reply to this testimony by proving actual notice to the defendant before the date of the infringement.²

§ 1046. ¹ See as to this defence § 981 and notes, *ante*.

That a document offered to prove admissions by the plaintiff against his right speaks for itself whether in his

favor or against him, see *Campbell v. James* (1879), 18 O. G. 979; 17 Blatch. 42; 4 Bann. & A. 456.

² That under Sec. 13, act of March 2, 1861, the burden of proof is on the

§ 1047. Evidence under the Twenty-Fourth Defence : Release.

The twenty-fourth defence asserts that the cause of action described in the declaration has been released by the plaintiff. The burden of proof on this issue rests upon the defendant. When the release is in writing it must be produced or its absence duly accounted for and its contents proved. When the release is embraced in a broader transaction between the parties, so much of the transaction must be proved as to make it appear that the release was intended by the plaintiff and was made upon a lawful consideration. If there is any reasonable doubt as to its existence, or its applicability to the infringement on which the suit is based, the plaintiff must prevail.¹

§ 1048. Evidence under the Twenty-Fifth Defence : Res Adjudicata.

The twenty-fifth defence asserts that the cause of action arising out of the infringement has been extinguished by or merged in a judgment. The defendant assumes the burden of proof, and his evidence must show that the same acts of which the plaintiff now complains have been the subject of a prior suit, in which judgment was rendered for the defendant on some point fatal to the cause of action, or for the plaintiff to recover damages, either actual or nominal, for the infringement.¹ The record of the judgment, or a certified copy thereof, must be offered, together with such other evidence

defendant to show the failure of the patentee to stamp as required, then the burden shifts to the patentee to show that the defendant was notified that he was infringing and persisted in so doing, see *Goodyear v. Allyn* (1868), 3 Fisher, 374 ; 6 Blatch. 33.

§ 1047. ¹ See as to this defence § 982 and notes, *ante*.

§ 1048. ¹ That a judgment works an estoppel only when the record shows that the particular point in controversy was heard and decided, see *Steam Gauge & Lantern Co. v. Meyrose* (1886), 27 Fed. Rep. 213 ; 36 O. G. 1477.

See also §§ 983, 1175-1188, and notes, *post*.

That a defendant, parting with his interest in the infringing business during suit, but without change of parties on the record, is bound by the decree, see *Gloucester Isinglass & Glue Co. v. Le Page* (1887), 30 Fed. Rep. 370.

That an absolute decree on the merits binds the parties, see *Lyon v. Perin & Gaff Mfg. Co.* (1888), 43 O. G. 983.

That a new defence set up by a party to several prior suits should be proved beyond reasonable doubt, see *Seibert Cylinder Oil-Cup Co. v. Michigan Lubricator Co.* (1888), 34 Fed. Rep. 33.

as may be necessary to connect the plaintiff and defendant with the contestants in the former suit, either by showing that they are the same parties or that they are in privity with them.

§ 1049. Evidence Concerning Damages.

The special rules of evidence discussed in the preceding paragraphs are applicable to the first four of the five averments in the declaration, — the invention of the patentable subject-matter by the patentee or his assignor, the lawful issue and existence of the patent, the title of the plaintiff, and the infringement of the patent by the defendant. The fifth averment declares that the infringement has resulted in damage to the plaintiff; and of the evidence admissible upon the issue raised by this averment it is impossible to treat intelligibly until the principles which govern the award of damages have been considered. These principles are few and simple, and though the topic has been long regarded as one of the most confused and difficult in the whole body of our Patent Law, the careful distinguishing of one subject from another will relieve it of much of its obscurity, and indicate the proper rules to be observed in fixing the amount to which the plaintiff is entitled in every case that may arise.

§ 1050. Distinction between the Rule of Damages at Law and the Measure of Recovery in Equity.

The first distinction to be made is that between the measure of recovery in equity and the measure of recovery at law. The theory of a suit in equity for an infringement is entirely different from that at law. The accountability of the defendant rests upon grounds totally dissimilar, and imposes upon him obligations utterly unlike those which he sustains in an action at law. This is especially apparent in the rules by which the amount of his pecuniary liability to the plaintiff is determined. In law he is regarded as a mere wrong-doer, compelled to make compensation for the injury he has inflicted. In equity he has a double character, being first treated as a species of agent or trustee practising the invention for the benefit of its true owner and obliged to pay to

him the profits of the enterprise, and then, if in the judgment of the court the interests of the plaintiff so require, mulcted as a tort-feasor in a sum sufficient to redress the injury which the plaintiff has sustained.¹ This wide and fundamental dis-

§ 1050. ¹ In *Birdsall v. Coolidge* (1876), 93 U. S. 64, Clifford, J. : (68) "Controversies and cases arising under the Patent Laws are originally cognizable, as well in equity as at law, by the circuit courts, or by any district court having circuit powers. Prior to the passage of the act of the 8th of July, 1870, two remedies were open to the owner of a patent whose rights had been infringed, and he had his election between the two. He might proceed in equity and recover the gains and profits which the infringer had made by the unlawful use of his invention, the infringer in such a suit being regarded as the trustee of the owner of the patent as respects such gains and profits; or the owner of the patent might sue at law, in which case he would be entitled to recover, as damages, compensation for the pecuniary injury he suffered by the infringement, without regard to the question whether the defendant had gained or lost by his unlawful acts; the measure of damages in such case being not what the defendants had gained, but what the plaintiff had lost. (Curtis on Pat., 4th ed. 461; 5 Stats. at Large, 123.) When the suit is at law, the measure of damages remains unchanged to the present time, the rule still being that the verdict of the jury must be for the actual damages sustained by the plaintiff, subject to the right of the court to enter judgment thereon for any sum above the verdict, not exceeding three times that amount, together with costs. (16 Stat. 207.) Damages of a compensatory character may also be allowed to the complainant suing in equity in certain cases, where the gains and profits made by the re-

spondent are clearly not sufficient to compensate the complainant for the injury sustained by the unlawful violation of the exclusive right secured to him by the patent. Gains and profits are still the proper measure of damages in equity suits, except in cases where the injury sustained by the infringement is plainly greater than the aggregate of what was made by the respondent, in which event the provision is that the complainant shall be entitled to recover, in addition to the profits to be accounted for by the respondent, the damages he has sustained thereby." 10 O. G. 748 (750).

In *Goodyear Dental Vulcanite Co. v. Van Antwerp* (1876), 2 Bann. & A. 252, Nixon, J. : (254) "The terms *profits* and *damages* as used in the act are hardly convertible. They seem to mean different things. The latter are to be awarded '*in addition*' to the former. Profits, doubtless, refer to what the defendant has gained by the unlawful use of the patented invention, and damages to what the complainant has lost. Before the act of 1870 it was incumbent on the patentee to make his election of remedies, and to proceed at law for the damages which he could show had been sustained from the infringement, or in equity for the gains and profits that the defendant had realized for the unauthorized use of his property. Now no such election is necessary, because he is entitled to pray in one action for the relief both in regard to profits and damages." 9 O. G. 497 (498).

In *Cowing v. Rumsey* (1870), 4 Fisher, 275, Woodruff, J. : (277) "A patentee whose rights are infringed has

inction leads to radical differences in the standards by which the court or jury are to estimate the amounts to be awarded, and in the rules by which the relevancy and weight of evidence concerning these amounts must be determined. The principles adopted in the courts of equity cannot be imported into the courts of law, or those of law into equity, without serious confusion and inevitable mistake. Nor can the definitions and modes of calculation recognized in one tribunal be followed by the other without equally disastrous consequences. Decisions in which this essential distinction has been disregarded have been rendered, and to these may be attributed much of the difficulty which besets the legal aspect of this subject. It is, therefore, of primary importance that in discussing damages at law, or profits and damages in equity, each topic should be kept free from the special doctrines appertaining to the other, and that the former be investigated in the light of its own principles as these have been interpreted and applied in courts of law.

his election of remedies. He may treat the infringer who illegally appropriates the invention to his own use, making profit thereby, as his trustee in respect of such profits, and compel him to account therefor in equity. In such case the plaintiff may recover those profits, be they more or less; and he can recover no more, however great the damages may be which the illegal interference has occasioned. If, on an accounting, it should appear that the defendant used the invention so unskillfully that he realized no profit, there could be no recovery. On the other hand the patentee may sue at law for the damages which he has sustained; and those damages he is entitled to recover whether the defendant has made any profits or not. In such an action it is precisely what is lost to the plaintiff, and not what the defendant has gained,

which is the legal measure of the damages to be awarded. Under this rule it may often be entirely proper to prove the profits of the ordinary use of the invention, and the demand existing in the market, evidenced by sales made, and so, as an element of consideration, show the profits realized by the defendant, in order to furnish to the jury all proper materials for determining how much the plaintiff has lost. But I apprehend that they are to answer the precise question — how much loss has the plaintiff sustained by reason of the defendants' infringement?" 8 Blatch. 36 (38).

The statement in the foregoing extracts, that the plaintiff has an election of remedies, is qualified by more recent cases. See §§ 1084-1094, and notes, *post*.

§ 1051. Distinction between the Rule of Damages and the Rules of Evidence concerning Damages.

Another essential distinction, which is too often overlooked, is that between the rule of damages in actions at law and the rules governing the evidence by which the amount of damages is to be ascertained. The rule of damages is fixed and uniform, as much so as in any ordinary action on the case. It recognizes two species of damages, — nominal and actual. It determines definitely when nominal damages shall be awarded, and when actual damages shall be allowed. It establishes the same measure for the latter as that which courts of law adopt in all breaches of contract as well as in all other torts. But inasmuch as the infringement of a patent may inflict injuries of various degrees and characters, according to the method of infringement or the mode in which it reaches and affects the plaintiff, the evidence by which his loss is proved, and the amount of his recovery is determined, must also be of great variety. No more unalterable rule can, therefore, be prescribed concerning the admissibility or weight of certain evidence, or the bearing of certain facts upon the question of damages, in actions of infringement than in actions of trespass *quare clausum*, or of general *assumpsit*.¹ Each case must stand on its own facts, and be illustrated by its own evidence, admitted and weighed in accordance with the general rules of relevancy and credibility.² With this distinction

§ 1051. ¹ In *Graham v. Mason* (1872), 5 Fisher, 290, Shepley, J. : (293) "It must be apparent to the most superficial observer of the immense variety of patents issued every day, that there cannot, in the nature of things, be any rule of damages or any rule for estimating profits which will equally apply to all cases. The mode of estimating profits or damages must necessarily depend on the peculiar nature of the monopoly granted. (*Seymour v. McCormick*, before cited.) Where the patentee is entitled to damages, the rule must be so modified as to afford him indemnity and give him the actual damage he has suffered by the infringement. Where

he is entitled to profits, he is entitled to any profit the infringer has made by the unlicensed use of the contrivance included in the monopoly, and of that alone, without regard to profit or loss on the whole structure or machine of which such mechanism forms a part, and without recoupment for losses on other infringing mechanisms made or sold." 1 O. G. 609 (610); Holmes, 88 (90).

See also *Bell v. Daniels* (1858), 1 Fisher, 372; 1 Bond, 212; *Ransom v. Mayor of New York* (1856), 1 Fisher, 252; *Earle v. Sawyer* (1825), 4 Mason, 1; 1 Robb, 490.

² That in estimating damages all the

in mind, the rule of damages in actions at law for infringement loses most of its obscurity, while even the rules of evidence seem capable of clearer and more permanent definition than those applied in many other actions. To this rule of damages our attention will now be directed, after which the rules of evidence will be considered.

§ 1052. Rule of Nominal Damages.

The rule of damages requires that in all cases where the jury find the issues for the plaintiff on the first four averments of the declaration, they shall award him at least nominal damages.¹ The law implies damage from the violation of the patent, and though the infringement may be ignorant or unintentional, or result in no particular injury to the plaintiff, the commission of the wrong entitles him to some recovery in vindication of his invaded rights.² The amount of such recovery the jury are at liberty to determine within the ordinary limits of nominal damages.³

§ 1053. Rule of Actual Damages.

The rule of damages further provides that, upon proper evidence, the jury shall allow the plaintiff actual damages.¹

circumstances must be considered, see *Whitney v. Emmett* (1831), Baldwin, 303 ; 1 Robb, 567.

§ 1052. ¹ In *Poppenhusen v. New York Gutta Percha Comb Co.* (1858), 2 Fisher, 62, Ingersoll, J. : (73) "When a patent has been violated, it necessarily follows that the plaintiff is entitled to some damages. The act of violation is proof that he is entitled to some damages ; and when the amount of damages is not proved, the rule is, that the jury give nominal damages ; and if the plaintiff intends to claim more than nominal damages, he, being entitled to recover his actual damages, must satisfy the jury what his actual damages are."

² That damages are implied from the infringement, see *Wooster v. Muser* (1884), 28 O. G. 286 ; 20 Fed. Rep.

162 ; *Campbell v. Barclay* (1870), 5 Bissell, 179 ; *Whittemore v. Cutter* (1813), 1 Gallison, 429 ; 1 Robb, 28.

That the character and financial condition of the parties are not to be considered in estimating damages, see *Hayden v. Suffolk Mfg. Co.* (1862), 4 Fisher, 86.

That the good faith of the defendant does not excuse him, see *Hogg v. Emerson* (1850), 11 How. 587.

³ That six cents are nominal damages, see *Hall v. Bird* (1869), 6 Blatch. 438 ; 3 Fisher, 595.

§ 1053. ¹ That a patentee proving his case is entitled to the same relief as any other plaintiff, see *McComb v. Ernest* (1871), 1 Woods, 195.

That actual damages alone will be awarded, see *Philp v. Nock* (1873), 17

Actual damages are an indemnity for injury inflicted, a compensation for a loss sustained.² Their amount is to be measured by the direct and immediate evil consequences to the plaintiff of the wrongful act of the defendant, from the date of the infringement to the institution of the suit.³ The proof

Wall. 460 ; *Page v. Ferry* (1857), 1 Fisher, 298 ; *Whitney v. Emmett* (1831), Baldwin, 303 ; 1 Robb, 567.

² In *Birdsall v. Coolidge* (1876), 93 U. S. 64, Clifford, J. : (64) " Damages are given as a compensation, recompense, or satisfaction to the plaintiff for an injury actually received by him from the defendant. Compensatory damages and actual damages mean the same thing, — that is, that the damages shall be the result of the injury alleged and proved, and that the amount awarded shall be precisely commensurate with the injury suffered, neither more nor less, whether the injury be to the person or estate of the complaining party. 2 Greenl., Ev., 10th ed., sec. 253." 10 O. G. 748 (749).

In *Parker v. Hulme* (1849), 1 Fisher, 44, Kane, J. : (56) " The damages to be assessed should be compensatory. The criterion is indemnity. You may take into consideration the loss sustained by the plaintiff, as you may likewise the profit made by the defendant. In estimating the loss to the plaintiff from the defendant's unauthorized use of the machine, the price of a license is sometimes a fair guide ; but not always. Sometimes a trifle from every one may well content the patentee, as in the case of a medicine, where a license to use is thrown in to all who will pay for the dose. So in the case of machines ; in some of which, as for example, an improved pocket-knife or comb, where a half-cent, singly, might amply compensate a patentee in the sale of a license, but would be no criterion of damage in case of infringement. It is so with every other inven-

tion which depends, for its value, on a general use by the community, and is, from policy, sold cheap. You are therefore to give compensatory damages, such as may indemnify the plaintiff for the injuries he has directly sustained ; but, according to the directions heretofore given in this court, you will not include his expenses of litigation in the amount of your verdict. Yet, upon the whole, the question of damages being one of compensation, of which it is always, in such cases, difficult to fix a standard, much must depend upon the discretion of the jury, who may sometimes properly take the conduct and motives of a defendant into consideration. I may add that, with the limitations and qualifications which I have stated, your verdict may be founded upon a full and liberal measure of the plaintiff's actual damages."

³ That only direct and immediate damages can be recovered, see *Buerk v. Imhaeuser* (1876), 10 O. G. 907 ; 14 Blatch. 19 ; 2 Bann. & A. 452.

That remote consequential damages cannot be recovered, see *Carter v. Baker* (1871), 4 Fisher, 404 ; 1 Sawyer, 512.

That the jury in estimating damages from general evidence can only allow them for the period of infringement not for the whole term of the patent, see *Suffolk Co. v. Hayden* (1865), 3 Wall. 315.

That damages are recoverable for the period between loss of the patent by fire and its restoration, if there be no unreasonable delay, see *Hogg v. Emerson* (1848), 6 How. 437 ; 2 Robb, 655.

That damages for infringement before re-issue are not recoverable in a

of the existence and extent of these consequences must be clear and definite, and present sufficient data to the jury to enable them to estimate with certainty the compensation to which the plaintiff is entitled.⁴ In the absence of such proof, either through the fault or the misfortune of the plaintiff, nominal damages alone can be awarded.⁵ Vindictive damages are not permitted, power being conferred upon the court to increase the amount fixed by the jury in cases of malicious or persistent injury.⁶

suit on the re-issue, see *Agawam Co. v. Jordan* (1868), 7 Wall. 583.

That a verdict can only cover the damages up to the date of the writ, see *Hayden v. Suffolk Mfg. Co.* (1862), 4 Fisher, 86.

⁴ That the plaintiff must affirmatively show the amount of actual damages, see § 1071 and notes, *post*.

⁵ That nominal damages of six cents only are recoverable unless actual damages are proved, see *Hall v. Bird* (1869), 6 Blatch. 438 ; 3 Fisher, 595.

That although it is a mere lack of evidence which prevents the plaintiff from proving such infringements as would call for heavy damages, this is his misfortune, and the jury can only give nominal damages unless he proves actual ones, see *Schwarzel v. Holenshade* (1866), 3 Fisher, 116 ; 2 Bond, 29.

⁶ In *Whittemore v. Cutter* (1813), 1 Gallison, 478, Story, J. : (482) "As to the rule by which the plaintiff's damages are to be estimated, it is clear by the statute, that only the actual damages sustained can be given. By the terms 'actual damages,' in the statute, are meant such damages as the plaintiffs can actually prove and have in fact sustained, as contradistinguished to mere imaginary or exemplary damages, which in personal torts are sometimes given. The statute is highly penal, and the legislature meant to limit the single damages to the real injury done, as in other cases of viola-

tion of personal property, or of incorporeal rights. In mere personal torts, as assaults and batteries, defamation of character, etc., the law has, in proper cases, allowed the party to recover not merely for any actual injury, but for the mental anxiety, the public degradation and wounded sensibility, which honorable men feel at violations of the sacredness of their persons or characters. But the reason of the law does not apply to the mere infringement of an incorporeal right, such as a patent, and the legislature meant to confine the damages to such a sum as would compensate the party for his actual loss." 1 Robb, 40 (44).

See also *Goodyear v. Bishop* (1861), 2 Fisher, 154 ; *Smith v. Higgins* (1859), 1 Fisher, 537 ; *Ransom v. Mayor of N. Y.* (1856), 1 Fisher, 252 ; *Wintermute v. Redington* (1856), 1 Fisher, 239 ; *Hall v. Wiles* (1851), 2 Blatch. 194 ; *Buck v. Hermance* (1849), 1 Blatch. 398 ; *Guyon v. Serrell* (1847), 1 Blatch. 244.

In several decisions statements may be found giving authority for the claim that vindictive damages may be awarded in cases of wilful infringement. Thus in *Parker v. Corbin* (1848), 4 McLean, 462, McLean, J. : (463) "That where the act complained of had been done without a knowledge of the plaintiff's right, and under such circumstances as to authorize the jury to infer that the defendant was not aware that he was

§ 1054. Rules of Evidence Concerning Damages Vary with the Mode in which the Plaintiff takes the Benefit of his Monopoly.

The rules of evidence concerning damages are all intended to secure the presentation of such testimony to the jury as will enable them to ascertain the loss inflicted on the plaintiff, and the amount of actual damages which will compensate him for the injury. The evil consequences resulting to the plaintiff from the violation of his patent depend upon the method in which he receives the benefits of his monopoly, and the extent to which these benefits are affected by the infringement.¹ The owner of a patent who neither derives, nor purposes to derive, any advantage from his rights under

violating the rights of any one, the damages should be so graduated as to give nothing more than to compensate the injury done to the plaintiff. But where the circumstances were of a somewhat aggravated character, what was sometimes called in the law vindictive damages might be given, which would include counsel fees, and something more by way of example to deter others from doing the same thing." 2 Robb, 736 (736).

See also *Buerk v. Imhaeuser* (1876), 10 O. G. 907 ; 14 Blatch. 19 ; 2 Bann. & A. 452 ; *American Nicholson Pavement Co. v. City of Elizabeth* (1874), 6 O. G. 764 ; 1 Bann. & A. 439 ; *Bryce v. Dorr* (1845), 3 McLean, 582 ; 2 Robb, 302.

That no exemplary damages are allowed where the defendant purchased the invention in good faith in open market not knowing of the patent, and abandoned it upon notice, see *Emerson v. Simm* (1873), 3 O. G. 293 ; 6 Fisher, 281.

That one who works under another patent is not liable to punitive damages, see *Buerk v. Imhaeuser* (1876), 10 O. G. 907 ; 14 Blatch. 19 ; 2 Bann. & A. 452.

The power of the court to increase the damages is, however, sufficient for

all the purposes of a penalty, and so far as these cases suggest that the jury have a similar power, the doctrine must be regarded as erroneous. See, further, § 1069, and notes, *post*.

§ 1054. ¹ In *Spaulding v. Page* (1871), 4 Fisher, 641, Sawyer, J. : (645) "One patentee may choose to use his invention himself, and find his profits in the sale of its products ; another may establish a royalty for the use of his patent ; another sell his right out for designated portions of territory ; and another exclusively manufacture and sell his machines and seek his remuneration in the profits of such manufacture and sale. The measure of damages, and the consequences of a recovery, should have some relation to the mode of remuneration adopted by the patentee, and to the nature of the injury inflicted by the infringement. Even the consequences of a recovery with respect to the subsequent rights of the parties, may be modified by the measure of damages adopted." 1 Sawyer, 702 (705).

That the monopoly protects only the use of the invention, not the ultimate property therein, see § 61 and notes, *ante*.

the patent, cannot sustain substantial injury from any appropriation of the invention on the part of others.² If he confines his own enjoyment of his privilege to a single mode of use, he does not suffer loss from the employment of the invention in a totally different method. Hence the first point, on which proof should be offered in reference to actual damages is the use made of his patent privilege by the plaintiff; the second is the effect produced upon the value of such use by the wrongful acts of the defendant. If the evidence on these two points is so presented as to afford the jury a complete view of the facts which they involve, the amount of actual damages to be awarded can be easily determined.

§ 1055. Evidence Concerning Damages: Two Modes in which the Plaintiff may Take the Benefit of his Monopoly.

The methods by which the owner of a patent can avail himself of his monopoly may be grouped in two distinct classes. In methods of the first class the practice of the patented invention is thrown open to the public upon condition that the user pay to the owner a definite pecuniary consideration. In methods of the second class the exclusive use of the invention is confined to the owner of the patent or to specific licensees, and the remainder of the public are prohibited from its employment upon any conditions.¹ When any method of

² That a patentee, who neither derives nor intends to derive benefit from his invention, cannot suffer loss by its infringement, see *Everest v. Buffalo Lubricating Oil Co.* (1887), 31 Fed. Rep. 742; *Hoe v. Knap* (1886), 27 Fed. Rep. 204; 36 O. G. 1244; *Whitney v. Emmett* (1831), Baldwin, 303; 1 Robb, 567.

§ 1055. ¹ The distinction between these two modes of enjoyment will be lost sight of unless it be remembered that the former embraces only those cases where the license is universal. The patentee has a right to limit the number of his licensees, and where he does this, no other persons can become licensees against his will. The number

of his specific licensees is immaterial. However great their multitude, the patent protects them in their exclusive enjoyment against all the world, and one who uses without authority granted to him violates the monopoly, and cannot be regarded as in any sense a licensee. In such cases a license fee is never the measure of damages; if it were, the patentee could be compelled to grant licenses against his will to all on the mere ground that he had chosen to license certain individuals. It is only where he offers licenses to all who desire to take them, without discrimination of persons, that an infringer can be treated as a licensee, and the recovery be restricted to the customary fee.

the first class is adopted, it is evident that the sole injury sustained by the owner of the patent from the act of a defendant, who has practised the invention without fulfilling the condition, is the withholding of the definite pecuniary recompense, and that this, when ascertained, is therefore the measure of his actual damages. When methods of the second class are pursued, the loss suffered by the owner of the patent or his specific licensees, is the depreciation of the pecuniary value of their own enjoyment of the exclusive use of the invention through its wrongful use by the defendant. The amount of such depreciation can rarely be measured by any absolute standard. It is a matter of inference from all the circumstances of the case; but when the facts are clearly proved, and the inference is probable, the jury are warranted in assuming it as a sufficient guide. The owner of the patent may resort to methods of either class at his pleasure, and may employ the different classes within different areas. He may also adopt the methods of one class in relation to one of his exclusive rights, and the methods of the other class in relation to his other rights, as where he freely licenses all who desire to make and use the invention, but preserves a close monopoly in reference to its manufacture and sale. But he cannot employ methods of the distinct classes in relation to the same right at the same time and within the same territory, since it is impossible for him at once to offer to the whole public an unrestricted privilege upon definite terms, and prohibit portions of the public from enjoying it on any terms. Hence in any case of infringement it can be shown which class of methods was in operation, at the date

Hence evidence of numerous existing licenses, though, as appears in § 1057, *post*, it is sufficient to prove the amount of the established fee, cannot show that an infringer, even when performing acts for which the licenses are granted, has a right to pay the fee and thus escape further liability. It must be also manifest from the testimony that the plaintiff, at the date of the infringement, contemplated the enjoyment of the invention by the public, and by the de-

fendant as a member of the public, and that the sole wrong committed by the latter has, therefore, virtually consisted in delaying the payment of the proper recompense for such a privilege. In the absence of this testimony the case comes under the second class, and the license fee, whatever light it may throw upon the amount of the plaintiff's loss by the infringement, cannot be accepted as an absolute measure of damages.

and place of the infringement, in reference to the right wrongfully exercised by the defendant. If the method belonged to the first class the defendant must make compensation by paying the established fee. If it belonged to the second class the defendant must make good that depreciation in the value of the plaintiff's enjoyment which his own wrongful act has caused.²

§ 1056. Evidence Concerning Damages: Monopoly Enjoyed by Granting Licenses.

Of the methods of the first class there are various forms, though all are reducible to the same contract relation between the owner of the patent and those who practise the invention. Whether he bestows on all who wish to comply with his conditions the right to make and use or the right to make and sell, and whether he receives his payments in a gross sum, or in periodical instalments, or in royalties based on the number of the patented articles that may be used or sold, and whether the privilege already conferred be personal and universal, or confined to a single shop or locality, the principle underlying the transaction is the same. The owner of the patent has put his own price upon the exercise of the right, and offered it to all who are disposed to pay the price for its enjoyment.¹ He has thus fixed the measure of his compensation for every case in which the right so estimated may be exercised, and the defendant's employment of the privilege may, therefore, be properly and fairly treated as an acceptance of the offer and as constituting the basis of an implied contract upon his part to pay the customary fee.² He has, in fact, become by his own act,

² That the value of the plaintiff's invention is determined by the way he uses it, whether by licensing or manufacturing, see *Creamer v. Bowers* (1888), 35 Fed. Rep. 206; *Spaulding v. Page* (1871), 4 Fisher, 671; 1 *Sawyer*, 702; *Burr v. Duryee* (1862), 2 Fisher, 275.

That the grantor of an exclusive license at a specific royalty can sustain no damage except the loss of his royalty,

whatever his licensees may suffer, see *Bell v. United States Stamping Co.* (1887), 32 Fed. Rep. 549.

§ 1056. ¹ That by establishing a license fee the plaintiff fixes the compensation which he is willing to receive, see *Livingston v. Jones* (1861), 2 Fisher, 207; 3 *Wall. Jr.* 330; *Seymour v. McCormick* (1853), 16 *How.* 480.

² That by using the invention, as licensees in general use it, the defendant

though not perhaps intentionally, the licensee of the owner of the patent under the terms contained in the proposition of the latter to the public, and is bound, like any other licensee, to comply with the obligations which he has thereby assumed.³ In order to establish this, or any other contract relation, two matters must be proved: the offer by the plaintiff; and its acceptance by the defendant. In the absence of either of these elements no such relation can be implied, and the defendant is neither obliged to pay, nor the plaintiff to receive, any predetermined sum as compensation for the infringement.

§ 1057. Evidence Concerning Damages: Monopoly Enjoyed by Granting Licenses: Evidence that the Plaintiff has Adopted that Mode of Enjoyment.

The proposal of the owner of a patent to permit the public to enjoy a right in his invention, upon payment of a definite pecuniary consideration, may be proved either by his formal declarations to that effect, or by his conduct in customarily receiving this specific compensation. To show his formal declarations, his circulars, advertisements, or oral propositions; if such exist, are admissible. To prove his customary reception of a definite recompense, the testimony must demonstrate that this amount has generally been paid by those who have exercised the right, in pursuance of an agreement previously made with the owner of the patent, until it has become an established fee.¹ What constitutes a general use

accepts the offer of the plaintiff and becomes liable for the customary fee, see *Livingston v. Jones* (1861), 3 Wall. Jr. 330; 2 *Fisher*, 207; *Seymour v. McCormick* (1853), 16 How. 480.

³ That a license fee fixes the amount of damages where there have been licenses enough issued to establish a market value, and where the use by the defendant has been with the express or implied consent of the plaintiff, and no compensation has been agreed on, see *Packet Co. v. Sickles* (1873), 19 Wall. 611.

§ 1057. ¹ In *Rude v. Westcott* (1889),

130 U. S. 152, Field, J. (185): "It is undoubtedly true that where there has been such a number of sales by a patentee of licenses to make, use, and sell his patents, as to establish a regular price for a license, that price may be taken as a measure of damages against infringers. . . . Sales of licenses, made at periods years apart, will not establish any rule on the subject and determine the value of the patent. Like sales of ordinary goods they must be common, that is, of frequent occurrence, to establish such a market price for the article

and payment, and after what period the fee customarily paid shall be regarded as established, are questions for the jury to determine. A single license cannot show a custom, nor can a license fee, varying with the obstinacy of the licensee, ever become definite, nor can promises to pay be taken as equivalent to actual payments.² The essential legal requisite, however, is that the amount be fixed by previous agreement with a view to future use, and under circumstances where the owner of the patent is at liberty to demand what he deems a

that it may be assumed to express, with reference to all similar articles, their salable value at the place designated. In order that a royalty may be accepted as a measure of damages against an infringer, who is a stranger to the license establishing it, it must be paid or secured before the infringement complained of, it must be paid by such a number of persons as to indicate a general acquiescence in its reasonableness by those who have occasion to use the invention, and it must be uniform at the places where the licenses are issued."

That an established royalty is a proper measure of damages, but not where the invention has been used but little or for a short time, general evidence being necessary in such cases, see *Judson v. Bradford* (1878), 16 O. G. 171 ; 3 Bann. & A. 539.

That a license fee does not become "established" until sufficient cases arise to fix the market value of the patent at a uniform rate, see *Adams v. Bellaire Stamping Co.* (1886), 28 Fed. Rep. 360 ; 36 O. G. 567 ; *Packet Co. v. Sickles* (1873), 19 Wall. 611.

That a license fee to be a measure of damages must be a fee for the identical invention, and it alone, see *Adams v. Bellaire Stamping Co.* (1886), 28 Fed. Rep. 360 ; 36 O. G. 567.

That license fees paid for two patents jointly will not establish a fee for either separately, see *Vulcanite Paving*

Co. v. American Artificial Stone Pavement Co. (1888), 36 Fed. Rep. 378 ; *Adams v. Bellaire Stamping Co.* (1886), 28 Fed. Rep. 360 ; 36 O. G. 567 ; *Westcott v. Rude* (1884), 19 Fed. Rep. 830 ; 27 O. G. 719.

² That a single license cannot establish a license fee, see *Graham v. Piano Mfg. Co.* (1888), 35 Fed. Rep. 597 ; *Westcott v. Rude* (1884), 19 Fed. Rep. 830 ; 27 O. G. 719.

That two licenses may evidence an established fee, see *Cary v. Lowell Mfg. Co.* (1889), 37 Fed. Rep. 654.

That no license fee can be said to be fixed when it varies with the persistence of the infringer, see *Black v. Munson* (1877), 14 Blatch. 265 ; 2 Bann. & A. 623.

That where an assignee is compelled by the acts of the defendant to allow him to use the invention for a certain royalty, the royalty is no criterion of the damages, see *American Nicholson Pavement Co. v. City of Elizabeth* (1874), 6 O. G. 764 ; 1 Bann. & A. 439.

That the allowance of a *pro rata* sum as damages in a suit does not establish a license fee, see *Graham v. Piano Mfg. Co.* (1888), 37 Fed. Rep. 597.

That a license fee must be shown by actual payments, not by mere promises to pay, see *Adams v. Bellaire Stamping Co.* (1886), 28 Fed. Rep. 360 ; 36 O. G. 567.

fair compensation, and the alleged licensees are free to accept or reject his terms.³ A fee of small amount temporarily adopted in order to introduce the invention, or to raise money under the pressure of necessity, does not comply with this requirement; nor, on the other hand, does a large amount paid under compulsion by infringers in settlement for injuries inflicted by their wrongful acts; and evidence of either of these payments under emergency is inadmissible.⁴ The amount of

³ In *National Car Brake Shoe Co. v. Terre Haute Car & Mfg. Co.* (1884), 19 Fed. Rep. 514, Woods, J. : (517) "I instruct you that it is competent for a patentee, in order to enable the jury to measure his damages, to prove contract prices at which licenses had been granted under the patent while it was in force, but that it is not competent for him to prove the prices paid for infringements; that is to say, payments made in settlement of infringements already perpetrated. In order to be competent evidence of value, the prices agreed upon must have been fixed with regard to future use, when, there being no liability between the parties, they are presumed, on both sides, to have acted voluntarily, and therefore to have made up their minds deliberately as to what was a fair price. Such arrangements, licenses thus granted, fees thus fixed, are competent evidence to consider in determining what the actual value of an invention is, and what the recovery ought to be for its use. But settlements for past transactions, where the parties are liable to suit if they do not pay, I instruct you, are not admissible as evidence for the plaintiff upon the subject of value." 28 O. G. 1007 (1008).

⁴ In *Campbell v. Barclay* (1870), 5 Bissell, 179, Blodgett, J. : (179) "The price for which the plaintiff has sold his rights to certain territory is no criterion by which to determine the value of his patent or the damage sustained by its infringement in the territory retained.

Inventors are frequently compelled by stress of poverty, or force of circumstances, to dispose of some part of their rights in the thing invented at much lower rates than they and others know them to be worth. The fact that the inventor has sold or given away some portion of a patented right is no justification to another who has wrongfully infringed upon the rights retained."

That early contracts at varying rates do not establish a license fee, see *Gottfried v. Crescent Brewing Co.* (1884), 30 O. G. 892; 22 Fed. Rep. 433.

That agreements to secure the introduction of an invention do not furnish a guide to true license fees, see *Graham v. Geneva Lake Crawford Mfg. Co.* (1885), 32 O. G. 1603; 24 Fed. Rep. 642; *Sickels v. Borden* (1856), 3 Blatch. 535.

That special permits under special circumstances do not alter the usual license fee, see *Asmus v. Freeman* (1888), 34 Fed. Rep. 902.

That a grantee of territory, making a contract with an agent to sell machines without limit, repudiates a close monopoly and his damages must be measured by the usual fee, see *Burdell v. Denig* (1865), 2 Fisher, 588.

That payments made in settlement of suits for infringement do not establish a license fee, see *Cornely v. Marckwald* (1889), 131 U. S. 159; *Rude v. Westcott* (1889), 130 U. S. 152; *United Nickel Co. v. Central Pacific R. R. Co.* (1888), 36 Fed. Rep. 186; *Cornely v.*

an established license fee may be shown by parol, though the licenses by which it is fixed are in writing, and the defendant was not a party to the instruments, the important fact being the payment of the fee.⁵

§ 1058. Evidence Concerning Damages: Monopoly Enjoyed by Granting Licenses: Evidence that the Defendant's Acts are Identical with those Covered by such Licenses.

The acceptance of the plaintiff's proposal by the defendant must be proved by evidence showing his performance of the precise act for which the license fee has been established. Not every invasion of the monopoly by the defendant subjects him to the payment of this fee or entitles him to claim that the plaintiff's damages are to be limited to that amount. It is only when he has put himself in the same position which he would have occupied had he been a licensee under a previous agreement, that he can be held liable to the obligations, and can avail himself of the immunities, of such a licensee. Thus where the license fee has been established in regard to one right under the patent and he has exercised a different right, or where it contemplates a continuous and permanent employment of the invention and his employment of

Marckwald (1885), 23 Blatch. 163 ; 32 Fed. Rep. 292 ; Gottfried v. Crescent Brewing Co. (1884), 22 Fed. Rep. 433 ; 30 O. G. 892.

That where the plaintiff had settled with certain infringers for less than the usual license fee, the amount so paid may in some cases be taken as the measure of damages, see *Tates v. St. Johnsbury & L. C. R. Co.* (1887), 32 Fed. Rep. 628.

That a license fee cannot be fixed by settlements between the plaintiff and other infringers, where various amounts are received or where other circumstances show that there is no regular fee, see *Matthews v. Spangenberg* (1882), 14 Fed. Rep. 850.

⁵ That the amount of the license fee may be shown by parol though the license is in writing, if the defendant is

not one of the parties to the license, see *Wooster v. Simonson* (1884), 20 Fed. Rep. 316 ; 28 O. G. 918.

That a rescinded contract for royalties is not competent evidence as to the measure of damages, see *Bussey v. Excelsior Mfg. Co.* (1880), 17 O. G. 744 ; 1 Fed. Rep. 640 ; 1 McCrary, 161 ; 5 Bann. & A. 135.

That a revoked or abandoned license may show what value an inventor puts upon the right to use his invention, see *Graham v. Geneva Lake Crawford Mfg. Co.* (1885), 32 O. G. 1603 ; 24 Fed. Rep. 642.

That evidence of license fees charged or sales made to others is admissible to show the value of the invention to the plaintiff, but is not conclusive, see *Gottfried v. Crescent Brewing Co.* (1884), 30 O. G. 892 ; 22 Fed. Rep. 433.

it has been short or infrequent, his acts do not fall within the scope of the proposed license and do not create a contract relation between him and the plaintiff.¹ If the owner of the patent, for example, grants licenses to make and use the patented invention, but retains the exclusive right to make and sell, a wrongful sale by the defendant cannot be contemplated as within the license, nor the loss which it inflicts upon the plaintiff be measured by the amount of the established fee.² If a different fee is fixed as the compensation for the enjoyment of each different right, and the defendant exercises either alone, the fee established for the other is irrelevant. When the license fee is a gross sum, whose payment authorizes the enjoyment of the invention during the term of the patent or for any considerable period, and the defendant's use has been brief and limited, or when the use of several connected inventions is covered by an indivisible fee and but one of these inventions is employed by the defendant, or where he uses only a part of an invention to which, as a whole, a single compensation is attached, the customary price ceases to afford an exact criterion of the amount of loss incurred, or of the damages to be paid.³ In all such cases the actual dam-

§ 1058. ¹ That a license fee for the whole invention is no measure of damages when only a part is infringed, but further evidence must be given to show the value of the part employed, see *Wooster v. Simonson* (1883), 16 Fed. Rep. 680.

² That a license fee for the use of an invention is no measure of the damage caused by an infringing sale, see *Colgate v. Western Electric Mfg. Co.* (1886), 28 Fed. Rep. 146; 37 O. G. 893.

That a royalty for a license to sell the right to use does not show the value of a right to sell, see *Colgate v. Western Electric Mfg. Co.* (1886), 37 O. G. 893; 28 Fed. Rep. 146.

That a use under two Claims must be of more value than a use under one, and a license fee covering both does not show the value of either, see *Westcott*

v. Rude (1884), 27 O. G. 719; 19 Fed. Rep. 830.

³ In *Judson v. Bradford* (1878), 16 O. G. 171, Clifford, J.: (174) "Frequent cases arise where proof of an established royalty furnishes a pretty safe guide for the instructions of the court and the finding of the jury; but cases also arise where it cannot be applied without qualification, as where the patented improvement has been used only to a limited extent, and for a very short period. Proof of a single license was given in this case, but it cannot, in view of the circumstances, be regarded as affording the only measure of compensation to which the plaintiff is entitled. Where there is proof of an established license fee, it may, in case of protracted infringement, be regarded as a pretty safe guide; but the proof in this case is not of that character, and in such a case

ages must be ascertained by a different method. The defendant, not having performed the acts, and all the acts for which the license fee is the established compensation, cannot be justly required to pay it to the plaintiff. The plaintiff, not having empowered him to enjoy the invention as he has enjoyed it upon condition that he will make the customary recompense, cannot be justly compelled to accept such recompense as his entire satisfaction for the injury. No other course is possible than to treat the defendant as an invader of the exclusive privileges of the plaintiff, and estimate the compensation of the latter by the actual damage which he can prove himself to have sustained.⁴

general evidence may be resorted to as the basis of decision." 8 Bann. & A. 539 (549).

In *Birdsall v. Coolidge* (1876), 93 U. S. 64, Clifford, J.: (70) "Evidence of an established royalty will undoubtedly furnish the true measure of damages in an action at law where the unlawful acts consist in making and selling the patented improvement, or in the extensive and protracted use of the same, without palliation or excuse; but where the use is a limited one, and for a brief period, as in the case before the court, it is error to apply that rule arbitrarily and without any qualification." 10 O. G. 748 (751).

That a license fee for an exclusive right to sell is not a measure of damages for occasional sales in particular territory, see *Colgate v. Western Electric Mfg. Co.* (1886), 25 Fed. Rep. 146; 37 O. G. 393.

That the full established license fee is a proper measure of recovery, though the infringement has been limited and brief, if it were malicious, see *Stutz v. Armstrong* (1885), 25 Fed. Rep. 147.

That where a rescinded contract for the use of several patents fixed the same royalty however many of the patents were used, and only two of the patents were infringed, the royalty furnishes no measure of damages, and if none are proved, only nominal damages will be

allowed, see *Bussey v. Excelsior Mfg. Co.* (1880), 17 O. G. 744; 1 McCrary, 161; 1 Fed. Rep. 640; 5 Bann. & A. 135.

That where the whole patent is covered by a gross license fee, and the defendant infringes a single Claim, if the license fee can be fairly apportioned among the Claims it may be taken as the measure of damages, see *Willimantic Thread Co. v. Clark Thread Co.* (1886), 27 Fed. Rep. 865.

That though when the license has expired the license fee is still the usual measure of damages, yet if the device embodies other patented inventions, it must be shown how much of the license fee is paid for the one in question, see *Porter Needle Co. v. National Needle Co.* (1885), 22 Fed. Rep. 829.

⁴ Although a license fee furnishes the precise measure of recovery only in the specific cases named, yet it is a fact often relevant to the question of damages in other cases, and in connection with additional facts may afford an inference as to the amount of loss the plaintiff has sustained. Thus, for example, a general license fee covering two inventions is relevant as to the damage resulting from the wrongful use of one of them, if other testimony shows the proportionate value of the use of each, etc. So, also, on the question of profits made by the defendant from the use of an improvement with its

§ 1059. Evidence Concerning Damages: Monopoly Enjoyed by Granting Licenses: License Fee the Measure of Damages for Wrongful Acts which are Identical with those Covered by such Licenses.

When the evidence discloses that a license fee has been established and that the defendant's acts of infringement have been such as in quality and extent were contemplated by the license to which the fee has been attached, the amount of this fee as it existed at the date of the infringement, with interest from that date, must be taken by the jury as conclusive proof of the actual damages to which the plaintiff is entitled.¹ It is the sum which he has offered to accept; it is

original, the license fee voluntarily paid by others, who make the same use of the improvement, may tend to show the proportion of profits due to the improvement alone. In all these cases the relevancy of the evidence must be decided by the court according to the usual rules.

§ 1059. ¹ In *McCormick v. Seymour* (1854), 3 Blatch. 209, Nelson, J.: (224) "As we understand the opinion of the Court, it lays down these principles: In cases where a patentee avails himself of his invention, and of his exclusive right to the enjoyment of its profits, by putting it into market, and selling rights under it, as is most usually the case with inventors,—that is, rights for States, or counties, or smaller districts, or portions of the invention itself,—in such cases the customary charge for the right to use the patented invention is the measure of the damages which the patentee is entitled to recover in case of an infringement, with interest upon the same from the time of infringement. In other words, if he is accustomed to sell a single right for the manufacture of a machine for twenty, thirty, forty, fifty, or one hundred dollars, and if that is his usual price for the right throughout the country, that fee, with interest from the time of the particular infringement, is the measure of damages for each infringement."

In *Seymour v. McCormick* (1853), 16 How. 480, Grier, J.: (490) "Where an inventor finds it profitable to exercise his monopoly by selling licenses to make or use his improvement, he has himself fixed the average of his actual damages, when his invention has been used without his license. If he claims anything above that amount, he is bound to substantiate his claim by clear and distinct evidence. When he has himself established the market value of his improvement, as separate and distinct from the other machinery with which it is connected, he can have no claim in justice or equity to make the profits of the whole machine the measure of his demand."

That an established license fee is the proper measure of damages for an infringement which consists of acts covered by the license, see *Jennings v. Dolan* (1887), 38 O. G. 1018; 29 Fed. Rep. 861; *Keller v. Stolzenbach* (1886), 28 Fed. Rep. 81; 37 O. G. 564; *May v. County of Fond du Lac* (1886), 27 Fed. Rep. 691; *Clark v. Wooster* (1886), 119 U. S. 322; 37 O. G. 1477; *Canan v. Pound Mfg. Co.* (1885), 31 O. G. 119; 23 Blatch. 173; *Graham v. Geneva Lake Crawford Mfg. Co.* (1885), 32 O. G. 1603; 24 Fed. Rep. 642; *Wooster v. Simonson* (1884), 20 Fed. Rep. 316; 28 O. G. 918; *Cottier v.*

the sum which the defendant has impliedly agreed to pay; and the jury can do no otherwise than ratify this agreement by their verdict. It is immaterial whether the practice of the invention has been profitable to the defendant, or whether other devices which he was free to use might not have better served his purpose.² It is equally immaterial whether the plaintiff has been prejudiced by the defendant's enjoyment of the right under the patent. Evidence upon these points is, therefore, inadmissible, in order to increase or diminish any damages which are to be computed on the basis of a license fee, though often accepted provisionally as a guide to the

Stimson (1884), 20 Fed. Rep. 906; 10 Sawyer, 212; Westcott v. Rude (1884), 19 Fed. Rep. 830; 27 O. G. 719; Emigh v. Balt. & Ohio R. R. Co. (1881), 19 O. G. 935; 6 Fed. Rep. 283; 4 Hughes, 271; Locomotive Engine Safety Truck Co. v. Pennsylvania R. R. Co. (1880), 2 Fed. Rep. 677; 5 Bann. & A. 514; 14 Phila. 432; Croninger v. Paige (1880), 48 Wis. 229; Wooster v. Taylor (1878), 14 Blatch. 403; 3 Bann. & A. 241; Birdsall v. Coolidge (1876), 93 U. S. 64; 10 O. G. 748; Goodyear Dental Vulcanite Co. v. Van Antwerp (1876), 9 O. G. 497; 2 Bann. & A. 252; Burdell v. Denig (1875), 92 U. S. 716; American Nicholson Pavement Co. v. City of Elizabeth (1874), 6 O. G. 764; 1 Bann. & A. 439; Emerson v. Simm (1873), 3 O. G. 293; 6 Fisher, 281; Packet Co. v. Sickles (1873), 19 Wall. 611; Philp v. Nock (1873), 17 Wall. 460; Spaulding v. Page (1871), 4 Fisher, 641; 1 Sawyer, 702; Goodyear v. Bishop (1861), 2 Fisher, 154; Sanders v. Logan (1861), 2 Fisher, 167; Livingston v. Jones (1861), 2 Fisher, 207; 3 Wall. Jr. 330; Sickels v. Borden (1856), 3 Blatch. 535.

That a license fee at a given rate, with a discount for prompt payment, will be taken as fixing the lower rate as the true measure of damages, see Graham v.

Geneva Lake Crawford Mfg. Co. (1885), 32 O. G. 1603; 24 Fed. Rep. 642.

That damages are not unliquidated when a royalty was established before the defendant began to infringe, see Locomotive Engine Safety Truck Co. v. Penna. R. R. Co. (1880), 14 Phila. 432; 5 Bann. & A. 514; 2 Fed. Rep. 677.

That the license fee existing at the date of the infringement is the measure, see Wooster v. Thornton (1886), 34 O. G. 560; 26 Fed. Rep. 274.

That a license fee established after the infringement is not a conclusive measure of damages though it may be considered, see Wooster v. Thornton (1886), 34 O. G. 560; 26 Fed. Rep. 274.

That whether the value at the date of the infringement was equal to the subsequent license fee is a question of fact, see Wooster v. Thornton (1886), 34 O. G. 560; 26 Fed. Rep. 274.

That interest must be allowed on license fees when taken as a measure of damages, see Creamer v. Bowers (1888), 35 Fed. Rep. 206; Sickels v. Borden (1856), 3 Blatch. 535.

² That a cessation of use or the fact that other equally useful devices existed is of no weight as to the amount of damages when there is a regular license fee to measure by, see Emerson v. Simm (1873), 3 O. G. 293; 6 Fisher, 281.

amount of actual damages in case the license fee and the defendant's implied obligation to pay it should not be fully proved.

§ 1060. Evidence Concerning Damages: Monopoly Enjoyed by the Exclusive Practice of the Invention: Two Forms of Such Exclusive Practice and of Corresponding Injury.

When no established license fee is proved, or when the acts of the defendant do not correspond with those for which the license fee is payable, the loss sustained by the plaintiff, if any loss there be, must arise from the effect produced by the infringement upon the value of the exclusive enjoyment of the invention by the owner of the patent or his specific licensees.¹ Two forms of this exclusive enjoyment are possible. The first consists in the use of the invention and the sale of its products; and this form is the common one when the invention is a process or a design, and is frequent when the invention is a machine. The second consists in the making and sale of the patented articles, and is usually adopted when the invention is a manufacture or a composition of matter.² When it is an improvement, its enjoyment follows the form which is pursued in reference to its original. The pecuniary value of the first form is measured by the advantage which the use of the invention confers on its employer, by improving the quality of his products and giving him a greater command of the market, or by diminishing their cost of manufacture in comparison with the price for which they sell and thereby increasing the percentage of his profits.³ The pecuniary value of the second form is represented by the difference between the expense of production and the price obtained.⁴ In both forms the amount of compensation to the

§ 1060. ¹ That where there is no established license fee general evidence concerning damages may be given, see *Suffolk Co. v. Hayden* (1865), 3 Wall. 315.

² That infringements by sale and by use are essentially distinct, see *Colgate v. Western Electric Mfg. Co.* (1886), 28 Fed. Rep. 146; 37 O. G. 893.

³ That the difference in the cost or

the value of the product when made by the plaintiff's process may be considered in estimating damages, see *Waterbury Brass Co. v. New York & Brooklyn Brass Co.* (1858), 3 Fisher, 43.

⁴ That the measure of damages for an unlawful sale may be the difference between the cost price to the patentee and the market price when the sales are

enjoyer of the monopoly depends upon the quantity sold and the price received, and hence the amount of injury inflicted upon him by the infringement is determined by its effect upon his prices or his sales. The evidence concerning this effect may be either direct or indirect. Direct evidence shows the extent to which the actual enjoyment of the invention by the plaintiff has been diminished by the wrongful acts of the defendant. Indirect evidence discloses the benefits derived by the defendant from the infringement, and thence infers the extent of the plaintiff's loss. Evidence of both species is admissible whenever it can tend to prove the amount of injury which the plaintiff has sustained.

§ 1061. Evidence Concerning Damages: Monopoly Enjoyed by the Exclusive Practice of the Invention: Direct Evidence of the Extent of Injury.¹

Direct evidence of the extent to which the plaintiff has been injured consists of testimony showing the amount of the plain-

made, see *American Saw Co. v. Emerson* (1880), 8 Fed. Rep. 806.

§ 1061. ¹ In examining and citing cases in reference to damages and profits great discrimination is necessary. Profits were until recently the only measure of recovery in equity. They have always been admissible in evidence upon the question of the amount of damages at law. Damages are and must be the measure of recovery at law. By the act of 1870 they may also be awarded in equity where the account of profits fails to give the plaintiff a sufficient compensation. Thus any cases since 1870, whether at law or in equity, may have required an investigation into both damages and profits, and have demanded the discussion of their modes of ascertainment and the principles by which they are governed. But profits at law are not estimated in all respects as they are in equity, nor do they occupy the same relation toward the measure of recovery, and yet

so great is their similarity and so nice and subtle are their distinctions that it would be in vain expected that the judges should have confined their definitions and illustrations to that species of damages and profits which was appropriate to the tribunal wherein for the time being they presided.

A protracted study of the reported cases has satisfied the present writer that any attempt to classify them would be futile. Profits at law have often been present, perhaps unconsciously, in the mind of the court when giving an opinion concerning profits in equity. Damages in equity and their relation to profits have found consideration in judgments awarding damages at law. In this condition of the cases two courses were open: one, to select those only which were decided in the tribunal whose acts and jurisdiction were the subject of discussion in the text, and which limited their statements and explanations to the doctrines and methods

tiff's sales or prices before the invasion of his rights by the defendant and the decrease in either which has resulted from the infringement. The effect of the infringement on the quantity sold may be proved by evidence that customers have been diverted from the plaintiff to the defendant, or that the defendant has supplied the market formerly controlled by the plaintiff, or that the inferiority of the defendant's infringing articles has lowered the reputation of and reduced the demand for the plaintiff's goods.² The effect of the in-

there appropriate; the other, to employ all cases which were useful for their definitions and illustrations, without reference to the tribunal, trusting to the caution of the reader, under the guidance of the text, to preserve him from serious errors. The first course would have reduced the cited cases to a number pitifully small, and would have cast aside a multitude of valuable decisions which, if they could be safely utilized, could not well be spared. The latter course has, therefore, been adopted; and in referring to the cases, those at law and equity have been distinguished from each other by the letters L. and E. whenever in the judgment of the author the reader needed to be put upon his guard.

² In *McComb v. Brodie* (L. 1872), 5 Fisher, 384, Woods, J.: (394) "This rule is not what defendant made by the infringement, or what he might have made, but it is the loss sustained by plaintiffs by reason of the infringement. The amount of this loss you must gather from the evidence. It is proper to inquire how many customers were diverted from plaintiffs by the wrongful conduct of defendant, and what loss plaintiffs have sustained in profits by reason of such diversions. If plaintiffs were ready to supply the market with their patented goods, and their business was hindered or interfered with by the competition of defendant, plaintiffs' damages will be the amount of

profit which they have lost by reason of such interference." 1 Woods, 153 (161); 2 O. G. 117 (120).

That where the infringement consists in the sale of infringing articles, the damages are measured by the loss of trade diverted from the plaintiff and the profits he could have made therefrom, see *Hall v. Stern* (E. 1884), 20 Fed. Rep. 788.

That where no licenses are sold the damages to the plaintiff may be determined by inquiring how many customers were diverted from the plaintiff to the defendant, whether the plaintiff was prepared to supply the market and was prevented by the defendant, and whether the competition has interfered with the plaintiff's business or damaged him in a sum equal to the profits he would have made if he had sold the quantity sold by the defendant over and above what he himself had sold, see *Goodyear v. Bishop* (L. 1861), 2 Fisher, 154.

See also § 1063, note 3, *post*.

That the damages for infringing a patented hotel register include the profit on the book when sold and of the advertisements in it, see *Hawes v. Washburne* (L. 1872), 5 O. G. 491; *Hawes v. Gage* (L. 1872), 5 O. G. 494.

That damages are to cover loss through disparagement of plaintiff's invention by defendant's publications during the infringement, see *McCormick v. Seymour* (L. 1851), 2 Blatch. 240.

fringement on the prices may be shown by evidence that the defendant has compelled the plaintiff to lessen his rates of recompense by diminishing his own, or by flooding the market with his products, or by asserting the superiority of the infringing articles to those offered by the plaintiff.⁸ To the

⁸ That reduction of prices, and consequent loss of profits, through infringing competition, is proper ground for damages, see *Yale Lock Co. v. Sargent* (E. 1886), 117 U. S. 536 ; 35 O. G. 497 ; *Sargent v. Yale Lock Mfg. Co.* (E. 1879), 17 O. G. 105 ; 17 Blatch. 244 ; 4 Bann. & A. 574 ; *Smith v. O'Connor* (E. 1873), 6 Fisher, 469 ; 4 O. G. 633 ; 2 Sawyer, 461.

That the plaintiff has a right to keep up the price of the invention and if the infringement prevents this, the reduction in price is part of the damages, see *Carter v. Baker* (L. 1871), 4 Fisher, 404 ; 1 Sawyer, 512.

That where the plaintiff grants no licenses but makes and sells articles containing the invention which are unsalable without it, and the defendant by selling infringing articles compels the plaintiff to lower his prices, the entire loss is imputable to the defendant, and may be recovered by the plaintiff less a proper allowance for other patented devices contained in the defendant's article and for advantages enjoyed by him in selling, see *Yale Lock Co. v. Sargent* (E. 1886), 117 U. S. 536 ; 35 O. G. 497 ; *Fitch v. Bragg* (E. 1883), 16 Fed. Rep. 243 ; 21 Blatch. 302 ; *Sargent v. Yale Lock Mfg. Co.* (E. 1879), 17 O. G. 105 ; 17 Blatch. 244 ; 4 Bann. & A. 574.

That where the only damage consists in the reduction of the plaintiff's sales, and the essential features of the plaintiff's and defendant's devices are the same, and this being part of a structure is always embraced with other things, and yet by it the profit on the entire structure is made, and the defendant sells at low prices and so takes away the

entire profit which the plaintiff would otherwise have made, the entire loss of the plaintiff is to be compensated for in damages, after deducting a proper sum for any other patented device contained in the defendant's device and for any other cause giving the defendant an advantage in selling the device, see *Fitch v. Bragg* (E. 1883), 16 Fed. Rep. 243 ; 21 Blatch. 302.

That the value of the invention to the plaintiff may be shown by license fees, prices on sales, etc., see *Gottfried v. Crescent Brewing Co.* (E. 1884), 30 O. G. 892 ; 22 Fed. Rep. 433.

That damages are measured by the profit the patentee ordinarily received from the sale of machines of that size, see *Blake v. Greenwood Cemetery* (E. 1883), 16 Fed. Rep. 676 ; 21 Blatch. 222.

That where the plaintiff manufactures the invention his damages may be measured by the manufacturer's profits, see *Westlake v. Cartter* (L. 1873), 4 O. G. 636 ; 6 Fisher, 519.

That when the plaintiff is deprived of his profits by the use of an element covered by his patent, they are the measure of damages, that being the amount the defendant would have paid him for it, see *Putnam v. Lomax* (E. 1881), 9 Fed. Rep. 448 ; 10 Bissell, 546.

That a loss by reduction of prices must be proved to be due solely or to a definite extent to the defendant's infringement, see *Cornely v. Marckwald* (E. 1889), 131 U. S. 159.

That loss by reduction of prices through defendant's competition must be proved, not conjectured, and is counter-indicated if the plaintiff had gradually dropped his prices before the in-

loss inflicted by this decrease of sales or lowering of prices may be added that on goods made and left unsold through the defendant's competition.⁴ Evidence of remote or contingent losses, which cannot be measured by the difference between the amount that the plaintiff would have cleared by his invention had it not been for the infringement and the amount of profits which he has actually received, is not admissible.⁵

§ 1062. Evidence Concerning Damages: Monopoly Enjoyed by the Exclusive Practice of the Invention: Indirect Evidence of the Extent of Injury in Cases where the Owner of the Patented Invention Uses the Invention and Sells its Products.

Indirect evidence of the extent to which the plaintiff has been injured, in cases where his exclusive enjoyment of the invention consists in its use in his own business and the sale of its products, is afforded by the profits resulting to the defendant from the use of the invention during the infringement.¹ There is no presumption, either of law or fact, that

fringement, see *Cornely v. Marckwald* (E. 1885), 28 Blatch. 163; 32 Fed. Rep. 292.

That if the defendant causes the plaintiff to lower his prices by publishing the superiority of the infringing articles, this is to be also considered, see *McCormick v. Seymour* (L. 1851), 2 Blatch. 240.

⁴ That the loss on goods made and not sold on account of the defendant's competition are part of the damages, see *Carter v. Baker* (L. 1871), 4 Fisher, 404; 1 Sawyer, 512.

⁵ That remote and uncertain losses not distinctly traceable to the infringement cannot be shown, see *Carter v. Baker* (L. 1871), 4 Fisher, 404; 1 Sawyer, 512.

§ 1062. ¹ Under the theory of equity that an infringer is accountable to the patentee for all the gains or savings which he may have effected by the unlawful use of the invention, the plaintiff is of course entitled to recover all the

defendant's profits irrespective of his own loss, not, however, as damages but as benefits accruing from the use of his invention. In several cases the courts have been misled by this equitable doctrine into the statement that the plaintiff may recover at law, as damages, whatever the defendant may have made by the infringement, employing thus his profits as the measure of the plaintiff's loss. See *Carter v. Baker* (L. 1871), 4 Fisher, 404; 1 Sawyer, 512; *Case v. Brown* (L. 1862), 2 Fisher, 268; 1 Bissell, 382; *Conover v. Rapp* (L. 1859), 4 Fisher, 57; *Serrell v. Collins* (L. 1857), 1 Fisher, 289; *Sickels v. Borden* (L. 1856), 3 Blatch. 525; *Wintermute v. Redington* (L. 1856), 1 Fisher, 289; *McCormick v. Seymour* (L. 1851), 2 Blatch. 240; *Wilbur v. Beecher* (L. 1850), 2 Blatch. 132; *Buck v. Hermance* (L. 1849), 1 Blatch, 398; *Parker v. Banker* (L. 1855), 6 McLean, 631.

That the profits realized by the de-

the plaintiff has lost all that the defendant has gained, or that the defendant's advantage is equal to the plaintiff's loss. But

defendant from the use of the invention represent the value of that use to him, and constitute a fact to be considered by the jury in arriving at an estimate of the plaintiff's loss, there can be no doubt. Such a rule is sound in theory and has been demonstrated by experience to be advantageous in practice. Thus that the profits made by the defendant from the infringement may be shown by evidence and regarded by the jury, see *Byerly v. Cleveland Linseed Oil Works* (L. 1887), 31 Fed. Rep. 73; *Royer v. Coupe* (L. 1886), 39 O. G. 239; 29 Fed. Rep. 358; *Burdell v. Denig* (L. 1875), 92 U. S. 716; *Littlefield v. Perry* (E. 1874), 21 Wall. 205; 7 O. G. 964; *Cowing & Rumsey* (L. 1870), 4 Fisher, 275; 8 Blatch. 36; *Waterbury Brass Co. v. N. Y. & Brooklyn Brass Co.* (L. 1858), 3 Fisher, 43; *Ransom v. Mayor of New York* (L. 1856), 1 Fisher, 252.

It is also sometimes stated that in ascertaining the defendant's profits the methods proper in equity may be employed. (See *Burdell v. Denig* (L. 1875), 92 U. S. 716.) So far as this relates to the actual profits received by the defendant in money or in money's worth it is perhaps true. But in equity the profit of the defendant is measured by the advantage which he derived from the use of the infringing invention in excess of what he might have gained by the employment of some art or instrument already open to the public,—a method whose justice and correctness is doubtful at least in equity and which is evidently erroneous at law. (See the matter discussed, note 5, *post.*) In equity the defendant's profit also includes not merely the positive gains which he obtained by the infringement, but the saving from greater losses than he has actually incurred, though the infringing

business has been conducted at a loss. (See *Conover v. Mers* (E. 1873), 11 Blatch. 197; 6 Fisher, 506.) That such savings can in all cases be embraced in the defendant's profits as a guide to the loss sustained by the plaintiff may well be disputed. When the infringement can be separated from the other parts of the defendant's enterprise, and has in its separate state been profitable, such profits are to be considered. But when the infringement takes place under circumstances which entail a loss on the defendant, and at the same time show that had the plaintiff engaged in the undertaking in which he has been thus forestalled by the defendant he would have met with similar losses, the fact that the defendant's loss would have been greater if he had not employed the patented invention, so far from tending to show that his infringement has prevented the plaintiff from realizing profits, proves that it has benefited him by protecting him from loss.

The true doctrine of profits at law seems to be stated in the following cases: In *Campbell v. Barclay* (L. 1870), 5 Bissell, 179, Blodgett, J.: (180) "Nor is the amount of damages to be measured solely by the profits which the defendant realized by the use of the patent, because he may have conducted his business in so unsuccessful a manner as to have made no profits, notwithstanding the use of the patent. In other words, he might have lost money in the business whether he used the patented tool or used the old-fashioned implement."

In *Many v. Sizer* (L. 1849), 1 Fisher, 17, Sprague, J.: (30) "The number of wheels which the defendant has made, and the amount of profit he has realized from them have been presented to you by the plaintiff, as grounds of damages.

the pecuniary benefit which the defendant has derived from the unlawful use of the invention, whether by an increase in the quality of his products and the quantity of his sales, or by a decrease in the expense of manufacture, is a fact from which, in connection with other facts, the jury may infer the amount by which the plaintiff's sales and prices have been reduced through the infringement.² If it be shown that the

They are proper to be taken into consideration, but are not conclusive as to the extent of the injury, which may be either greater or less than the profits realized by the defendants. A plaintiff may be manufacturing his patented article himself, and making it to a profit, while another man may make it to a disadvantage, and yet the spurious article carried into the market may displace the original. In such case, the injury to the patentee would be greater than any profit upon the spurious production. On the other hand, a defendant's article may not displace the original, and in that case the injury would be less. And again, it may be that a plaintiff may derive a profit from licensing other parties to construct his invention; and any piracy upon it, by depriving him of a portion of the profits of such licenses, would be an injury to be taken into account by a jury."

That the profits of the defendant are not always the measure of the plaintiff's damages, the damages being the loss actually sustained by the plaintiff as shown by the evidence, see *Magic Ruffle Co. v. Elm City Co.* (E. 1877), 11 O. G. 501; 14 Blatch. 109; 2 Bann. & A. 506; *Birdsall v. Coolidge* (L. 1876), 93 U. S. 64; 10 O. G. 748; *Goodyear Dental Vulcanite Co. v. Van Antwerp* (E. 1876), 9 O. G. 497; 2 Bann. & A. 252; *McComb v. Brodie* (L. 1872), 2 O. G. 117; 1 Woods, 153; 5 Fisher, 384; *Cowing v. Rumsey* (L. 1870), 4 Fisher, 275; 8 Blatch. 36.

That the defendant's profits measure the damages only when the invention is

a new thing, or a new form of a known thing, which as a distinct species can be put into market cheaper, or is more valuable, so as to supersede or exclude other articles of the same class, and where the profit of the patentee consists in a complete monopoly of the invention as a unit, all competition being excluded, see *Livingston v. Jones* (E. 1861), 2 Fisher, 207; 3 Wall. Jr. 330.

That profits due to the use of an improvement cannot be regarded as part of the damages in a suit upon a patent for the original invention, see *Carter v. Baker* (L. 1871), 4 Fisher, 404; 1 Sawyer, 512.

² In *Philp v. Nock* (L. 1873), 17 Wall. 460, Swayne, J.: (462) "In arriving at their conclusion the profit made by the defendant and that lost by the plaintiff are among the elements which the jury may consider."

In *Suffolk Co. v. Hayden* (L. 1865), 3 Wall. 315, Nelson, J.: (320) "This question of damages, under the rule given in the statute, is always attended with difficulty and embarrassment both to the court and jury. There being no established patent or license fee in the case, in order to get at a fair measure of damages, or even an approximation to it, general evidence must necessarily be resorted to. And what evidence could be more appropriate and pertinent than that of the utility and advantage of the invention over the old modes or devices that had been used for working out similar results? With a knowledge of these benefits to the persons who have used the invention, and the extent of the use

plaintiff was ready and able to supply the market with his products, the inference is a fair one that he would have sold all that the defendant sold.⁹ If his facilities for manufacturing were equal to those of the defendant it may well be concluded that the percentage of his profits would not have been less than those of the defendant. When these two connecting facts are established, the value of the use of the invention to the defendant, as shown by the increase of his sales or profits, affords a just and reasonable measure of the plaintiff's loss.⁴ It has been often stated by the courts that in estimating the

by an infringer, a jury will be in possession of material and controlling facts, that may enable them, in the exercise of a sound judgment, to ascertain the damages, or, in other words, the loss to the patentee or owner, by the piracy instead of the purchase of the use of the invention."

See also *Cowing v. Rumsey* (L. 1870), 4 Fisher, 275; 8 Blatch, 86.

That profits may be recovered for the use of the invention without reference to the usual royalty, see *Knox v. Great Western Quicksilver Mining Co.* (E. 1878), 14 O. G. 807; 0 Sawyer, 480; 4 Bann. & A. 25.

That profits cannot be measured by royalties, see *Tilghman v. Proctor* (E. 1888) 125 U. S. 136; 43 O. G. 628; *Wooster v. Taylor* (E. 1878) 14 Blatch. 403; 3 Bann. & A. 241.

⁹ That there is no presumption of law that the plaintiff would have sold all that the defendant did, see *Roemer v. Simon* (E. 1887), 31 Fed. Rep. 41; 40 O. G. 1456; *Cornely v. Marekwald* (E. 1885) 32 Fed. Rep. 392; 23 Blatch. 163; *Zane v. Peck Brothers* (E. 1882), 13 Fed. Rep. 475; 23 O. G. 191; *Ingersoll v. Musgrove* (E. 1878), 13 O. G. 966; 14 Blatch. 541; 3 Bann. & A. 304; *Hawes v. Washburne* (L. 1872), 5 O. G. 491; *Carter v. Baker* (L. 1871), 4 Fisher, 404; 1 Sawyer, 512; *Goodyear v. Bishop* (L. 1861), 2 Fisher, 154; *Sey-*

mour v. McCormick (L. 1853), 16 How. 480. See also § 1063, note 2, *post.* *Contra*, *McCormick v. Seymour* (L. 1851), 2 Blatch. 240; *Wilbur v. Beecher* (L. 1850), 2 Blatch. 132.

That the measure of damages is the profits the plaintiffs would have made if they had supplied the defendant's customers provided it is shown that they would have supplied them, see *Zane v. Peck Brothers* (E. 1882), 13 Fed. Rep. 475; 23 O. G. 191.

That where the plaintiff is able and ready to supply all customers and has had a previous control of the market, it may be inferred that all who bought of the defendant would have bought of him, see *Gould's Mfg. Co. v. Cowing* (E. 1882), 105 U. S. 253; 21 O. G. 1277; *Bigelow Carpet Co. v. Dobson* (E. 1882), 21 O. G. 1200; 10 Fed. Rep. 385.

That where before his infringement the defendant bought the articles from the plaintiff it is a fair presumption that had he not infringed he would have bought the same number which he wrongfully made, see *Creamer v. Bowers* (E. 1888) 35 Fed. Rep. 206.

⁴ That the profits of the defendant are equally the measure of the plaintiff's damages, whether the infringement is wilful or not, see *Wintermute v. Redington* (L. 1856), 1 Fisher, 239.

advantage derived by the defendant from the use of the plaintiff's invention, the comparison must be instituted between the patented invention and such instruments or operations as are open to public employment, and that if the benefit which he receives from the practice of the plaintiff's invention does not exceed that which he would obtain by using other means already in possession of the public, he does not gain nor does the plaintiff lose by the infringement.⁵ The theory on which this doctrine rests is this, — that as the quality of the defendant's products and the quantity of his sales are not increased, by the invasion of the monopoly, beyond the standard which they might have rightfully reached without it, nor the cost of production reduced below the amount attending the proper use of different appliances, it cannot be considered that his profits or his sales have been enlarged by his unlawful use of the invention; while the existence of other inventions, to which the public had no free access, or of better means which were devised and patented after the issue of the plaintiff's

⁵ In *Black v. Thorne* (E. 1884), 111 U. S. 122, Field, J. c. (124) "It does not always follow that because a party may have made an improvement in a machine and obtained a patent for it, another using the improvement and infringing upon the patentee's rights will be mulcted in more than nominal damages for the infringement. If other methods in common use produce the same results, with equal facility and cost, the use of the patented invention cannot add to the gains of the infringer or impair the just rewards of the inventor. The inventor may indeed prohibit the use, or exact a license fee for it, and if such license fee has been generally paid, its amount may be taken as the criterion of damage to him when his rights are infringed. In the absence of such criterion, the damages must necessarily be nominal." 27 O. G. 415 (416).

See also *Tilghman v. Proctor* (E. 1888) 125 U. S. 136; 43 O. G. 628;

Shannon v. Bruner (E. 1888) 83 Fed. Rep. 871; *McMurray v. Emerson* (L. 1888) 36 Fed. Rep. 901; *Royer v. Coupe* (L. 1886), 29 Fed. Rep. 358; 30 O. G. 289; *Turrill v. Illinois Central R. R. Co.* (E. 1878), 5 Biscell, 344; *Serrell v. Collins* (L. 1857), 1 Fisher, 289.

That the damages may be measured by the difference in value between the old and new devices, see *Brodie v. Ophir Silver Mining Co.* (L. 1867), 4 Fisher, 137; 5 Sawyer, 608.

That the measure of damages for the infringement of a design is its excess of value over any open to the public, see *Tomkinson v. Willetts Mfg. Co.* (E. 1888) 84 O. G. 536.

That some one else has got as good a device as the plaintiff's does not destroy its value though it may affect it, see *National Car Brake Shoe Co. v. Terre Haute Car & Mfg. Co.* (L. 1884), 19 Fed. Rep. 514; 28 O. G. 1007.

patent, are facts which cannot be considered, since the defendant, having chosen to avail himself of the plaintiff's invention, should not be permitted to escape responsibility on the ground that he could have derived a similar benefit from the infringement of a different patent.⁶ Whether or not this doctrine and its underlying theory will bear investigation when applied to profits in equity, they certainly seem to be erroneous in reference to those profits which can be taken as the measure of damages at law.⁷ But they have been so

⁶ That the defendant could have obtained the same advantage by employing a different patented invention is immaterial, see *Turrill v. Illinois Central R. R. Co.* (E. 1880), 20 Fed. Rep. 912.

⁷ The doctrine whose correctness is here questioned may be stated in the following proposition: viz., that the profits of a defendant from the use or sale of an infringing invention, when taken as the subject-matter of an account in equity or as the measure of damages at law, includes only such gains or savings as he could not have derived from the use or sale of any invention then open to the public. This proposition contains a truth which must be carefully distinguished before the errors of the remainder can be fairly judged.

(1) Every invention is either an original invention or an improvement on an original. If an original, it belongs entirely to the inventor and its infringement involves an injury commensurate with the scope of the complete invention used. If an improvement, the improvement merely, not the original, belongs to the inventor, and an infringement consisting in the use or sale of the original *plus* the improvement involves an injury commensurate only with the scope of the improvement as distinguished from the original; the employment of the latter, if it be not open to the public, being an injury to the rights of its inventor alone. Hence where the

plaintiff's invention is an improvement used with its original, and he is not the owner of the patent for the original, or the original is free to the public, the sole loss that he can sustain, and the sole benefit which the defendant can derive, from the infringement must relate to the improvement; and in ascertaining this benefit, whether in equity or at law, no advantage should be included which could have been obtained by the use of the original without the plaintiff's improvement. This rule is indisputable, but it is simply another way of stating that the profits arising from the use of the plaintiff's invention must be separated from those arising from any other cause, and required no additional expression in the proposition now considered. It applies, however, in either mode of statement only to cases in which the improvement is used *with its original*, since if the improvement is independently employed it loses its character as an improvement and follows the rule now to be discussed concerning original inventions.

(2) When an infringing act of making, use, or sale, is confined to and embraces the plaintiff's entire invention, such invention is, at least in reference to that infringement, an original invention, not dependent on any other for whose use in connection with it an allowance must be made, and not including any whose value must be separated from its own in order that the plaintiff's loss or

long accepted, and are now supported by so many eminent authorities, that they must here be treated as correct. If,

the defendant's gain from its employment may be measured. Here it would seem most in harmony with the foregoing rule, whose proper antithesis it is, as well as with the ordinary methods of practical jurisprudence, to estimate the profits of the defendant at the entire advantage derived by him from the use of the invention, irrespective of any other arts or instruments whatever. And such would probably have been the current of authority but for the utterances of several of our courts (of which the extract in note 5, *ante*, is a sample) where the doctrine applicable to improvements only is stated without limitation and thus extended to cover all infringements of whatever character or scope. To detect and weigh the error in these utterances it is necessary to consider them first as they affect the rule of profits in equity, and second as they affect the rule of damages at law.

(3) First, profits in equity are the gain or saving, or both, which the defendant has made by employing the infringing invention. This gain or saving is a fact. It is an actual pecuniary benefit which has resulted directly from the defendant's wrongful use of the plaintiff's property, which he has had and enjoyed, and to which, on equitable theories, the plaintiff is entitled. Now what relevancy to this condition of affairs has the fact, if it be a fact, that the defendant, by using an invention which he had a right to use, might have received the same pecuniary benefit? It does not alter the fact that he has wrongfully used the plaintiff's invention. It does not lessen the amount of dollars and cents that he has received or saved as the direct result of his infringement. It does not qualify the plaintiff's claim to his own property and to the proceeds of its unauthorized use. On the contrary,

to allow the defendant to keep his unrighteous gains, because he might have honestly acquired an equal amount, ignores the facts, deprives the plaintiff of his lawful rights, and recompenses the wrong-doer for the injury he has inflicted. Such a proceeding finds no parallel in any other department of remedial justice, whether civil or criminal. If the defendant were a true trustee of the plaintiff, and by a misappropriation of the trust estate had fortunately realized large profits, could he retain them on the ground that he had property of his own with which he might have entered on the same enterprises with the same results? If he were a trustee *de son tort*, and having intruded himself into the management of the *cestui que trust's* estate had profited by converting its resources to his own use, could he refuse to render up both capital and profits because other and lawful methods might have yielded him a corresponding gain? If he were a simple tort-feasor and were required to disgorge the fruits of his appropriation of the plaintiff's property, could he defend by showing that he might have bought or borrowed to the same advantage property of the same amount or kind? The rule becomes an absurdity upon analysis or varied application, and its presence in our law can only be accounted for by regarding it as a careless extension of the true rule which separates between the improvement and the original invention.

(4) Second, at law the profits of the defendant serve merely as an indication of the amount which the plaintiff has lost through the infringement, and are of no significance until it has been proved that the advantage derived by the defendant from the invention would, but for the infringement, have been enjoyed

therefore, the evidence discloses that the defendant enjoyed advantages in the use of the plaintiff's invention which could

by the plaintiff. Obviously to make this rule of any practical value the same mode of estimating the defendant's profits must be employed that would have been pursued in ascertaining them if they had been made by the plaintiff. The same items must be debited to him as representing the "yield" of the enterprise, and the same deductions allowed as constituting the "cost," as if he were the plaintiff balancing his account of gains and loss. But into a calculation of profits by the rightful owner of an invention, the amount he might have made by using something else never enters either as an expense or a receipt. The enterprise, like all other commercial undertakings, stands by itself, its results being rendered neither greater nor less by the possible results of different ventures to which the time or capital or labor of the manufacturer or merchant might have been directed. The profit which the plaintiff would have made thus embraces the entire difference between "cost" and "yield"; the loss which he has suffered is commensurate with the profit he would have made; and this profit having been received by the defendant must be estimated as the plaintiff's profits would have been and as his loss must be, irrespective of all exterior comparisons, or the whole rule becomes uncertain, speculative, and impracticable. The analogies as well as the reason of the law are all in harmony with this position. A disseisor cannot reduce the amount of *mesne profits* for which he is accountable by showing that he might have occupied land of his own with equal benefit to himself. A converter of personal property does not decrease the plaintiff's damages for the unlawful detention by proving that similar and as available chattels were lawfully at his

command. On what ground can a distinction be made in the case of a wrongful appropriation of another's patented invention, whereby the owner is to be deprived wholly or in part of adequate redress because the defendant could, by obedience to law, have reaped a similar advantage?

(5) To the foregoing argument it may be objected that the benefit conferred by any inventor on the public is measured by the difference in value between his new art or instrument and those which were already in possession of the public. Theoretically this is true; but it has nothing to do with the present question for two reasons: first, that such a difference is always incapable of pecuniary calculation or of any approximate conjecture; and second, that though it were ascertainable, the general benefit to the public from the invention, if it were free, cannot tend to show the actual loss to the inventor or the unlawful gain to the infringer by his invasion of the monopoly. It would be an outrage upon common-sense as well as justice to decide that a defendant who had lost by the infringement must account in equity for profits which, on the basis of the general public benefit derived from the invention, he ought to have secured; or, it being found that but for the infringement the plaintiff would have commanded the entire market, to mulct the infringer in damages at law measured by the profits which manufacturers in general would have realized from the business, without regard to his own expense for production or the prices realized upon his sales. And on the other hand an equal wrong would be inflicted on the plaintiff if compensation for the infringement were denied him on the ground that his invention, however valuable in itself and productive to its

not have been attained by the employment of means already given to the public, the pecuniary value of that advantage, measured by whatever increase in his sales or profits may be due to the invention, indicates the extent to which the plaintiff has suffered by his wrongful acts. This value should be calculated for the entire period of the infringement, but must not include the advantage which the defendant may have gained by any use of the invention before the issue of the patent.⁸ It must also be confined to the benefits which flow from the use of the plaintiff's invention, as distinguished from every other instrument or operation which the defendant has employed in the manufacture of his products. Thus

employers, was of no greater comparative utility than other inventions which were not protected by a patent. Of the limitation placed by the court to the operation of this controverted doctrine, in confining the comparison to inventions already free to the public, and making no allowance to the defendant because other patented inventions might have been equally profitable to him, it is necessary to say only that if the main doctrine is unsound this becomes of no consequence, while if the former is sustained as an arbitrary rule of calculation the latter, which evidently rests rather upon some notion of a penalty to the wrong-doer than on that of compensation to the injured party, is no more arbitrary and unreasonable than the former.

(6) Shorn of the errors thus pointed out and explained, the true rule in reference to the subject seems to be this :

1. That the inventor of an improvement is entitled to profits or damages only for the infringement of his improvement, and that in estimating these a deduction must be made from the entire profits of the enterprise of all such profits as are due to the original.

2. That where the invention is an original invention, or an improvement used independently and as an original,

the plaintiff is entitled to profits or damages for its use by the defendant as he has used it, without regard to anything else he might have used, lawfully or unlawfully, in the promotion of his business.

Recognitions more or less explicit of this distinction and of the rule as here maintained are discoverable in many of the cases heretofore referred to, of which *Shannon v. Bruner* (1888), 26 Fed. Rep. 901, and *American Nicholson Pavement Co. v. City of Elizabeth* (1874), 6 O. G. 764, 1 Bann. & A. 439, are fair examples. In the text, however, the rule as generally stated by the courts is followed, their utterances being regarded as the law, to whatever criticism it may be subjected in this collateral discussion.

⁸ That the value of an infringement is its value at the date of the infringement, see *National Car Brake Shoe Co. v. Terre Haute Car & Mfg. Co.* (L. 1884), 28 O. G. 1067 ; 19 Fed. Rep. 514.

That where the infringing articles were in use when the patent was granted the value of their use since the issue of the patent and as long as they will last, is the measure of damages, see *Brodie v. Ophir Silver Mining Co.* (L. 1867), 4 Fisher, 137 ; 5 Sawyer, 608.

where the plaintiff's invention is a mere improvement upon an existing process or machine, the advantage derived from the improvement must be separated from that accruing from the original, and only the value of the former advantage be considered.⁹ But if the process or machine was valueless without the improvement, or if the two were always used together in the practice of the art, or if the defendant has so confused his own invention with that of the plaintiff that their respective benefits cannot be separated, the value of the whole advantage gained is imputed to the plaintiff's improvement and may be taken as the measure of his loss.¹⁰ The amount of the pecuniary profit received by the defendant from his use of the invention may be shown by evidence disclosing the quantity of his sales, the prices obtained, the cost of manufacture, and the expense of marketing.¹¹ If his products

⁹ In *Philp v. Nock* (L. 1873), 17 Wall. 460, Swayne, J. : (462) "Where the infringement is confined to a part of the thing sold, the recovery must be limited accordingly. It cannot be as if the entire thing were covered by the patent; or, where that is the case, as if the infringement were as large as the monopoly."

That the damages are to be ascertained by the increased profit to the defendant from making and selling the invention, not considering the increased facilities in manufacture due to inventions since the issue of the patent or its assignment to the plaintiff, see *Wayne v. Holmes* (L. 1856), 2 Fisher, 20; 1 Bond, 27.

That the profits of the patented invention alone are to be considered, apart from other devices with which it may be associated, see *Tuttle v. Gaylord* (E. 1886), 36 O. G. 694; 28 Fed. Rep. 97; *Hayden v. Suffolk Mfg. Co.* (L. 1862), 4 Fisher, 86; *Seymour v. McCormick* (L. 1853), 16 How. 480.

See § 1063, note 6, *post*.

¹⁰ That where the plaintiff's invention is an improvement and the old device is now never used without it, the

entire profit is the measure of damages, see *McCormick v. Seymour* (L. 1851), 2 Blatch. 240.

That if the defendant's process derives all its value from the plaintiff's invention, the profits are measured by that value, though other processes equally useful to the defendant, but resulting in a different but as valuable a product, were open to him, see *Whitney v. Mowry*, (E. 1870), 4 Fisher, 207.

That the profits due to the defendant's improvements do not form a measure of the plaintiff's damages, but if inseparable from those resulting from the use of the plaintiff's device, they belong to the plaintiff, not to the defendant who wrongfully confused them, see *Carter v. Baker* (L. 1871), 4 Fisher, 404; 1 Sawyer, 512.

See also § 1063, note 7, *post*.

¹¹ That when damages are measured by profits, these are the selling price less the cost of making and selling, the risk of bad debts and interest on capital, see *McCormick v. Seymour* (L. 1851), 2 Blatch. 240; *Wilbur v. Beecher* (L. 1850), 2 Blatch. 132.

That the added price charged by the

derive their entire market value from the use of the plaintiff's invention, this evidence will be sufficient, since the difference between cost and receipts will be the profit resulting from the invention. If his products are marketable when not made with the plaintiff's process or machine, but in less quantities or at a lower price or greater cost, other evidence becomes necessary to separate that increase in the sales or profits which is due to the invention. Definite and direct testimony upon this point is not always procurable, and in its absence any facts which indicate the degree of such increase may be shown. The amount afterwards paid by the defendant for an equivalent invention, or for a license to use it, or as royalties upon his products, may thus be proved as an admission by him of its value in his business.¹² Even the opinions of witnesses having experience in the trade are proper testimony upon this subject.¹³ But the expense of making the invention, or the price for which it is sold to others by the plaintiff, or the amount of an injunction-bond demanded from the defendant in the case at bar, are of themselves no guide to its value to the defendant, since this value must depend, not on the cost of the invention, nor the estimation formed by others of its worth, but on the profits he himself has made by its employment.¹⁴ When the value of the advantage received by

defendant when he used the plaintiff's invention is a fair indication of its value to him, see *Vulcanite Paving Co. v. American Artificial Stone Pavement Co.* (E. 1888), 36 Fed. Rep. 378.

That upon the question of the defendant's profits, the whole expense of opening and closing up the business cannot be charged to the patent, see *Goodyear v. Bishop* (L. 1861), 2 Fisher, 154.

Upon the whole question of profits and the items which enter into the account, see §§ 1063, 1138-1149, and notes, *post*.

¹² That the value of the invention to the defendant may be shown by license fees paid by him for an equivalent benefit, see *Sargent v. Yale Lock Mfg.*

Co. (E. 1879) 17 Blatch. 249; 4 Bann. & A. 579; 17 O. G. 106.

That an established royalty is evidence of value but not an absolute test, see *Wooster v. Thornton* (E. 1886), 26 Fed. Rep. 274; 34 O. G. 560.

¹³ That when there is no established license fee, the court in estimating damages may consider (1) the manufacturer's price; (2) the percentage which usually makes a fair royalty; (3) the judgment of competent experts familiar with the sale and profit; (4) the price paid by others for licenses, etc., see *McKeever v. United States* (1878), 14 Court of Claims, 396; 23 O. G. 1525.

¹⁴ That neither the price for which the device might sell nor the expense of making it is the proper measure of

the defendant from the use of the plaintiff's invention has been thus determined, and other evidence has demonstrated that but for the infringement the plaintiff would have supplied the market at an equal profit, the question still remains whether the plaintiff has not suffered other losses beyond the mere supersedure of his own products by those of the defendant. The goods placed on the market by the defendant may have been of an inferior quality and by diminishing the reputation may have decreased the salability of all products of the patented machine or process by whomsoever manufactured, or the defendant may have lowered his prices to obtain a market, content with a less profit than justice would award the plaintiff at whose expense of skill or time or money the invention was created, and in this manner may not only have received a smaller benefit himself than the plaintiff would have gained from the manufacture and sale of the same products, but have directly injured the business of all those who use the invention under the protection of the patent.¹⁵ These damages

damages where only making is proved, see *Whittemore v. Cutter* (L. 1813), 1 Gallison, 478 ; 1 Robb, 40.

That the damages are not shown by the prices at which the plaintiff sold certain territory, see *Campbell v. Barclay* (L. 1870), 5 Bissell, 179.

That it cannot be assumed that the defendant's profit was as much as the plaintiff's would have been, see *Roemer v. Simon* (E. 1887), 31 Fed. Rep. 41 ; 40 O. G. 1456.

That the amount of the bond ordered on an injunction is no evidence of the value in dispute, see *Brown v. Shannon* (E. 1857), 20 How. 55.

¹⁵ That where the goods sold by the defendant would otherwise have been sold at a higher price by the plaintiff, the measure of damages is the profit the plaintiff would have received on such sales at such advanced price, see *Hobbie v. Smith* (L. 1886), 27 Fed. Rep. 656 ; *American Saw Co. v. Emerson* (E. 1880), 8 Fed. Rep. 806 ; *McComb v. Brodie*

(L. 1872), 5 Fisher, 384 ; 2 O. G. 117 ; 1 Woods, 153 ; *Carter v. Baker* (L. 1871), 4 Fisher, 404 ; 1 Sawyer, 512.

See also § 1063, note 10, *post*.

That the defendant's profits are usually the measure of the plaintiff's damages, though additional damages are occasionally required, see *Littlefield v. Perry* (E. 1874), 21 Wall. 205 ; 7 O. G. 964.

That the plaintiff's profit is the measure of damages if it be shown that the sales would have been made by him, see *Blake v. Greenwood Cemetery* (E. 1883), 16 Fed. Rep. 676 ; 25 O. G. 89 ; 21 Blatch. 222 ; *American Saw Co. v. Emerson* (E. 1880), 8 Fed. Rep. 806 ; *McComb v. Brodie* (L. 1872), 5 Fisher, 384 ; 2 O. G. 117 ; 1 Woods, 153.

That a receipt in full for the use of certain machines is admissible to lessen the damages *pro tanto*, see *Burdell v. Denig* (L. 1875), 92 U. S. 716.

That no damages are allowed unless the invention is proved to be useful, see

are not shown by the value of the use of the invention to the defendant, but are additional losses falling upon the plaintiff or his specific licensees in consequence of the infringement, and are to be proved by direct evidence in the mode before described.

§ 1063. Evidence Concerning Damages: Monopoly Enjoyed by the Exclusive Practice of the Invention: Indirect Evidence of the Extent of Injury when the Owner of the Patented Invention Makes and Sells it to the Public.

When the exclusive use of the invention by the plaintiff or his specific licensees assumes the second form, and consists in the manufacture and sale of the patented invention, indirect evidence of the loss sustained by the infringement is afforded by the profits made by the defendant upon his unlawful sales.¹ Here, as in the case of an infringing use of the invention, it cannot be assumed that the plaintiff would have sold all that the defendant sold, or that his percentage of profit would have been the same.² Nor, on the

Knight v. Baltimore & Ohio R. R. Co. (L. 1840), Taney, 106 ; 3 Fisher, 1.

That the defendant cannot show that the plaintiff's device was useless to him, if he used it, see *Turrill v. Illinois Central R. R. Co.* (E. 1873), 5 Bissell, 344.

§ 1063. ¹ That the profits made by the defendant on infringing articles sold by him tends to show the amount of the plaintiff's loss, see *Covert v. Sargent* (E. 1889), 38 Fed. Rep. 237 ; *Carter v. Baker* (L. 1871), 4 Fisher, 404 ; 1 Sawyer, 512 ; *Buck v. Hermance* (L. 1849), 1 Blatch. 398.

² In *Seymour v. McCormick* (L. 1853), 16 How. 480, Grier, J. : (490) "It is only where, from the peculiar circumstances of the case, no other rule can be found, that the defendant's profits become the criterion of the plaintiff's loss. Actual damages must be actually proved, and cannot be assumed as a legal inference from any facts which amount not to actual proof of the fact.

What a patentee 'would have made, if the infringer had not interfered with his rights,' is a question of fact and not 'a judgment of law.' The question is not what speculatively he may have lost, but what actually he did lose. It is not a 'judgment of law' or necessary legal inference that if all the manufacturers of steam-engines and locomotives who have built and sold engines with a patented cut-off, or steam-whistle, had not made such engines, that therefore all the purchasers of engines would have employed the patentee of the cut-off, or whistle ; and that, consequently, such patentee is entitled to all the profits made in the manufacture of such steam-engines by those who may have used his improvement without his license. Such a rule of damages would be better entitled to the epithet of 'speculative,' 'imaginary,' or 'fanciful,' than that of 'actual.'"

A contrary doctrine has sometimes

contrary, can it be inferred that the plaintiff's loss is limited to what the defendant may have gained. When it is proved that the plaintiff was ready and able to supply the market, that those who would have been his customers have bought of the defendant, and that his expense in manufacturing and marketing the patented articles would not have exceeded that incurred by the defendant, it may safely be presumed that but for the infringement he would have made the profits which have been received by the defendant.³ These essential connecting facts being established, the amount of the defend-

been held. Thus in *Wilbur v. Beecher* (L. 1850), 2 Blatch. 132, Nelson, J. : (143) "If the defendant has been guilty of violating the plaintiff's rights, the rule on the question of damages is, that the plaintiff is entitled to all the actual profits which the defendant has made by the use of the principle of the plaintiff's combination. In other words, the plaintiff is entitled to all the damages which he has sustained by reason of the use which the defendant has made of the plaintiff's property. This is, in effect, the same thing, because the law presumes that if the defendant had not put his machines into the market, the demand would have been for the plaintiff's, and that he would have received the profits on the machines which have been made and sold by the defendant. Vindictive or exemplary damages are not allowed. The jury are confined to the actual damages, and the law has provided that the court may increase those damages in proper cases."

Further, that it cannot be presumed that the plaintiff would have sold all that the defendant sold, see *Roemer v. Simon* (E. 1887), 31 Fed. Rep. 41 ; 40 O. G. 1456 ; *Hall v. Stern* (E. 1884), 20 Fed. Rep. 788 ; *Ingersoll v. Musgrove* (E. 1878), 13 O. G. 966 ; 14 Blatch. 541 ; 3 Bann. & A. 304 ; *Hawes v. Washburne* (L. 1872), 5 O. G. 491 ; *Carter v. Baker* (L. 1871), 4 Fisher, 404 ; 1 Saw-

yer, 512 ; *Goodyear v. Bishop* (L. 1861), 2 Fisher, 154.

That it cannot be assumed that the plaintiff would have sold all the defendant sold, especially where defendant's articles are cheaper and of poorer quality, see *Dobson v. Dornau* (E. 1886), 118 U. S. 10 ; 35 O. G. 750.

³ That where the plaintiff has had control of the market it will be presumed that he would have sold all that has been sold, and that all profits made by the defendant would have been made by him, see *Gould's Mfg. Co. v. Cowing* (E. 1882), 105 U. S. 253 ; 21 O. G. 1277.

That on proof of the quantity sold by the plaintiff during his first season with the profit on it, and of the quantity sold by the defendant during the second season and that plaintiff's sales declined, the measure of damages is the profit which would have accrued to the plaintiff if he had sold the quantity sold by the defendant, it being presumed that the plaintiff would have sold what the defendant did sell, see *Bigelow Carpet Co. v. Dobson* (E. 1882), 21 O. G. 1200 ; 10 Fed. Rep. 385.

That the jury may infer from circumstances such as diversion of custom, &c., that the plaintiff would have made the sales but for the infringement, see *Covert v. Sargent* (E. 1889), 38 Fed. Rep. 237.

ant's profits on his sales becomes an important indication of one element in the plaintiff's loss. The other elements are comprised in the injury which his own business may have suffered by the depreciation of demand or prices on account of the defendant's wrongful acts, and which is to be shown by direct evidence, in the manner already stated.⁴ The profits arising from the sale of a patented article are represented by the difference between cost and yield. In its cost are included the expense for materials and interest thereon, the price paid for labor in making and selling, the manufacturer's profit on materials and labor, the rental value of the factory or store, and any other items which a manufacturer ordinarily reckons among the expenses of his business. Its yield is the price obtained by the infringer.⁵ When the plaintiff's patent covers the entire article, the defendant's profit is thus ascertained by a simple process of computation upon the data afforded by the gross amount of his prices and expenses. But where the patent covers only a portion of the article, such as an improvement in a composition or machine, the profit due to the incorporation of the improvement into the article must be separated from the profit which would have been received by the defendant had this portion been omitted, and the latter profit be excluded from the computation.⁶ If the article

⁴ That injuries to the plaintiff's rights by reducing prices, etc., are additional grounds of recovery, see § 1061, notes 1 and 2, and § 1062, note 14, *ante*.

⁵ In *Rubber Co. v. Goodyear* (E. 1869), 9 Wall. 788, Swayne, J. : (804) "The profits made in violation of the rights of the complainants in this class of cases, within the meaning of the law, are to be computed and ascertained by finding the difference between cost and yield. In estimating the cost, the elements of price of materials, interest, expenses of manufacture and sale, and other necessary expenditures, if there be any, and bad debts, are to be taken into the account, and usually nothing else. The calculation is to be made as a

manufacturer calculates the profits of his business. 'Profit' is the gain made on any business or investment, when both the receipts and payments are taken into the account."

See also *Piper v. Brown* (E. 1873), 6 Fisher, 240 ; 3 O. G. 97 ; *Holmes*, 196 ; *McCormick v. Seymour* (L. 1851), 2 Blatch. 240 ; *Wilbur v. Beecher* (L. 1850), 2 Blatch. 132.

As to the items to be reckoned in estimating profits on sales of infringing articles, see further §§ 1138-1143, and notes, *post*.

⁶ That the damages must be limited to the value of the use of the improvement infringed, see *Burdell v. Denig* (L. 1865), 2 Fisher, 588.

That where the entire invention be-

would, however, have been unsalable without this portion, or if through the defendant's fault in confusing this with the other portions of the article no separate estimate of profits can be made, the entire profit may be regarded as derived from the invention of the plaintiff.⁷ In this inquiry into the

longs to the plaintiff the whole profit is regarded as due to it, see *Welling v. La Bau* (E. 1888), 43 O. G. 117.

That if the entire value of the defendant's device flows from the plaintiff's invention the entire profits belong to that invention, but otherwise they must be apportioned, see *Hurlburt v. Schillinger* (E. 1889), 130 U. S. 456; *Fifield v. Whittemore* (E. 1888), 33 Fed. Rep. 835; *Reed v. Lawrence* (E. 1886), 29 Fed. Rep. 915; *Whitney v. Mowry* (E. 1868), 4 Fisher, 141.

That the plaintiff must prove what portion of the profits are due to his invention, or else that the defendant's device is unsalable without it, see *Fay v. Allen* (E. 1887), 30 Fed. Rep. 446.

That evidence as to the special value of the part used by the infringer is not required where the rest is without value, see *Asmus v. Freeman* (E. 1888), 34 Fed. Rep. 902.

⁷ In *McCormick v. Seymour* (L. 1854), 3 Blatch. 209, Nelson, J. : (224) "But if the patentee comes to the conclusion not to vend to others his rights under the patent, and not to avail himself of the proceeds of sales of his mere patent-right, but to use the patented invention exclusively himself, and to furnish the products to the community himself out of his own manufactory or establishment, — in such cases a different measure of damages is to be adopted by the jury. And that is this : If the patent is for a machine, — an entire machine, — the patentee is entitled, as damages in case of infringement, to the profits he could have made in constructing and vending his ma-

chine, over and above the mere profits arising out of its manufacture. By that we mean the mere profits of its mechanical construction, and not the profits that grow out of the exclusive right to manufacture the invention under the patent. The latter belong to the patentee, while the former — the mere mechanical profits — are excluded from the damages. And if the case is one of an improvement on a machine, then he is entitled, as a measure of damages, to all the advantages of the use of his patented improvement, excluding the profits of the manufacture, and excluding also the value, if any, of the use of the old machine. Now, so far as respects the benefits and advantages that a patentee would derive from an improvement on a machine, you see at once that they would depend very much, if not altogether, upon the usefulness of the machine with that improvement, compared with its usefulness without that improvement. Hence you have found in the course of the trial that witnesses have been introduced for the purpose of ascertaining the relative value of the plaintiff's machine with the improvements in controversy, and of the same machine without those improvements. If the machine stripped of those improvements would be a useless article in the market, and if no person would buy it unless those improvements were annexed to it, then its value, so far as its utility is concerned, depends on those improvements; because they give it vitality and usefulness in the eye of the business community. Hence, it is proper

amount of the defendant's profits, moreover, the actual profit made is alone to be considered.⁸ It is immaterial how much

to make this discrimination in canvassing the facts bearing upon the proper measure of damages."

In *McCormick v. Seymour* (L. 1851), 2 Blatch. 240, Nelson, J. : (257) "It has been suggested by the counsel for the defendants that, inasmuch as the claims of the plaintiff in question here are simply for improvements upon his old reaping machine, the patent for which expired on the 21st of June, 1848, and not for an entire machine and every part of it, the damages should be limited in proportion to the value of the improvements thus made ; and that, therefore, a distinction exists, in regard to the rule of damages, between an infringement of an entire machine and an infringement of a mere improvement on a machine. I do not assent to this distinction. On the contrary, according to my view of the law regulating the measure of damages in cases of this kind, the rule which is to govern is the same whether the patent covers an entire machine or an improvement on a machine. Those who choose to use the old machine in this case, have a right to use it without incurring any responsibility. But if they engraft on it an improvement secured by a patent, and use the machine with that improvement, they have deprived the patentee of the fruits of his invention, the same as if he had invented the entire machine ; because it is his improvement that gives value to the machine, on account of the public demand for it. The old instrument is abandoned, and the public call for the improved instrument, and the whole instrument, with the improvement upon it, belongs to the patentee. Any person has a right to use the old machine, but if an inventor engrafts upon the old machine,

which he has a right to use, an improvement that makes it superior to anything of the kind for the accomplishment of its purposes, he is entitled, under a patent for the improvement, to the benefit of the operation of the machine under all circumstances, with the improvement engrafted upon it, to the same degree in which the original patentee was entitled to the old machine." See a criticism on this language in *Seymour v. McCormick* (L. 1853), 16 How. 480.

That it cannot be assumed that the profit made by the plaintiff on each article sold by him is made by the defendant on each article sold by him, unless it is shown that the value of the article depends on the plaintiff's invention, see *Roemer v. Simon* (E. 1887), 31 Fed. Rep. 41 ; 40 O. G. 1456 ; *Dobson v. Hartford Carpet Co.* (E. 1884), 114 U. S. 439 ; 31 O. G. 787.

That where the defendant's device is useless without the plaintiff's, the entire profits are part of the damages, see *Zane v. Peck Bros.* (E. 1882), 23 O. G. 191 ; 13 Fed. Rep. 475 ; *Carter v. Baker* (L. 1871), 4 Fisher, 404 ; 1 Sawyer, 512.

That a defendant who wrongfully confuses his invention with the plaintiff's is liable for the entire profit, see *Carter v. Baker* (L. 1871), 4 Fisher, 404 ; 1 Sawyer, 512.

⁸ That the plaintiff cannot recover profits unless the defendant made profits, see *Elizabeth v. Pavement Co.* (E. 1877), 97 U. S. 126 ; *Vaughn v. Central Pacific R. R. Co.* (E. 1877), 4 Sawyer, 280 ; 3 Bann. & A. 27.

That where the profits of the defendant are the proper measure of damages, the amount is governed by the profits the defendant actually made,

he might have realized with higher skill or diligence, since the only theory on which the evidence of his profits becomes admissible is that the plaintiff would have sold what he has actually sold, and has, therefore, lost what he has actually made.⁹ In addition to such profits as the defendant has received, the plaintiff is also entitled to recover any excess which would have been included in his own profits had he supplied the market with a similar amount and quality of goods.¹⁰ It being proved that he would have sold all that

not by what the plaintiff can show he might have made, see *Burdell v. Denig* (L. 1875), 92 U. S. 716.

⁹ That the gain which the defendant might have made by diligence, etc., is no measure of the plaintiff's loss, though the actual gain might be, see *New York v. Ransom* (L. 1859), 23 How. 487; *Dean v. Mason* (E. 1857), 20 How. 198.

That articles sold before the issue of the patent cannot be reckoned in the account of profits or damages, see *Lyon v. Donaldson* (L. 1888), 34 Fed. Rep. 789.

¹⁰ In *Pitts v. Hall* (L. 1851), 2 Blatch. 229, Nelson, J. : (238) "One mode of arriving at the actual damages is to ascertain the profits which the plaintiff derives from the machines which he manufactures and sells, and which have been made and sold by the defendant. This mode is founded on the presumption of law that if the defendant had not been wrongfully concerned in the manufacture of the machines, those persons who procured them from him would have applied to the patentee or assignee for them. Another mode, and the one resorted to partially in this case, is to ascertain the profits which the party infringing has derived from the use of the invention or the construction of the machines; because whatever profits he has derived have arisen from the wrongful use of the invention, and belong to the real owner of the

machine. This measure of damages, however, is not controlling, and ought not to be; because a party concerned in infringing a patent stands in a different position from the patentee, not having been previously subjected to the expense and labor to which the latter is frequently exposed in the process of invention and experiment. Hence the person who enters upon the business without previous expense may very well afford to sell machines at less profit than the patentee. The latter must have his profit, not only for the expense of putting in operation the improvement, but by way of indemnity for the previous time, labor, and money which he has been obliged to bestow on the invention. He must, therefore, charge a higher price, to cover these greater expenses. Thus profits which the party infringing might be satisfied with, and which would afford him compensation, would not afford indemnity to the patentee. If, therefore, on looking into the profits made by the defendant, the jury shall be of opinion that they do not correspond with the fair profits which the plaintiff, if left alone, would have realized, they are not bound by the measure of the profits of the defendant, but have a right to look to the profits which the plaintiff or the patentee would have made under the circumstances, if not interfered with."

Further, that the excess of the plaintiff's profits over the defendant's may be

the defendant sold, and that his expense of manufacture would not have been greater than that of the defendant, it is evident that he would have derived an equal profit if his sales had been effected at the same prices. But if he could have made the articles at less expense, or sold them at a higher price, than the defendant did, his loss exceeds the profit of the defendant by whatever sum may cover this difference between the profit which he would have realized and that which the defendant has obtained. The testimony concerning the amount of the defendant's sales and profits is generally elicited by subjecting him to examination as a witness, in connection with his books of account, though any other relevant evidence may be offered.

§ 1064. Evidence Concerning Damages : Monopoly Enjoyed by the Exclusive Practice of the Invention : Evidence of the Extent of Injury where the Infringing Acts Differ from those by which the Monopoly is Enjoyed.

The acts of infringement performed by the defendant do not always correspond with those by which the plaintiff or his specific licensees enjoy the patented invention. Where their advantage is derived from the use of the invention and a sale of its products, the defendant may infringe by making and selling the patented article itself. Or while they seek their profit in its manufacture and sale, he may make and use it only in his individual business. In such cases the loss sustained by the plaintiff must be determined in a different manner. When the defendant makes and sells an instrument, the use of which is confined by the plaintiff to himself and certain licensees, the sale no otherwise affects the plaintiff than as it puts the invention into the hands of others to be used by them

added to the latter in computing damages, where the jury are satisfied that the plaintiff would have sold all the defendant has sold, see *Hobbie v. Smith* (L. 1886), 27 Fed. Rep. 656 ; *Zane v. Peck Bros.* (E. 1882), 13 Fed. Rep. 475 ; 23 O. G. 191 ; *Carter v. Baker* (L. 1871), 4 Fisher, 404 ; 1 Sawyer, 512.

The evidence necessary to show this

excess and the circumstances from which the jury would be justified in believing that the plaintiff's sales would have covered those made by the defendant, must in most if not all cases be equivalent to direct evidence of the loss occasioned to the plaintiff by the defendant's infringement, and thus require no investigation of the profits of the latter.

in methods hostile to his own. The purchasers and users thus become the principal infringers, and liable for the actual damages resulting from their infringing use. The maker and seller may be held responsible for all these damages, in addition to that arising from the act of sale, on the ground of his concurrence in their acts of user, or on the ground that in the price which he received the value of such use must be presumed to have been included.¹ If neither of these grounds is tenable, the sale must be regarded as an independent infringement, and its evil effect, if any, on the sales and prices of the plaintiff's products must be the measure of his actual injury. If no such evil effect follows from the sale, the damages are only nominal. When the plaintiff enjoys his monopoly by the manufacture and sale of the patented articles, and the defendant infringes by making and using the articles in his individual business, the amount of profit which the plaintiff would have gained if the defendant had bought the articles of him is the measure of his loss, and consequently of his actual damages. Ordinarily, the mere making of the invention, without using or selling it, does not interfere with the plaintiff's enjoyment, and though an infringement of the patent is compensated for by nominal damages.²

§ 1064. ¹ That one who makes and sells a patented invention, or the parts of a patented invention, with intent that the articles sold shall be used in violation of the patent, becomes thereby a joint tort-feasor with the actual users, and may be sued singly or together with them for the damages inflicted on the plaintiff, see §§ 903, 924, and notes, *ante*.

² In *Whittemore v. Cutter* (L. 1813), 1 Gallison, 478; Story, J. : (483) "If the jury are of opinion that an user of the machine is actually proved in this case, the rule of damages should be the value of the use of such a machine during the time of the illegal user. If the jury are of opinion that a making of the machine only is proved, as there is no evidence in the case to shew any actual damages by the making, they ought to give

nominal damages to the plaintiffs. For where the law has given a right, and a remedy for the violation of it, such violation of itself imports damage; and in the absence of all other evidence the law presumes a nominal damage to the party. The counsel for the plaintiffs have argued that although there is no evidence of actual damage, the jury ought to give damages either to the full value of the expense of making the machine, or of the price at which such a machine might be sold. But neither of these estimates can form a rule for damages for the illegal making of the machine. As to the expense of making the machine, it is obvious that it is an expense altogether incurred by the defendant, and is not a loss sustained by the plaintiffs. The latter neither found the materials nor the labor. How then

§ 1065. Effect of Recovery of Damages upon the Future Rights of the Defendant.

The effect of a recovery of damages upon the future rights of the defendant, and of those who claim under him, depends upon the measure adopted for the estimation of such damages. When the measure is an established license fee, payable in a gross sum and covering the entire term of the patent, the defendant, having satisfied the judgment, becomes entitled to enjoy the licensed privilege during the remainder of the term. If the measure is a license fee paid in royalties based upon quantities or sales, or in periodical instalments, and the license privilege is unrestricted in duration, he may continue to employ the invention upon the same conditions after judgment as are allowed to other licensees.¹ But if the plaintiff's

can it be an actual damage sustained by them? As to the price for which such a machine would sell, it is open to the same and to this farther objection; that the price is compounded of the value of the materials and the workmanship, and also of the right of user of the machine. Now admitting the plaintiffs recover in this action, there can be no pretence that thereby a legal right will pass to the defendant to use the machine made by him. Every future use will be an infringement of the plaintiffs' patent; and, therefore, if the plaintiffs could in this suit recover such price, they not only would recover for materials and labor which they never furnished, and for a right of user which never passed from them, but also for that which might lawfully be the subject of another action, viz., the future user of the defendant's machine, so that there might be a double recovery for the same supposed injury." 1 Robb, 40 (45). See also *Carter v. Baker* (L. 1871), 4 Fisher, 404; 1 Sawyer, 512.

§ 1065. ¹ In *Spaulding v. Page* (1871), 4 Fisher, 641, Sawyer, J.: (645) "This was so held by Mr. Justice Nelson in his charge to the jury in *Sickels v. Borden*, 3 Blatch. 536. If

the principles stated in that case be correct, I think it decisive of this case. The learned justice stated to the jury that if the patentee has an established price in the market for his patent right, or what is called a patent fee, that sum with the interest constitutes the measure of damages. He also stated that the adoption of the patent fee, as the measure of damages for infringement by the use of a machine, operates to vest in the defendant the right to use the machine during the term of the patent. *Ib.* 543, 545. This must be upon the principle that the patentee has adopted a patent fee, or royalty, as one mode of remuneration, and in the fee has fixed his own measure of the value of the use of the machine for the entire term, or till that particular machine is worn out; and in case of an infringement the court gives him his price, and the defendant, having paid the full price, is entitled henceforth to the use of the machine." 1 Sawyer, 702 (705). See also *Stutz v. Armstrong* (1885), 25 Fed. Rep. 147; *Emerson v. Simm* (1873), 6 Fisher, 281; 3 O. G. 293; *Sickels v. Borden* (1856), 3 Blatch. 535.

That where a plaintiff exercises his rights by selling licenses the defendant

use of the invention is exclusive, or if he preserves a monopoly in its sale, the satisfaction of the judgment confers on the defendant no right to any future use or sale.² His vendees, under sales for which he has already made compensation to the plaintiff, have an implied license to use the purchased articles until they are destroyed, but neither the judgment nor its payment authorizes any repetition of the acts for which the damages have been recovered.³ These damages are esti-

will be allowed to take a license on reasonable terms, see *Colgate v. Gold & Stock Telegraph Co.* (1879), 16 O. G. 583 ; 4 Bann. & A. 415 ; 16 Blatch. 503.

That where there is an established license fee the plaintiff may, in some cases not falling within the license, recover damages only for the past infringement, and restrain the defendant for the future, see *Stutz v. Armstrong* (1885), 25 Fed. Rep. 147.

² In *Spaulding v. Page* (1871), 4 Fisher, 641, Sawyer, J.: (645) "If no patent fee has been adopted, then generally the patentee is entitled to recover the profits made in the use of the machine. A recovery of the profits for the use of the machine does not vest the title in the defendant, for the recovery, based upon this rule of damages, can only be for the use of the machine prior to the recovery, and ordinarily does not cover the value of the use for the entire period over which the patent right extends, or the period during which the particular machine is capable of being used. While the recovery of the established patent fee covers the entire value as fixed by the patentee himself, of the use for the entire term, and affords a complete compensation, the recovery of the profits for the use is but for a limited portion of the time, and but a partial compensation." 1 Sawyer, 702, (706). See also *Sickels v. Borden* (1856), 3 Blatch. 535.

That a decree for damages gives

no right to use the invention during the life of the patent, see *Birdsell v. Shaliol* (1884), 112 U. S. 485 ; 30 O. G. 261.

That the satisfaction of a judgment for damages gives no right to a future use of the invention, see *Bragg v. City of Stockton* (1886), 11 Sawyer, 597 ; 27 Fed. Rep. 509 ; *Matthews v. Spangenberg* (1883), 23 O. G. 1624 ; 15 Fed. Rep. 813.

That a judgment for nominal damages does not operate as a license for the future, see *Blake v. Greenwood Cemetery* (1883), 25 O. G. 89 ; 21 Blatch. 222 ; 16 Fed. Rep. 676.

That a judgment for nominal damages with satisfaction in favor of a licensor is not a bar to a suit by the licensee against a subsequent user of the article sold by the former defendant, see *Birdsell v. Shaliol* (1884), 112 U. S. 485 ; 30 O. G. 261.

³ In *Steam Stone Cutter Co. v. Sheldons* (1884), 21 Fed. Rep. 875, Wheeler, J.: (878) "There is another view of this question which has been touched upon formerly in this case, and that is that the recovery of the profits of the sale for use vested the title to the use in the purchaser of the machines. (*Stone Cutter Co. v. Sheldons*, 15 Fed. Rep. 608.) It was upon this ground that the recovery of the profits against the Windsor Manufacturing Co. was based. (*Stone Cutter Co. v. Windsor Manufacturing Co.*, 17 Blatch. 24.) This view is supported by several decided

mated only in view of acts performed before the suit was instituted for the infringement, and any subsequent acts of the same character are new injuries demanding similar redress.

§ 1066. Interest on Damages: when Recoverable.

The interest allowable upon the items which enter into the foregoing estimate of actual damages also depends upon the measure which has been adopted for determining the plaintiff's loss. In all cases where this measure is a license fee, however payable, interest is to be computed from the date on which, in the usual course of business, it should have been paid to the plaintiff.¹ When the amount is fixed by the value of the use of the invention to the defendant or by the profits on his sales, the date of his reception of the benefit or profits is that from which the interest should be reckoned.² When

cases (*Perrigo v. Spaulding*, 13 Blatch. 389; *Spaulding v. Page*, 1 Sawyer, 702; *Allis v. Stowell*, 15 Fed. Rep. 242); and it is not inconsistent with *Blake v. Greenwood Cemetery*, 16 Fed. Rep. 676. There merely nominal damages had been recovered against a manufacturer of the infringing machine with an injunction. The defendant purchased the machine and set up the former recovery as a bar to a recovery for the infringement by its use by him. This was held to be no bar, because there had been no recovery for this use, or for the profits or damages on a sale for use. Where an owner of a patent has compensation for the sale of a specific machine embodying the invention, that machine is forever freed from the monopoly. (*Bloomer v. Millinger*, 1 Wall. 340.) A compensation by recovery in an action for the same thing should have the same effect." 22 Blatch. 484 (487). See also § 830, and notes, *ante*.

That the settlement of the vendor with the patentee for past infringements does not protect vendees subsequently purchasing, see *Matthews v. Spangen-*

berg (1882), 23 O. G. 92; 20 Blatch. 482; 19 Fed. Rep. 823.

That a plea alleging a former recovery against the defendant's vendor must show that the judgment has been satisfied or it does not disclose a defence, see *Fisher v. Consolidated Amador Mine Co.* (1885), 11 Sawyer, 190; 25 Fed. Rep. 201.

§ 1066. ¹ That interest is allowed on license fees, see *Sickels v. Borden* (1856), 3 Blatch. 535.

² That the value of the damages is the value at the time of the infringement, see *National Car Brake Shoe Co. v. Terre Haute Car & Mfg. Co.* (1884), 19 Fed. Rep. 514; 28 O. G. 1007.

That interest is allowed by way of damages, see *Bates v. St. Johnsbury & L. C. R. R. Co.* (1887), 32 Fed. Rep. 628; *Tatham v. Le Roy* (1852), 2 Blatch. 474.

It is indeed sometimes held that interest on the profits made by the defendant cannot be awarded, the rule appropriate to unliquidated damages being also here applied (see *Tilghman v. Proctor* (E. 1888), 125 U. S. 136; 43 O. G. 628; *Illinois Central R. R. v.*

the amount of damages is based upon the injury directly inflicted on the plaintiff's own enjoyment of the invention, as shown by his diminished sales or prices, the date of the suit is the period at which the damages are complete and the interest begins.³ Whenever commencing, interest continues to the date of judgment, and should be included in the amount awarded to the plaintiff.⁴

§ 1067. Counsel Fees, etc., not Recoverable as Damages.

Counsel fees and other expenses of the litigation do not enter into the estimate of actual damages.¹ They are in-

Turrill (E. 1884), 110 U. S. 301; 26 O. G. 917; Parks v. Booth (E. 1880), 102 U. S. 96; 17 O. G. 1089). Upon the theory, however, that the profits actually received by the defendant would, but for the infringement, have been paid to the plaintiff (which is the only view in which such profits can be regarded at all in an action at law), it would certainly appear that the plaintiff's loss became complete when the profit was realized by the defendant, that its amount in each case was at the same time definitely settled, and that this amount with interest was, as in actions for conversion or for money had and received, the only and true measure of recovery. Thus in *Creamer v. Bowers* (E. 1888), 35 Fed. Rep. 206, Wales, J., (210): "The general rule is that interest should be allowed on royalties from the time those royalties ought to have been paid, in all cases where a royalty is the measure of the complainant's damages, — the theory in such cases being that damages are liquidated at such time as the royalty would have been due, if the defendant had elected to purchase instead of to infringe the right to the use of the invention in suit, but that no interest is due on damages measured otherwise than by royalty, because such damages are unliquidated until they are ascertained by an action. But the latter part of this rule is subject to

exceptions, and in equity the allowance of interest appears to have been left largely to the discretion of the court. On reason, it is difficult to conceive why, where a patentee's loss is ascertained to have been incurred at a certain time, interest should not begin to run from that time, whether the loss was measured by a royalty or by other equally conclusive evidence of the fact." See also *Bates v. St. Johnsbury & L. C. R. R. Co.* (1887), 32 Fed. Rep. 628. As the account of profits in equity is based on an entirely different theory, the rule there may well be different. See § 1152 and notes, *post*.

³ In this case the damages are truly unliquidated, and cannot be ascertained until the verdict, and then by an arbitrary decision based on such evidence as may be offered. The period of damage terminates only at the commencement of the suit and the amount of loss to the plaintiff now becomes a definite and interest-bearing sum. In this respect the infringement resembles trespasses to person or property, in actions for which no interest is awarded.

⁴ That interest on damages from the date of suit may be recovered, see *May v. County of Fond du Lac* (1886), 27 Fed. Rep. 691; *McCormick v. Seymour* (1851), 2 Blatch. 240.

§ 1067. ¹ In *Teese v. Huntingdon*

curred, not in consequence of the infringement, but of the defendant's neglect or refusal to make compensation for the injury without a suit, and such of the items of expense as are legally chargeable to the defendant are taxable against him among the costs. The power, given to the court, of increasing the damages in certain cases, enables it to protect the plaintiff against serious loss in this respect, and to punish the defendant for any wanton and unreasonable defiance of the plaintiff's claims.²

§ 1068. **Nominal Damages: when Recoverable.**

When the plaintiff fails to prove an established license fee, or a depreciation of the value of his exclusive use by the infringement, he can recover only nominal damages.¹ Even

(1859), 23 How. 2, Clifford, J.: (8) "Counsel fees are not a proper element for the consideration of the jury in the estimation of damages in actions for the infringement of a patent right. That point has been directly ruled by this court, and is no longer an open question. Jurors are required to find the actual damages incurred by the plaintiff at the time his suit was brought; and if, in the opinion of the court, the defendant has not acted in good faith, or has caused unnecessary expense and injury to the plaintiff, the court may render judgment for a larger sum, not exceeding three times the amount of the verdict." See also *Parks v. Booth* (1880), 102 U. S. 96; 17 O. G. 1089; *Philp v. Nock* (1873), 17 Wall. 460; *Bancroft v. Acton* (1870), 7 Blatch. 505; *Blanchard's Gun Stock Turning Factory v. Warner* (1848), 1 Blatch. 258; *Stimpson v. Railroads* (1847), 1 Wall. Jr. 164; 2 Robb, 595; *Whittemore v. Cutter* (1813), 1 Gallison, 429; 1 Robb, 40.

That expenses of suit are never allowed in assessing damages or profits, see *Parks v. Booth* (1880), 102 U. S. 96; 17 O. G. 1089; *Holbrook v. Small*

(1878), 17 O. G. 55; 3 Bann. & A. 625; *Philp v. Nock* (1873), 17 Wall. 460; *Parker v. Hulme* (1849), 1 Fisher, 44; *Blanchard's Gun Stock Turning Factory v. Warner* (1848), 1 Blatch. 258; *Stimpson v. Railroads* (1847), 1 Wall. Jr. 164; 2 Robb, 595.

² That when a verdict included counsel fees and expenses, and no exception was taken, the verdict was allowed to stand, as the court would reach the same result by increasing the damages, see *Stimpson v. Railroads* (1847), 1 Wall. Jr. 164; 2 Robb, 595.

§ 1068. ¹ That unless some measure of actual damages is clearly proved, only nominal damages can be awarded, see *National Car Brake Shoe Co. v. Terre Haute Car & Mfg. Co.* (1884), 28 O. G. 1007; 19 Fed. Rep. 514; *Faulks v. Kamp* (1882), 10 Fed. Rep. 675; 22 O. G. 2244; *Fisk v. West, Bradley, & Cary Mfg. Co.* (1880), 19 O. G. 545; *Ingersoll v. Musgrove* (1878), 13 O. G. 966; 14 Blatch. 541; 3 Bann. & A. 304; *Robertson v. Blake* (1876), 94 U. S. 728; 11 O. G. 877; *Philp v. Nock* (1873), 17 Wall. 460; *Campbell v. Barclay* (1870), 5 Bissell, 179; *Poppenhusen v. New York Gutta Percha*

when actual damages are clearly shown, nominal damages alone may be awarded if the defendant has been misled by the plaintiff under circumstances out of which a complete estoppel to the action does not arise.² A jury have no power to go beyond the evidence in this particular, and give substantial damages where nominal damages only are appropriate. Such an error in their verdict is a fatal one, and cannot be cured by a *remittitur*, but the verdict must be set aside by the court and a new trial ordered.³ A verdict for excessive actual damages, when actual damages are proper, can, however, be accepted, and upon a suitable *remittitur* be made the basis of a judgment, though no objection to a verdict on this ground will be regarded unless the excess is evident.⁴

Comb Co. (1858), 2 Fisher, 62. See also § 1071, and notes, *post*.

That if the plaintiff has claimed a close monopoly and the defendants show that he did not preserve it, he must prove a license fee or he can recover only nominal damages, see *Burdell v. Denig* (1865), 2 Fisher, 588.

That if open methods are equally cheap and useful, and no license fee is proved, only nominal damages are allowed, see *Black v. Thorne* (E. 1883), 111 U. S. 122; 27 O. G. 415. But see § 1062, note 7, *ante*.

That only nominal damages are allowed where the license offered to show the measure of damages covers two patents, one of which is void, and the value of the infringement of the other is not proved, see *Moffitt v. Cavanagh* (1886), 27 Fed. Rep. 511.

That when only one Claim of the patent is found valid, and no license fee is proved therefor, only nominal damages can be awarded, see *Proctor v. Brill* (1880), 4 Fed. Rep. 415.

That nominal damages alone are recoverable where only certain Claims of the patent, and those of little importance, were infringed, see *Moffitt v. Cavanagh* (1886), 27 Fed. Rep. 511.

That mere nominal damages should

not be allowed if the invention is valuable, though the question of actual damages is difficult to settle, see *Graham v. Geneva Lake Crawford Mfg. Co.* (1885), 32 O. G. 1603; 24 Fed. Rep. 642.

That for the mere making without sale or use only nominal damages are allowed, see *Carter v. Baker* (1871), 4 Fisher, 404; 1 Sawyer, 512; *Whittemore v. Cutter* (1813), 1 Gallison, 429; 1 Robb, 28; *Whittemore v. Cutter* (1813), 1 Gallison, 478; 1 Robb, 40.

² That where the defendant has been misled by the plaintiff, only nominal damages will be allowed, see *Adams v. Edwards* (1848), 1 Fisher, 1.

That only nominal damages are allowed unless the plaintiff's device was stamped or due notice was given, see *McComb v. Brodie* (1872), 5 Fisher, 384; 2 O. G. 117; 1 Woods, 153.

That no damages can be awarded for infringements to which the plaintiff consented, see *Westlake v. Cartter* (1873), 6 Fisher, 519; 4 O. G. 636.

³ That where the court instructs the jury to give only nominal damages and they obstinately give more, a new trial must be had, and the error is not cured by *remittitur*, see *Johnson v. Root* (1862), 2 Fisher, 291.; 2 Clifford, 108.

⁴ That where the verdict was exces-

§ 1063. Increase of Damages by the Court.

In order to provide for cases in which a verdict for the actual damages sustained would not afford complete redress to the plaintiff, the law empowers the court to increase the award of the jury to an amount not exceeding three times that fixed by the verdict.¹ This is distinctively the province of the court, and confers no authority upon the jury, on any ground, to transcend the limits of the actual damages which have been established by the evidence.² The court exercises this power principally in cases of wanton infringement, or where the defendant has compelled the plaintiff to resort to needless and expensive litigation.³ Where the plaintiff is a mere assignee for speculative purposes and not a *bona fide* user of the invention,⁴ or where the defendant has acted in

sive and it appeared that the defendant infringed wantonly, no new trial was allowed, but the damages were reduced by a *remittitur*, and then increased by the court, see *Russell v. Place* (1871), 5 Fisher, 134; 9 Blatch. 173.

That damages are not considered excessive unless clearly too great, see *Allen v. Blunt* (1846), 2 W. & M. 121; 2 Robb, 530; *Whitney v. Emmett* (1831), Baldwin, 303; 1 Robb, 567. See also §§ 1052, 1053, and notes, *ante*.

§ 1069. ¹ Sec. 4919, Rev. Stat. 1874.

That where a license fee is the measure of damages, the court may increase the amount, see *Clark v. Wooster* (1886), 119 U. S. 322; 37 O. G. 1477.

² That the verdict of the jury must be confined to the actual damages, and the court may then treble them, see *Judson v. Bradford* (1878), 16 O. G. 171; 3 Bann. & A. 539; *Birdsall v. Coolidge* (1876), 93 U. S. 64; 10 O. G. 748; *Smith v. Higgins* (1859), 1 Fisher, 537; *Ransom v. Mayor of New York* (1856), 1 Fisher, 252; *Gray v. James* (1817), Peters, C. C. 394; 1 Robb, 120; *Whittemore v. Cutter* (1813), 1 Gallison, 478; 1 Robb, 40.

³ That the discretion to treble damages was given to the court to most cases of wilful wrong where the jury did not give enough, see *Russell v. Place* (1871), 5 Fisher, 134; 9 Blatch. 173; *Merchant v. Lewis* (1857), 1 Bond, 172; *Motte v. Bennett* (1849), 2 Fisher, 642.

That the damages are to be trebled where the invention is valuable, the piracy wanton, the litigation expensive, and the verdict small, see *Schwarzal v. Holensshade* (1866), 3 Fisher, 116; 2 Bond, 29.

That the court can increase the damages found by the verdict, but should exercise this power only when the plaintiff is compelled to vindicate himself against wanton and persistent infringement, see *Brodie v. Ophir Silver Mining Co.* (1867), 4 Fisher, 137; 5 Sawyer, 608. See also *Lyon v. Donaldson* (1888), 34 Fed. Rep. 789.

That damages will be increased if the defendant perseveres in the infringement after notice, or combines with others to resist the plaintiff's suit, see *Peek v. Frame* (1871), 5 Fisher, 113; 9 Blatch. 194.

⁴ In *Schwarzal v. Holensshade* (1866), 3 Fisher, 116; *Leavitt, J.*: (119)

good faith, or under the protection of a rival patent, the plaintiff will be left to the compensation given him by the jury.⁵

“Cases may be readily conceived in which it would be the imperative duty of a court to exercise the discretion given by the statute, by increasing the damages. It has happened, and may occur again, that a meritorious inventor of a valuable improvement, after spending years of patient thought and toil in making it practically useful, and obtaining a patent for it, has been wantonly and unjustly pirated upon, and compelled for the establishment of his rights to engage in long, vexatious, and expensive litigation, in which, at last, the sum that may be awarded by the verdict of a jury may be wholly inadequate as a compensation for the wrongs and injuries he has sustained. In such a case the instincts of justice would demand of a judge that he should exercise the discretion vested in him by law, by trebling the damages and thus as far as practicable doing justice to one who, from the great utility of his invention, may be entitled to the name of a public benefactor. But clearly there is no such feature in the present case. The plaintiff has no claim or merit as an inventor, but is the mere assignee of a patented machine, the right to which he has purchased on speculation. The law under such circumstances will give him the actual damages which his evidence shows he has sustained, but will give him nothing more.” 2 Bond, 29 (33).

That power is given to the court to treble the damages in order to remunerate patentees who are compelled to sustain their patents against malicious infringers, not to benefit mere collectors on expired patents, see *Bell v. McCullough* (1853), 1 Fisher, 380; 1 Bond, 194.

⁵ In *American Nicholson Pavement Co. v. City of Elizabeth* (1874), 6 O. G. 764, Nixon, J.: (770) “It is proper to

premise that there is nothing in the case which authorizes the court, if it had the power and were so disposed, to visit upon the defendants any consequences in the nature of a penalty. They were not wanton infringers. They were proceeding under an authority equal on its face to that of complainant, to wit, a patent from the Government of the United States, and they had a right to assume that it was valid until a competent tribunal declared to the contrary. They are not to be treated like another class of infringers—unhappily too large—who, without a pretext of right, seize upon the inventions or property of others, and trust to the ignorance, or the poverty, or the kind-heartedness of the owners, for immunity in retaining their piratical gains. All that the defendants should be required to do in the present case is simply to restore to the complainant the money which the use of its property had enabled them to make.” 1 Bann. & A. 439 (457). See also *Adams v. Edwards* (1849), 1 Fisher, 1.

That where the defendant believed himself to be in the right, the damages will not be increased on the ground that he stoutly contested the case, see *Welling v. La Bau* (1888), 35 Fed. Rep. 302.

That the good faith of the infringer is a reason for not increasing the damages, see *Hogg v. Emerson* (1850), 11 How. 587.

That the ignorance of the infringer may be considered, see *Parker v. Hulme* (1849), 1 Fisher, 44.

Among the above are cases in which it was held that the facts named might lessen the damages. If this implies that actual damages may be reduced in view of the defendant's good faith, &c., the position is not sustainable, the plaintiff

An increase may be made in proper cases though no costs could be allowed on account of a disclaimer pending suit.⁶

§ 1070. Distribution of Damages Recovered among Different Plaintiffs.

Where there are several plaintiffs, each entitled to his individual proportion of the damages recovered, no mention of the share of each is necessary in the verdict.¹ The entire sum may be awarded in gross and paid by the defendant upon the execution or into court, and from this sum the different plaintiffs will receive their respective amounts.² In a suit by one part owner against another the plaintiff is entitled only to such a portion of the actual damages as is commensurate with his interest in the patent.³ The damages recovered in a suit by an executor belong to the estate if the infringement occurred during the life of his testator, but if after his death to those equitable owners of the patent of whom the executor is the representative.⁴

§ 1071. Burden of Proof on the Question of Damages.

The burden of proof in reference to the existence and amount of damages resting upon the plaintiff, he must produce sufficient evidence to satisfy the jury that he has sustained actual damages, and must furnish the necessary data for their computation, before the defendant can be required to

being entitled to compensation without regard to the motive of the defendant. But the discretion of the court to increase the damages may properly be governed by these and similar considerations.

⁶ That courts may increase the damages even where no costs can be allowed because no disclaimer was filed, see *Guyon v. Serrell* (1847), 1 Blatch. 244.

§ 1070. ¹ That a recovery by joint plaintiffs is in proportion to their respective interests, see *Campbell v. James* (E. 1880), 18 O. G. 1111; 18 Blatch. 92; 5 Bann. & A. 354; 2 Fed. Rep. 338.

² That where several plaintiffs in interest recover in equity, the court will

allow the defendant to pay the gross sum into the registry instead of his share to each, see *Campbell v. James* (E. 1880), 18 O. G. 1111; 2 Fed. Rep. 338; 18 Blatch. 92; 5 Bann. & A. 354.

³ That part owners suing each other for infringement recover in proportion to their respective interests, see *Herring v. Gas Consumers Association* (E. 1878), 9 Fed. Rep. 556; 21 O. G. 203; 13 O. G. 637; 3 McCrary, 206; 3 Bann. & A. 253.

⁴ That the damages recovered in a suit by an executor belong to the estate, see *Goodyear v. Providence Rubber Co.* (1864), 2 Fisher, 499; 2 Clifford, 351.

offer anything whatever on the subject.¹ While the plaintiff's case on this point remains unproved, irregularities in the

§ 1071. ¹ In *New York v. Ransom* (1859), 23 How. 487, Grier, J. : (488) "Where a plaintiff is allowed to recover only actual damages, he is bound to furnish evidence by which the jury may assess them. If he rest his case after merely proving an infringement of his patent, he may be entitled to nominal damages, but no more. He cannot call on a jury to guess out his case without evidence. Actual damages must be calculated, not imagined, and an arithmetical calculation cannot be made without certain data on which to make it."

Further, that the plaintiff must affirmatively show the amount of his loss or give the jury sufficient data from which to compute it, see *Rude v. Westcott* (1889), 130 U. S. 152; *Bell v. U. S. Stamping Co.* (1887), 32 Fed. Rep. 549; *Tuttle v. Gaylord* (1886), 36 O. G. 694; 28 Fed. Rep. 97; *Cornely v. Marckwald* (1885), 32 Fed. Rep. 292; 23 Blatch. 163; *National Car Brake Shoe Co. v. Terre Haute Car & Mfg. Co.* (1884), 19 Fed. Rep. 514; 28 O. G. 1007; *Maier v. Brown* (1883), 17 Fed. Rep. 736; *Fitch v. Bragg* (1883), 16 Fed. Rep. 243; 21 Blatch. 302; *Calkins v. Bertrand* (1881), 8 Fed. Rep. 755; 10 Bissell, 445; *Garretson v. Clark* (1879), 16 O. G. 806; 4 Bann. & A. 536; *Ingersoll v. Musgrove* (1878), 13 O. G. 966; 14 Blatch. 541; 3 Bann. & A. 304; *Gould's Mfg. Co. v. Cowing* (1877), 3 Bann. & A. 75; 12 O. G. 942; 14 Blatch. 315; *Robertson v. Blake* (1876), 94 U. S. 728; 11 O. G. 877; *Buerk v. Imhaeuser* (1876), 10 O. G. 907; 14 Blatch. 19; 2 Bann. & A. 452; *Gould's Mfg. Co. v. Cowing* (1874), 8 O. G. 277; 12 Blatch. 243; 1 Bann. & A. 875; *Philp v. Nock* (1873), 17 Wall. 460; *Carter v. Baker* (1871), 4 Fisher, 404; 1 Sawyer, 512; *Campbell v. Barelay* (1870), 5 Bissell,

179; *Schwarzel v. Holenshade* (1866), 3 Fisher, 116; 2 Bond, 29; *Goodyear v. Bishop* (1861), 2 Fisher, 154; *Poppenhusen v. New York Gutta Percha Comb Co.* (1858), 2 Fisher, 62.

That the burden of proof rests on the plaintiff to show the amount of profits made by the defendant from the infringement, see *Tilghman v. Proctor* (1888), 125 U. S. 136; 43 O. G. 628; *Faulks v. Kamp* (1882), 10 Fed. Rep. 675; 22 O. G. 2244; *Kirby v. Armstrong* (1881), 5 Fed. Rep. 801; 19 O. G. 661; 10 Bissell, 135; *Garretson v. Clark* (1879), 16 O. G. 806; 4 Bann. & A. 536; *Black v. Munson* (1877), 14 Blatch. 265; 2 Bann. & A. 623; *Robertson v. Blake* (1876), 94 U. S. 728; 11 O. G. 877; *Buerk v. Imhaeuser* (1876), 2 Bann. & A. 452; 10 O. G. 907; 14 Blatch. 19.

That unless the plaintiff shows what profits are due to his exact invention, only nominal damages can be recovered, see *Byerly v. Cleveland Linsced Oil Works* (1887), 31 Fed. Rep. 73; *Roemer v. Simon* (1887), 40 O. G. 1456; 31 Fed. Rep. 41; *Bostock v. Goodrich* (1885), 34 O. G. 1047; 25 Fed. Rep. 819; *Garretson v. Clark* (1884), 111 U. S. 120; 27 O. G. 524; *National Car Brake Shoe Co. v. Terre Haute Car & Mfg. Co.* (1884), 28 O. G. 1007; 19 Fed. Rep. 514; *Kirby v. Armstrong* (1881), 19 O. G. 661; 10 Bissell, 135; 5 Fed. Rep. 801; *Gould's Mfg. Co. v. Cowing* (1877), 12 O. G. 942; 14 Blatch. 315; 3 Bann. & A. 75; *Gould's Mfg. Co. v. Cowing* (1874), 8 O. G. 277; 12 Blatch. 243; 1 Bann. & A. 375; *Burdell v. Denig* (1865), 2 Fisher, 588.

That a plaintiff must show what profits or damages are attributable to the infringing design, see *Dobson v. Dornan* (1886), 118 U. S. 10; 35 O.

rejection or reception of the defendant's evidence are, therefore, of no consequence and cannot be made the occasion for review on writ of error.² But the plaintiff is not obliged to produce such testimony as removes all reasonable doubt. The inquiry is to be conducted on the same principles as any other investigation into an amount of damages, and especially when the infringement has been wilful must the evidence be liberally interpreted in favor of the plaintiff.³ After he has shown that his entire loss has resulted from the infringement, and has refuted all the defendant's suggestions as to contributory causes, he is not obliged to controvert all other possible causes and exclude every hypothesis except that which he maintains.⁴

§ 1072. Order in which Evidence is Produced in Court.

When the pleadings are closed upon the general issue, whether with or without notice, the plaintiff goes forward at the trial, and must introduce the evidence required to make out a *prima facie* case upon all the averments in his declaration. The letters-patent, or a certified copy thereof, being

G. 750; *Dobson v. Dornan* (1885), 114 U. S. 439; 31 O. G. 786.

That there is no presumption that all the defendant's goods infringed because some did, see *National Car Brake Shoe Co. v. Terre Haute Car & Mfg. Co.* (1884), 19 Fed. Rep. 514; 28 O. G. 1007.

² That the defendant's evidence is of no consequence until the plaintiff establishes his claim to profits or damages, and objections to its admissibility will not be considered, see *Garretson v. Clark* (1878), 14 O. G. 485; 15 Blatch. 70; 3 Bann. & A. 352; *Black v. Munson* (1877), 14 Blatch. 265; 2 Bann. & A. 623.

³ That the plaintiff is entitled to substantial damages if he furnishes reasonably satisfactory evidence, see *National Car Brake Shoe Co. v. Terre Haute Car & Mfg. Co.* (1884), 19 Fed. Rep. 514; 28 O. G. 1007.

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That where wanton infringers conceal their profits, and the plaintiff gives some available evidence as to the amount, he may recover them, see *Creamer v. Bowers* (E. 1888), 35 Fed. Rep. 206.

That in cases of wilful infringement the defendant is held to rigid accountability, and there is no presumption in his favor as to the inconclusiveness of the plaintiff's proof, but such proof is interpreted liberally for the plaintiff, see *Bigelow Carpet Co. v. Dobson* (1882), 21 O. G. 1200; 10 Fed. Rep. 385; 15 Phila. 476.

⁴ That after the plaintiff has shown that the defendant's infringement had caused his entire damage, and has refuted all the defendant's suggestions as to contributory causes, he need not disprove all possible causes not claimed as existing, see *Fitch v. Bragg* (1883), 16 Fed. Rep. 243; 21 Blatch. 302.

produced and offered, sufficiently prove their own validity as well as the patentability of the invention.¹ Some writers, indeed, assert that in addition to the patent extraneous testimony of the novelty and utility of the invention, and of the completeness and precision of the specification, should be presented; but the courts having held that the patent is *prima facie* evidence on these points, it would seem to be unnecessary though frequently practised. The plaintiff must then prove his title, either by the patent if he is the patentee, or by the proper documentary evidence if he is an assignee or grantee.² Evidence of the performance of the infringing acts by the defendant, and of the identity of the invention which he sells or uses with that covered by the plaintiff's patent, must be also laid before the jury, and the data given for an estimate of the damages sustained.³ To this evidence the defendant must reply by counter-proof, either in whole or in part, according to the number and nature of his defences. The plaintiff follows with testimony rebutting the new matter disclosed by the defendant, or supporting the *prima facie* presumptions of his patent against the denials or evasions of his adversary. When the defendant files a special plea on which issue is joined, the order of procedure is reversed. Such special plea admits all allegations in the declaration which it does not specifically or impliedly dispute. The defendant, therefore, first offers evidence in pursuance of his plea, to which the plaintiff replies by testimony appropriate to the issue, and the defendant in rebuttal controverts the plaintiff's proof. The rule regarding the burden of proof upon the different questions involved in the action is the same, whatever form the pleadings may assume or in whatever order the evidence may be introduced.

§ 1073. Nonsuit not Ordered in Federal Courts: Equivalent Procedure.

The Federal courts have no authority to order a nonsuit of the plaintiff, though his evidence may be plainly insufficient

§ 1072. ¹ See §§ 1016, 1018, and notes, *ante*.

³ See §§ 1041-1048, 1071, and notes, *ante*.

² See § 1040 and notes, *ante*.

to warrant a verdict in his favor, but must submit the issue to the jury on such proof as has been offered.¹ The defendant may, however, request the court to instruct the jury that the testimony will not support a verdict for the plaintiff, and a refusal of the request in cases where it should be granted is a ground of error.² If the jury disregard this instruction and render a verdict for the plaintiff, the court cannot accept it, but must set it aside and order a new trial.³ But when any evidence is introduced by the plaintiff which could, in the reasonable and legal judgment of a jury, tend to support the plaintiff's cause, whether the judge would consider it sufficient as a guide to his own conclusions or not, it must be submitted to them, and their verdict on it, if otherwise correct, must be received.⁴

§ 1073. ¹ That the Federal courts cannot order a nonsuit, see *Castle v. Bullard* (1859), 23 How. 172; *Silsby v. Foote* (1852), 14 How. 218; *Foote v. Silsby* (1849), 1 Blatch. 445; *Crane v. Morris* (1832), 6 Peters, 598; *De Wolf v. Rabaud* (1828), 1 Peters, 476; *Elmore v. Grymes* (1828), 1 Peters, 469.

That if the plaintiff is guilty of fraud against the defendant it is no ground for a nonsuit, but the jury may give nominal damages, see *Reutgen v. Kanowrs* (1804), 1 Wash. 168; 1 Robb, 1.

² That upon a demurrer to evidence in an action at law the judge must decide whether the plaintiff has made out a *prima facie* case, and if not must charge the jury to find for the defendant, see *Royer v. Schultz Belting Co.* (1886), 28 Fed. Rep. 850; 38 O. G. 898; *Millner v. Schofield* (1881), 4 Hughes, 258; *Bevans v. United States* (1871), 13 Wall. 56.

That to refuse to instruct the jury to find for the defendant when the plaintiff has not made out a *prima facie* case is error, see *Torrent & Arms Lumber Co. v. Rodgers* (1884), 112 U. S. 659; 30 O. G. 449; *Curtis, Jur. Courts U. S.* 222.

That where a patent is manifestly

void it is the duty of the court to charge the jury to return a verdict for the defendant, and failure so to charge is error, see *Torrent & Arms Lumber Co. v. Rodgers* (1884), 112 U. S. 659; 30 O. G. 449.

³ That where the jury without sufficient evidence against the defendant, render a verdict for the plaintiff, the verdict should be set aside and a new trial granted, see *Wilson v. Janes* (1854), 3 Blatch. 227.

⁴ In *Roberts v. Schuyler* (1875), 12 Blatch. 444, Shipman, J.: (447) "It is true that the same weight is not given by courts to the verdict of a jury upon the validity of a patent which is justly given to the opinion of a jury upon other questions of fact. The subject-matter involved often requires a patient and quiet examination of different structures, and an investigation of the modes of operation of machinery, for which the hurried and imperfect scrutiny which the jury can give during the trial of a case is sometimes inadequate. The result often depends more upon the examination of machines or structures than upon the testimony of witnesses. And yet, notwithstanding the fact that less weight and

§ 1074. Charge to the Jury: Requests: Exceptions.

The charge of the judge to the jury must arise out of and be limited to the questions in controversy and the evidence produced, and must be sufficiently full and clear to serve them as an intelligible guide in arriving at their verdict.¹ General abstract discussions are improper.² Either party may request the judge to give certain instructions, and if this request is not complied with the instructions are regarded as refused.³ Unless such requests are made, the court is bound to notice only the points made by either party on the trial.⁴ When the request is granted it is not essential that the exact form of the desired instruction should be followed, if the instruction actually given comports with the justice of the case and

authority is given to the decision of a jury in this class of cases than in other civil causes, it is equally true that the verdict of a jury is not to be set aside merely because the court might have arrived at a different conclusion. Unless the court can see that the jury was palpably mistaken, and that the weight of evidence is decidedly against their verdict, it should not be set aside. Otherwise the court enters upon the province of the jury, and passes beyond the limit of its own duty. At the same time, when it is manifest that juries have been warped from the direct line of their duty by mistake, prejudice, or even by an honest desire to reach the supposed equity, contrary to the law of the case, it will be the duty of the court to set the verdict aside." 2 Bann. & A. 5 (8). See also *Aiken v. Bemis* (1847), 3 W. & M. 348; 2 Robb, 644; *Brooks v. Bicknell* (1845), 4 McLean, 70.

That if there is evidence on both sides of the issue, the matter must be submitted to the jury unless the court would set aside the verdict as against evidence if they decided contrary to its judgment, see *Keyes v. Grant* (1886,) 118 U. S. 25; 35 O. G. 747.

§ 1074. ¹ That the instructions of the court must be sufficient to enable

the jury to arrive at a proper verdict, see *Morris v. Platt* (1864), 32 Conn. 75; *Waters v. Bristol* (1857), 26 Conn. 398; 3 Chitty, Gen. Prac. pp. 911-916.

That the court should instruct the jury that the burden of proof as to novelty, after the patent is in evidence, is on the defendant, see *Allen v. Blunt* (1846), 2 W. & M. 121; 2 Robb., 530.

That where the court would set aside a verdict, if given for the plaintiff, it should instruct the jury to find for the defendant, see *Royer v. Schultz Belt- ing Co.* (1886), 29 Fed. Rep. 281.

² That abstract discussions in the charge should be avoided, see *Gayler v. Wilder* (1850), 10 How. 477; *Allen v. Blunt* (1846), 2 W. & M. 121; 2 Robb, 530; *Pitts v. Whitman* (1843), 2 Story, 609; 2 Robb, 189.

³ That failure to comply with requests to charge is equivalent to a refusal, see *Emerson v. Hogg* (1845), 2 Blatch. 1.

⁴ That the failure of the court to charge on special points not essential to the understanding of the case is not error unless requests to that effect were made, see *Pennock v. Dialogue* (1829), 2 Peters, 1; 1 Robb, 542.

affords the jury an opportunity to render a proper verdict.⁶ A refusal to give desired instructions may be taken advantage of on writ of error, but the exception must be noted at the time, so that the error can be corrected while the jury are at bar, or the objection will be waived.⁶

§ 1075. Questions of Law : Questions of Fact.

Under each of the twenty-five enumerated defences certain questions arise whose decision is within the province of the court, while others are to be determined by the jury. The general distinction between these is that which always separates matters of law from matters of fact, but their particular characteristics are best comprehended when they are stated in connection with the defences in which they arise. On the first defence, which denies that the invention originated in an inventive act, the court defines the nature of an inventive act and of its result; the jury decide whether the patented invention is due to such an act and corresponds with such result.¹ On the second defence, which admits that the

⁶ That the court is not bound to instruct the jury as counsel request if the instruction given is correct, see *Pitts v. Whitman* (1843), 2 Story, 609; 2 Robb, 189.

That a court having given the jury all needed instructions may decline to give special instructions as requested, see *Winans v. New York & Harlem R. R. Co.* (1855), 4 Fisher, 1.

That in a suit at law on a question of priority the counsel cannot require that the court, on inspecting rival patents, shall instruct the jury, as matter of law, that they are or are not identical, see *Bischoff v. Wethered* (1869), 9 Wall. 812.

⁶ That errors or refusals not excepted to at the time are waived, see *Allen v. Blunt* (1846), 2 W. & M. 121; 2 Robb, 530; *Emerson v. Hogg* (1845), 2 Blatch. 1.

§ 1075. ¹ The performance of an inventive act is determined largely by

comparing the alleged invention with inventions previously known, and ascertaining its substantial identity with or diversity from them. This is a matter for the jury under the direction of the court. Thus in *Tucker v. Spalding* (1872), 13 Wall. 453, Miller, J. : (455) "Whatever may be our personal opinions of the fitness of the jury as a tribunal to determine the diversity or identity in principle of two mechanical instruments, it cannot be questioned that when the plaintiff, in the exercise of the option which the law gives him, brings his suit in the law in preference to the equity side of the court, that question must be submitted to the jury if there is so much resemblance as raises the question at all. And though the principles by which the question must be decided may be very largely propositions of law, it still remains the essential nature of the jury trial that while the court may, on this mixed question

invention originated in an inventive act, but denies the performance of that act by the alleged inventor and asserts that he has surreptitiously appropriated to himself the fruit of another's inventive skill, the court describes the attributes of an inventive act; the jury determine whether the alleged inventor has performed this act, or has derived his idea of the invention from the true inventor.² On the third defence, which admits that an inventive act resulting in the patented invention has been performed by the alleged inventor, but avers that the same act had previously been performed by a different inventor, who had already reduced it to practice, or who was using reasonable diligence in its reduction, the court declares at what stage of its development the conception of an idea of means becomes complete, and what diligence the law requires of the inventor in perfecting it; the jury find whether the complete conception of the invention by the supposed prior inventor anticipated that of the plaintiff's inventor, and whether the former, if the first conceiver, had reduced it to practice before its production by the latter, or was then reducing it with such diligence as the law demands.³ On the fourth defence, which denies that the invention patented is embraced in either of the six classes made patentable by the Acts of Congress, the court determines from the patent what the character of the invention is, and from the law whether it is included in the protected classes; the duty of the jury is to render a verdict in pursuance of this finding of the court, unless the patent employs terms of art upon whose meaning

of law and fact, lay down to the jury the law which should govern them, so as to guide them to truth and guard them against error, and may if they disregard instructions set aside their verdict, the ultimate response to the question must come from the jury." 5 Fisher, 297 (300); 1 O. G. 144 (145).

See also Tyler v. Boston (1868), 7 Wall. 327; Turrill v. Railroad Co. (1863), 1 Wall. 491; Battin v. Taggart (1854), 17 How. 74; Tatham v. Le Roy (1852), 2 Blatch. 474; Reutgen v.

Kanowrs (1804), 1 Wash. 168; 1 Robb, 1.

² That the jury are to determine by whom an inventive act was performed, see Gray v. Halkyard (1886), 28 Fed. Rep. 854; 38 O. G. 784; Reutgen v. Kanowrs (1804), 1 Wash. 168; 1 Robb, 1.

³ That priority of invention is a question of fact, see Gray v. Halkyard (1886), 28 Fed. Rep. 854; 38 O. G. 784; Reutgen v. Kanowrs (1804), 1 Wash. 168; 1 Robb, 1.

they must also pass.⁴ On the fifth defence, which denies the novelty of the invention, the court defines the attributes of novelty and the essential qualities of a prior use or prior publication, and decides whether the Claims of a prior patent cover the same invention as the one in suit; the jury find whether the patent, or the publication, or the use, existed in such a manner as to render the invention accessible to the public before it was conceived by the alleged inventor.⁵ On the sixth defence, which denies the utility of the invention, the court declares in what utility consists, and where the patented invention is manifestly frivolous or injurious to the public directs the jury to find accordingly; otherwise the jury determine whether the invention is practically available for any useful purpose.⁶ On the seventh defence, which asserts

⁴ So far as this question involves the character of the patented invention as a simple art, machine, manufacture, composition, design, or improvement, it may nearly always be considered as mainly a question of law; the answer consisting in a definition of the patentable class and an interpretation of the Claims of the patent, with a submission of the question to the jury under such instructions as this definition and interpretation require. See *Bischoff v. Wethered* (1869), 9 Wall. 812; *Teese v. Phelps* (1855), 1 McAllister, 17. When the invention purports to be a combination, however, additional questions are raised which are essentially questions of fact and must be passed on by the jury. Thus, that where the effect and operation of mechanical contrivances enter into a question of a combination, the question is one of law and fact for the jury to determine under the instructions of the court, see *Foot v. Silsby* (1849), 1 Blatch. 445.

That whether an invention is patentable is a mixed question of law and fact and usually is not to be settled without a jury trial unless the title is fixed by law, see *Teese v. Phelps* (1855), 1 McAllister, 17.

⁵ That novelty is a question for the jury, see *Westlake v. Cartter* (1873), 6 Fisher, 519; 4 O. G. 636; *Battin v. Taggart* (1854), 17 How. 74; *Carver v. Braintree Mfg. Co.* (1843), 2 Story, 432; 2 Robb, 141.

That the identity of prior and present inventions is a question for the jury, see *Tyler v. Boston* (1868), 7 Wall. 327; *Turrill v. Railroad Co.* (1863), 1 Wall. 491.

That whether two patents, whose specifications are not in the same terms, describe the same invention, is a question for the jury, see *Hawkes v. Remington* (1872), 111 Mass. 171; *Bischoff v. Wethered* (1869), 9 Wall. 812.

That whether the patented invention is identical with one described in a printed publication is a question for the jury, where the inventions differ on their face and in the judgment of experts, see *Keyes v. Grant* (1886), 118 U. S. 25; 35 O. G. 747; *Adams v. Bellaire Stamping Co.* (1886), 28 Fed. Rep. 360; 36 O. G. 567.

⁶ That utility is a question for the jury, see *Westlake v. Cartter* (1873), 6 Fisher, 519; 4 O. G. 636. *Doubted*: *Langdon v. De Groot* (1822), 1 Paine, 203; 1 Robb, 433.

That where an invention is useless

that the inventor has abandoned the invention to the public, the court defines the doctrine of abandonment, and the presumptions that arise from public use or sale; the jury pass upon all questions of intention on the part of the inventor, on the existence and significance of the facts urged as evidence of his purpose to abandon, and on the occurrence of such instances of public sale or use as are in law conclusive evidence of an abandonment.⁷ On the eighth defence, which denies the issue of any patent corresponding with the description in the declaration, the court determines the necessary characteristics of the described patent; the jury judge whether the patent of the plaintiff is the one described.⁸ On the ninth defence, which asserts that the issue of the plaintiff's patent was in violation of the rules of law, the court declares the requisites of a legal patent so far as they are applicable to the one in suit, decides whether the patent covers a sole or joint invention, and whether the Claims of a re-issue depart from the invention attempted to be described and claimed in the original; the jury find whether the legal requisites existed, whether the invention was in fact joint or sole, and whether the invention claimed in the re-issue is identical with that which the inventor attempted to secure by his original patent.⁹ On the tenth defence the questions for the court

on its face the court may so direct the jury, see *Langdon v. De Groot* (1822), 1 Paine, 203; 1 Robb, 433.

⁷ That abandonment is a question for the jury, see *Kendall v. Winsor* (1858), 21 How. 322; *Battin v. Taggart* (1854), 17 How. 74.

That the motive for the delay in applying for a patent while the invention is in use is a question for the jury, see *Morris v. Huntington* (1824), 1 Paine, 348; 1 Robb, 448.

That the question of the continuity of an application is for the jury, see *Godfrey v. Eames* (1863), 1 Wall. 317.

That the question whether the continuity of an application is destroyed by the filing of a new application is, in an action at law, for the jury, see *Howe v. Newton* (1865), 2 Fisher, 531.

⁸ This issue may be determined in several ways. If the patent is offered in evidence and excluded, the plaintiff's case necessarily fails, and no nonsuit being permitted, the court directs a verdict for the defendant. But where the evidence, not being objected to, is submitted to the jury, the question of identity between the patent declared on and the one in evidence is in form passed upon by the jury, under the instruction of the court.

⁹ That whether the re-issue is broader than the invention attempted to be protected by the original is a question for the jury, see *Battin v. Taggart* (1854), 17 How. 74; *Carver v. Braintree Mfg. Co.* (1843), 2 Story, 432; 2 Robb, 141.

That whether a re-issue was obtained with fraudulent intent is for the jury,

and jury are the same as on the fourth, already stated. On the eleventh defence, which asserts that the description of the invention given in the patent is fraudulent, the court construes the language of the specification and points out what invention it purports to describe; the jury decide whether the actual invention is disclosed by this description, and if not, whether the concealment or redundancy resulted from an intention to deceive.¹⁰ On the twelfth defence, which asserts that the description is ambiguous, the court defines the attributes of a sufficient description and determines what interpretations can be given to the language of the one contained in the patent; the jury find whether this description so discloses the invention that persons skilled in the art can practise it from such disclosure.¹¹ On the thirteenth defence, which avers that the Claims of the patent are excessive and have not been lawfully cured by a disclaimer, the court construes the alleged excessive Claim, and fixes the standard by which the diligence of the plaintiff in filing any necessary disclaimer must be measured; the jury decide whether the Claim exceeds the limits of the actual invention, and whether the delay in filing a disclaimer is unreasonable.¹² On the fourteenth defence, which alleges the ambiguity of the Claim, the court interprets the Claim so far as it is capable of an interpretation, and declares whether an exact intelligible conception of the real character of any invention can be thence derived; the jury follow this interpretation, and if it does not,

see *Carver v. Braintree Mfg. Co.* (1843), 2 Story, 432; 2 Robb, 141.

¹⁰ That whether a specification is fraudulent is a question for the jury, see *Reutgen v. Kanowrs* (1804), 1 Wash. 168; 1 Robb, 1.

¹¹ That whether a specification would enable one skilled in the art to practise the invention is a question of fact for the jury, see *Westlake v. Cartter* (1873), 6 Fisher, 519; 4 O. G. 636; *Page v. Ferry* (1857), 1 Fisher, 298; *Battin v. Taggart* (1854), 17 How. 74; *Carver v. Braintree Mfg. Co.* (1843), 2 Story, 432; 2 Robb, 141; *Reutgen v. Kanowrs* (1804), 1 Wash. 168; 1 Robb, 1.

¹² That what is an unreasonable delay in filing a disclaimer is a mixed question of law and fact to be decided by the jury under the instructions of the court, see *McCormick v. Seymour* (1854), 3 Blatch. 209; *Hall v. Wiles* (1851), 2 Blatch. 194; *Brooks v. Bicknell* (1844), 3 McLean, 432.

That under certain circumstances the question of unreasonable delay may be a question of law only, for the court, see *Singer v. Walmsley* (1860), 1 Fisher, 558; *Seymour v. McCormick* (1856), 19 How. 96.

in the judgment of the court, clearly set forth any patentable matter, finds the patent void.¹³ On the fifteenth defence, which rests upon a surrender of the patent, the court declares the law which governs the surrender of a patent and its effect upon existing rights of action: the jury determine whether the patent of the plaintiff has thus been cancelled and destroyed. On the sixteenth defence, which asserts that the patent has been annulled or repealed, the court informs the jury of the nature and consequences of these different proceedings and the weight to be attached to the records of these judgments: the jury acting under such instructions find whether the patent is extinct or still remains in force.¹⁴ On the seventeenth defence, which denies the title of the plaintiff, the court determines the meaning and effect of the written instruments in pursuance of which he claims to be the owner of the patent; the jury pass upon the fact of the execution of such instruments by their alleged makers, and on the identity of the plaintiff with the party to whom the conveyances were made. On the eighteenth defence, which denies that the invention used by the defendant is identical with that included in the plaintiff's patent, the court defines the patented invention as indicated by the language of the Claims; the jury judge whether the invention so defined covers the art or article employed by the defendant.¹⁵ On the nineteenth defence, which asserts that the acts of the defendant in reference to the patented invention were not acts of infringement, the court declares the legal attributes of an infringing act, the circumstances under which an em-

¹³ That the court must determine whether the Claim is ambiguous, and its instructions on this point control the jury, see *Ames v. Howard* (1833), 1 Sumner, 482; 1 Robb, 689; *Barrett v. Hall* (1818), 1 Mason, 447; 1 Robb, 207.

¹⁴ As to both the fifteenth and sixteenth defences the finding of the jury must in most cases be simply *pro forma*, since the evidence is matter of record, and, being accepted and interpreted by the court in reference to the questions

at issue, constitutes such proof that no verdict departing from it could be accepted.

¹⁵ That the identity of the plaintiff's and defendant's inventions is a question for the jury, see *National Car Brake Shoe Co. v. Terre Haute Car & Mfg. Co.* (1884), 19 Fed. Rep. 514; 28 O. G. 1007; *Tyler v. Boston* (1868), 7 Wall. 327; *Battin v. Taggart* (1854), 17 How. 74; *Orr v. Burwell* (1849), 15 Ala. 378; *Reutgen v. Kanows* (1804), 1 Wash. 168; 1 Robb, 1.

ployee is or is not responsible for obedience to the commands of his employer, and what degree of complicity renders one whose act is not a complete act of infringement liable for the infringement when completed by the acts of others; the jury decide whether the defendant's acts were true infringements according to the doctrines thus declared.¹⁶ On the twentieth defence, which alleges that the term of the patent had expired before the acts the defendant were committed, the court informs the jury when the patent would expire of its own limitation, what effect would be produced upon it by a prior foreign patent to the same inventor having a shorter term, and whether the foreign patent covers the same invention as the one in suit; the jury find whether a prior foreign patent had been granted to the same inventor, or to another party in his interest, and whether the infringing act anticipated the expiration of the domestic patent as fixed by its own limitations or by the term of the foreign patent. On the twenty-first defence, which asserts that the use of the patented invention by the defendant was authorized by the owner of the patent, the court declares the legal rights of part owners or licensees, as the nature of the defence requires, interprets the effect of the instruments or contracts under which the defendant claims, and defines the acts which they empower him to perform; the jury pass upon the existence and authenticity of the conveyances, the identity of parties, and the correspondence of the defendant's acts with those permitted by his grant. On the twenty-second defence, which rests upon the Statute of Limitations, the court construes the statute; the jury decide whether the suit was instituted within the time prescribed. On the twenty-third defence, which avers that the plaintiff is estopped from pursuing his remedy against the defendant, the court explains the doctrine of estoppel, interprets any written instruments out of which an estoppel is said to have arisen, and defines any legal duty of the plaintiff by the neglect of which the defendant claims that he has been misled into the acts for which he has been sued; the jury

¹⁶ That whether the defendant infringes is a question for the jury, see *Haute Car & Mfg. Co.* (1884), 19 Fed. Rep. 514; 28 O. G. 1007; *Jackson v. National Car Brake Shoe Co. v. Terre Allen* (1876), 120 Mass. 64.

determine whether the facts alleged as the basis of the estoppel actually occurred, whether the defendant acted on them in good faith, and whether he would now be prejudiced were the plaintiff permitted to avoid them. On the twenty-fourth defence, which sets up a release of the defendant by the plaintiff, the court declares the nature and effect of a release, construes it if in writing, and if by parol gives the jury legal tests of its sufficiency; the jury find whether the release was given and whether the infringing acts of the defendant are within its operation. On the twenty-fifth defence, which claims that the cause of action has been extinguished by or merged in a former judgment, the court declares the doctrine of *res adjudicata*, and interprets the record of the previous adjudication; the jury decide whether the plaintiff and defendant were parties or privies to such judgment, and whether the present and the former suits were based upon the same infringing acts. On the question of damages the court instructs the jury in the rule of damages, and points out the inferences which they are permitted to deduce from indirect evidence; the jury, in pursuance of this rule, draw their conclusions from the data furnished by the testimony, and compute the amount of the compensation to be awarded for the plaintiff's loss.¹⁷ In reference to many of the foregoing points the spheres of the court and jury approach so closely to each other that the latter appear rather to affirm by their verdict the decision of the former than to exercise an independent judgment of their own; but with one or two exceptions which are above stated, this appearance is illusive, the jury having in all the other questions a necessary judicial function to perform. For either tribunal to assume the powers of the other in any matter of importance is a ground of error, unless the parties have precluded themselves from making the objection by treating the question during the trial as if it were presented to the authority by whom it has been decided.¹⁸

¹⁷ That the amount of damages is matter for the jury, see *National Car Brake Shoe Co. v. Terre Haute Car & Mfg. Co.* (1884), 19 Fed. Rep. 514; 28 O. G. 1007.

a question as to the nature of the invention as a question of fact for the jury, he cannot claim that the court erred by not defining it as a matter of law, see *Foots v. Silsby* (1849), 1 Blatch. 445.

¹⁸ That when the defendant treats

§ 1076. Verdict.

The verdict of the jury must follow the evidence, not their private opinion apart from the evidence, and must be based on all the testimony offered.¹ If manifestly the result of prejudice or error, or contrary to the instructions given by the court, or void for repugnancy or uncertainty, it will be set aside and a new trial ordered.² But it is not to be interfered with simply because the court would have arrived at a different conclusion from the same premises, nor because the jury have awarded larger damages than might have been expected, unless the amount is palpably extravagant, and therefore indicates corruption or mistake.³

§ 1077. Trial of Issues of Fact by the Court without a Jury.

An act of Congress passed in 1865 empowered the circuit courts to try issues of fact in civil causes without the inter-

§ 1076. ¹ In *Page v. Ferry* (1857), 1 Fisher, 298, Wilkins, J. : (316) "Your verdict, to be true, must be based on the evidence, and not according to your private belief independent of the evidence, and be based on all the evidence. A juror, as a judge of facts, should be without bias — have no friendships — be free from all favor or affections, in order to be 'no respecter of persons,' to render righteous judgment. Sometimes a juror will enter the judgment seat with his mind bent upon a particular course, irrespective of the law or the evidence. Such a course is highly dishonorable. It stains the soul with perjury, and pollutes the fountains of justice with the poison of prejudice. The jury-box, as the bench, is holy ground, and we must put off our shoes ere we tread the sacred threshold. A juror holds a highly honorable and important position in the administration of the law, and as he would value his own just self-esteem, let him cleave with pertinacity to the simple issue, and to the evidence admitted as bearing upon it. This is the only safe ground for both court and jury."

² That a verdict evidently resulting from mistake, prejudice, or a higher regard for the equities than the law of the case, will be set aside, see *Roberts v. Schuyler* (1875), 12 Blatch. 444; 2 Bann. & A. 5.

That a repugnant or uncertain verdict will be set aside, see *Stearns v. Barrett* (1816), 1 Mason, 153; 1 Robb, 97.

³ That a verdict is not set aside as against evidence merely because the court might have come to a different conclusion, see *Roberts v. Schuyler* (1875), 12 Blatch. 444; 2 Bann. & A. 5.

That a new trial for a verdict against evidence will not be granted if there was evidence on both sides, unless there has been a clear mistake or manifest abuse, see *Aiken v. Bemis* (1847), 3 W. & M. 348; 2 Robb, 644; *Brooks v. Bicknell* (1845), 4 McLean, 70.

That a verdict will not be set aside on the ground that the damages are excessive unless the excess is evident, see *Aiken v. Bemis* (1847), 3 W. & M. 348; 2 Robb, 644, and cases cited in § 1068, notes 3 and 4, *ante*, and § 1078, note 7, *post*.

vention of a jury, whenever the parties or their attorneys of record should file with the clerk a stipulation in writing to that effect.¹ In such cases the trial proceeds before the court alone, who determines all questions of law and fact, and whose finding occupies the same position as the verdict of a jury. This finding may be either general or special, at the discretion of the court. A special finding resembles a special verdict, and the decision of the court upon any question of law or fact thereby presented is reviewable in the Supreme Court of the United States.²

§ 1078. New Trials.

The Federal courts have authority to grant new trials in civil cases, in which a verdict has been rendered by a jury, for the reasons recognized by other courts of law as sufficient to warrant such proceedings.¹ These reasons consist principally of some error committed by the court or jury during the former trial, or of the discovery of new evidence by the defeated party since the former verdict. The court may err by admitting improper evidence, or rejecting admissible evidence, or by departing from the law in its instructions to the jury.² The admission of improper evidence is generally a sufficient ground for a new trial; but if the same facts have been shown by proper testimony, or if the evidence was rendered immaterial by subsequent disclosures, or if the objection though sustained is purely technical and the result of the trial was justified by the remaining correct evidence, the motion for another trial will be refused.³ A similar rule is

§ 1077. ¹ Sec. 649, Rev. Stat. 1874. Desty, Fed. Prac. 256; Judson v. Bradford (1878), 16 O. G. 171; 3 Bann. & A. 539.

² Sec. 700, Rev. Stat. 1874. Desty, Fed. Prac. 318.

That a question certified to the Supreme Court under Sec. 652, Rev. Stat. must be a question of law involving a single point, not a general question as to the whole case, see California Artificial Stone Paving Co. v. Molitor (1885), 113 U. S. 609; 31 O. G. 1044.

§ 1078. ¹ Sec. 726, Rev. Stat. 1874.

² As to the grounds of new trial in general, see 1 Graham & Waterman, N. T. Introd. 1-502; 2 Graham & Waterman, N. T. 1-50; 3 Bl. Com. pp. 378, 386-393.

³ That a new trial will not be granted on the ground of the admission of inadmissible evidence where the same facts were afterwards proved by admissible evidence, or where the erroneous evidence was rendered immaterial, or the objection was purely formal, and the

followed when the error has arisen through the rejection of admissible evidence; if its reception would have made no difference in the result, or if its place has been supplied by other testimony, its exclusion will not be sufficient ground for a new trial.⁴ An error in the charge of the court to the jury, either by submitting a question of law to their decision, or by misdirecting them on a material point, is fatal to the verdict, but a neglect to give the instructions prayed for by the defeated party does not warrant a new trial if the same ground is covered by the charge and the law governing the whole case has been correctly stated.⁵ The jury may err either by the misconduct of any or all of their number during the trial, or by departing from the law or the evidence in rendering their verdict. The former errors cannot be enumerated. They consist in acts or omissions which involve a breach of the oath taken by the jury when impanelled, and vitiate the entire subsequent proceedings.⁶ Errors in their verdict may be committed by finding for the plaintiff or defendant contrary to the evidence, or by returning a verdict for excessive damages. In the first case the verdict will be set aside; in the second the plaintiff may cure the error by entering a *remittitur*.⁷ Mistakes of the defeated party or his counsel, in not

proper evidence justified the verdict, see *Allen v. Blunt* (1846), 2 W. & M. 121; 2 Robb, 530. See this case for a full statement of the doctrine of new trials.

⁴ That the improper rejection of a witness is ground for a new trial, see *Buck v. Hermance* (1848), 1 Blatch. 322.

⁵ That the submission to the jury of a question of law, such as the construction of the patent, is ground for new trial, see *Emerson v. Hogg* (1845), 2 Blatch. 1.

That a misdirection in a material point is ground for new trial, see *Allen v. Blunt* (1846), 2 W. & M. 121; 2 Robb, 530.

That a refusal to charge as requested is no ground for a new trial if the charge as given was sufficient and correct, see *Winans v. New York & Harlem R. R.*

Co. (1855), 4 Fisher, 1; *Pitts v. Whitman* (1843), 2 Story, 609; 2 Robb, 189.

⁶ That an irregularity in the conduct of the parties or the jury, in order to obtain a new trial, must be satisfactorily proved, though it need not appear that the conduct of the party certainly influenced the jury, if it might have affected the impartiality of the proceedings, see *Johnson v. Root* (1862), 2 Fisher, 291; 2 Clifford, 108.

⁷ That a verdict against evidence may be set aside, see *Wilson v. Janes* (1854), 3 Blatch. 227.

That a verdict will not be set aside as against evidence unless the preponderance of evidence is clear, see *Brooks v. Bicknell* (1845), 4 McLean, 70.

That where there is a fair balance of evidence the verdict will not be set

properly preparing the case for trial, or in not attending to the case when called, are irremediable;⁸ and any of the foregoing errors, which came to the knowledge of the defeated party or his counsel during the former trial, and were not then excepted to, are thereby waived.⁹ A new trial may be granted for the introduction of newly discovered evidence provided the evidence is material and not cumulative, will probably change the result, and could not have been known before or during the former trial by the exercise of due diligence.¹⁰ But where the evidence was known and was not

aside unless it appears that the jury acted wrongfully in other respects, see *Milligan v. Lalancé & Grosjean Mfg. Co.* (1884), 29 O. G. 367; 21 Fed. Rep. 570.

That on a motion for a new trial on a feigned issue the proponent may have the evidence, or the substance of it, as submitted to the jury, made part of the record, and the court will determine whether the conclusions of the jury are satisfactory, see *Watt v. Starke* (1879), 101 U. S. 247; 17 O. G. 1092.

That a verdict will not be set aside for excessive damages unless they were plainly and largely beyond the injury sustained, see *Aiken v. Bemis* (1847), 3 W. & M. 348; 2 Robb, 644; *Stimpson v. Railroads* (1847), 1 Wall. Jr. 164; 2 Robb, 595; *Stephens v. Felt* (1846), 2 Blatch. 37; *Allen v. Blunt* (1846), 2 W. & M. 121; 2 Robb, 530; and cases cited in § 1068, notes 3 and 4, *ante*.

That where the damages are merely excessive the error can be cured by *remittitur*, see *Russell v. Place* (1871), 5 Fisher, 134; 9 Blatch. 173. See also § 1068, notes 3 and 4, *ante*.

⁸ That mistakes and negligence of parties and counsel are not ground for new trial, see *De Florez v. Reynolds* (1879), 16 Blatch. 397; 4 Bann. & A. 331.

⁹ That errors known to the party during the trial are waived unless excepted to, see *Allen v. Blunt* (1846), 2 W. &

M. 121; 2 Robb, 530; *Emerson v. Hogg* (1845), 2 Blatch. 1.

¹⁰ That a new trial will not be granted in order to introduce immaterial evidence, see *Spill v. Celluloid Mfg. Co.* (1884), 29 O. G. 773; 22 Blatch, 441; 22 Fed. Rep. 94; *Munson v. Mayor of New York* (1882), 22 O. G. 586; 20 Blatch. 358; 11 Fed. Rep. 72.

That the discovery of new cumulative evidence is no ground for new trial, see *Pfanschmidt v. P. H. Kelly Mercantile Co.* (1887), 41 O. G. 1501; 32 Fed. Rep. 667; *Aiken v. Bemis* (1847), 3 W. & M. 348; 2 Robb, 644; *Ames v. Howard* (1833), 1 Sumner, 482; 1 Robb, 689.

That where prior use was originally in issue, new evidence of other instances of prior use is merely cumulative, see *Blandy v. Griffith* (1873), 6 Fisher, 434.

That a new trial will be refused unless the new evidence would probably change the result, see *Starling v. St. Paul Plow Works* (1887), 41 O. G. 818; 32 Fed. Rep. 290; *Munson v. City of New York* (1882), 22 O. G. 586; 20 Blatch. 358; 11 Fed. Rep. 72; *McCloskey v. DuBois* (1881), 20 O. G. 1086; 9 Fed. Rep. 38; 20 Blatch. 7; *De Florez v. Reynolds* (1879), 16 Blatch. 397; 4 Bann. & A. 331.

That where the new evidence could by due diligence have been discovered before or during the former trial a new

produced because its materiality could not be perceived until the testimony of the adversary had been offered, the surprise affords no ground for a new trial. A continuance in order to obtain the evidence should have been requested, and if the party has seen fit to risk the issue on the proof presented, he is without a remedy.¹¹ Any party in interest who bears the expenses of the suit may move for a new trial, but such a motion once denied cannot be repeated except upon the basis of additional facts.¹²

§ 1079. Writ of Error.

A writ of error lies to the Supreme Court of the United States from the judgment of a circuit court in any action at law for an infringement, whether the trial has been conducted with or without a jury.¹ This writ is a matter of right, and the amount involved is of no consequence if the error to be corrected relates to any principle or rule of Patent Law.² The judgment must have been final, and not upon a matter

trial will be refused, see *Spill v. Celluloid Mfg. Co.* (1884), 29 O. G. 773 ; 22 Blatch. 441 ; 22 Fed. Rep. 94 ; *De Florez v. Reynolds* (1879), 16 Blatch. 397 ; 4 Bann. & A. 331 ; *Aiken v. Bemis* (1847), 3 W. & M. 348 ; 2 Robb, 644.

That the motion for a new trial on the ground of new evidence must state in detail what efforts were made to obtain the evidence for the former trial, see *Burdsell v. Curran* (1887), 31 Fed. Rep. 918 ; 42 O. G. 1167 ; *Spill v. Celluloid Mfg. Co.* (1884), 29 O. G. 773 ; 22 Blatch. 441 ; 22 Fed. Rep. 94 ; *Page v. Holmes Burglar Alarm Tel. Co.* (1880), 18 Blatch. 118 ; 5 Bann. & A. 439 ; 2 Fed. Rep. 330 ; *Barker v. Stowe* (1879), 16 O. G. 807.

That where the new evidence is of late discovery, and the excuse for delay is vague and unsatisfactory, no new trial will be allowed, see *Albany Steam Trap Co. v. Felthousen* (1886), 26 Fed. Rep. 318.

That if a new trial is granted on this

ground the mover must pay the costs of the former trial, see *Aiken v. Bemis* (1847), 3 W. & M. 348 ; 2 Robb, 644.

¹¹ That if a party is taken by surprise a continuance may be granted, but if he goes on he waives the matter of surprise, see *Ames v. Howard* (1833), 1 Sumner, 482 ; 1 Robb, 689.

¹² That a motion once rejected cannot be repeated unless on a new basis of facts, see *Gage v. Kellogg* (1886), 36 O. G. 234 ; 26 Fed. Rep. 242 ; *Matthews v. Puffer* (1882), 22 O. G. 332 ; 20 Blatch. 233.

That if a verdict is satisfactory to the court and evidence was given on both sides, a decision on a motion for a new trial will not be elaborately set out, see *Bray v. Hartshorn* (1860), 1 Clifford, 538.

§ 1079. ¹ Secs. 691, 699, 700, Rev. Stat. 1874.

² That the writ of error is matter of right, not of discretion, without regard to the amount in controversy, see *Philp v. Nock* (1871), 13 Wall. 185.

within the discretion of the court, such as a question of continuance, new trial, amendment, or costs.³ Errors in law alone can be the subject of a writ of error, and these must appear upon the record with the exceptions duly taken.⁴ Any party aggrieved by the judgment can obtain this writ, even though other parties on the same side of the cause decline to join, by stating that fact on the record.⁵ The writ must issue within two years after the entry of the final judgment, except in certain cases when the disability of the defeated party necessitates a longer period.⁶ The entire record in the circuit court must be sent to the Supreme Court, and the matters claimed as error must be properly assigned, or they will not be noticed in the court above.⁷ The Supreme Court has power to reverse or modify or affirm the judgment, and when affirming it to award the prevailing party suitable damages for the delay.⁸

³ That error lies only from a final judgment, see *Potter v. Mack* (1868), 3 Fisher, 428; *Rutherford v. Fisher* (1800), 4 Dallas, 22.

That error does not lie from a decision on any matter within the discretion of the court, see *Pomeroy v. Bank of Indiana* (1863), 1 Wall. 592; *Dean v. Mason* (1857), 20 How. 198; *Silby v. Foote* (1852), 14 How. 218.

That no error lies on the grant or refusal of a continuance, see *Livingston v. Dorgenois* (1813), 7 Cranch, 577.

That no error lies on the grant or refusal of a new trial, see *Insurance Co. v. Benton* (1871), 13 Wall. 603; *Pomeroy v. Bank of Indiana* (1863), 1 Wall. 592.

That no error lies on a decision allowing or rejecting an amendment, see *Pickett v. Legerwood* (1833), 7 Peters, 144; *Walden v. Craig* (1824), 9 Wheaton, 576.

That no error lies on a decision regarding costs unless they exceed \$2000, see *Sizer v. Many* (1853), 16 How. 98.

⁴ That errors in law alone can be noticed on writ of error, see *Miles v.*

United States (1880), 103 U. S. 304; *United States v. Goodwin* (1812), 7 Cranch, 108.

That no error can be noticed unless it appears of record, see *Chaffee v. Boston Belt Co.* (1859), 22 How. 217; *Phelps v. Mayer* (1853), 15 How. 160.

That a bill of exceptions must follow the established forms, see *Pomeroy v. Bank of Indiana* (1863), 1 Wall. 592.

⁵ That any party aggrieved may have a writ of error though other parties refuse to join, see *O'Dowd v. Russell* (1871), 14 Wall. 402.

⁶ Sec. 1008, Rev. Stat. 1874.

⁷ Sec. 997, Rev. Stat. 1874. Rule 8, Supreme Court Rules.

That where the invention is clearly not patentable the Court will dismiss the suit, though that defence was not set up, see *Slawson v. Grand Street R. R. Co.* (1882), 107 U. S. 649; 24 O. G. 99.

⁸ Secs. 691, 699, 700, Rev. Stat. 1874.

That where the cause is tried without a jury and a special finding is made, the Supreme Court may decide whether the

§ 1080. Costs.

As a general rule, the party who recovers judgment in an action at law for infringement also recovers costs.¹ To this rule there are, however, certain exceptions. When an excessive Claim is cured by a disclaimer pending suit, or where upon a contest over several Claims one is adjudged to be excessive and no disclaimer has been filed, or where certain Claims are abandoned at the trial as unlawful, though without a formal disclaimer, costs to the plaintiff are denied.² But a disclaimer filed without necessity, or after verdict, or in a different divi-

facts found support the judgment, see Sec. 700, Rev. Stat. 1874.

That damages for the delay may be allowed when the judgment is affirmed, see Sec. 1010, Rev. Stat.; *Pennywit v. Eaton* (1872), 15 Wall. 380; *McKee v. Rains* (1869), 10 Wall. 22.

§ 1080. ¹ That in actions at law for infringement costs usually follow the judgment, see Sec. 4919, Rev. Stat. 1874. See also *Kittredge v. Race* (1875), 92 U. S. 116.

That under Sec. 14, act of 1836 (repeated in Sec. 4919, Rev. Stat.), costs follow a verdict for any amount, and whether the court increases the damages or not, see *Merchant v. Lewis* (1857), 1 Bond, 172.

² In *Peek v. Frame* (1871), 5 Fisher, 211, Woodruff, J. : (212) "On the one hand, the mere fact that the plaintiffs obtained a verdict is not conclusive that they are also entitled to costs; for they may have obtained the verdict under and in pursuance of section 9 of the act of 1837, which warrants a recovery for an infringement of what is, in fact, new, and claimed as the plaintiff's invention, notwithstanding the patentee has also, through mistake, without fraud or intent to deceive, claimed something which is not new. If this verdict was rendered for an infringement of valid Claims, and it appeared that other Claims were rejected in pursuance of that section, then although the plain-

tiffs obtained a verdict, they are not entitled to costs. But if the verdict was in fact upon all the Claims, in affirmance of the validity of each, and of the novelty of the inventions claimed in each, then the plaintiffs are entitled to costs. On the other hand, the mere fact that the plaintiffs have, since the trial and verdict, disclaimed one or more of the Claims made in the patent, is not alone conclusive that the plaintiffs are not entitled to costs. If the verdict was rendered, as secondly above suggested, upon all the Claims, affirming their validity, and the novelty of the invention claimed in each, then what the plaintiffs may have said or done, by disclaimer or otherwise, does not deprive them of the effect of the verdict; and so long as it remains in force, not set aside, it is conclusive between the parties. The fact of disclaimer is high evidence, in such case, that the verdict was wrong, and that the plaintiff should only have recovered on the parts of the invention or patent therefor which are not disclaimed, and such evidence might warrant a new trial. But while such a verdict stands it is conclusive."

See also, as to disclaimer *Hayes v. Bickelhaupt* (1885), 23 Fed. Rep. 183; 32 O. G. 135; *Matthews v. Spangenberg* (1882), 23 O. G. 92; 20 Blatch. 482; 19 Fed. Rep. 823; *Tuck v. Bramhill* (1868), 3 Fisher, 400; 6 Blatch. 95;

sion of a re-issued patent, has no effect upon the right to costs.³ A verdict for nominal damages usually carries costs.⁴ Various reasons operate in equity to deprive a victorious party of his costs, as where the suit is based on several patents some of which are held invalid, or where the defendant

Singer v. Walmsley (1860), 1 Fisher, 558.

That suits can be maintained on the valid Claims in a re-issue, but no costs can be recovered unless the invalid Claims were disclaimed, see *Wordon v. Searls* (1884), 21 Fed. Rep. 406.

That a disclaimer to save costs, under Sec. 4922, is needed only when the Claim is originally excessive, not when the right to claim by re-issue has been lost by delay and a disclaimer is thus necessary, for then costs are allowed, see *Mundy v. Lidgerwood Mfg. Co.* (1884), 20 Fed. Rep. 191.

That when the patent contains several Claims, some of which are abandoned at the trial, costs will not be allowed unless a disclaimer were filed before suit, see *Proctor v. Brill* (1883), 16 Fed. Rep. 791.

That valid Claims may be recovered on without costs if invalid Claims are not disclaimed, but unreasonable delay in disclaiming defeats also the valid Claims, see *McCormick v. Seymour* (1854), 3 Blatch. 209; *Hall v. Wiles* (1851), 2 Blatch. 194.

That where the plaintiff recovers on a valid Claim and invalid Claims have not been disclaimed and the patent having expired no disclaimer can now be filed, if there has been no unreasonable delay in disclaiming, the plaintiff may have a decree without costs on the valid Claim, and on an appeal to the Supreme Court each party pays his own costs and one half the expense of printing the records, see *Yale Lock Co. v. Sargent* (1886), 117 U. S. 536; 35 O. G. 497.

³ That if a disclaimer is unnecessarily filed costs will be allowed the plaintiff

as if it were not filed, see *Sharp v. Tiff* (1880), 17 O. G. 1282; 18 Blatch. 132; 2 Fed. Rep. 697.

That the disclaimer of immaterial features does not affect costs, see *Peck v. Frame* (1871), 5 Fisher, 211.

That a disclaimer after verdict may give rise to a new trial, but cannot affect the verdict or costs in any other way, see *Peck v. Frame* (1871), 5 Fisher, 211.

That a disclaimer upon one division of a re-issue has no effect upon the costs in a suit on the other, see *Elastic Fabrics Co. v. Smith* (1879), 100 U. S. 110.

⁴ In *Merchant v. Lewis* (1857), 1 Bond, 172, Leavitt, J. : (173) "A verdict for damages, whatever may be the amount, implies that the defendant has been a wrong-doer in the unauthorized use of the plaintiff's exclusive right under his patent; and such a verdict will carry costs. It is not a just inference, in a patent-right case, that because nominal damages are found by the jury, the action is necessarily frivolous or vexatious. It happens, not unfrequently, that the owner of a patent is compelled, for the protection of his rights, to sue for an infringement under circumstances in which he neither seeks to recover nor asserts a right to anything beyond mere nominal damages. This may be necessary for the establishment of his patent, and to prevent infringements. And, as by the legislation of Congress, the Circuit Courts of the United States have exclusive jurisdiction in patent cases, it would be a great hardship if he were subjected to the costs in thus asserting his legal rights."

has been misled by the plaintiff into the belief that his acts were not an invasion of the patent, or where upon the trial of two distinct issues each party prevails in one, or where the suit is brought entirely for the vindication of the plaintiff's patent, or to secure a judicial interpretation of its Claims, and the defendant has been guilty of no wilful wrong.⁵

⁵ That when the patent contains two Claims and only one is sustained, plaintiff recovers no costs, under Sec. 4922, see *Stewart v. Mahoney* (1879), 5 Fed. Rep. 302 ; 4 Bann. & A. 84.

That where the plaintiff recovers on one patent and the defendant on the other, costs will be apportioned, see *Pennsylvania Diamond Drill Co. v. Simpson* (1886), 29 Fed. Rep. 288 ; 37 O. G. 218.

That where the suit is based on several patents and the plaintiff recovers only on one, he can have no costs, see *Schmid v. Scoville Mfg. Co.* (1889), 37 Fed. Rep. 345 ; *Albany Steam Trap Co. v. Felthousen* (1884), 20 Fed. Rep. 633 ; 22 Blatch. 169 ; *American Wood Paper Co. v. Heft* (1867), 3 Fisher, 316.

That no costs will be taxed against a defendant who has been misled by the plaintiff into believing that he did not infringe, see *Sarven v. Hall* (1873), 6 Fisher, 495 ; 4 O. G. 666 ; 11 Blatch. 295.

That a defendant who misled the plaintiff into buying the patent cannot recover costs if the patent is defeated, see *Bunker v. Stevens* (1885), 36 O. G. 345 ; 26 Fed. Rep. 245.

That the successful party recovers costs unless his conduct has been such as to render their allowance unlawful or unjust, see *Bunker v. Stevens* (1885), 36 O. G. 345 ; 26 Fed. Rep. 245.

That where there are two distinct causes of action and the plaintiff prevails in one and the defendant in another, no costs will be allowed, see

Adams v. Howard (1884), 19 Fed. Rep. 317 ; 22 Blatch. 47 ; 26 O. G. 825 ; *Yale & Greenleaf Mfg. Co. v. North* (1867), 3 Fisher, 279 ; 5 Blatch. 455.

That if the proceeding is solely for the plaintiff's benefit, no costs are allowed against the defendant unless he is guilty of wrong, but if the defendant succeeds on other grounds his own costs may be disallowed, see *Hovey v. Stevens* (1846), 3 W. & M. 17 ; 2 Robb, 567.

That one who unnecessarily joins in a defence on the merits cannot recover costs, see *Tyler v. Galloway* (1882), 13 Fed. Rep. 477 ; 22 O. G. 1294 ; 21 Blatch. 66.

The following decisions concerning the items to be allowed or rejected from a bill of costs in patent cases are here inserted, a discussion of them in the text being regarded as unnecessary.

Patents, Copies, etc. :

That copies of the plaintiff's patent procured by defendant are not taxable in his favor, because the plaintiff is bound to produce it, see *Hathaway v. Roach* (1846), 2 W. & M. 63.

That copies of patents procured by the defendant cannot be taxed as costs against the plaintiff, see *Woodruff v. Barney* (1862), 2 Fisher, 244 ; 1 Bond, 528.

Assignments, Copies :

That copies of assignments of the patent, procured by the defendant, are taxable, see *Hathaway v. Roach* (1846), 2 W. & M. 63.

Models, Copies, etc. :

That models like the plaintiff's device may be included in the taxation of costs,

SECTION IV.

OF INFRINGEMENT: REMEDY IN EQUITY.

§ 1081. Origin of Equity Jurisdiction over Infringement Cases in England.

The right of the owner of a patent to invoke the assistance of a court of equity in cases of infringement, where no ade-

see *Woodruff v. Barney* (1862), 2 Fisher, 244; 1 Bond, 528; *Hathaway v. Roach* (1846), 2 W. & M. 63.

That copies of models in the Patent Office are taxable, but other models, machines, or photographs are not taxable, see *Wooster v. Handy* (1885), 23 Fed. Rep. 49; 23 Blatch. 113; *Hussey v. Bradley* (1864), 5 Blatch. 210; *Parker v. Bigler* (1857), 1 Fisher, 285.

That the expense of obtaining a model of defendant's infringing machine is not taxable among the plaintiff's costs, see *Cornely v. Marckwald* (1885), 23 Blatch. 248; 24 Fed. Rep. 187.

Attendance, Parties, Counsel, etc.:

That the expense of attending court, and of counsel for attending, is not taxable, see *Hussey v. Bradley* (1864), 5 Blatch. 210.

Copies of Arguments, etc.:

That the expense of copying papers or of reporting arguments for the use of the court will not be taxed, see *Hussey v. Bradley* (1864), 5 Blatch. 210.

Printing:

That the expense of printing pleadings, evidence, briefs, etc., and of lithographing drawings, unless incurred by order of the court, or by agreement of the parties, is not taxed, see *Hussey v. Bradley* (1864), 5 Blatch. 210.

Expense of Getting Evidence:

That the expenses required to obtain needed evidence may be taxed under the act of 1858, see *Spaulding v. Tucker* (1871), 4 Fisher, 633.

Telegraphing:

That necessary telegraphic expenses may be taxed, see *Hussey v. Bradley* (1864), 5 Blatch. 210.

Marshal:

That a marshal cannot tax mileage by zig-zag travel to reach a witness, see *Parker v. Bigler* (1857), 1 Fisher, 285.

That a marshal is not entitled to fees for serving a rule to plead, see *Parker v. Bigler* (1857), 1 Fisher, 285.

Witnesses:

That the travelling fees of voluntary witnesses, attending at the request of the prevailing party, will not be taxed against the loser, see *Spaulding v. Tucker* (1871), 4 Fisher, 633.

That witnesses who attend without summons are voluntary witnesses and cannot be taxed against the loser, see *Woodruff v. Barney* (1862), 2 Fisher, 244; 1 Bond, 528.

That witnesses from out of the district, or living over one hundred miles distant, are always voluntary witnesses, see *Spaulding v. Tucker* (1871), 4 Fisher, 633.

That the reasonable expenses of a voluntary witness may be taxed when the evidence is taken under an agreement of the parties, see *Spaulding v. Tucker* (1871), 4 Fisher, 633.

That a witness summoned in several suits against several defendants, is entitled to attendance and mileage in each case, see *Parker v. Bigler* (1857), 1 Fisher, 285.

That a witness has mileage for going

quate relief is possible at law, rests upon fundamental principles of jurisprudence, and is independent of any legislative enactment.¹ It is true that in the statute of James I. exclusive jurisdiction over all letters-patent, and over all questions concerning their force and validity, was reserved to the tribunals which administered the "common laws;" and that for a long period this reservation was interpreted as prohibiting the interference of the court of chancery, at least until the claims of the patentee had been fully vindicated in a court of law. But in the latter part of the last century the rigor of this doctrine was abated, and the chancellors began to grant injunctions without a prior suit at law, and if the plaintiff's right was undisputed to order an account of profits and thus dispose of the entire cause without a jury. Theoretically, however, those proceedings were always in aid of an action at law; and, therefore, when the defendant denied either the validity of the patent, or the title of the plaintiff, or the fact of infringement, these issues were submitted to a jury in a court of common-law jurisdiction, and the verdict there rendered was made the basis of the final decree in equity.²

§ 1082. Origin of Equity Jurisdiction over Infringement Cases in the United States.

It was during this condition of the English chancery practice, in cases of infringement, that our own patent system was

home, not for coming to court, see *Woodruff v. Barney* (1862), 2 Fisher, 244; 1 Bond, 528.

Depositions:

That a deposition cannot be taxed if instead of using it the party called and examined the witness in court, see *Hathaway v. Rosch* (1846), 2 W. & M. 63.

Practice:

That the Circuit Court may tax costs *nunc pro tunc* after the mandate of the Supreme Court has been issued and received by the Circuit Court, see *Sizer v. Many* (1853), 16 How. 98.

That where, on a judgment for the defendant, the costs cannot be collected

on execution, the court will not on motion appoint a receiver to dispose of the patent as an asset, but a new bill for that purpose must be filed, see *Thayer v. Hart* (1885), 23 Blatch. 303; 24 Fed. Rep. 558.

For further rules in equity cases, see §§ 1162, 1163, and notes, *post*.

§ 1081. ¹ As to the necessity and advantage of equitable interference by injunction in cases of infringement, see § 1168 and notes, *post*.

² As to the origin and development of equitable jurisdiction over patent cases in England, see § 932 and notes, *ante*.

established. The acts of Congress, prior to 1819, made no provision for any suit in equity by the owner of a patent, nor for his enjoyment of any form of equitable relief in connection with his action for damages at common law. Nevertheless, the Federal courts, following the decisions of the lords chancellors, held that equity had jurisdiction over patents for inventions, and could exercise its ordinary powers in behalf of the patentee, whenever these were needed to give complete effect to the statute under which the patent had been granted.¹ But this jurisdiction was not regarded as original, or even as concurrent with that of the courts of common law. While proceedings might commence by the filing of a bill in equity, and by the issue of a preliminary injunction against the defendant, yet if the case were contested on its merits an immediate trial at law was ordered to determine the real points in controversy; after which, if the plaintiff obtained a verdict, the court of equity could decree an accounting and a perpetual injunction in his favor.²

§ 1083. Difficulties in the Administration of Equitable Remedies before the Act of 1819: Object of the Act.

In the administration of these equitable remedies the Federal courts encountered one difficulty which only a legislative enactment could remove. The authority conferred upon these courts by the Judiciary Act of 1789 did not extend to actions between parties both of whom were citizens of the same individual State, and thus required suits for infringement to be

§ 1082. ¹ The acts of 1790, 1793, and 1800 gave to the plaintiff the right to recover certain specific penalties by an action on the case founded on the statute. That such actions at law could be aided by a Federal court of equity seems never to have been doubted, except where the litigants were citizens of the same State (see *Livingston v. Van Ingen* (1811), 1 Paine, 45), and is recognized as a long subsisting practice by Thompson, J., in *Sullivan v. Redfield* (1825), 1 Paine, 441; 1 Robb, 477. See also § 932 and notes, *ante*.

² That equity interferes only in aid

of an action at law, see *Sullivan v. Redfield* (1825), 1 Paine, 441; 1 Robb, 477.

That where a material issue was raised, relating to the fact of infringement or the validity of the patent, a trial at law was ordered, or a feigned issue sent to a jury for decision, see *Orr v. Merrill* (1846), 1 W. & M. 376; 2 Robb, 323; *Brooks v. Bicknell* (1845), 4 McLean, 70; *Parker v. Hatfield* (1845), 4 McLean, 61; *Brooks v. Bicknell* (1843), 3 McLean, 250; 2 Robb, 118.

brought before the local courts except in cases where the parties were resident in different States. The act of 1800 cured this defect, so far as actions at law were concerned, but left the jurisdiction in equity unchanged. Hence while a suit for damages would lie against an infringer in any Circuit court, irrespective of his citizenship, no equitable relief could be obtained against him unless he resided in a different State from that of the plaintiff.¹ To remove this difficulty the act of 1819 was passed, bestowing on the Circuit courts original cognizance, in equity as well as at law, over all patent cases, with full authority to grant injunctions according to the course and principles of courts of equity.²

§ 1084. Legal and Equitable Jurisdiction over Infringement Cases not Concurrent.

The sweeping language employed in the act of 1819, and adopted from it into the acts of 1836 and 1870, gave rise to an erroneous doctrine concerning the nature and extent of equity jurisdiction over patent causes, which has found its expression in numerous decisions of the courts. These acts provide that all actions, suits, controversies, and cases, arising under any law of the United States, granting or confirming to inventors the exclusive right to their inventions or discoveries, shall be originally cognizable, as well in equity as at law, by the Circuit courts of the United States. Under this provision it has been claimed and held that the jurisdiction in equity is concurrent with that at law in all cases, and that no suit for infringement can be maintained at law which could not also be prosecuted in equity; thus giving to the injured patentee a choice of remedies without reference to the situation of the parties or the facts in controversy.¹ This doctrine ignores the

§ 1083. ¹ That prior to the act of 1819 the Federal courts had no equity jurisdiction in patent cases unless the parties were citizens of different States, see *Livingston v. Van Ingen* (1811), 1 Paine, 45.

² That the purpose of the act of 1819 was to extend equity jurisdiction to patent cases in which the parties are

citizens of the same State, see *Sullivan v. Redfield* (1825), 1 Paine, 441; 1 Robb, 477.

§ 1084. ¹ In *Nevins v. Johnson* (1853), 3 Blatch. 80, Betts, J.: (82) "We see no reason for regarding the power to issue injunctions as the primary and substantive authority of courts of equity under this statute. They have plenary

fundamental distinction between law and equity, as systems of practical jurisprudence, and contemplates the Circuit court not as an ordinary judicial body clothed with common-law and chancery powers, but as a special tribunal constituted to hear and determine patent causes and authorized to entertain actions on the case or bills for injunctions or accounts, at the option of the plaintiff. In opposition to this doctrine, however, it has with equal pertinacity been held by other judges that the equitable jurisdiction of the Federal courts was not enlarged as to its subject-matter or its forms of procedure by these acts of Congress, but that the spheres of law and equity are still distinct in patent cases as in all others, and that the latter powers are exercisable only where the plaintiff has no adequate remedy at law.² This view has been accepted and confirmed by the Supreme Court in a recent and exhaustive

jurisdiction over all actions, suits, controversies, and cases in equity and at law, arising under the Patent Laws. A suit demanding a discovery of the extent of an infringement of a patent right, and an account of the profits realized from such infringement, is manifestly a case arising under the Patent Law; and the natural interpretation of the language of the act would seem to be, that Congress has bestowed upon this Court a common jurisdiction, both on its law and equity sides, over all cases of that class, and that no suit of that character can be maintained at law which may not also be prosecuted in equity." See further *Birdsall v. Coolidge* (1876), 93 U. S. 64; 10 O. G. 748; *Perry v. Corning* (1870), 7 Blatch. 195; *Hoffheins v. Brandt* (1867), 3 Fisher, 218; *Goodyear v. Hullihen* (1867), 3 Fisher, 251; 2 Hughes, 492.

That the Circuit courts have original jurisdiction over patent cases in equity as well as in law, and the power to issue an injunction is a mere incident, see *Atwood v. Portland Co.* (1880), 10 Fed. Rep. 283; 5 Bann. & A. 533.

That the Federal court has jurisdiction in equity when the parties to a

patent case belong in different States, but whether it has such jurisdiction when they belong in the same State, except for the purposes of an injunction, is doubtful, see *Sayles v. Richmond, Fredericksburg, & Potomac R. R. Co.* (1879), 16 O. G. 43; 3 Hughes, 172; 4 Bann. & A. 239.

² That although jurisdiction in equity is complete it is not exclusive, nor are its differences from law abolished, see *Livingston v. Jones* (1861), 2 Fisher, 207; 3 Wall. Jr. 330.

That equity has no jurisdiction where there is adequate remedy at law, see *Spring v. Domestic Sewing Mach. Co.* (1882), 13 Fed. Rep. 446; 22 O. G. 1445; *Hayward v. Andrews* (1882), 12 Fed. Rep. 786; *Merriam v. Smith* (1882), 11 Fed. Rep. 588.

That the act of 1819 did not enlarge or alter the equity jurisdiction of the Federal courts over the subject-matter of the controversy, but simply empowered those courts to exercise that jurisdiction when both the litigants were citizens of the same State, see *Sullivan v. Redfield* (1825), 1 Paine, 441; 1 Robb, 477.

decision, and it may now, therefore, be considered as a settled principle that the legal and equitable remedies afforded to the owner of a patent are not concurrent, or interchangeable, nor can they be made so without a violation of the Federal Constitution, but that where adequate legal remedy exists he must seek his redress in an action at law, the issues in which may be submitted to a jury.³

§ 1085. Jurisdiction of Equity Complete whenever any Form of Equitable Relief is Necessary.

Pending the settlement of the foregoing question, another equitable doctrine has gradually introduced a change into the practice of the courts, and rendered still more clear the distinction between the jurisdictions of chancery and law. It is an established principle of equity that whenever it obtains cognizance of a cause for any purpose it will retain it until complete relief has been afforded to the injured party.¹ Thus in the earlier period of patent litigation, although after the grant of a preliminary injunction a trial at law was ordered upon certain issues, the case was finally adjudicated by the court of chancery, which awarded not only a compensation for the plaintiff's loss, but whatever other remedies might be required for his protection.² Under the influence of the theory that the acts of Congress enlarged the powers of equity, and the increasing conviction that the intricate questions of fact involved in patent causes were more appropriate for the determination of a skilful judge than of an inexperienced

³ In *Root v. Lake Shore & Michigan Southern R. R. Co.* (1882), 105 U. S. 189; 21 O. G. 1112; the following fundamental propositions are stated by the Supreme Court:—

1. That Secs. 55, 59, and 61 of the act of 1870 (being in substance Secs. 4919, 4920, and 4921 of the Revised Statutes, and embracing the provisions of the act of 1819, &c.) do not abolish the distinction between law and equity, nor change their ancient boundaries.

2. That the preservation of the distinction between law and equity is guaranteed by the Constitution.

3. That legal rights must be enforced in courts of law.

4. That equity cannot interfere where there is an adequate remedy at law.

§ 1085. ¹ That if equity obtains jurisdiction for one purpose it will exercise it as to all, see *Burdell v. Comstock* (1883), 15 Fed. Rep. 395; *Magic Ruffle Co. v. Elm City Co.* (1877), 11 O. G. 501; 14 Blatch. 109; 2 Bann. & A. 506.

² For instances of this practice at an early date, see cases cited in notes to § 932, *ante*.

jury, this doctrine gained additional importance, and was applied to such advantage that trials at law upon the merits of the controversy slowly disappeared, and the entire disposal of the cause, in all its stages, vested in the court of equity alone.³ Hence, though the judge in chancery has still the power to send the issues to a jury in a court of common law, this measure is rarely if ever adopted, and the whole proceedings are conducted as if no other tribunal than his own were in existence.⁴

§ 1086. **No Equity Jurisdiction where Adequate Remedy Exists at Law.**

As the result of these two principles, the respective jurisdictions of law and equity over suits for infringement are now clearly defined, and capable of accurate statement. Where the remedy at law is adequate, equity has no jurisdiction.¹

³ For examples of this complete assumption of equity jurisdiction without reference to proceedings at law, see cases cited in notes to § 932, *ante*.

⁴ That chancery may still send an issue to be tried at law, see *Watt v. Starke* (1879), 101 U. S. 247; 17 O. G. 1092.

That equity has complete jurisdiction in patent causes and without the aid of courts of law may determine rights and give a complete remedy, see *Wise v. Grand Avenue R. R. Co.* (1888), 33 Fed. Rep. 277; *Avery v. Wilson* (1884), 20 Fed. Rep. 856; *Sickles v. Gloucester Mfg. Co.* (1856), 1 Fisher, 222; 3 Wall. Jr. 196.

That Sec. 61, act of 1870, provides a mode of trying all issues of fact and law without framing special issues and sending them to a jury, see *Root v. Lake Shore and Michigan Southern R. Co.* (1882), 105 U. S. 189; 21 O. G. 1112.

That the equity jurisdiction of the Federal courts is not merely ancillary to law, and does not require that the patent be first established by the ver-

dict of a jury, see *Wise v. Grand Avenue R. R. Co.* (1888), 33 Fed. Rep. 277; *McMillin v. Barclay* (1872), 4 Brews. (Pa.) 275; 5 Fisher, 189; *Doughty v. West* (1865), 2 Fisher, 553; *Goodyear v. Providence Rubber Co.* (1864), 2 Fisher, 499; 2 Clifford, 851; *Potter v. Fuller* (1862), 2 Fisher, 251; *Sanders v. Logan* (1861), 2 Fisher, 167; *Sickles v. Gloucester Mfg. Co.* (1856), 1 Fisher, 222; 3 Wall. Jr. 196; *Motte v. Bennett* (1849), 2 Fisher, 642.

§ 1086. ¹ That the distinction between law and equity is the same in patent cases as in others, and if the remedy at law is adequate equity has no jurisdiction, see *Brooks v. Miller* (1886), 28 Fed. Rep. 615; *Crandall v. Plano Mfg. Co.* (1885), 32 O. G. 1122; 24 Fed. Rep. 738; *Root v. Lake Shore & Mich. Southern R. R. Co.* (1882), 105 U. S. 189; 21 O. G. 1112; *Spring v. Domestic Sewing Mach. Co.* (1882), 13 Fed. Rep. 446; 22 O. G. 1445; *Hayward v. Andrews* (1882), 12 Fed. Rep. 786; *Merriam v. Smith* (1882), 11 Fed. Rep. 588; *Sayles v. Richmond*,

Where equitable interference is necessary for the complete protection of the plaintiff, equity has jurisdiction not only for that purpose but for all purposes, and can fully hear and finally determine all the issues in the cause.² No precise and universal test can be established for ascertaining the necessity of equitable interference. It depends upon the circumstances of the individual case, and relief will never be withheld where justice to the parties apparently requires its application. There are, however, certain classes of cases, which evidently fall upon one side or the other of the line dividing equity from law, and concerning which, therefore, the rule of jurisdiction may be more fully and explicitly declared.

§ 1087. *Adequate Remedy Exists at Law in what Cases.*

An adequate remedy at law exists in favor of the owner of a patent against an infringer wherever the sole relief required

Fredericksburg, & Potomac R. R. Co. (1879), 16 O. G. 43; 3 Hughes, 172; 4 Bann. & A. 239; Jenkins v. Greenwald (1857), 2 Fisher, 37; 1 Bond, 126; Motte v. Bennett (1849), 2 Fisher, 642.

That the test of equity jurisdiction is adequate remedy at law under the Judiciary Act of 1789 and subsequent Federal legislation, see McConihay v. Wright (1887), 121 U. S. 201.

That jurisdiction in equity attaches unless the legal remedy, both in respect to the final relief and the mode of obtaining it, is as efficient as the remedy which equity would confer under the same circumstances, see Kilbourn v. Sunderland (1889), 130 U. S. 505.

That the remedy in account is generally more complete and adequate in equity than at law, see Kilbourn v. Sunderland (1889), 130 U. S. 505.

That where the plaintiff's remedy at law is adequate the bill will be dismissed on demurrer, see Crandall v. Plano Mfg. Co. (1885), 32 Q. G. 1122; 24 Fed. Rep. 738.

² That equity will take jurisdiction

whenever the rights of the parties require it, see Brick v. Staten Island R. R. Co. (1885), 25 Fed. Rep. 553; Root v. Lake Shore & Mich. Southern R. R. Co. (1882), 105 U. S. 189; 21 O. G. 1112.

That if equity obtains jurisdiction for any purpose it will afford complete relief as to all matters involved in the suit, see Burdell v. Comstock (1883), 15 Fed. Rep. 395; Magic Ruffle Co. v. Elm City Co. (1877), 11 O. G. 501; 14 Blatch. 109; 2 Bann & A. 506.

That if the evidence shows that no equitable relief is or was required the bill will be dismissed *in toto*, and no relief given, see Clark v. Wooster (1886), 119 U. S. 322; 37 O. G. 1477.

That equity will retain jurisdiction after the death of an infringer, though no injunction will issue, but only an accounting can be ordered, see Kirk v. Du Bois (1886), 37 O. G. 102; 28 Fed. Rep. 460. *Contra*, Judson v. Draper (1873), 3 O. G. 354; 6 Fisher, 327; Holmes, 208.

is compensation for a past injury, provided this relief can be afforded without equitable aid. Thus where the plaintiff has chosen to seek his recompense for the enjoyment of the patented invention through an established license fee, and the infringing acts of the defendant raise an implied acceptance of the offer of the plaintiff, the sum which the plaintiff is entitled to recover is fixed and certain, the remedy at law is adequate, and equity can have no jurisdiction.¹ Where the infringement has already ceased, and the defendant, having made no gains or savings by his wrongful acts, can be held liable only for the damages sustained by the plaintiff, the legal remedy is also sufficient, and equity cannot interfere.² Where profits

§ 1087. ¹ In *Livingston v. Jones* (1861), 2 Fisher, 207, Grier, J.: (210) "But it is plain that a patentee, whose invention is only valuable because used by all who pay a license fee, and who suffers no other wrong than the detention of such fee, has fixed his own measure of compensation, and needs none of the remedies which it is the duty of the chancellor to give for his protection. An injunction would do him no good; an account is not wanted; and the only remedy to which he is entitled being a judgment for a given sum of money, with interest, a court of law is his proper resort, where also he may recover a penalty to the extent of treble damages, if the judge sees fit to inflict it." 3 Wall. Jr. 330 (343). See also *Brewster v. Tuthill Spring Co.* (1888), 34 Fed. Rep. 769; *Smith v. Sands* (1885), 24 Fed. Rep. 470; 32 O. G. 1467; *Vaughn v. Central Pacific R. R. Co.* (1877), 4 Sawyer, 280; 3 Bann. & A. 27; *Sanders v. Logan* (1861), 2 Fisher, 167.

That the licensor cannot sue in equity to recover royalties, see *Crandall v. Plano Mfg. Co.* (1885), 24 Fed. Rep. 738; 32 O. G. 1123.

That a court of equity will not annul a license on the ground that the licensee does not pay the royalties, or make re-

port, the remedy at law being adequate, see *Densmore v. Tanite Co.* (1887), 32 Fed. Rep. 544.

That an action for damages or profits on a license cannot be maintained in equity unless there is some other ground for equitable relief, see *Consolidated Middlings Purifier Co. v. Wolf* (1886), 28 Fed. Rep. 814; 37 O. G. 567.

That equity has jurisdiction to compel a discovery of the number of articles made under a license, where the licensee refuses to make his periodical reports as agreed, see *Pope Mfg. Co. v. Owsley* (1886), 27 Fed. Rep. 100; 37 O. G. 781.

That where the patentee grants licenses to certain persons only, he may sue an infringer at law for the license fee or damages, or in equity for an injunction with profits and damages, see *Bragg v. City of Stockton* (1886), 27 Fed. Rep. 509; 11 Sawyer, 597.

² That where the plaintiff has a mere right to damages for past infringements equity has no jurisdiction, see *Ulman v. Chickering* (1887), 33 Fed. Rep. 582; *Burdell v. Comstock* (1883), 15 Fed. Rep. 395; *Root v. Lake Shore & Mich. Southern R. R. Co.* (1882), 105 U. S. 189; 21 O. G. 1112; *Spring v. Domestic Sewing Mach. Co.* (1882), 22 O. G. 1445; 13 Fed. Rep. 446; *Jenkins v.*

have been made by the defendant by an infringement now incapable of repetition, and the amount of these profits can be ascertained and collected through the ordinary action at law, this legal remedy is ample, and no recourse to equity is necessary.³ When the patent has expired, and the entire claim of the plaintiff against the defendant rests upon infringing acts performed during the term, an action on the case for the recovery of damages often affords complete redress without the aid of equity.⁴ Where the infringement is a breach of contract, by whose provisions the compensation of the plaintiff for the injury is determined, the sum due to the injured party is recoverable at law, and equitable interference cannot be invoked.⁵ Of course, in many of these cases circumstances may arise, collateral to the main facts in the controversy, which require the interposition of a court of equity, but where these are absent, and the plaintiff's right to compensation and its amount can both be made manifest by the proceedings incident to a jury trial in a court of law, the remedy at law is adequate, and no occasion for the assistance of a court of equity exists.⁶

Greenwald (1857), 2 Fisher, 87; 1 Bond, 126.

³ That equity has no jurisdiction over an action to recover profits where the account can be as readily settled at law, see *Vaughn v. East Tennessee, Va., & Ga. R. R. Co.* (1877), 11 O. G. 789; 1 Flippin, 621; 2 Bann. & A. 537; and cases cited in note 2, *ante*.

That equity has jurisdiction where an account can be more readily settled in equity than at law, see *Vaughn v. East Tennessee, Va. & Ga. R. R. Co.* (1877), 11 O. G. 789; 1 Flippin, 621; 2 Bann. & A. 537.

That in actions for an account of profits or receipts the remedy at law is less adequate than that in equity, see *Kilbourn v. Sunderland* (1889), 130 U. S. 505.

That the mere intricacy of an account does not give equity jurisdiction, see *Creamer v. Bowers* (1887), 30 Fed.

Rep. 185; *Adams v. Bridgewater Iron Co.* (1886), 26 Fed. Rep. 324; 34 O. G. 1045; *Lord v. Whitehead & Atherton Mach. Co.* (1885), 24 Fed. Rep. 801; 33 O. G. 499.

As to whether an account of profits can be had at law in infringement cases, see § 1091, note 6, *post*.

⁴ See § 1092 and notes, *post*.

⁵ That equity has no jurisdiction over actions for breach of contract, see *Magic Ruffle Co. v. Elm City Co.* (1877), 11 O. G. 501; 14 Blatch. 109; 2 Bann. & A. 506.

⁶ That where any necessity for equitable interference exists on any substantial ground equity will take jurisdiction, see *Root v. Lake Shore & Mich. Southern R. R. Co.* (1882), 105 U. S. 189; 21 O. G. 1112; *Vaughn v. East Tennessee, Va., & Ga. R. R. Co.* (1877), 11 O. G. 789; 1 Flippin, 621; 2 Bann. & A. 537.

§ 1088. No Adequate Remedy at Law against Future Infringements.

An adequate remedy at law does not exist in any case where future infringements are to be prevented, or where full compensation for past infringements is unobtainable in courts of law. Future infringements can be prevented only by an injunction issuing out of chancery, and to this relief the plaintiff is entitled whenever he has reason to apprehend a violation of his rights by the defendant.¹ In two cases an injunction is unnecessary; one where the plaintiff has an established license fee, which can be collected from the defendant in a suit at law if he should make the threatened use of the invention; the other where the infringement has been finally abandoned by the defendant, or has become impossible through the expiration of the patent.² But in every case where the patent is

§ 1088. ¹ In *Motte v. Bennett* (1849), 2 Fisher, 642, Wayne, J.: (645) "The principle upon which courts of equity have jurisdiction in patent cases, and upon which injunctions are granted in them, is not that there is no legal remedy, but that the law does not give a complete remedy to those whose property is invaded; for if each infringement of the patent were to be made a distinct cause of action, the remedy would be worse than the evil. The inventor or author might be ruined by the necessity of perpetual litigation, without ever being able to have a final establishment of his rights. *Hogg v. Kirby*, 8 Ves. 223; *Harmer v. Playne*, 14 Ves. 132; *Lawrence v. Smith*, Jacob's R. 472. In addition to this consideration, the plaintiff could have no preventive at law to restrain the future use of his invention or the publication of his work, injuriously to his title and interest."

That where an infringement is expected, but has not yet occurred, equity will enjoin, though both parties live in the same State, see *Sherman v. Nutt* (1888), 35 Fed. Rep. 149.

That an existing infringement calls for equitable interference by injunction, and upon suit therefor damages will also be awarded, see *Brooks v. Miller* (1886), 28 Fed. Rep. 615.

That equity has jurisdiction whenever during the life of a patent damages and an injunction are asked for, see *McMillin v. St. Louis & Miss. Valley Transportation Co.* (1883), 18 Fed. Rep. 260; 5 *McCrary*, 561.

That no injunction will issue, under the Patent Law, against one who infringes pending the application for a patent, see *Rein v. Clayton* (1889), 37 Fed. Rep. 354.

That a court of equity will take jurisdiction and enjoin the defendant whenever the plaintiff's right requires it, see *Brick v. Staten Island R. R. Co.* (1885), 25 Fed. Rep. 553.

² That where plaintiff has an established license fee for all who choose to practise the invention no injunction is usually needed, see §§ 1171, 1198, and notes, *post*.

That where the defendant is no longer able to infringe no injunction is required, see §§ 1173, 1191, 1193, and

still in force, and the defendant is able and is apparently disposed to commit acts of infringement, if no established license fee exists, or if on account of the insolvency of the defendant or from any other cause this customary fee could not be collected, equity will restrain him from the use of the invention, and having thus acquired jurisdiction over the parties, and the subject-matter of the controversy, will afford such further relief as the plaintiff may require.³

§ 1089. No Adequate Remedy at Law where the Injured Party is not the Legal Owner of the Patent.

A court of law can give complete redress for past infringements only where the injured party is the legal owner of the patent, and where the compensation to which he is entitled can be measured by the actual damage that he has sustained.¹ A plaintiff, who is equitably interested in the patent but is not its legal owner, however he may suffer from an infringement, cannot maintain a suit for damages, but must resort to equity for the protection and enforcement of his rights.² Thus where he has contracted for the patent but has not yet received the instrument of conveyance, or where he has acquired rights in the patent by estoppel which he can vindicate against the legal owner, or where he is an heir or devisee for whom the personal representative of his deceased ancestor or testator holds the patent in trust, or where he is a licensee whose exclusive privileges the licensor himself invades, or in any other case where it is evidently impossible for him to secure complete relief without the assertion of his equitable interest

notes, *post*; and *Potter v. Crowell* (1866), 1 Abbott, 89; 3 Fisher, 112.

³ That wherever the defendant may still infringe, equity will interfere, see *Potter v. Crowell* (1866), 1 Abbott, 89; 3 Fisher, 112.

§ 1089. ¹ That only the holder of the legal title to the patent can sue at law, see § 937 and notes, *ante*.

² That the owner of an equitable title only must resort to equity for relief, see *Rogers v. Reissner* (1887), 30 Fed. Rep. 525; 41 O. G. 351; *Root v.*

Lake Shore & Mich. Southern R. R. Co. (1882), 105 U. S. 189; 21 O. G. 1112.

That whenever the equitable owner can sue at law, and obtain an adequate remedy, in the name of the legal owner, equity has no jurisdiction, see *Hayward v. Andrews* (1883), 106 U. S. 272; 23 O. G. 533.

That the possession of two consistent titles does not warrant a resort to equity, see *Hayward v. Andrews* (1883), 106 U. S. 272; 23 O. G. 533.

against the infringer, equity may interfere in his behalf and administer complete relief according to the nature of his rights and the mode in which they are affected by the infringement.³

§ 1090. **No Adequate Remedy at Law where a Discovery is Necessary or the Defence Rests on Equitable Grounds.**

In many cases where the sole right of the plaintiff is to recover compensation for past infringements, it may be impossible to ascertain its measure or enforce its payment without recourse to those methods of investigation and compulsion which are peculiar to a court of equity. When data essential to the computation of the sum to which the plaintiff is entitled, or other facts material to his case, are within the personal knowledge of the defendant and cannot be ascertained except through his disclosure, equity may assume jurisdiction of the controversy in order to compel such a discovery as the plaintiff may require, and then retain it for all other purposes until entire relief has been afforded.¹ In the same manner, when the defence of the alleged infringer rests on equitable grounds, and when a suit at law would be enjoined upon his application if the plaintiff there pursued his remedy, equity will, in the first instance, entertain the plaintiff's claim in order to prevent the circuitry of action which must otherwise ensue.²

³ That one who has contracted to purchase the patent but has not perfected his legal title can sue only in equity, see § 938 and notes, *ante*.

That a licensee can sue only in equity in his own name, see § 938 and notes, *ante*.

§ 1090. ¹ That where a discovery is needed equity may take jurisdiction, see *Root v. Lake Shore & Mich. Southern R. R. Co.* (1882), 105 U. S. 189; 21 O. G. 1112; *Vaughn v. East Tennessee, Va., & Ga. R. R. Co.* (1877), 11 O. G. 789; 1 *Flippin*, 621; 2 *Bann. & A.* 537; *Perry v. Corning* (1870), 7 *Blatch.* 195; *Sickles v. Gloucester Mfg.*

Co. (1856), 1 *Fisher*, 222; 3 *Wall. Jr.* 196; *Nevins v. Johnson* (1853), 3 *Blatch.* 80.

That where an injunction or discovery is sought against a licensee, equity has jurisdiction, see *Hat Sweat Mfg. Co. v. Porter* (1888), 44 O. G. 1070.

² That where equitable rights are involved equity has jurisdiction, see *Root v. Lake Shore & Mich. Southern R. R. Co.* (1882), 105 U. S. 189; 21 O. G. 1112.

That equity will protect the equitable interest of the defendant although the plaintiff has the legal title, see *Day v. Candee* (1853), 3 *Fisher*, 9.

§ 1091. Whether Adequate Remedy Exists at Law when the Defendant's Gain from the Infringement Exceeds the Plaintiff's Loss.

Whether the mere fact that the defendant has derived pecuniary benefits from his wrongful use of the invention is sufficient to confer jurisdiction on a court of equity, in order to enforce an accounting and delivery of the profits to the owner of the patent, has been a most important and much disputed question. In favor of this ground of jurisdiction it has been often claimed, and sometimes held, that the defendant becomes by his infringement a constructive trustee, or trustee *de son tort*, for the plaintiff, and as such is accountable to him in equity for all the gains and savings which have resulted from his use of the invention.¹ This proposition has

§ 1091. ¹In *Atwood v. Portland Co.* (1880), 10 Fed. Rep. 283, Lowell, J.: (283) "The defendants contend that a suit in equity cannot be maintained because no injunction can now be issued, and they consider the account to be a mere incident to the injunction. In my opinion the account is no more incident to the injunction than the reverse. In *Eureka Co. v. Bailey Co.*, 11 Wall. 488, which was an appeal from my decision, a bill was sustained for an account of royalties due by a contract concerning a patent; but the suit was not a patent suit, and an injunction against the use of the plaintiff's invention was asked and issued as incident to the accounting, — that is to say, until the defendants should pay the royalties. A similar case is *Magic Ruffle Co. v. Elm City Co.*, 11 O. G. 501; 13 Blatch. 151, where the bill was sustained for an account under a contract relating to a patent, but without injunction, the patent having expired. Bills have been upheld and decrees rendered for an account, when the patent had expired during the progress of the cause, in *Jordan v. Dobson*, 2 Abb. (U. S.) 398; *Sickles v. Gloucester Manfg. Co.*, 1 Fish. 222; 3 Wall. Jr. 196; 4 Blatch. 229, note; *Imlay v.*

Nor. & Wor. R. Co., 4 Blatch. 227; *Neilson v. Betts*, L. R. 5 H. of L. 1; *Seymour v. Marsh*, 6 Fish. 115; affirmed, 97 U. S. 348. In this last case the point was not taken, but the fact was an obvious one, and the point was undoubtedly considered untenable. So where the patent had expired before suit was brought, or the defendant had died before or during suit, and there were no circumstances which authorized an injunction against his executor. (*Howes v. Nute*, 4 Fish. 263; *American Wood Paper Co. v. Glens Falls Paper Co.*, 8 Blatch. 513; *McComb v. Beard*, 10 Blatch. 350; *Smith v. Baker*, 5 O. G. 496; *Atterbury v. Gill*, 13 O. G. 276.) In *Draper v. Hudson*, 1 Holmes, 208, Judge Shepley refused an account because an injunction could not be granted, but he cited none of the foregoing cases, and evidently overlooked the decision of Mr. Justice Clifford and myself in *Howes v. Nute*, 4 Fish. 263. As an authority in this court, therefore, his decision is not binding. It was made upon the supposed authority of *Stevens v. Gladding*, 17 How. 447, which, when carefully examined, is found not to decide this point. An injunction having been ordered in that

been declared erroneous by the Supreme Court of the United States, in a decision which asserts that a trustee *de son tort*

case, an account was given as incident thereto ; but it was not, and, under the facts, could not be, decided that an account could never be ordered excepting as incident to an injunction. The question has lately been revived, and two judges have refused to sustain a bill after the expiration of the patent. (Vaughan v. Cent. P. R. Co., 4 Sawyer, 280 ; Sayles v. Richmond, &c., R. Co., 11 Chi. Leg. N. 281.) Two other judges, one of whom has had very great experience in patent causes, have upheld the equitable jurisdiction. (Vaughan v. East Tenn., &c. R. Co., 9 Chi. Leg. N. 255 ; 11 O. G. 789 ; Gordon v. Anthony, before Blatchford, J., April, 1879, an extract from whose judgment has been handed me. 16 Blatch. 234.) In the absence of a decision by the Supreme Court, I follow what I consider the preponderance of authority in the circuit courts. The statute of February 15, 1819 (3 St. 481), gave to the circuit courts of the United States 'original cognizance, as well in equity as at law, of all actions, suits, and controversies' arising under the Patent Laws. To this broad grant is added an express power to grant injunctions according to the course of courts of equity. This law was re-enacted in the two general acts revising and remodelling the Patent Law. (Statute July 4, 1836, § 17 (5 St. 124), and July 8, 1870, § 55 (16 St. 206).) This case arises under the law of 1870, and I have therefore no occasion to consider the effect of the provisions of the Revised Statutes upon this subject, though I should be surprised to find that they had changed the law. I do not see how it is possible to contend that this comprehensive grant of power can be construed to depend upon the added power to grant injunctions. In the following cases, very able and learned judges have

said that the jurisdiction is statutory, and not dependent upon the general rules which govern what we may call customary equity, or have simply said that the plaintiff might elect his remedy. (Nevins v. Johnson, 3 Blatch. 80 ; Sickles v. Gloucester Manfg. Co., 3 Wall. Jr. 196 ; Imlay v. Nor. & Wor. R. Co., 4 Blatch. 227 ; Howes v. Nute, 4 Fish. 263 ; Hoffheins v. Brandt, 3 Fish. 218 ; Marsh v. Seymour, 97 U. S. 348, 349 ; Perry v. Corning, 7 Blatch. 195 ; Cowing v. Rumsey, 8 Blatch. 36, 38.) Add to these the several decisions before cited, and the point seems to be established ; for those decisions can hardly rest upon a narrower foundation. Mr. Justice Grier, one of the first judges to lay down this broad rule, afterwards qualified its generality in certain dicta, but he was careful not to decide against the jurisdiction in equity. (See Livingston v. Jones, 3 Wall. Jr. 330, 344 ; Sanders v. Logan, 2 Fish. 170 ; and see Judge McKennan's explanation of these cases in McMillen v. Barclay, 5 Fish. 189, 194.) A constitutional objection might, perhaps, be raised to the denial of a jury trial in the case of a bill for the mere recovery of a definite sum of money if the plaintiff clearly required no equitable remedy or assistance whatsoever. That point has not been argued in this or any other case that I know of, and may be left for decision when it shall arise. Such cases must be rare, because the accounting in equity is a peculiar remedy, to which an action at law for damages can very rarely be adequate, unless the plaintiff chooses to consider it so. He may call for an account in equity, and if that proves unsatisfactory, may add damages in the same suit. This case might rest upon that basis." 5 Bann. & A. 533 (533).

can exist only where the property wrongfully appropriated was already subject to a trust, and that although when an account from an infringer is required the rules which govern it resemble those applied to a trustee, the duty of accounting rests on other grounds than those of a trusteeship between the infringer and the owner of the patent.² Another claim

² In *Root v. Lake Shore & Mich. Southern R. R. Co.* (1882), 105 U. S. 189; 21 O. G. 1112; Matthews, J., at great length argues and clearly demonstrates that equity has no jurisdiction where the remedy at law is adequate, and that though an infringer is treated in equity in some respects like a trustee, he is not really a trustee *de son tort* since the latter becomes such only by meddling with property already held in trust. No extract from this opinion could do justice to the subject or supply the place of the discussions and explanations therein contained.

In *Sayles v. Richmond, Fredericksburg, & Potomac R. R. Co.* (1879), 3 Hughes, 172, Hughes, J.: (178) "The question of jurisdiction did not arise in any one of these cases. Much less did the court in a single instance intimate, in the remotest manner, that notwithstanding the existence of an adequate common-law remedy equity could take jurisdiction of a bill for profits arising from the use of a patent, solely on the ground of constructive trusteeship. I have looked through the reports in vain for any direct authority for such a jurisdiction. There is such a thing known in equity jurisprudence as a trustee *de son tort*, but in every mention of such a trustee in the books, the property in respect to which a person has been regarded as a trustee *de son tort* has possessed, before the interference with it, the character of fiduciary property. I think it clear law that it is only in respect to property already subject to a trust and stamped with the fiduciary character that a person can become a trust-

tee *de son tort*. In the present case, if the assignment of the patent from Tanner to Sayles had been in trust for the benefit of beneficiaries recognized in law as such, and Sayles were here suing for the trust funds for the benefit of such beneficiaries, the defendant might, I suppose, upon the teaching of the authorities on the subject, be treated as a trustee *de son tort*, and be sued in equity. But I think that it may safely be held that in any case of constructive trusteeship the character of trustee *de son tort* does not attach in such manner as to give equitable jurisdiction over him, unless the property with which he interfered was already trust property when the interference occurred." 16 O. G. 43 (44); 4 Bann. & A. 239 (245).

In *Draper v. Hudson* (1873), 3 O. G. 554, Shepley, J.: (355) "The record in this case shows the death of the defendant. No injunction can issue against the defendant, and, as there is no proof of infringement by the executor, none can issue against him. No discovery is prayed for against the executor and there is no presumption of any knowledge by him of his testator's acts. When the title to the principal relief which is the proper subject of a suit in equity—the injunction and discovery—fails, the incident right to an account fails, also. (*Price's Pat. Candle Co. v. Beawans C. Co.*, 4 K. & J. 727; *Bailey v. Taylor*, 1 R. & M. 73; *Smith v. London & S. W. R. R. Co.*, Kay, 415; *Kerr on Injunctions*, 435.) Although the jurisdiction of the Circuit court in equity, in patent causes, rests upon statute provisions, it is to be exercised

in support of such jurisdiction grows out of the alleged right of the plaintiff to recover in all cases the gains and savings of the defendant whenever these exceed the actual damages which he has sustained. Before the act of 1870, the plaintiff could at law recover only damages measured by his own loss, however great the profits of the defendant may have been, while in equity he could secure the entire profits of the defendant without reference to the extent of his own loss.

Hence it was argued that as the law could not have intended to discriminate between owners of patents in reference to the amount of compensation for infringement, on the mere basis of their right to other equitable relief and irrespective of the injury they had actually received, it must be held that whenever the defendant's profits exceed the plaintiff's loss no adequate remedy exists at law and an accounting may be had in equity.³

Whatever force resides in this argument was much increased by the act of 1870, which gave additional advantage to the plaintiff in equity by enabling him to recover not only the gains and savings made by the defendant, but damages also where his loss exceeded the defendant's profit. The principle from which this argument is deduced rests on sound reason and true public policy. The amount of compensation justly due to the owner of a patent for a past infringement cannot depend in any degree upon his present right to an injunction, a discovery, or other equitable remedies; and to limit his recovery to simple damages in one case and allow him damages and profits in another, where the circumstances and extent of the injury have been the same, is an unreasonable and unfounded distinction against plaintiffs who have not discovered, or have been unable to begin an action for, the infringement

according to the course and principles of courts of equity; and the Supreme Court of the United States having decided in *Stevens v. Gladding*, 17 Howard, 455, that 'the right to an account of profits is incident to the right to an injunction in copy and patent right cases,' it would seem to follow that in a case like the present, where the title to equitable relief fails, the general rule

of equity applies that the incidental relief fails also." *Holmes*, 208 (209); 6 *Fisher*, 327 (328).

See also *Brooks v. Miller* (1886), 28 Fed. Rep. 615; *Jenkins v. Greenwald* (1857), 2 *Fisher*, 37; 1 *Bond*, 126.

³ That where the defendant's profits exceed the plaintiff's damages there is no adequate remedy at law, see *Perry v. Corning* (1868), 6 *Blatch*. 134.

until an injunction or other equitable relief is no longer necessary. But whether in all cases, where the plaintiff seeks for compensation on the ground of gains and savings made by the defendant, he should be permitted to proceed in equity for an accounting, presents a different question. It has, indeed, been held that whenever the defendant's gains exceed the plaintiff's loss equity has jurisdiction to order an account and enforce payment of the excess, and some courts have decided that the existence of gains and savings is alone sufficient to authorize a court of equity to entertain an action for account without regard to any other element of controversy.⁴ To this question, however, the Supreme Court has likewise given a negative answer, declaring that an account, in cases of infringement, is never *ipso facto* an equitable remedy, but is always incidental to an injunction or some other form of equitable relief, and hence that chancery acquires no jurisdiction from the fact that profits have been made by the defendant, whether these were less or greater than the damages sustained.⁵ At the same time it suggested that where the nature of the account renders equitable interposition necessary chancery jurisdiction might exist, as if an account for gains and savings might in some cases be obtained at law. The true solution of the difficulty may perhaps be found by holding the defendant responsible for his

⁴ See note 1, *ante*.

⁵ In *Root v. Lake Shore & Michigan Southern R. R. Co.* (1882), 105 U. S. 189, Matthews, J.: (215) "Our conclusion is that a bill in equity for a naked account of profits and damages against an infringer of a patent cannot be sustained; that such relief ordinarily is incidental to some other equity, the right to enforce which secures to the patentee his standing in court; that the most general ground for equitable interposition is to insure to the patentee the enjoyment of his specific right by injunction against a continuance of the infringement; but that grounds of equitable relief may arise other than by way of injunction, as where the title of the

complainant is equitable merely, or equitable interposition is necessary on account of the impediments which prevent a resort to remedies purely legal; and such an equity may arise out of and inhere in the nature of the account itself, springing from special and peculiar circumstances which disable the patentee from a recovery at law altogether, or render his remedy in a legal tribunal difficult, inadequate, and incomplete; and as such cases cannot be defined more exactly each must rest upon its own particular circumstances as furnishing a clear and satisfactory ground of exception from the general rule." 21 O. G. 1112 (1120).

profits in all cases where they exceed the damages sustained by the plaintiff, and by requiring the plaintiff to bring his action of account in a court of law whenever the number of the parties and the nature of the transactions will permit, and by allowing him to resort to equity, when the law cannot adjust the conflicting claims, under the general jurisdiction which chancery possesses over partners, bailiffs, and all others who are similarly related to each other.⁶

⁶ In reference to this proposition the question first arises whether in pursuing a legal remedy for an infringement the plaintiff is by law confined to an action on the case for damages. That such has been the general opinion must be conceded. The acts of 1790, 1793, and 1800 imposed specific penalties on an infringer, and treated the right of action for these penalties as resting on the statute, and indicated trespass on the case as the form in which the right thereto might be enforced. The acts of 1836 and 1870 and the Revised Statutes prescribe that the plaintiff *may* recover actual damages in an action on the case, and are silent as to any other method of redress. That in several cases wrongs, which in their nature are true infringements, are remedied in different modes even in courts of law is evident, as, for example, when an infringer may be treated as a licensee and sued for royalties, or a licensee who has violated his contract and lost his right to its protection may still be held for damages for breach of his agreement. If the wrong done to the plaintiff by the unauthorized use of his invention be regarded as a wrong simply, and not a mere occasion for inflicting a statutory penalty, there would seem no reason why a patentee should not seek any redress known to the law in any form which might be appropriate therefor.

A second question relates to the nature of the wrong suffered by a patentee from an infringement. Actual damages are indeed measured by actual loss;

but, as a fact, it is certainly true that the wrong committed against a patentee is often greater than the loss he has sustained by the unlawful use of his improvement. This fact is recognized by the constant practice of equity, confirmed and extended by statute, of giving to the plaintiff the entire benefit which the defendant has derived from the infringement. No servile adherence to equitable methods of procedure could preserve this rule, were it not founded in justice and in the universal conviction that the plaintiff is entitled not only to the profits of which the defendant has deprived him, but to all the advantage which has flowed from his invention. Now if the right to the defendant's profits is a right inhering in the plaintiff by reason of the infringement, as distinguished from a mere incident of equity procedure, why should not the plaintiff be allowed to treat the defendant as his agent or trustee, in law as well as equity, and where the nature of the transaction permits find his remedy by waiving the tort and suing in assumpsit or by the special action of account? See *Steam Stone Cutter Co. v. Sheldons* (1883), 24 O. G. 703; 21 Blatch. 260; 15 Fed. Rep. 608.

A third question has reference to the power of the court to remove this discrepancy, at least in part, under its authority to treble damages. In an action at law has the judge the right to take notice of the excess of the defendant's profits over the plaintiff's loss as a ground for increasing the amount awarded

§ 1092. Whether Adequate Remedy Exists at Law when the Patent has Expired before Suit is Commenced.

Upon the solution of this question depends in part that of another: Whether a court of equity can entertain an action for infringement which has been instituted since the expiration of the patent? An infringing act can be committed after the patent has expired only by the use or sale of patented articles which were made for that purpose during the life of the patent, and therefore an injunction can be necessary in these instances alone. In such cases equity has jurisdiction at whatever period the action may be brought, and may restrain the defendant in the same manner as in suits begun while the patent was still in force.¹ When the plaintiff has an equitable

by the jury? If so, relief exists in cases where actual damages are rendered, and the defendant's profits are not more than twice the plaintiff's loss. But in other cases of actual damages, and in all cases of nominal damages, this resort would fail, and the plaintiff thus suffer in the amount of his recovery, solely because no ground for equitable interference could be discovered.

In the absence of any authority directly bearing on these questions, allusions and suggestions of the courts become important. In *Root v. Lake Shore & Mich. Southern R. R. Co.* (1882), 105 U. S. 189; 21 O. G. 1112; and in *Vaughn v. East Tennessee, Va., & Ga., R. R. Co.* (1877), 1 Flippin, 621; 11 O. G. 789; 2 Bann. & A. 537,—the judges use language implying that in some form of accounting the plaintiff may have relief at law, and on that ground deny the jurisdiction of chancery unless the nature of the account is such that it cannot be as readily settled at law. But the subject is not yet sufficiently developed for the formation of a permanent opinion, nor can it be intelligently considered until the second question stated in this note has been decided.

That mere intricacy in the account

does not give jurisdiction in equity, see *Adams v. Bridgewater Iron Co.* (1886), 26 Fed. Rep. 324; 34 O. G. 1045; *Lord v. Whitehead & Atherton Mach. Co.* (1885), 24 Fed. Rep. 801; 33 O. G. 499.

§ 1092. ¹ That the use, after the patent has expired, of articles made for that purpose without authority during the life of the patent, is an infringement, see § 908 and notes, *ante*.

That the use of such articles may be enjoined after the patent expires, see *New York Belting & Packing Co. v. Magowan* (1886), 27 Fed. Rep. 111; 34 O. G. 1278; *Toledo Mower & Reaper Co. v. Johnson Harvester Co.* (1885), 23 Blatch. 332; 24 Fed. Rep. 739; 32 O. G. 1010; and cases cited in §§ 1171, 1191, 1193, and notes, *post*.

That an injunction will not be granted after a patent has expired to prevent the use or sale of articles which were made and sold during the life of the patent, the remedy being at law for the past infringement, see *Westinghouse v. Carpenter* (1888), 46 O. G. 244.

That an assignee of the damages after patent expires has adequate remedy at law and cannot sue in equity, see *Hayward v. Andrews* (1882), 12 Fed. Rep. 786.

That a bill cannot be maintained

interest without the legal title and cannot obtain adequate redress by a suit at law in the name of the legal owner, or when the defence rests upon equitable grounds, or for any reason a discovery is required, equity will also take cognizance of the action without reference to the expiration of the patent.² But when the only remedy to which the plaintiff is entitled consists in compensation for past infringements, and for these he could maintain a suit for damages at law, his right to proceed in equity for an account of profits must be determined by the answer given to the question discussed in the preceding paragraph. That such an accounting may be had in equity as incidental to other equitable relief, whether after or before the patent expires, is certain.³ It is equally certain that where no other equitable relief can be afforded, and an account of profits can be obtained at law, no suit in equity can be commenced.⁴ But

after the patent expires merely because it prays for an injunction against the use and sale of such infringing tools, &c., made during the patent, "as may be found in the defendant's possession," see *Consolidated Safety Valve Co. v. Ashton Valve Co.* (1886), 26 Fed. Rep. 319.

² That a bill for discovery will lie after the patent expires, see *Sickles v. Gloucester Mfg. Co.* (1856), 1 Fisher, 222; 3 Wall. Jr. 196; *Nevins v. Johnson* (1853), 3 Blatch. 80.

That where equitable relief of any form is necessary equity will have jurisdiction though the patent has expired, see *Root v. Lake Shore & Mich. Southern R. R. Co.* (1882), 105 U. S. 189; 21 O. G. 1112.

³ That whenever any equitable relief is required an account or damages may be also awarded, see *Burdell v. Comstock* (1883), 15 Fed. Rep. 395; *Magic Ruffle Co. v. Elm City Co.* (1877), 11 O. G. 501; 14 Blatch. 109; 2 Bann. & A. 506.

⁴ If it be conceded (as is here suggested only, but not claimed) that a

plaintiff can recover the profits of the defendant by an action at law (otherwise than as they have already been shown to be a measure of his damages), his proper remedy must be not case but assumpsit or account. Still in these actions, according to their ordinary rules, the profits must be limited to gains received, and could not embrace those remote pecuniary benefits which are represented only by the difference between a lesser and a greater loss. The real difficulty appears to lie in the fact that under our decisions as to the items entering into "profits in equity," a patentee who can sue in equity can recover a more extended money compensation for the same infringement than he could at law, and the measure of his recompense is thus made to depend in part upon his right to other relief with which the amount of his recovery is neither in theory nor in fact connected. See § 1091 and notes, *ante*.

That equity has no jurisdiction where the bill shows on its face that the patent had expired before the suit began and merely prays for an injunction, account,

when the number and relation of the parties, or the nature of the account, renders it impossible that an adequate accounting can be had at law, it seems that equity may entertain proceedings of this character, in order to secure to the plaintiff that complete redress of which he must otherwise be deprived.⁵

§ 1093. Whether Adequate Remedy Exists at Law where the Patent Expires Pending Suit.

A suit commenced in equity in good faith, while the patent is in force, is not affected by its expiration.¹ Whatever relief

and damages, and not for any special relief, see *Brooks v. Miller* (1886), 28 Fed. Rep. 615; *Campbell v. Ward* (1882), 12 Fed. Rep. 150.

⁶ That where the titles in controversy are equitable, or the nature of the account requires it, or any equitable relief is demanded, equity will take jurisdiction after the patent expires, see *Root v. Lake Shore & Mich. Southern R. R. Co.* (1882), 105 U. S. 189; 21 O. G. 1112; *Campbell v. Ward* (1882), 12 Fed. Rep. 150.

That mere intricacy in the account does not give jurisdiction in equity, see *Adams v. Bridgewater Iron Co.* (1886), 26 Fed. Rep. 324; 34 O. G. 1045; *Lord v. Whitehead & Atherton Mach. Co.* (1885), 24 Fed. Rep. 801; 33 O. G. 499.

That a bill in equity cannot be sustained after the patent expires for the mere purpose of discovering the extent of the infringement and the recovery of profits, the procedure and remedy at law being adequate, see *Lord v. Whitehead & Atherton Mach. Co.* (1885), 24 Fed. Rep. 801; 33 O. G. 499.

That after a patent has expired equity will not enjoin an action at law unless there is a purely equitable defence not available at law, see *Concord v. Norton* (1883), 16 Fed. Rep. 477.

Under the views of equity jurisdiction formerly prevailing it was frequently held that a bill for an account

of profits, without other equitable relief, could be entertained after the patent had expired. See *Atwood v. Portland Co.* (1880), 10 Fed. Rep. 283; 5 Bann. & A. 533; *Gordon v. Anthony* (1879), 16 O. G. 1135; 16 Blatch. 234; 4 Bann. & A. 248; *Stevens v. Kansas Pacific R. Co.* (1879), 5 Dillon, 486; *Sayles v. Dubuque & Sioux City R. R. Co.* (1878), 5 Dillon, 561; *Howes v. Nute* (1870), 4 Fisher, 263; 4 Clifford, 173; *Blank v. Mfg. Co.* (1856), 3 Wall. Jr. 196; 1 Fisher, 222.

§ 1093. ¹ That jurisdiction in equity over an action once properly instituted is not destroyed by the expiration of the patent, see *Beedle v. Bennett* (1887), 122 U. S. 71; 39 O. G. 1326; *Clark v. Wooster* (1886), 119 U. S. 322; 37 O. G. 1477; *Adams v. Bridgewater Iron Co.* (1886), 34 O. G. 1045; 26 Fed. Rep. 324; *Brooks v. Miller* (1886), 28 Fed. Rep. 615; *Dick v. Struthers* (1885), 25 Fed. Rep. 103; 34 O. G. 131; *Burdell v. Comstock* (1883), 15 Fed. Rep. 395.

That the expiration of the patent, pending suit, will not affect the jurisdiction if an injunction were granted or prayed for during the life of the patent, see *Burdell v. Comstock* (1883), 15 Fed. Rep. 395.

That equity will retain jurisdiction, once acquired, after the patent expires, if equitable relief were prayed for in the bill, though no injunction were asked or

was prayed for in the bill may nevertheless be granted, unless the cessation of the exclusive privilege has rendered it no longer necessary. Thus although no injunction can be issued, and though adequate redress at law might be obtained if an action for damages were now begun, the court of equity having once properly acquired jurisdiction will retain it for the purpose of an account and until the remedy of the plaintiff has been finally secured.² The interval which elapses between the institution of proceedings and the expiration of the patent is immaterial, except as bearing on the question of good faith.³

granted, see *Dick v. Struthers* (1885), 25 Fed. Rep. 103 ; 34 O. G. 131.

² In *Adams v. Howard* (1884), 19 Fed. Rep. 317, Wallace, J.: (319) "No doubt is entertained of the propriety of decreeing an accounting, although the patent has expired since the commencement of the suit, and although for that reason there should not be an injunction. The jurisdiction of a court of equity having been legitimately invoked by the complainant, he will not be sent away without redress merely because all the redress to which he was originally entitled cannot now be awarded to him. Under such circumstances, the court will retain the cause in order to completely determine the controversy." 22 Blatch. 47 (48); 26 O. G. 825 (826).

In *Imlay v. Norwich & Worcester R. R. Co.* (1858), 1 Fisher, 340, Ingersoll, J.: (342) "Exception has been taken by the defendants that, as an injunction cannot now be ordered, that the account and the other relief sought by the bill cannot be granted ; that the ordering the account, and the granting the other relief, are ancillary to the granting of the injunction, and that an account cannot be ordered unless an injunction is also ordered. The Patent Act of 1836, in the 17th section thereof, provides that all actions, suits, controversies, and cases arising under any law of the United States granting or

confirming to inventors the exclusive right to their inventions or discoveries, shall be originally cognizable, as well in equity as at law, by the Circuit courts of the United States. And it has already been expressly decided by Judge Grier, in a case tried before him, on the Sickles patent [*Sickles v. Gloucester Manufacturing Co.*, *ante*, p. 222], where, between the time of filing the bill and the hearing, the patent had expired, that an account could be ordered, and other relief granted, though on account of the expiration of the patent an injunction to restrain the further use could *not issue*." 4 Blatch. 227 (228).

Further, that equity jurisdiction is not defeated by the expiration of the patent pending suit, but the court will give any relief that may be needed, see *Gottfried v. Moerlein* (1882), 14 Fed. Rep. 170 ; *Jones v. Barker* (1882), 11 Fed. Rep. 597 ; 22 O. G. 771 ; *Bloomer v. Gilpin* (1859), 4 Fisher, 50.

Contra: *Draper v. Hudson* (1873), Holmes, 208 ; 6 Fisher, 327 ; 3 O. G. 354.

That if one of two patents counted on in the bill expires pending suit an injunction may be granted in reference to the other, and an account for damages and profits on both, see *Consolidated Safety Valve Co. v. Crosby Steam Gauge & Valve Co.* (1884), 113 U. S. 157 ; 30 O. G. 991.

³ That equity may take jurisdiction

A suit commenced without intent to ask for an injunction or other equitable interference, but merely to procure an accounting after the patent has expired in a case over which, if then brought, equity would have no jurisdiction, is an evasion of the law, and when the patent does expire will be dismissed.⁴ But though a bill is filed and an injunction issues

where under the rules of the court an injunction can issue before the patent expires, however short the period when it can be effective, and may also grant such other relief as is required, see *Singer Mfg. Co. v. Wilson Sewing Mach. Co.* (1889), 38 Fed. Rep. 586; *Westinghouse Air Brake Co. v. Carpenter* (1887), 32 Fed. Rep. 484; *Kittle v. Rogers* (1887), 33 Fed. Rep. 49; *Kittle v. De Graaf* (1887), 30 Fed. Rep. 689; *Beedle v. Bennett* (1887), 122 U. S. 71; 39 O. G. 1326; *Clark v. Wooster* (1886), 119 U. S. 322; 37 O. G. 1477; *Toledo Mower & Reaper Co. v. Johnson Harvester Co.* (1885), 23 Blatch. 332; 24 Fed. Rep. 739; 32 O. G. 1010.

That where a bill is filed on several patents soon enough to issue an injunction as to all, the expiration of either will not oust equity of jurisdiction over it as far as needed in order to give proper relief, see *New York Grape Sugar Co. v. Peoria Grape Sugar Co.* (1884), 32 O. G. 138; 21 Fed. Rep. 878.

That the Supreme Court will not reverse a decree for want of jurisdiction in the court below if when the bill was filed the court had jurisdiction, though on narrow grounds, and the defendant did not then except, see *Clark v. Wooster* (1886), 119 U. S. 322; 37 O. G. 1477.

That a court does not acquire jurisdiction until the entire title is before it, and if some of the owners are not brought in until after the patent expires, equity has no further authority and the bill must be dismissed, see *Hewitt v. Pennsylvania Steel Co.* (1885), 31 O. G. 1686; 24 Fed. Rep. 367.

That if a bill in equity is amended

after the patent expires and as amended shows ground for equitable relief, equity will retain jurisdiction, see *Reay v. Raynor* (1884), 26 O. G. 1111; 19 Fed. Rep. 308; 22 Blatch. 13.

That where a bill is filed too late for an injunction to issue before the patent expires, and adequate relief exists at law, jurisdiction in equity does not exist, see *Clark v. Wooster* (1886), 119 U. S. 322; 39 O. G. 1477; *Mershon v. Pease Furnace Co.* (1885), 23 Blatch. 329; 24 Fed. Rep. 741; 32 O. G. 1010.

That a bill filed too late for an injunction before the patent expires is to be dismissed with costs to the defendant, see *Mershon v. Pease Furnace Co.* (1885), 23 Blatch. 329; 24 Fed. Rep. 741; 32 O. G. 1010; *Davis v. Smith* (1884), 19 Fed. Rep. 823.

That a bill filed before the patent expires, but not praying for a preliminary injunction, may be amended by inserting such a prayer at any time, and if in good faith confers equity jurisdiction, see *Adams v. Bridgewater Iron Co.* (1886), 26 Fed. Rep. 324; 34 O. G. 1045.

⁴ That where a bill was filed five days before the patent expired and no effort was made to obtain an injunction, the prayer for injunction will be held a mere pretext and the case not within equity jurisdiction, see *Burdell v. Comstock* (1883), 15 Fed. Rep. 395.

That where a patent is to expire in two months it is doubtful whether equity can take jurisdiction, see *Racine Seeder Co. v. Joliet Wire-check Rower Co.* (1886), 27 Fed. Rep. 367; 37 O. G. 452.

just before the expiration of the patent, the tardiness of the application, if the plaintiff has been guilty of no laches and in good faith brings his suit, cannot defeat his right to whatever equitable relief the court may at that time or thereafter be able to afford.

§ 1094. General Rules of Equity Jurisdiction.

From this review of the nature and extent of equity jurisdiction, over cases founded on the violation of a patent privilege, the following conclusions may be drawn:¹ (1) That primary jurisdiction over all suits for infringement resides in courts of law, and that whenever adequate redress can be obtained by an action on the case for damages, or other common-law proceeding, equity has no jurisdiction; (2) That where an adequate remedy at law does not exist, whatever may be the cause or the degree of such inadequacy, equity will take cognizance of the action, and will retain it until complete redress has been afforded; (3) That no adequate remedy exists at law in cases where future infringements are to be prevented, or a discovery is required, or equitable interests are to be protected, or equitable defences are to be urged, or perhaps where an account of profits cannot be obtained by methods known to courts of law, and therefore that in all these cases equity has jurisdiction to entertain original proceedings and to administer entire relief; (4) That in any case, in which the peculiar circumstances of the parties or the controversy render a just determination of the issues impos-

§ 1094. ¹ For a history and discussion of the equity jurisdiction over actions for infringement, see *Root v. Lake Shore & Mich. Southern R. R. Co.* (1882), 105 U. S. 189; 21 O. G. 1112; *Motte v. Bennett* (1849), 2 Fisher, 642.

That equity will not entertain a case unless the prospect of affording ultimate equitable relief is reasonable, see *Brooks v. Miller* (1886), 28 Fed. Rep. 615.

That equity will not entertain a matter which a party has had a chance to litigate in another court, in a case there

decided against him, unless something prevented him from urging it, see *Brooks v. Moorhouse* (1878), 13 O. G. 499; 3 Bann. & A. 229.

That in some cases legal and equitable jurisdiction are concurrent notwithstanding Sec. 723, Rev. Stat., see *Spring v. Domestic Sewing Mach. Co.* (1882), 22 O. G. 1445; 13 Fed. Rep. 446.

That the equity powers of the Federal Courts under the Patent Acts include all the incidents of equity jurisdiction, see *Potter v. Dixon* (1863), 2 Fisher, 381; 5 Blatch. 160.

sible at law, equity may interfere and apply such remedies as the cause demands.

§ 1095. Equity Jurisdiction not Confrable by Waiver or Agreement of Parties.

A want of jurisdiction in equity, on account of the existence of an adequate remedy at law, cannot be waived by any acquiescence or agreement of the parties to the suit.¹ It is an incurable defect of which advantage may be taken at any stage of the proceedings; and whenever noticed by the court, whether or not insisted on by the defendant, the suit will be dismissed and the plaintiff will be left to the pursuit of his legal remedy.

§ 1096. Local Jurisdiction in Equity in General Identical with that at Law.

Actions in equity may be brought in any district within which the defendant can be personally and lawfully served with process. The rule on this point is the same as that in actions at law.¹ A service by the attachment of property con-

§ 1095. ¹ In *Spring v. Domestic Sewing Mach. Co.* (1882), 13 Fed. Rep. 446, Nixon, J.: (448) "But it is never too late at any time, during the pendency of the proceedings, for the court to examine into its right and power to make a decree or enter a judgment in a case. In the Federal courts, especially, where there is no presumption in favor of jurisdiction, but where it rests solely upon the facts which appear in the record of the suit (*Ex parte Smith*, 24 U. S. 456), it has long been the practice of the judges, at any state of the proceedings, *sua sponte*, to decline jurisdiction and dismiss the case, when the want of authority to act becomes apparent. They do not wait for the question to be raised by demurrer or answer or plea, or to be suggested by the counsel. And they pursue this course for obvious reasons. It is not merely a matter of the form of procedure. To entertain a

suit in equity, when the party has a plain and complete remedy at law, is to deprive the defendant of his constitutional right of trial by jury. The late Justice Baldwin, of this circuit, discusses the subject with much ability and research, in the case of *Baker v. Biddle*, 1 Bald. 394. See, also, the more recent cases of *Hipp v. Babin*, 19 How. 278; *Lewis v. Cocks*, 23 Wall. 466; *Dumont v. Fry*, 12 Fed. Rep. 21." 22 O. G. 1445 (1446).

That an evident defect in jurisdiction may be taken advantage of at the hearing, see *Burdell v. Comstock* (1883), 15 Fed. Rep. 395.

That want of jurisdiction over the subject-matter cannot be waived, see *Gould on Pleading*, ch. v. §§ 14-25; *Cooley Const. Lim.*, pp. 398-407.

§ 1096. ¹ That a suit in equity for infringement may be brought in any district where the defendant may be

fers no jurisdiction over the person, nor does a service on the defendant, while attending other legal proceedings under the protection of the court, compel him to answer and defend the suit in which such service has been made.³ A corporation can be sued in any district in the State from which its charter was received, or in any foreign district in which it can be served with process according to the local law.³ Service upon its officers within the district, in the absence of local provisions to the contrary, is not service on the corporation, nor is the objection waived though the officers served appear by attorney and plead to the jurisdiction.⁴ When any defendant is sued out of his own district it must appear, by the marshal's return on the *subpœna*, that he was personally served in the district of suit.⁵ A defendant, appearing by attorney, submits to the jurisdiction, and in all cases waives the objection unless he duly and seasonably urges it as a ground for the dismissal of the action.⁶

§ 1097. Local Jurisdiction in Equity, wherein Different from that at Law.

In one respect, however, this subject of local jurisdiction raises a different question in equity from that which it presents at law. A judgment in a court of law for damages ren-

found, though he resides in another district and infringes there, see *Thompson v. Mendelsohn* (1871), 5 Fisher, 187; but see § 934, note 3, *ante*.

That the local jurisdiction of a Federal court of equity over the person in patent cases is governed by the same rules as that of a court of law, see Sec. 739, Rev. Stat.; also *Winter v. Ludlow* (1859), 3 Phila. 464; *Chaffee v. Hayward* (1857), 20 How. 208; *Day v. Newark Mfg. Co.* (1850), 1 Blatch. 628; *Allen v. Blunt* (1849), 1 Blatch. 480.

² That service by attachment of property cannot confer jurisdiction, see *Saddler v. Hudson* (1854), 2 Curtis, 6; *Day v. Newark Mfg. Co.* (1850), 1 Blatch. 628.

That service on the defendant within the district while attending court or an examination of witnesses is not valid, see § 934 and notes, *ante*.

³ For the rules governing service on corporations, see § 935 and notes, *ante*.

⁴ As to service on the officers of a corporation, see § 935 and notes, *ante*.

⁵ That the marshal's return must show that the service was legally made within the district, see *Allen v. Blunt* (1849), 1 Blatch. 480.

⁶ That defect of service is waived by appearance unless immediate objection is taken, see *Teese v. Phelps* (1855), 1 McAllister, 17.

That a defect in signing the citation is cured by appearance, see *Chaffee v. Hayward* (1857), 20 How. 208.

ders the defendant liable to the plaintiff for the payment of a definite sum of money that can be collected out of his property wherever situated, without regard to the limits of the district in which the judgment was obtained. A decree in equity, on the other hand, can be enforced only against the person of the defendant, and within the territorial jurisdiction of the court by which it was passed. Hence where the relief prayed for in the bill cannot be wholly or in part afforded, without the exercise of authority over the person of the defendant beyond the limits of the district within which the suit is brought, the court can make no order that will benefit the plaintiff and must, therefore, decline to entertain the case.¹ Thus for the prevention of future infringements, or other similar redress which can be enforced only within a given district, the action in equity must be instituted in that district although a legal remedy might be obtained wherever the defendant could be found.² To this rule there is one exception, in favor of the district in which the defendant resides, the court of such

§ 1097. ¹ That equity will not take jurisdiction where it has no power to enforce its decrees, see *Goodyear v. Chaffee* (1855), 3 Blatch. 268.

² In *Locomotive-Engine Safety-Truck Co. v. Erie R. R. Co.* (1872), 3 O. G. 93, Blatchford, J.: (97) "Under this bill, therefore, the plaintiffs, having proved an infringement by the use in this district of the engine referred to, are entitled to a decree for an accounting by the defendants in respect of all infringements committed in this district by making or using or vending therein, and to an injunction against making in this district, and against using therein, and against vending therein. If the plaintiffs desire to proceed for an account and an injunction in respect of infringements in the Northern District, they must proceed by bill filed there. The defendants are suable in the Circuit Court for that district, their legal existence, under their incorporation by the State of New York, being co-extensive with the territorial

limits of that State." 10 Blatch. 292 (306); 6 Fisher, 187 (202). This case seems to have turned, however, on a special statute, as also the following: *Hodge v. Hudson River R. R. Co.* (1868), 3 Fisher, 410; 6 Blatch. 85.

That an infringement by sale takes place in the territory of delivery, see *Hobbie v. Smith* (1886), 27 Fed. Rep. 656.

That the defendant may waive the objection that the cause of action arose in another district, and does waive it unless he sets it up in his answer, see *Black v. Thorne* (1872), 5 Fisher, 550; 2 O. G. 388; 10 Blatch. 66.

That pendency of a suit in equity in one district is no bar to another suit in a different district, see *Rumford Chemical Works v. Hecker* (1874), 5 O. G. 644; 11 Blatch. 552; 1 Bann. & A. 120; *Wheeler v. McCormick* (1873), 4 O. G. 692; 6 Fisher, 551; 11 Blatch. 334; *Wheeler v. McCormick* (1871), 4 Fisher, 433; 8 Blatch. 267.

district being presumed to have a continuing authority over the defendant, by virtue of his residence within its jurisdiction, and consequently able to enforce its decrees against him, to whatever wrongful acts they may relate. A suit may consequently be maintained against him in that district, though the infringing acts to be enjoined or compensated for would be or were committed beyond its territorial limits.³

§ 1098. Parties Plaintiff in Equity.

The parties to a suit in equity comprise all those persons, natural or artificial, who can be affected by the decree, without regard to their number or the diversity of their relations to the subject-matter of the controversy.¹ Any person having, at the time of the infringement, either a legal or an equitable interest in the patented invention, which has been or is capable of being prejudiced by the infringing act, may be a party plaintiff.² Legal and equitable owners may be joined as plaintiffs, and if no party plaintiff has a legal or an equitable interest the suit must be dismissed.³ In whom an interest vests may be determined by the local law in pursuance of which the contract creating or transferring it was made.⁴ The patentee possesses such an interest until he has finally and irrevocably parted with the entire monopoly, although his sole right may

³ That equity has jurisdiction to enforce its decrees against a resident in the district wherever the infringement was committed, see *Hatch v. Hall* (1884), 22 Fed. Rep. 438; 30 O. G. 1096.

§ 1098. ¹ That all persons to be affected by the decree must be made parties in equity, see *Williams v. Bankhead* (1873), 19 Wall. 563; *West v. Randall* (1820), 2 Mason, 181.

² That the legal owner may recover damages in equity, though he may have a partner in the business of making and selling the invention, see *Yale Lock Co. v. Sargent* (1886), 117 U. S. 536; 35 O. G. 497.

That an equitable title is as good in equity as a legal one, see *Ruggles v. Eddy* (1872), 5 Fisher, 581; 10 Blatch.

52; *Continental Windmill Co. v. Empire Windmill Co.* (1871), 4 Fisher, 428; 8 Blatch. 295.

That where the title is doubtful through many assignments, equity will take jurisdiction over all parties, see *Bicknell v. Todd* (1851), 5 McLean, 236.

³ That the bill will be dismissed if the evidence shows that the complainant had no legal or equitable interest in the controversy, see *Pelham v. Edelmeyer* (1883), 15 Fed. Rep. 262; 25 O. G. 292; 21 Blatch. 188.

⁴ That the local law may determine who are the parties in interest, see *Lorillard v. Standard Oil Co.* (1880), 17 O. G. 1507; 18 Blatch. 199; 2 Fed. Rep. 902; 5 Bann. & A. 432.

consist of a reversion expectant on the termination of some subordinate ownership or on the nonfulfilment of certain future conditions, or though he may have agreed to sell to others undivided interests in the patent.⁵ An assignee is entitled to equal recognition with the patentee, even before the agreement to assign has been executed by the delivery of the written instrument of conveyance, provided he has fulfilled the conditions upon which the conveyance was to take effect, though where these conditions remain unfulfilled his right to be a party to the suit may be doubted.⁶ Where an assignment has been made before the issue of the patent, and the patent has been granted to the assignee, the applicant or inventor has no interest which equity can protect in any action for infringement, whatever contract rights might be enforced between him and the owner of the patent. A grantee has within his territory the same ownership as a patentee or assignee possesses throughout the whole United States, and may appear as plaintiff whenever the infringement would affect his territorial

⁵ That when the patentee retains any interest in the patent, present or expectant, he must be a party in equity, see § 939 and note 2, *ante*.

That a reservation of a share in the profits, or of royalties, does not entitle the grantor to sue, see *Rude v. Westcott* (1889), 130 U. S. 152; *Tilghman v. Proctor* (1888), 125 U. S. 136; 43 O. G. 628.

That a patentee may sue at law in his own name though he is under contract to hold the patent for the benefit of others, but in equity the others may be made parties against the infringers, see *Wheeler v. McCormick* (1873), 4 O. G. 692.

That a licensor may sue though he has given an exclusive license to make and sell throughout the United States, see *Freese v. Swartchild* (1888), 38 Fed. Rep. 141.

⁶ That assignees as well as inventors may invoke the equity powers of the courts, see *Jenkins v. Greenwald* (1857), 2 Fisher, 37; 1 Bond, 126.

That the assignee of an extension may have an injunction against licensees whose rights expired with the original term, see *Mitchell v. Hawley* (1873), 16 Wall. 544; 3 O. G. 241; 6 Fisher, 331.

That whether a person who has a right, upon performing certain conditions, to become the equitable owner of an extended term, but who has not yet fulfilled the conditions, ought to be made a party to a bill filed by the other equitable owners to restrain a third party from infringing, is doubtful, see *Aiken v. Dolan* (1867), 3 Fisher, 197.

That under an assignment of a patent, as security for a debt not due, the assignee should be made a party in equity, and a complete assignment to him pending suit does not change the legal status of the plaintiff, see *Waterman v. McKenzie* (1886), 39 O. G. 122; 29 Fed. Rep. 316.

rights.⁷ A licensee, although unable to sue in his own name at law, may be a plaintiff in a court of equity, if the infringing acts of the defendant impair the value of his license, and may be joined as plaintiff with his licensor, the owner of the patent, or may sue alone when the licensor himself is the infringer.⁸ The government, pending proceedings for repeal, has no such interest in the invention or the patent as warrants it in suing for infringement either at law or equity.⁹

§ 1099. Joinder of Plaintiffs in Equity.

All legal owners of the patent, and all equitable owners who have been or would be injured by the infringement, should be joined as plaintiffs, and if they refuse to sue as plaintiffs should be made defendants.¹ If the patentee

⁷ That a part-owner may sue alone for the protection of his own interest, but must make his co-owners respondents, see *Spring v. Domestic Sewing Mach. Co.* (1882), 22 O. G. 1445 ; 13 Fed. Rep. 44. , *Sheehan v. Great Eastern R. Co.* (1880), L. R. 16 Ch. D. 59.

⁸ That a bill by a licensee, not joining the owner of the patent, is demurrable, see *Bogart v. Hinds* (1885), 33 O. G. 1268 ; 25 Fed. Rep. 484 ; *Birdsell v. Shaliol* (1884), 112 U. S. 485 ; 30 O. G. 261.

That a licensee to use for one purpose only cannot sue without joining the owner of the patent, see *Cottle v. Kremenetz* (1885), 25 Fed. Rep. 494.

Contra :

That a licensee may enjoin in a bill, in his own name, any one who infringes his rights under his license, see *Brammer v. Jones* (1867), 3 Fisher, 340 ; 2 Bond, 100.

That a licensee may sue in equity against the patentee for the infringement by the patentee himself of rights secured by the license, see *Littlefield v. Perry* (1874), 21 Wall. 205 ; 7 O. G. 964.

That a suit by the patentee alone with the consent of the licensee is a bar

to a new suit against the same defendant though the licensee be then joined as plaintiff, see *Birdsell v. Shaliol* (1884), 112 U. S. 485 ; 30 O. G. 261.

⁹ That no injunction can be granted at the prayer of the United States to restrain suits for infringement, pending proceedings for repeal, the United States having no interest in such suits, see *United States v. Colgate* (1884), 21 Fed. Rep. 318 ; 22 Blatch. 412.

§ 1099. ¹ That all owners of the patent must be parties to a suit in equity for its infringement, see *Jordan v. Dobson* (1870), 4 Fisher, 232 ; 2 Abbott, 398 ; 7 Phila. 533.

That in equity the party injured by the infringement may be joined with the patentee as plaintiff, see *Goodyear v. Allyn* (1868), 3 Fisher, 374 ; 6 Blatch. 33.

That the proper parties to a bill for an injunction are the owner of the legal title to the patent and the person equitably entitled to the damages, these being the parties immediately injured by the infringement, see *Goodyear v. Railroad* (1853), 1 Fisher, 626.

That it is not essential in equity that the adverse parties be on opposite sides, see *Campbell v. James* (1880), 2 Fed.

retains any interest in the patent, whether it be present or reversionary, certain or contingent, he should join with his grantee or assignee.² All assignees, whether their rights are conditional or absolute, and whether or not they are evidenced by the required written conveyance, are also necessary parties.³ Grantees, within whose territory and against whose exclusive privileges the infringement was committed; ⁴ licensees, to whose prejudice the defendant has wrongfully practised the invention; ⁵ the heirs or devisees of a deceased owner, in whose interest the executor institutes a suit; ⁶ *cestuis que trust* of any class, whose equitable rights could be affected by

Rep. 338; 18 O. G. 1111; 18 Blatch. 92; 5 Bann. & A. 354.

² That if the patentee retains any interest in the patent he must be a party, see *Wheeler v. McCormick* (1873), 4 O. G. 692; *Dibble v. Augur* (1869), 7 Blatch. 86.

³ That one claiming under a contract to assign must be joined, see *Wheeler v. McCormick* (1873), 4 O. G. 692.

⁴ That a grantee must be a party when his rights are invaded, see § 941 and notes, *ante*.

⁵ That a licensee cannot sue at law in his own name but in the name of the patentee only, while in equity he may be joined as plaintiff with his licensor, and if not joined at the outset the court may order him to be made a party, see *Birdsell v. Shaliol* (1884), 112 U. S. 485; 30 O. G. 261.

That the owner of a patent and the owner of an exclusive right to make and sell for use abroad may join as plaintiffs in a bill in equity against parties who make and sell for use abroad, see *Dorsey Revolving Harvester Rake Co. v. Bradley Mfg. Co.* (1874), 12 Blatch. 202; 1 Bann. & A. 330.

That in an action brought by a licensee the owner of the patent must be a party, see *Gamewell Fire Alarm Telegraph Co. v. City of Brooklyn* (1882), 14 Fed. Rep. 255; 22 O. G. 1978.

That one of two or more licensees may recover of the infringer his proportion of the profits and damages without joining the others, unless objection for nonjoinder is made, see *Adams v. Howard* (1884), 23 Blatch. 27; 22 Fed. Rep. 656.

That the licensee of an exclusive right to make a particular machine containing the patented device need not be joined, see *Nellis v. Pennock Mfg. Co.* (1882), 13 Fed. Rep. 451; 22 O. G. 1131; 15 Phila. 493.

That under Sec. 17, act of 1836, the licensor is a "party aggrieved," and may sue in equity without joining his licensees, see *Hussey v. Whitely* (1860), 2 Fisher, 120; 1 Bond, 407.

⁶ That heirs for whom an administrator holds in trust must be made parties to a suit in equity on a patent, see *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.* (1874), 6 O. G. 34; 1 Bann. & A. 177; 10 Phila. 227; *Stimpson v. Rogers* (1859), 4 Blatch. 333.

That when an inventor during his lifetime assigns his interest his assignees, not his heirs, must be made parties, see *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.* (1874), 6 O. G. 34; 1 Bann. & A. 177; 10 Phila. 227.

an action brought by their trustee, — must in like manner be made plaintiffs or defendants.⁷ A licensee can sue alone in equity when his licensor is the infringer and is made defendant, but not otherwise.⁸

§ 1100. Addition of New Plaintiffs Pending Suit.

Whenever necessary parties are omitted at the commencement of the action the court may order them to appear and be made parties, and until they do appear it may suspend proceedings and refuse to hear those who are already on the record.¹ When the licensor has sued alone the defendant may obtain an order that the injured licensee be joined.² A suit brought by the licensee alone may be corrected by a subsequent joinder of the actual owner of the patent.³ An equitable owner, who has commenced his action in the name of the person holding the legal title, may be entered on the record as a co-plaintiff, on his own motion at any time before the final hearing.⁴ These various additions may be made at the request

⁷ That if one person has the legal and another the equitable title to the patent a suit in equity for infringement must make both parties, see *Gamewell Fire Alarm Telegraph Co. v. City of Brooklyn* (1882), 22 O. G. 1978 ; 14 Fed. Rep. 255.

That when all a patentee's right vests in a trustee by agreement with third parties, a suit must be brought by a bill joining the trustee and *cestuis que trust*, see *Dibble v. Augur* (1869), 7 Blatch. 86.

⁸ That where the licensor is the infringer the licensee may sue alone in his own name, see *Littlefield v. Perry* (1874), 21 Wall. 205 ; 7 O. G. 964.

§ 1100. ¹ That a defect of parties may be cured by amendment, see *Harrison v. Rowan* (1819), 4 Wash. 202.

That if a decree cannot be made until absent persons become parties, the court may order an amendment and suspend proceedings till they appear, see *Wallace v. Holmes, Booth, & Haydens* (1871), 5 Fisher, 37 ; 1 O. G. 117 ; 9 Blatch. 65.

² That a licensee, if equitably entitled to the damages, should be a party, see *Goodyear v. Railroads* (1853), 1 Fisher, 626.

That a mere licensee, as such, is not a necessary party, see *Forbes v. Barstow Stove Co.* (1864), 2 Clifford, 379 ; *Hussey v. Whitely* (1860), 2 Fisher, 120 ; 1 Bond, 407.

That the court may order the licensee to be joined if the defendant demands it, or his presence is necessary to a decree, see *Birdsell v. Shaliol* (1884), 112 U. S. 485 ; 30 O. G. 261.

That a patentee being plaintiff cannot afterwards join with him a licensee having the exclusive right to make and sell, though the defendant knew of the licensee's claim, see *Goodyear v. Bourn* (1855), 3 Blatch. 266.

³ That a suit brought by a licensee may be amended by bringing in the real owner, see *Gamewell Fire Alarm Telegraph Co. v. City of Brooklyn* (1882), 22 O. G. 1978 ; 14 Fed. Rep. 255.

⁴ That the owner of an equitable

of any party to the suit, or of the person who desires to be made a party, or when the court itself perceives that complete justice cannot otherwise be done. An order of the court directing such additions cannot be enforced unless the required party can be served with a *subpœna* within the jurisdiction, or voluntarily appears and enters as a plaintiff or defendant.⁵ New parties cannot be added where the effect of the addition would be the institution of a new suit, both as to the parties and the rights of action.⁶

§ 1101. **Plaintiffs in Equity Must Sue in their own Names.**

The real parties in interest must bring their action in equity in their own names and not in that of any attorney or other delegate, since those who are to be affected by the decree must be in court and subject to its orders.¹ A corporation must sue in its corporate name, but an unincorporated association in the names of all its members.² An assignee should sue in his own name though his assignment is not yet recorded; and if the assignment covers the assignor's claims against past infringers, he can maintain an action in his own name for these as well as for future violations of the patent.³ A grantee whose territorial rights have been

right, having begun a suit for his own benefit and at his own expense in the name of the legal owner, may be joined as plaintiff upon motion made after the answer has been filed, the evidence heard, and the case set down for final hearing, see *Patterson v. Stapler* (1881), 7 Fed. Rep. 210.

⁵ That persons not within the jurisdiction cannot be made parties unless they voluntarily appear, see Sec. 737, Rev. Stat.

⁶ That a new party cannot be added to the bill when the effect would be to institute a new suit both as to the parties and the rights of action, see *Goodyear v. Bourn* (1855), 3 Blatch. 266.

§ 1101. ¹ That an action cannot be brought in the name of any attorney or delegate, see § 944, note 4, *ante*.

That a suit at law by order of chancery may be brought in the name of any one in the district who has an interest which the defendant has violated, see *Woodworth v. Edwards* (1847), 3 W. & M. 120; 2 Robb, 610.

² That an association must sue in the names of its members, see *Metal Stamping Co. v. Craudall* (1880), 18 O. G. 1531.

³ That under Sec. 4919, Rev. Stat., an assignee of the patent and of all claims for damages can recover in his own name on claims for past infringements as well as for infringements since the assignment, see *Adams v. Bellaire Stamping Co.* (1885), 25 Fed. Rep. 270; 33 O. G. 623.

That an assignee may sue in his own name though his assignment was not recorded before his bill was filed, see

invaded must also sue in his own name.⁴ Licensees cannot sustain an action in their own names alone, except when the licensor is the infringer, but must sue in the name of the owner of the patent from whom they derive their licenses and with whom they may join themselves as plaintiffs.⁵

§ 1102. Misjoinder of Plaintiffs.

The misjoinder of plaintiffs, not being real parties in interest, can be taken advantage of by the defendant on a demurrer to the bill for want of equity, and the bill as to such parties may then be dismissed.¹ But such misjoinder will not prevent the court from affording equitable relief to any party to the record who may be entitled to demand it.² After a final decree in the Supreme Court no objection for misjoinder will avail.³ The nonjoinder of parties may be cured by adding the omitted parties to the record after the proper order and appearance, or by a disclaimer of their title, in favor of the actual plaintiff, on the part of those whom the defendant asserts should have been joined.⁴ An objection on the ground of a nonjoinder is not favored when the defendant is an in-

Gay v. Cornell (1849), 1 Blatch. 506; Pitts v. Whitman (1843), 2 Story, 609; 2 Robb, 189. *Contra*: Wyeth v. Stone (1840), 1 Story, 273; 2 Robb, 23.

⁴ That a grantee may sue in his own name, see § 941 and notes, *ante*.

⁵ That a licensee cannot sue in his own name alone even in equity, see Birdsell v. Shaliol (1884), 112 U. S. 484; 30 O. G. 261; Union Paper Bag Mach. Co. v. Nixon (1882), 105 U. S. 766; 21 O. G. 1275; Littlefield v. Perry (1874), 21 Wall. 205; 7 O. G. 964. *Contra*: Brammer v. Jones (1867), 3 Fisher, 340; 2 Bond, 100.

That where the owner of the patent is the infringer, the licensee may sue in his own name only, see Littlefield v. Perry (1874), 21 Wall. 205; 7 O. G. 964.

That a suit in equity for the benefit of the licensee may be in the joint names of the licensee and the owner of the pat-

ent, see Birdsell v. Shaliol (1884), 112 U. S. 485; 30 O. G. 261.

§ 1102. ¹ That a misjoinder of plaintiffs, not interested parties, can be reached by a demurrer for want of equity, see Hodge v. North Missouri R. R. Co. (1869), 4 Fisher, 161; 1 Dillon, 104.

² That a misjoinder of plaintiffs will not prevent an injunction, if any of them are entitled to it, see Woodworth v. Hall (1846), 1 W. & M. 248; 2 Robb, 495.

³ That an objection on the ground of misjoinder is too late after final decree in the Supreme Court, see Livingston v. Woodworth (1853), 15 How. 546.

⁴ That nonjoinder may be cured by a disclaimer of title by the absent parties in favor of the record plaintiff, see Graham v. Geneva Lake Crawford Mfg. Co. (1880), 11 Fed. Rep. 133; 21 O. G. 1536.

fringer and has denied the title of the absent parties, or when the record plaintiff is the legal owner of the patent and the interest of the omitted parties rests upon an ancient and long dormant contract.⁵ No objection for nonjoinder can be urged on the accounting unless it has been set up in the answer, or unless the court must have the absent parties before it in order to render a decree.⁶ When the defendant sets up a nonjoinder in his answer or otherwise, he must name the parties of whose omission he complains.⁷

§ 1103. Effect of Conveyance *pendente lite* on the Rights of Parties: Collusive Suits.

Conveyances *pendente lite* do not affect the litigation as between the original plaintiff and defendant, but courts of equity will protect the rights of the real parties and secure to each his due proportion of the damages or profits resulting from the suit.¹ An assignment of the entire interest in the

⁵ That objections for nonjoinder of plaintiffs are not favored when the plaintiff has the legal title and the other interests are derived from an old and dormant contract, see *Graham v. McCormick* (1880), 11 Fed. Rep. 859; 21 O. G. 1533; 10 Bissell, 39; 5 Bann. & A. 244.

That the objection that other parties are not joined as plaintiffs has not much weight when the defendant denies their title, and it is really doubtful whether they are parties and the objector is an alleged infringer, see *Graham v. Geneva Lake Crawford Mfg. Co.* (1880), 11 Fed. Rep. 138; 21 O. G. 1536.

⁶ That a defendant who has litigated a case on its merits cannot at the hearing raise for the first time the question of defect of parties, unless indispensable parties are absent, and in that event the court will refuse to decree though the objection is not suggested, see *Adams v. Howard* (1884), 22 Fed. Rep. 656; 23 Blatch. 27; *Wallace v. Holmes, Booth, & Haydens* (1871), 5 Fisher, 37; 1 O. G. 117; 9 Blatch. 65.

That nonjoinder cannot be taken advantage of by objection to the decree, but by demurrer or answer, see *Adams v. Howard* (1884), 26 O. G. 825; 22 Blatch. 47; 19 Fed. Rep. 317.

⁷ That when a defendant objects to a bill for want of parties he must set forth what parties are wanting, see *Campbell v. James* (1880), 18 O. G. 1111; 2 Fed. Rep. 338; 18 Blatch. 92; 5 Bann. & A. 354.

§ 1103. ¹ That conveyances *pendente lite* do not affect the suit as between the original parties, but the court will protect the rights of the real owners to the fruits of the litigation, see *Campbell v. James* (1880), 2 Fed. Rep. 338; 18 O. G. 1111; 18 Blatch. 92; 5 Bann. & A. 354.

That if a plaintiff goes into bankruptcy the suit is not abated, though a supplemental bill may be required, see *Gear v. Fitch* (1878), 16 O. G. 1231; 3 Bann. & A. 573.

That a plaintiff becoming bankrupt and purchasing the right of action from his assignee, cannot be met with a plea

patent, pending suit, may reserve the avails of the action to the assignor, and equity will award these to him, while protecting the assignee against future infringements by injunction; but such an assignment, reserving the right to an injunction, calls for no equitable interference, since an injunction cannot issue in favor of one who is no longer an owner of the patent.² After a decree and an accounting, the right to the computed profits may be transferred by the plaintiff, and the transferee will be permitted to receive them, and, if necessary, to invoke the assistance of the court for their collection.³ Any person who pays the expenses of the litigation for his own benefit, under a contract with the plaintiff, in order to test the validity of the patent or the fact of infringement, or for any other legitimate purpose, has a sufficient standing in the court to enable him to control the suit;⁴ but a collusive action, in which one person bears the cost of both parties, in order to obtain a judgment to be employed in enforcing settlements or procuring injunctions against others, will not be entertained.⁵

in abatement, see *Gear v. Fitch* (1878), 16 O. G. 1231; 3 Bann. & A. 573.

² That an assignment during a suit "reserving the right to profits and damages in said suit and to have the patent declared valid, and an injunction," gives the plaintiff the right to the profits and damages up to the time of conveyance, but not to an injunction, see *Boomer v. United Power Press Co.* (1875), 13 Blatch. 107; 2 Bann. & A. 106.

³ That a bill will not be dismissed on account of the plaintiff's assignment of his interests, if it were made after the time when the computation of profits ended, see *Dean v. Mason* (1857), 20 How. 198.

That the court will enforce the rights of an assignee *pendente lite* to the avails of the suit, see *Campbell v. James* (1880), 2 Fed. Rep. 338; 18 O. G. 1111; 18 Blatch. 92; 5 Bann. & A. 354.

⁴ That a party bearing the expenses of a suit and prosecuting it for his own benefit, though in the name of another, has a right to control the proceedings, see § 938, note 5, *ante*.

⁵ That collusive suits will not be permitted, see *Barker v. Todd* (1882), 23 O. G. 438; 15 Fed. Rep. 265; and § 1182 and notes, *post*.

That a collusive decree may be annulled on the application of a stranger, see *Barker v. Todd* (1882), 23 O. G. 438; 15 Fed. Rep. 265.

That an action in which one party bears the expense of both sides, in order to obtain a judgment influencing other suits, is collusive under whatever disguise, see *Gardner v. Goodyear Dental Vulcanite Co.* (1873), 6 Fisher, 329; 3 O. G. 295.

That an agreement to sue and pay all expenses for one half the results is champerty and cannot be upheld in equity where the party suing had entire

§ 1104. Parties Defendant in Equity.

All persons who participate in the infringement, whether by performing the infringing act, or by ordering it to be committed by their servants, or by directly sharing in its benefits, may be joined as defendants.¹ A corporation may be made defendant when it profits by the unlawful use of the invention, and with it may be joined the officers by whose direction the infringing device or process is employed; or either may be sued alone without reference to the other.² When several distinct individuals are made defendants, the plaintiff's bill must show how they are related to each other, and that all are connected with the same infringing act; and where a defendant is one of a group of persons, whose operations are carried on beyond the limits of the district of the suit by their collective authority, the bill must allege that this defendant has the entire control of the infringement and can promote it or prevent it at his pleasure.³ The misjoinder of defendants does not impair the power of the court to afford relief against such of them as are found guilty of the infringement, though the bill as to the others will be dismissed.⁴

control of the claims, see *Gregerson v. Imlay* (1861), 4 Blatch. 503.

§ 1104. ¹ For rules determining who may be defendants, see §§ 946, 947, and notes, *ante*.

That complicity between defendants renders them liable to be sued in equity for a joint infringement, see *Wells v. Jacques* (1874), 5 O. G. 364; 1 Bann. & A. 60.

² For the liability of corporations and their officers, etc., see § 912 and notes, *ante*.

³ That a bill joining defendants should show how they are related to each other, whether as partners, etc., see *Shickle v. South St. Louis Foundry Co.* (1884), 22 Fed. Rep. 105.

That a bill alleging that the defendants were doing business as a company while infringing avers a joint infringe-

ment, see *Kaolatype Engraving Co. v. Hoke* (1887), 30 Fed. Rep. 444; 39 O. G. 585.

That if the defendant is one of several directors of a corporation, located and doing business in another district, it should appear that he has power alone to direct the use or disuse of the infringing device, or all or a majority of the directors must be made parties, see *Jones v. Osgood* (1869), 3 Fisher, 591; 6 Blatch. 435.

⁴ That where a bill alleges that the defendants "jointly and collectively and also separately infringed," and no joint use is shown, but the bill is not demurred to and a final hearing is had without objection, a decree may issue against each separately, see *Putnam v. Hollender* (1881), 6 Fed. Rep. 882; 19 O. G. 1423; 19 Blatch. 48.

§ 1105. Nonjoinder of Defendants.

The nonjoinder of defendants is no ground of defence against the action, unless the account of profits is inseparable, or for some other reason the presence of the omitted parties is indispensable to a decree.¹ The absence of proper defendants must be taken advantage of by the demurrer, plea, or answer, and the objection must set forth the connection of such persons with the cause of action and allege that they are within the territorial jurisdiction of the court.² If the objection is sustained, the persons named may be ordered to appear and be made parties, and if this order cannot be enforced the court will stay proceedings indefinitely or dismiss the bill.³ An amendment changing the capacity in which the defendants have been sued, and in effect creating a new defendant, cannot be allowed.⁴

§ 1106. Averments of a Bill in Equity in Actions for Infringement.

A bill in equity, in actions for infringement, must disclose the substantial groundwork of the case and contain aver-

§ 1105. ¹ That nonjoinder of defendants is no defence unless their presence is necessary to enable the court to decree any effectual relief, see *Florence Sewing Mach. Co. v. Singer Mfg. Co.* (1870), 4 Fisher, 329 ; 8 Blatch. 113.

² That the objection that the bill does not allege a joint infringement by the defendants is to be taken by demurrer, see *Fischer v. O'Shaughnessy* (1881), 6 Fed. Rep. 92.

That a plea of nonjoinder must allege that the absent defendants are within the jurisdiction, see *Goodyear v. Toby* (1868), 6 Blatch. 130.

³ That if the want of parties defendant is not objected to by demurrer, plea, or answer, it is too late to make the objection afterward, provided the court can make a decree concerning the actual parties separately from the others ; but where it cannot, the court will not proceed, though the absent

parties are out of its jurisdiction, see *Florence Sewing Mach. Co. v. Singer Mfg. Co.* (1870) 4 Fisher, 329 ; 8 Blatch. 113.

That in a suit against a mere vendee his vendor may apply to be made a defendant, and if admitted he submits to the jurisdiction for all purposes though not originally within it, but cannot set up in a cross-bill any matter which the original defendant could not have alleged, see *Curran v. St. Charles Car Co.* (1887), 32 Fed. Rep. 835.

⁴ That a bill against several defendants as copartners cannot be amended to charge them as separately the president, secretary, and directors of a company, this being unnecessary in a suit against them as individuals, and improper in a suit against the company as a whole, see *Tyler v. Galloway* (1882), 13 Fed. Rep. 477 ; 22 O. G. 1294 ; 21 Blatch. 66.

ments covering every material fact, the court having no authority to consider what is proved and not alleged, or what is alleged and not supported by the evidence.¹ The material facts in equity, as at law, relate to these five questions: (1) The performance by the alleged inventor of an inventive act resulting in the alleged invention; (2) The existence and validity of a patent protecting this invention; (3) The title of the plaintiff to that patent; (4) The infringement of that patent by the defendant; and (5) The damage sustained by the plaintiff, and the benefits accruing to the defendant, from the infringing acts. The averment of the inventive act may state the performance of the act and the resulting invention in general terms, sufficient to identify the invention with the subject-matter, and the inventor with the grantee, of the letters-patent, as these appear in the ensuing allegations.² The averment of the patent may describe it by its date and title with a *profert*, neither setting it out according to its terms,

§ 1106.¹ That the substantial groundwork of a case must be alleged in the bill or no decree can be rendered, see *Pelham v. Edelmeyer* (1883), 15 Fed. Rep. 262; 25 O. G. 292; 21 Blatch. 188.

That the bill must aver every material fact, for the court cannot consider what is proved and not alleged or what is alleged and not proved, see *Blandy v. Griffith* (1869), 3 Fisher, 609.

That a bill in equity under the act of 1870 must follow and be supported by the general doctrines of equity, see *Root v. Lake Shore & Michigan Southern R. Co.* (1882), 105 U. S. 189; 21 O. G. 1112.

For the form and requisites of a bill in equity, see *McCoy v. Nelson* (1887), 121 U. S. 484; 39 O. G. 831.

² That a bill in equity must describe the invention, not merely by date and number of the patent, but so fully as to apprise the court of its nature and characteristics, see *Post v. Richards Hardware Co.* (1885), 25 Fed. Rep. 905.

That unless a clear description of

the invention is given in the bill, the patent must be annexed or *profert* made, or the bill will be demurrable, see *Wise v. Grand Ave. R. R. Co.* (1888), 33 Fed. Rep. 277.

That the description of the invention is sufficient when the bill refers to and makes *profert* of the patent, or employs the language of the specification, or gives a full and accurate description in the pleader's own words, see *Post v. Richards Hardware Co.* (1885), 25 Fed. Rep. 905.

That the bill or declaration must allege that the invention was not in public use or on sale for more than two years before the application, see *Blessing v. Steam Copper Works* (1888) 34 Fed. Rep. 753.

That the history of the art being part of the controversy in a patent cause, the description of prior patents and the litigation thereon may be proper averments in the bill, see *Steam Gauge & Lantern Co. v. McRoberts* (1886), 26 Fed. Rep. 765; 36 O. G. 822.

nor in the case of a re-issue specifying the ground of the re-issue nor the concurrence of the owners of the original in its surrender.³ The averment of title may allege the interest of the plaintiff in the patent without reciting the chain of title or declaring that the conveyance under which he claims has been recorded, but it must define the right in which he sues, and if this right is based upon or is to be established by reference to a former judgment such judgment must be also stated.⁴ The averment of infringement need not describe the particular acts performed by the defendant, nor point out the portions of the invention which he has appropriated nor the articles produced by its unlawful use.⁵ It must allege

³ That the patent need not be set out in the bill, but a statement of title and a *profert* are enough, see *American Bell Telephone Co. v. Southern Telephone Co.* (1888), 34 Fed. Rep. 803; *McMillin v. St. Louis & Mississippi Valley Transportation Co.* (1883), 18 Fed. Rep. 260; 5 *McCrary*, 561.

That a bill on a re-issued patent need not aver that the grantee of a territorial right acted with the patentee in the surrender of the original patent, or that he concurred in the re-issue, see *Meyer v. Bailey* (1875), 8 O. G. 437; 2 *Bann. & A.* 73.

That a bill for the infringement of a re-issue need not aver the ground of re-issue, see *Spaeth v. Barney* (1885), 22 Fed. Rep. 828; 30 O. G. 997.

That a bill in equity, setting forth the issue of a patent and its re-issue with expanded Claims after two years and not explaining the delay, suggests sufficient to serve as a defence on demurrer, see *Wollensak v. Reiher* (1885), 115 U. S. 96; 31 O. G. 1301.

⁴ That the bill need not state the entire chain of title, an averment that the title is in the complainants being sufficient, see *Nourse v. Allen* (1859), 3 *Fisher*, 63; 4 *Blatch*. 376.

That a plaintiff grantee need not aver the recording of his grant, but the de-

fendant may claim to be the *bona fide* owner without notice, see *Perry v. Corning* (1870), 7 *Blatch*. 195.

That an allegation of an assignment of the whole patent except in certain specified counties, if not traversed in the answer or the evidence, cannot be otherwise objected to, see *Washburn & Moen Mfg. Co. v. Haish* (1880), 4 Fed. Rep. 900; 19 O. G. 173; 10 *Bissell*, 65.

That if the plaintiff relies on a former verdict and judgment to show his title, or his right to equitable relief, his bill must aver it, see *Blandy v. Griffith* (1869), 3 *Fisher*, 609; *Parker v. Brant* (1850), 1 *Fisher*, 58.

That a bill alleging the infringement of two claims and a judgment in a former suit on one of them does not imply that full relief has been obtained in the other suit, see *Allis v. Stowell*, (1883), 15 Fed. Rep. 242; 23 O. G. 1033.

That allegations of residence of parties are not necessary to confer jurisdiction, see *Teese v. Phelps* (1855), 1 *McAllister*, 17.

⁵ In *Thatcher Heating Co. v. Carbon Stove Co.* (1878), 4 *Bann. & A.* 68, *Nixon, J.* : (69) "It was insisted that, unless the whole invention, as claimed, had been infringed, it was necessary for the complainant to specify in the bill the particular Claims of the violation of

infringing acts committed in violation of the plaintiff's rights, and disclose such circumstances of time, place, and method as show upon the face of the averment that these rights, as before described, have been invaded.⁶ The allegation must be positive and certain, not stating the infringing acts hy-

which he complained. Perhaps that would have been the correct practice to have been established in suits for the infringement of patent rights, in analogy of what is required in courts of equity in actions for relief against fraud. In such cases it is not permitted to allege fraud generally. The party alleging it must state the facts which constitute the fraud. (*Small v. Boudinot*, 1 Stockt. 391; *Rorback v. Dorsheimer*, 10 C. E. Green, 516.) But such is not the recognized practice in patent cases. A statement of the complainant's patent, and a general allegation that the defendant has infringed, is deemed sufficient to put the defendant upon his answer. (*Turrell v. Cammerrer*, 3 Fisher, 462.) . . . When the proofs are closed, and at the final hearing, the complainant is permitted to specify the Claims of the patent on which he will ask for a decree." 15 O. G. 1051 (1051).

In *Turrell v. Cammerrer* (1868), 3 Fisher, 462, Leavitt, J.: (463) "The question before the court arises upon a demurrer to a bill filed by the complainant for the infringement of letters-patent. It is objected that the bill does not state facts enough to enable the court to base a decree upon it, and it is insisted that, before the defendant can be called upon to answer, the complainant shall be required to set forth the precise infringement complained of, by some adequate description of the patented invention, and of the infringing machine or process. This he has never been required by the practice of this court to do. The general allegation of the bill that the defendant has infringed the letters-patent has been sufficient to put him

upon his answer. It would obviously be a very inconvenient practice to require the complainant to set out at length in his bill the details of his invention and of the defendant's manufacture. The bill would be very voluminous and not necessarily more clear or explicit. The defendant is, by the general averment, put in possession of the allegation that he has infringed the complainant's patent. This he may deny by answer. The burden of proof is then upon the complainant to prove infringement and to show wherein it consists. If he fails to do this, he is not entitled to relief."

Further, that the bill may allege infringement generally without specifying particulars, see *American Bell Telephone Co. v. Southern Telephone Co.* (1888), 34 Fed. Rep. 803; *Haven v. Brown* (1873), 6 Fisher, 413.

That a bill for the infringement of a machine-patent need not state what articles the defendant has made by his machine, see *Fischer v. Hayes* (1881), 5 Fed. Rep. 76; 20 O. G. 239; 19 Blatch. 26.

⁶ That no recovery can be had unless an infringement by making, using, or selling the invention, before the filing of the bill, is alleged and proved, see *Slesinger v. Buckingham* (1883), 17 Fed. Rep. 454; 8 Sawyer, 469.

That a bill alleging a grant to the plaintiffs and that the defendants are now making and using the invention against the interest of the grantees, although informal, is a sufficient charge of the infringement as occurring after the grant and within the granted territory, see *Meyer v. Bailey* (1875), 8 O. G. 437; 2 Bann. & A. 73.

pothetically, argumentatively, nor in the disjunctive;⁷ and if the patent had expired before the date of the infringement it must aver that the infringing articles were unlawfully constructed while the patent was in force.⁸ Where the plaintiff has conveyed assignable interests to others, which were outstanding when the infringement was committed, the averment of infringement must deny that the defendant used the invention under such conveyance.⁹ If there is more than one defendant the relation which subsists between them must be sufficiently delineated to indicate that all participate in the infringing acts.¹⁰ The averment of damages may be in general terms; that of profits must set forth such facts as to the mode in which the defendant has practised the invention, and the benefits he has thence derived, as in connection with the preceding averments will show that there have been pecuniary gains or savings for which the plaintiff is entitled to an account.¹¹ Where the advantage to the defendant

⁷ That an allegation of infringement must not be in the disjunctive, as "making *or* selling," but if it alleges both making *and* selling it is sustained by evidence of either, see *Locomotive Engine Safety Truck Co. v. Erie Railway Co.* (1872), 6 Fisher, 187; 3 O. G. 93; 10 Blatch. 292.

That an allegation that the defendant "has built and is now using" does not aver that he uses what he built or built what he uses, see *Locomotive Engine Safety Truck Co. v. Erie Railway Co.* (1872), 6 Fisher, 187; 3 O. G. 93; 10 Blatch. 292.

That the allegation that the defendant is making and using devices "in some parts" substantially the same in construction and operation with those of the plaintiff, though objectionable, is still sustained as a sufficient statement of infringement, see *McMillin v. St. Louis & Mississippi Valley Transportation Co.* (1883), 18 Fed. Rep. 260; 5 McCrary, 561.

⁸ That a bill to enjoin a device after the patent expires must aver that the device was made before the patent ex-

pired, see *American Diamond Rock Boring Co. v. Rutland Marble Co.* (1880), 2 Fed. Rep. 355; 18 Blatch. 147; 5 Bann. & A. 346.

⁹ That in a suit by the owner of a patent, who has sold an exclusive right for a term of years, the bill must set out that the defendant is not operating under the licensee, see *Still v. Reading* (1881), 9 Fed. Rep. 40; 20 O. G. 1025; 4 Woods, 345.

¹⁰ That where a corporation is sued for infringement and its officers are made parties, the fact that they are such officers should be averred, see *Shickle v. South St. Louis Foundry Co.* (1884), 22 Fed. Rep. 105.

¹¹ That the bill need not pray for damages *eo nomine*, but they may be awarded under the general prayer for relief, see *Emerson v. Simm* (1873), 3 O. G. 293; 6 Fisher, 281.

That the bill must state such facts as indicate that profits were realized by the defendant in order to support a prayer for an account, see *Vaughn v. Central Pacific R. R. Co.* (1877), 4 Sawyer, 280; 3 Bann. & A. 27.

can only be estimated as a whole, or from the nature of the invention or his method of infringement could not result in profits, no account in equity can be decreed.¹² But profits may be alleged as either general or special, and the actual profits appearing on the accounting will then be covered by the averment.

§ 1107. Prayers for Equitable Relief.

The bill must close with a prayer for the desired relief, and the relief sought must be, in part at least, of such a character as equity alone can grant. If the bill prays for damages only, and in most cases where it prays for profits only, it presents no ground for equitable interference.¹ With these petitions must be united one for an injunction, or a discovery, or some other remedy not obtainable at law, unless those portions of the bill relating to the parties or the title or the infringement or the profits make it apparent that out of equity the plaintiff has no adequate redress.² To each of these forms of relief special averments of the circumstances which require such relief are necessary, in addition to the ordinary allegations of the bill.³ Thus where an injunction is requested, the bill must state that the defendant threatens to commit or re-

¹² That a bill claiming an account is improper where the advantage to the defendant is a general one and can only be estimated as a whole, see *Sayles v. Richmond, Fredericksburg, & Potomac R. R. Co.* (1879), 16 O. G. 43; 3 *Hughes*, 172; 4 *Bann. & A.* 239.

That a general allegation that profits were made by the defendant is not sufficient, and if from the nature of the invention it appears that profits were not obtainable, the bill will be dismissed, see *Vaughn v. Central Pacific R. R. Co.* (1877), 4 *Sawyer*, 280; 3 *Bann. & A.* 27.

That a bill averring an assignment of all right "for and to the past use of the invention and improvements under said letters-patent," and praying for an injunction, profits and damages and other relief, is sufficient basis for a re-

covery of damages for past infringements before the assignment, see *Campbell v. James* (1880), 2 *Fed. Rep.* 338; 18 O. G. 1111; 18 *Blatch.* 92; 5 *Bann. & A.* 354.

§ 1107. ¹ That over a mere claim for damages or profits equity has no jurisdiction, see § 1087 and notes, *ante*.

² That a bill in equity will not lie for damages alone, but must pray for an injunction, a discovery, or an account, see *Vaughn v. East Tennessee, Virginia, & Georgia R. R. Co.* (1877), 11 O. G. 789; 1 *Flippin*, 621; 2 *Bann. & A.* 537.

³ That the bill must aver such facts as show that the equitable relief prayed for is necessary, see *Dunham v. R. R. Co.* (1861), 1 *Bond*, 492; *Harrison v. Nixon* (1835), 9 *Peters*, 483.

fuses to desist from an infringement, and if the injunction is to precede the trial of the cause upon its merits a prior judgment sustaining the plaintiff's right, or long continued public acquiescence in the exercise of his exclusive privilege, must be averred.⁴ When the bill prays for a discovery it must point out the facts concerning which the disclosure is required and allege the inability of the plaintiff to establish them by any evidence at his command.⁵

§ 1108. Joinder of Different Causes of Action Based on Several Patents : Multifariousness.

Where several patents belonging to the plaintiff are violated by the same infringement on the part of the defendant, these different causes of action may be united and relief for the entire injury may be afforded in a single suit.¹ A bill in equity, therefore, is not multifarious merely because it counts upon numerous patents, or alleges various infringing acts. A bill is multifarious when it joins matters perfectly distinct, or de-

⁴ That if the bill contains a prayer for an injunction the facts which render it necessary must be set forth and the plaintiff's title shown, see § 1206 and notes, *post*.

That no allegation of a trial at law should be made as the foundation for an injunction unless there was a *bona fide* trial and judgment, see *Doughty v. West* (1865), 2 Fisher, 553.

⁵ That a prayer for discovery must indicate the points for a disclosure and the absence of other evidence, see *Vaughn v. Central Pacific R. R. Co.* (1877), 4 Sawyer, 280 ; 3 Bann. & A. 27.

§ 1108. ¹ That more than one patent may be embraced in the same suit, see *Matthews v. Lalance & Grosjean Mfg. Co.* (1880), 17 O. G. 1284 ; 2 Fed. Rep. 232 ; 18 Blatch. 84 ; 5 Bann. & A. 319 ; *Parks v. Booth* (1880), 102 U. S. 96 ; 17 O. G. 1089.

That several patents may be included in one suit when their subjects-matter are correlative and are embodied in the infringing process or device, see *Nellis*

v. Pennock Mfg. Co. (1882), 22 O. G. 1131 ; 13 Fed. Rep. 451 ; 15 Phila. 493.

That suits on a patent for an original invention and on a patent for an improvement thereon are not divisible, if both patents belong to the same owner, see *Case v. Redfield* (1849), 4 McLean, 526 ; 2 Robb, 741.

That one who is sole owner of one patent and exclusive licensee under another may, joining his licensor, enjoin a device which infringes both patents, see *Huber v. Myers Sanitary Depot* (1888), 34 Fed. Rep. 752.

That where the plaintiff owns one patent in one State and the same with another patent in a second State, and on an infringement in the second State his bill counts on both patents, it is proper, see *Gillespie v. Cummings* (1874), 3 Sawyer, 259 ; 1 Bann. & A. 587.

That where all the Claims of several patents are infringed by one structure a suit on all is not multifarious, see *Hayes v. Bickelhaupt* (1885), 23 Fed. Rep. 188 ; 32 O. G. 135.

mands remedies of an independent character against separate defendants: for a defendant cannot be compelled to associate wholly different defences in his answer, to the confusion of the evidence and the protraction of the controversy, nor can the expense of proceedings against separate defendants on distinct issues be imposed upon him.² No universal test of multifariousness can be established; but whenever, in its sound discretion, the court perceives that the defendant is embarrassed by the multiplicity of the plaintiff's claims, the bill may be treated as defective and its reduction to a more simple form required.³ In actions for infringement, as a general rule, the

² In *Hayes v. Dayton* (1880), 8 Fed. Rep. 702, Blatchford, J.: (703) "A bill is multifarious when it improperly unites in one bill against one defendant several matters perfectly distinct and unconnected, or when it demands several matters of a distinct and independent nature against several defendants in the same bill. The reason of the first case is that the defendant would be compelled to unite in his answer and defence different matters wholly unconnected with each other, and thus the proofs applicable to each would be apt to be confounded with each other, and delays would be occasioned by waiting for the proofs respecting one of the matters when the others might be fully ripe for hearing. The reason of the second case is that each defendant would have an unnecessary burden of costs by the statement in the pleadings of the several claims of the other defendants with which he has no connection." 18 O. G. 1406 (1407); 18 Blatch. 420 (421).

That in equity several causes of action may be joined between the same parties to avoid multiplicity of action, unless the defence may be embarrassed by confounding different issues and proofs, see *Nourse v. Allen* (1859), 3 Fisher, 63; 4 Blatch. 376.

³ In *Hayes v. Dayton* (1880), 8 Fed. Rep. 702, Blatchford, J.: (704) "Where

there is a joinder of distinct claims between the same parties it has never been held, as a general proposition, that they cannot be united, and that the bill is of course demurrable for that cause alone. Nor is there any positive, inflexible rule as to what, in the sense of courts of equity, constitutes a fatal multifariousness on demurrer. A sound discretion is always exercised in determining whether the subject-matters of the suit are properly joined or not. It is not very easy, *a priori*, to say exactly what is or what ought to be the true line regulating the course of pleading on this point. All that can be done in each particular case, as it arises, is to consider whether it comes nearer to the class of decisions where the objection is held to be fatal, or to the other class, where it is held not to be fatal. In new cases the court is governed by those analogies which seem best founded on general convenience, and will best promote the due administration of justice, without multiplying unnecessary litigation on the one hand, or drawing suitors into needless and oppressive expenses on the other." 18 O. G. 1406 (1407); 18 Blatch. 420 (422).

That whether a bill is multifarious depends on the circumstances of each case and the court must act on its discretion in sustaining it, see *United States v.*

bill will not be multifarious unless it charges several distinct violations of several independent patents. Where the same infringement, whether it be committed by one act or by a series of acts, invades the rights conferred on the plaintiff by numerous patents, he is not forced to divide the infringement into portions measured by the invention covered by each patent and pursue a separate remedy for every violated right.⁴

American Bell Telephone Co. (1888), 128 U. S. 315; Singer Mfg. Co. v. Springfield Foundry Co. (1888), 34 Fed. Rep. 393.

⁴ In *Hayes v. Dayton* (1880), 8 Fed. Rep. 702, Blatchford, J.: (704) "We are not without cases on this subject, in suits on patents in this country. In *Nourse v. Allen* (4 Blatch. C. C. R. 376), in 1859, before Mr. Justice Nelson, a bill on four patents was held good on demurrer, where it alleged that the machine sued contained all the improvements in all the patents. The court thought that the convenience of both parties, as well as a saving of the expenses in the litigation, seemed to be consulted in embracing all the patents in one suit in such a case; and that although the defences as respected the several improvements might be different and unconnected, yet the patents were connected with each other in each infringing machine. In *Nellis v. McLanahan* (6 Fisher's Patent Cases, 286), in 1873, before Judge McKennan, it was held that where a suit in equity is brought for the infringement of several patents for different improvements not necessarily embodied in the construction and operation of any one machine, the bill must contain an explicit averment that the infringing machines contain all the improvements embraced in the several patents, or it will be held bad for multifariousness on demurrer. In *Gillespie v. Cummings* (3 Sawyer, 259), in 1874, before Judge Sawyer, the bill was founded on two patents for the manufacture of brooms. There was a demurrer

on the ground of the joinder of two separate and distinct causes of action. It appearing by the bill that the defendant's broom, if infringing, must be an infringement of both of the patents, and that there was therefore a common point to be litigated, and much of the testimony must from the nature of things be applicable to both of the patents, the bill was held good. In *Horman Patent Mfg. Co. v. Brooklyn City R. R. Co.* (15 Blatch. C. C. R. 444), in 1879, before Judge Benedict, a bill in equity on two patents alleged that the defendant was using machines containing in one and the same apparatus the inventions secured by each of the two patents. It was demurred to on the ground that it did not allege that the devices were used conjointly or connected together in any one apparatus, but the demurrer was overruled. The court held that, as the bill did not show the controversy to be of such a character that prejudice to the defendant would result from the joinder in one action of the causes of action joined, the bill must be sustained. The court was of opinion that, in the absence of any other fact, the circumstance that the two transactions complained of were the use in a single machine of two patented devices connected with the mechanism of the machine warranted the inference that no prejudice would result to the defendant from the joinder of the two transactions. The decisions above cited all tend in one direction." 18 O. G. 1406 (1407); 18 Blatch. 420 (423).

That a bill counting on several pat-

The fact that the inventions are capable of a joint employment, and that the defendant has thus wrongfully employed them, entitles the plaintiff to regard this wrongful use as constituting a single injury, and to seek his redress for it in a single action, although the defences to each patent may be different and unconnected. In such cases, however, the bill must aver, and the evidence must prove, the joint employment of the several inventions; and even then the difficulties which attend the defendant's presentation of his claims may be so great as to demand a different method of procedure.⁵ Where the inventions covered by the various patents are incapable of a united use, or are applied to separate uses by the defendant, the infringements are distinct and a bill counting upon more than one of them is multifarious.⁶ A bill is not rendered

ents is not multifarious when all are alleged to be infringed by one machine, see *Deering v. Winona Harvester Works* (1885) 24 Fed. Rep. 90; 32 O. G. 654; *Nourse v. Allen* (1859), 3 Fisher, 63; 4 Blatch. 376.

⁵ In *Lilliendahl v. Detwiller* (1883), 18 Fed. Rep. 176, Nixon, J.: (177) "A bill is not necessarily obnoxious to the charge of multifariousness because the suit is brought upon more than one patent. Courts encourage single suits upon a number of patents to avoid multiplicity of actions; but in such cases the bill of complaint, in order to be maintainable, must allege and the proofs must show that the inventions embraced in the several patents are capable of conjoint use, and are so used by the defendants."

Further, that a bill alleging the infringement of several patents must aver that the inventions are capable of joint use and are so used by the defendant, see *Kaolatype Engraving Co. v. Hoke* (1887), 39 O. G. 589; 30 Fed. Rep. 444; *Griffith v. Segar* (1887), 29 Fed. Rep. 707; *Barney v. Peck* (1883), 16 Fed. Rep. 413; 24 O. G. 101; *Pope Mfg. Co. v. Marqua* (1883), 15 Fed. Rep. 400; *Gamewell Fire Alarm Telegraph*

Co. v. Chillicothe (1881), 7 Fed. Rep. 351; *Hayes v. Dayton* (1880), 8 Fed. Rep. 702; 18 O. G. 1406; 18 Blatch. 420; *Nellis v. McLanahan* (1873), 6 Fisher, 286.

That a bill alleging the infringement of five patents by one machine, when in fact each invention is capable of separate use and the trial as to each on the questions of validity and infringement must be separate and upon distinct issues, is multifarious, see *Consolidated Electric Light Co. v. Brush Co.* (1884), 20 Fed. Rep. 502; 22 Blatch. 206; 28 O. G. 544.

⁶ That one bill cannot embrace infringements of two wholly separate patents for non-unitable inventions, see *Hayes v. Dayton* (1880), 18 O. G. 1406; 8 Fed. Rep. 702; 18 Blatch. 420.

That a bill will not lie for the infringement of several patents for machines unless all the machines have been used conjointly, see *Shickle v. South St. Louis Foundry Co.* (1884), 22 Fed. Rep. 105.

That where one device is used in one machine and the other in another, no joinder can be permitted, see *Nourse v. Allen* (1859), 3 Fisher, 63; 4 Blatch. 376.

multifarious by charging separate infringements of the different Claims of the same patent, nor by praying several forms of relief for the same injury.⁷

§ 1109. Process in Equity: Service: Appearance.

Upon the filing of the bill in the proper court, a *subpœna* issues and is served by the marshal, his deputy, or other person duly appointed for that purpose by the court.¹ Service must be made upon the defendant personally unless he resides within the district, when it may be made by leaving a copy of the *subpœna* at his usual place of abode, with any adult member of his family.² If he fails to appear within the time required the bill may be taken *pro confesso*, and where the relief desired by the plaintiff can be afforded without the presence of the defendant the hearing will proceed *ex parte*, and a final decree will be awarded.³ If he appears, he must demur or plead or answer to the bill, and upon his neglect to do so a decree *pro confesso* may be entered and the cause be heard without him; or when an answer is essential to the plaintiff, as in bills for discovery or similar relief, an attachment may be issued to compel it.⁴

§ 1110. Demurrer in Equity.

A demurrer in equity is a pleading by which the defendant points out some defect in the bill, as a reason why he should not be compelled to answer further to its allegations.¹ This

⁷ That separate infringements of different Claims of the same patent may be joined in one bill, see *Bates v. Coe* (1878), 98 U. S. 31; 15 O. G. 337; *Kelleher v. Darling* (1878), 4 Clifford, 424; 14 O. G. 673; 3 Bann. & A. 438.

That a bill to repeal an interfering patent and to recover for infringements is not multifarious, see *Holliday v. Pickhardt* (1887), 29 Fed. Rep. 853; *Leach v. Chandler* (1883), 18 Fed. Rep. 262.

That a bill averring an infringement by a corporation and its assignee in insolvency, and alleging that the assignee

is about to distribute the corporate assets without regard to the plaintiff's rights, and praying for an injunction, decree, and account, is not multifarious and may be properly brought in the Federal courts, see *Gordon v. St. Paul Harvester Works* (1885), 23 Fed. Rep. 147.

§ 1109. ¹ Equity Rules, 7, 11, 15.

² Equity Rule 13.

³ Equity Rule 18.

⁴ Equity Rule 18.

§ 1110. ¹ For the nature and effect of a demurrer in equity, see *Story Eq. Pl.* §§ 436-646; Equity Rules, 31-38.

That a general demurrer to a bill

defect must be apparent on the face of the bill, and may consist either in a want of jurisdiction in the court, or the incapacity of the parties to sue or be sued in the mode adopted by the plaintiff, or in the want of proper allegations in the bill itself. Thus where the averments show that the invention was not patentable, or that the patent sued on is invalid, as in a variance between an original and its re-issue, or that the plaintiff has no interest in the patent which has been prejudiced by the infringement, or that the infringements charged are distinct violations of different patents or are by different defendants, or that the remedy at law is adequate, objection may be taken by demurrer, and if sustained the bill must be amended or dismissed.²

containing the usual averments cannot be sustained, see *McCoy v. Nelson* (1887), 121 U. S. 484; 39 O. G. 831.

That objections to form must be taken by demurrer, and after the evidence is given the bill will not be studied to discover defects, see *Pelham v. Edelmeyer* (1883), 15 Fed. Rep. 262; 25 O. G. 292; 21 Blatch. 188.

² That the question of patentability cannot be decided on demurrer except in clear cases, see *Blessing v. Steam Copper Works* (1888), 34 Fed. Rep. 753; *Dick v. Oil Well Supply Co.* (1885), 25 Fed. Rep. 105.

That a demurrer does not admit that the invention is patentable, see *Kaolatype Engraving Co. v. Hoke* (1887), 30 Fed. Rep. 444; 39 O. G. 589.

That where the court can see from the light of common knowledge that a patent is void it may so decree on a demurrer, see *West v. Rae* (1887), 33 Fed. Rep. 45; *Kaolatype Engraving Co. v. Hoke* (1887), 30 Fed. Rep. 444; 39 O. G. 589.

That where recovery can be had only by extending the re-issue beyond the original the bill will be dismissed, see *Covell v. Pratt* (1880), 18 O. G. 301;

18 Blatch. 126; 2 Fed. Rep. 359; 5 Bann. & A. 380.

That a variance between the original and re-issue cannot be taken advantage of on demurrer unless the original is set out in the complaint or attached to it, or *profert* is made of it, see *Adams & Westlake Mfg. Co. v. Meyrose* (1882), 12 Fed. Rep. 440.

That whether delay in applying for a re-issue is reasonable is a question of law for the court, and may be raised by demurrer, see *Wollensak v. Reiher* (1885), 115 U. S. 96; 31 O. G. 1301.

That a demurrer denying the right of the Commissioner to extend a patent will be overruled, see *New American File Co. v. Nicholson File Co.* (1881), 8 Fed. Rep. 816; 20 O. G. 524.

That a demurrer to a bill for profits, filed one day before the patent expired, was sustained with costs to defendant, see *Davis v. Smith* (1884), 19 Fed. Rep. 823.

That a question of title raised by demurrer cannot be removed by amendment, see *Steam Relief Valve Co. v. City of New Bedford* (1884), 28 O. G. 283; 19 Fed. Rep. 253.

§ 1111. Demurrer to Part of the Bill: Proceedings on Demurrer.

The defendant may demur to one part of the bill, plead to another part, and answer the remainder, but he is not permitted to demur, plead, and answer to the entire bill at once, especially when the answer contains all the objections which are urged by the demurrer or the plea.¹ The plaintiff may, however, overlook this defect and cannot object to the proceedings upon that account, unless before the argument on the demurrer he moves to strike out the superfluous pleadings or compel the defendant to elect between them.² For the purposes of a hearing upon a demurrer the allegations of the bill are, by the demurrer, admitted to be true.³ Where the demurrer covers the entire bill, a judgment thereon in favor of the defendant results in the dismissal or amendment of the bill.⁴ If the bill is good in part, a demurrer to it as a whole will be overruled.⁵ Where the demurrer objects to the entire

§ 1111. ¹ That under rule 32 in equity a defendant may demur to the whole bill, or demur to a part and answer the rest, but cannot both demur and answer to the whole bill, especially when the answer sets up all that is in the demurrer, the demurrer being thereby waived, see *Adams v. Howard* (1881), 9 Fed. Rep. 347; 21 O. G. 264; 20 Blatch. 38; see also rule 37, as interpreted *contra* in *Hayes v. Dayton* (1880), 18 Blatch. 420; 18 O. G. 1406; 8 Fed. Rep. 702.

² That if a demurrer and answer are filed simultaneously the plaintiff waives the right to object under rule 37, if he goes to argument on the demurrer, see *Hayes v. Dayton* (1880), 18 O. G. 1406; 8 Fed. Rep. 702; 18 Blatch. 420.

³ That after special demurrer to the bill the facts as alleged are taken as true on a hearing of the demurrer, see *Woodworth v. Edwards* (1847), 3 W. & M. 120; 2 Robb, 610.

That in a prayer for an injunction and a demurrer, the demurrer will be heard first, see *Woodworth v. Edwards* (1847), 3 W. & M. 120; 2 Robb, 610.

That a bill will not be dismissed for the reason that the complainant does not set down the demurrer for argument or take evidence within three months, if these are satisfactorily explained, see *Adams v. Howard* (1881), 21 O. G. 264; 20 Blatch. 38; 9 Fed. Rep. 347.

That where a demurrer is overruled the defendant is to answer over on terms and may contest the injunction, though if when ordered to file evidence he only filed a demurrer the judgment will not be opened for further hearing on the temporary injunction, but the case will be taken as confessed as to the facts, unless an affidavit is offered that delay was not the object, and a bond of indemnity is given, see *Woodworth v. Edwards* (1847), 3 W. & M. 120; 2 Robb, 610.

⁴ Equity Rule 35.

⁵ That if a bill is good in part a demurrer to the whole bill will be overruled, see *Perry v. Littlefield* (1879), 17 O. G. 51; 17 Blatch. 272; 4 Bann. & A. 624.

bill and also to some specific allegation, and the latter objection only is sustained, the bill may be dismissed as to the defective part and the defendant be required to plead or answer over as to the residue.⁶ A failure to demur within the proper time, or at the prescribed stage of the proceedings, operates as a waiver of all defects which are not *ipso facto* destructive to the action.⁷

§ 1112. Plea in Equity: When Proper.

A plea in equity is a special answer, urging some particular defence by which the issue is reduced to a single point. Such particular defences are a want of jurisdiction over the controversy or the parties by reason of some fact not apparent in the bill, or some statute, record, or other matter which, if established, would defeat the action.¹ But, except in special cases, a plea must not anticipate the answer by denying the substantial allegations of the bill, — since, if this were allowable, the defendant, in his answer over after the plea is overruled, might revive and again contest the same issues which had been decided against him on his plea.² Thus while such special

⁶ That on a demurrer to the whole bill, and also to part thereof, if the latter is sustained the bill will be dismissed as to the defective part and the rest answered, see *Giant Powder Co. v. California Powder Works* (1878), 98 U. S. 126; 15 O. G. 289.

⁷ That an omission to swear to a bill is no ground of demurrer after the hearing and an order to file the evidence, see *Woodworth v. Edwards* (1847), 3 W. & M. 120; 2 Robb, 610.

That the bill may be verified by the equitable owner without the legal owner, see *Goodyear v. Allyn* (1868), 8 Fisher, 374; 6 Blatch. 33.

That if the bill is not duly sworn to the objection should be taken as soon as the defendant appears, and the court may order the oath if it deems it necessary, see *Woodworth v. Edwards* (1847), 3 W. & M. 120; 2 Robb, 610.

That on a plea to the jurisdiction *ex*

parte affidavits which are introduced without notice or opportunity to cross-examine, as well as unauthenticated writings, are inadmissible, see *Lilienthal v. Washburn* (1881), 8 Fed. Rep. 707.

§ 1112. ¹ For the nature and effect of a plea in equity, see Story Eq. Pl. §§ 647-837; Equity Rules, 31-38.

² That general defences not averring new matter cannot be made under a special plea, see *Hubbell v. De Land* (1882), 14 Fed. Rep. 471; 11 Bissell, 382; 22 O. G. 1883; *Sharp v. Reissner* (1881), 20 O. G. 1161; 9 Fed. Rep. 445; 20 Blatch. 10.

That in some cases the plea may deny an averment of the bill, see *Matthews v. Lalance & Grosjean Mfg. Co.* (1880), 2 Fed. Rep. 232; 17 O. G. 1284; 18 Blatch. 84; 5 Bann. & A. 319.

That the defendant cannot set up all his issues, except the issue as to infringe-

matters as the departure of a re-issued patent from its original may form the subject of a plea, defences which attack the patentability of the invention, or the fact of infringement, or other principal averment of the bill, can be set up only in the answer.³ But a plea stating new matter, which displaces the equity of the bill, is proper though it may thereby attack the patent.⁴

§ 1113. Requisites of a Plea in Equity: Procedure Thereon.

A plea in equity must be single, clear, and unevasive.¹ Though it may cover several facts when all together constitute but one defence, if it embraces several defences it is fatally defective on account of the duplicity.² Double pleading in

ment, in pleas and try them separately, see *Giant Powder Co. v. Safety Nitro-Powder Co.* (1884), 10 Sawyer, 23; 27 O. G. 99; 19 Fed. Rep. 509.

³ That the departure of a re-issue from the original can be set up in a special plea, see *Hubbell v. De Land* (1882), 14 Fed. Rep. 471; 11 Bissell, 382; 22 O. G. 1883.

That a plea may aver the expiration of the patent before suit and so dispute the jurisdiction of equity, see *Edison Electric Light Co. v. United States Electric Lighting Co.* (1888), 35 Fed. Rep. 134.

That the issue of infringement as well as other issues on the merits must be raised by answer, not by plea, see *Korn v. Wiebusch* (1887), 33 Fed. Rep. 50.

That a plea denying infringement only will be struck out on motion, since the same matter could be set up in the answer were the plea overruled, see *Sharp v. Reissner* (1881), 9 Fed. Rep. 445; 20 O. G. 1161; 20 Blatch. 10.

That a plea, denying that the defendant's structures are covered by the plaintiff's patent, denies an allegation of the bill and is bad in substance, see *Matthews v. Lalance & Grosjean Mfg. Co.* (1880), 17 O. G. 1284; 2 Fed. Rep. 232; 18 Blatch. 84; 5 Bann. & A. 319.

⁴ That a plea setting up new matter, displacing the equity of the bill, will not be struck from the files or ordered to stand as an answer on the ground that it attacks the patent, see *Hubbell v. De Land*, (1882), 22 O. G. 1883; 14 Fed. Rep. 471; 11 Bissell, 382.

§ 1113. ¹ That every pleading in equity must be single, clear, and unevasive, see *Graham v. Mason* (1869), 5 Fisher, 1; 4 Clifford, 88.

That a plea may be negative in form, see *Edison Electric Light Co. v. United States Electric Lighting Co.* (1888), 35 Fed. Rep. 134.

² That several defences cannot be made by plea, see *Reissner v. Anness* (1877), 12 O. G. 842; 3 Bann. & A. 148.

That a plea must present a single issue, see *Giant Powder Co. v. Safety Nitro-Powder Co.* (1884), 10 Sawyer, 23; 27 O. G. 99; 19 Fed. Rep. 509.

That though a plea must present a single issue it may embrace several facts, see *Reissner v. Anness* (1877), 12 O. G. 842; 3 Bann. & A. 148.

That the defences of fraud, new matter in the re-issue, and prior foreign patent are independent defences and cannot be embraced in one plea, see *Reissner v. Anness* (1877), 12 O. G. 842; 3 Bann. & A. 148.

equity is not permitted except by special leave of the court, and if without leave the defendant enters several pleas he may be compelled to elect one of them on which to stand, or to treat the pleas as an answer on which a final hearing may be had.³ A plea may be interpreted, when necessary, by the exhibits thereunto annexed.⁴ Unless in proper form the plea should not be answered by the plaintiff.⁵ If on a trial of the issues it presents the defendant obtains judgment, the facts thus found in his favor will avail him as far as in law and equity they ought to do.⁶ By setting down the plea for argument on its sufficiency the plaintiff admits the truth of its averments; by joining issue he admits its sufficiency as a defence; and therefore if its allegations are sustained the bill must be dismissed.⁷ When upon argument or trial the

³ That there can be no double pleading in equity unless special leave is given, see *Giant Powder Co. v. Safety Nitro-Powder Co.* (1884), 19 Fed. Rep. 509; 10 Sawyer, 23; 27 O. G. 99.

That delay in asking leave to file several pleas is not encouraged, see *Giant Powder Co. v. Safety Nitro-Powder Co.* (1884), 10 Sawyer, 23; 19 Fed. Rep. 509; 27 O. G. 99.

That a double plea may stand as an answer, or the defendant may disclaim all the defences except one, see *Reissner v. Anness* (1877), 12 O. G. 842; 3 Bann. & A. 148.

⁴ That a plea in equity may be qualified by a paper annexed, the paper being treated as incorporated in the plea, see *Wheeler v. McCormick* (1871), 4 Fisher, 432; 8 Blatch. 267.

⁵ That if the plea is insufficient as a defence it should be set down for argument on that question, not replied to, see *Cottle v. Kremetz* (1885), 25 Fed. Rep. 494; *Birdseye v. Heilner* (1885), 26 Fed. Rep. 147; 34 O. G. 1392; 27 Fed. Rep. 289; *Sharp v. Reissner* (1881), 20 O. G. 1161; 9 Fed. Rep. 445; 20 Blatch. 10.

⁶ Equity Rule 33.

⁷ That the want of a certificate and

affidavit to the plea under Rule 31 is waived by demurrer and argument on the merits of the plea, see *Goodyear v. Toby* (1868), 6 Blatch. 130.

That a replication to a plea admits its sufficiency both in form and substance, and if the facts pleaded are proved the bill must be dismissed, see *Bean v. Clark* (1887), 40 O. G. 1454; *Cottle v. Kremetz* (1885), 25 Fed. Rep. 494; *Birdseye v. Heilner* (1885), 26 Fed. Rep. 147; 34 O. G. 1392; 27 Fed. Rep. 289; *Reissner v. Anness* (1878), 13 O. G. 7.

That where the plea merely denies an averment of the bill, a replication does not admit the plea to be valid, see *Matthews v. Lalance & Grosjean Mfg. Co.* (1880), 2 Fed. Rep. 232; 17 O. G. 1284; 18 Blatch. 84; 5 Bann. & A. 319.

That long neglect to join issue on a plea may admit its truth and sufficiency, see *Keller v. Stolzenbach* (1886), 28 Fed. Rep. 81; 37 O. G. 564.

That a decree against a plaintiff for failure to answer a plea or set it down for argument is not conclusive, see *Keller v. Stolzenbach* (1884), 27 O. G. 209; 20 Fed. Rep. 47.

That where a plea alleges a fact

plea is overruled the defendant may either file an answer to the bill or submit to a decree upon the merits.⁸

§ 1114. Answer in Equity, when Proper: Defences Peculiar to Equity: Laches: Estoppel.

An answer in equity is a denial, or a confession and avoidance, of the material allegations in the bill.¹ It is the method by which the defendant sets forth his general defences to the action. In cases of infringement all defences which are available at law may be resorted to in equity, and to certain of them equity attaches an especial significance. Those which deny the patentability of the invention, or the existence and validity of the patent, have the same weight and scope in either jurisdiction. But in equity the defendant may avail himself of any interest which he possesses in the patent whereby his use of the invention can be justified although the entire legal title may be vested in the plaintiff; and where a licensee is treated by his licensor as an infringer the former may defend himself on any ground open to infringers without regard to the conditions of his license.² In equity, also, the defence based on an estoppel is particularly favored, and here the laches of the plaintiff in enforcing his monopoly may often be sufficient to defeat his suit.³ Delays which he cannot avoid,

which may serve one of the defendants it will not be overruled, but held until the evidence is in and then decided, see *Williams & Albright v. Empire Transportation Co.* (1878), 14 O. G. 523; 3 Bann. & A. 533.

⁸ That the 34th rule in equity permits an answer even after plea overruled, see *Wooster v. Blake* (1881), 7 Fed. Rep. 816; 20 O. G. 158.

§ 1114. ¹ As to the nature and scope of an answer in equity, see Story, Eq. Pl. §§ 838-876.

² That the defendant may set up his equitable rights against the legal title of the plaintiff, see § 1090 and notes, *ante*.

That in equity a licensee treated as an infringer may avail himself of any

defence open to infringers, whatever covenants his license may contain, see *Pelham v. Edelmeyer* (1883), 15 Fed. Rep. 262; 25 O. G. 292; 21 Blatch. 188; *White v. Lee* (1882), 23 O. G. 1621; 14 Fed. Rep. 789. It would seem that this proposition can be true only when the licensee is sued as an infringer for doing the acts authorized by his license, the suit in such cases amounting to an eviction and releasing him from the license and its covenants.

³ That a patentee may forfeit his right to past profits by his laches and acquiescence, see *Kittle v. Hall* (1887), 29 Fed. Rep. 508; 39 O. G. 707; *Keller v. Stolzenbach* (1886), 28 Fed. Rep. 81; 37 O. G. 564; *New York Grape*

or for a period so short as to raise no presumption of his acquiescence in the wrong, or during the pendency of other suits involving similar issues, or after the defendant has been duly notified or has discovered that his acts were violations of the patent, cannot affect the right of the plaintiff to complete redress.⁴ But where the defendant is not conscious that his

Sugar Co. v. Buffalo Grape Sugar Co. (1883), 18 Fed. Rep. 638; 25 O. G. 1076; 21 Blatch. 519. See also § 1194, and notes, *post*.

That laches in obtaining a re-issue is a question of law when it appears on the face of the patent, and unless there explained by stating its reasons at length it may be raised by demurrer and may defeat the suit, see *Wollensak v. Reiher* (1885), 115 U. S. 96; 31 O. G. 1301.

That a delay of thirteen years in suing, if the bill does not show some good reason for it, is such laches as will prevent an injunction, though perhaps not a suit for damages, see *McLaughlin v. People's Railway Co.* (1884), 29 O. G. 277; 21 Fed. Rep. 574.

That laches is a good defence in equity and can be raised by demurrer if apparent on the bill, see *McLaughlin v. People's Railway Co.* (1884), 21 Fed. Rep. 574; 29 O. G. 277.

That a bill averring acts of infringement on "divers days and occasions" during twelve years does not allege continuous acts or show laches in the plaintiff, see *Kaolatype Engraving Co. v. Hoke* (1887), 30 Fed. Rep. 444; 39 O. G. 589.

That a delay not amounting to an estoppel will not prevent an injunction, though it may be a bar to a recovery of past profits, see *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.* (1883), 25 O. G. 1076; 18 Fed. Rep. 638; 21 Blatch. 519.

That an assignee of claims for past infringements is barred by the laches of his assignor, see *New York Grape Sugar*

Co. v. Buffalo Grape Sugar Co. (1885), 32 O. G. 1356; 24 Fed. Rep. 604.

⁴ In *McMillin v. Barclay* (1872), 5 Fisher, 189, McKenman, J.: (201) "I have failed to discover any evidence upon which an equitable estoppel in favor of the respondents can rest. It must necessarily grow out of some declaration or act of the applicant, by which they were induced to believe that they might rightfully or innocently use the invention now claimed by him. If they appropriated it without consulting him, and he was passive when he knew it because he was powerless to prevent them, he is not estopped from asserting his right when he is in a condition to enforce it. If they took the risk of using what they did not own, the owner's helplessness then will not shield them from accountability to him now. This is the only effect of the proof; for, although the applicant publicly used his invention after he applied for a patent, he did not intend to abandon it, as has been already shown; and as he had a clear right so to use it, the law does not presume from that fact that he assented to its use by others. (*Ryan v. Goodwin*, 3 Sum. 519.) Nor is this supposed estoppel invigorated by the fact that invasion of the patentee's rights has been widespread, and that all who may be found in that category may be held liable accordingly. Whoever reaps where he did not sow wrongfully appropriates what belongs to another, and equity will not stay the hand of the rightful owner of the harvest against him." 4 Brews. (Pa.) 275 (285).

That redress is promptly sought when

use of the invention is unlawful, and the plaintiff is aware of the infringement, the latter must take measures for his own protection with all reasonable diligence, or the delay will furnish a sufficient answer to his claim for an injunction if not for damages or profits on account of past invasions of his rights.⁶

§ 1115. Scope of Answer: Joinder of Defences.

The answer must include all matters of defence on which the defendant intends to rely, except such as are proper subjects for a plea or a demurrer.¹ Defences not inserted in the

action is brought within six months after the patent is granted, see *Brick v. Staten Island Ry. Co.* (1885), 25 Fed. Rep. 553.

That delay pending other suits is not laches, see *Van Hook v. Pendleton* (1846), 1 Blatch. 187; and §§ 1194, 1195, and notes, *post*.

That delay after due notice to the defendant is not laches, see *City of Concord v. Norton* (1883), 16 Fed. Rep. 477.

That seasonable notice to an infringer, followed by a suit within reasonable time, rebuts the claim of laches, see *Seibert Cylinder Oil-Cup Co. v. Michigan Lubricator Co.* (1888), 34 Fed. Rep. 33.

That the plaintiff is not guilty of laches by not suing infringers of whom he is ignorant, see *Adams v. Howard* (1884), 26 O. G. 825; 19 Fed. Rep. 317; *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.* (1883), 25 O. G. 1076; 18 Fed. Rep. 638; 21 Blatch. 519.

That a patentee who is diligently prosecuting infringers is not guilty of laches in not suing some particular one who knows of the other suits, see *American Bell Telephone Co. v. Southern Telephone Co.* (1888), 34 Fed. Rep. 795.

That laches of a plaintiff does not bar his rights where he gave such notice as he was able, see *Kittle v. Hall* (1837), 39 O. G. 707; 29 Fed. Rep. 508.

That where inaction of the patentee

is due to the misrepresentations of the defendant it is not laches, see *Wilson v. Keely* (1888), 43 O. G. 511.

That a delay in suing infringers caused by the patentee's bankruptcy and the passing of the patent into the hands of his trustee, with ineffectual efforts of the patentee to regain it until shortly before suit, is not such laches as forfeits in equity the right to sue, if timely notice of an intention to prosecute were given to infringers, see *Kittle v. Hall* (1887), 29 Fed. Rep. 508; 39 O. G. 707.

⁶ That if the plaintiff is aware of the infringement and the defendant acts in good faith notice must be given or the remedy by injunction may be lost by delay, see *Mundy v. Kendall* (1885), 23 Fed. Rep. 591; 32 O. G. 1237.

That equity will grant no relief to any one acting fraudulently, see *Hoffheins v. Brandt*, (1867), 3 Fisher, 218.

§ 1115. ¹ That in equity as at law the foundation for evidence must be laid in the pleadings, see *Wilson v. Stolley* (1847), 4 McLean, 275.

That a general defence of "want of equity" will not be regarded, see *Puetz v. Bransford* (1887), 39 O. G. 1083; 31 Fed. Rep. 458.

That the issue must be raised by allegations in the bill and answer, and if defective they may be amended, see *Doughty v. West* (1865), 2 Fisher, 553.

That every material fact must be set

answer will not be noticed by the court.² Any number of defences may be joined in the same answer provided they are consistent with each other, and defences are consistent when they can all be true.³ Inconsistent defences create a repugnancy which is fatal to the answer unless cured by an abandonment of one of the antagonistic claims. Each defence must be distinctly and affirmatively stated, with such particularity as to time, place, person, and circumstances that the plaintiff may be informed of the precise attack he has to meet.⁴ The answer must apprise the plaintiff of the defendant's theory as to the scope and meaning of the patent, in order that he may perceive under what view of the invention the defences will be urged, for the defendant cannot set up hypothetical defences based upon possible constructions of the patent subsequently to be given by the court.⁵ The defendant is concluded by

up in the pleadings, see *Blandy v. Griffith* (1869), 3 Fisher, 609.

That affirmative defences, especially that of prior knowledge, must be properly alleged as well as proved, see *Searls v. Bouton* (1882), 21 O. G. 1784 ; 12 Fed. Rep. 140 ; 20 Blatch. 426.

² That defences not set up in the answer will not be considered by the court, see *Sessions v. Romadka* (1884), 28 O. G. 721 ; 21 Fed. Rep. 124 ; *Bates v. Coe* (1878), 98 U. S. 31 ; 15 O. G. 337 ; *Salamander Felting Co. v. Haven* (1875), 9 O. G. 253 ; 3 Dillon, 131 ; 2 Bann. & A. 164 ; *Howes v. Nute* (1870), 4 Clifford, 173 ; 4 Fisher, 263.

That if the invention described in the patent is evidently not the result of inventive skill, the court will dismiss the bill though this defence is not urged in the answer, see *Slawson v. Grand St., Prospect Park, & Flatbush R. R. Co.* (1882), 107 U. S. 649 ; 24 O. G. 99.

³ In *National Mfg. Co. v. Meyers* (1881), 7 Fed. Rep. 355, Swing, J. : (357) "In equity a defendant has the right to set up as many defences as he may have, providing they are not inconsistent. (*Sharp v. Carlisle*, 5 Dana,

488 ; *Wood v. Wood*, 2 Paige, Ch. 108 ; *Hopper v. Hopper*, 11 Paige, Ch. 46 ; *Daniell's Ch. Pr.* 727.) Defences are inconsistent where they cannot both be true ; but where there are different defences and they may all be true, though entirely different in their nature, they are not inconsistent."

⁴ That if more than one defence is presented in the answer each must be distinct and unconditional, see *Graham v. Mason* (1869), 5 Fisher, 1 ; 4 Clifford, 88.

That substantial matters of defence as to the novelty of the invention must be set up in the answer with such particularity as to time, place, and person that the plaintiff may know what he has to meet, see *Brown v. Hall* (1869), 3 Fisher, 531 ; 6 Blatch. 401.

⁵ That the answer must inform the plaintiff of the defendant's theory as to the construction of the patent, and cannot aver that if the plaintiff's patent be so construed as to cover the defendant's device he will then defend on the ground of prior use, see *Graham v. Mason* (1869), 4 Clifford, 88 ; 5 Fisher, 1.

his answer, which is regarded as embracing his actual and entire defence, and cannot depart from it except by an amendment under leave of the court, especially where the plaintiff is entitled to an answer under oath.⁶

§ 1116. **Statement of Special Defences in the Answer.**

Those special defences, which in actions at law must be set forth in a notice served on the defendant, in equity appear only in the answer.¹ Their statement is, however, governed by the same rules as to precision and completeness which are applicable to a notice.² If the answer asserts that the patentee or his assignor surreptitiously or unjustly obtained the patent for that which was in fact invented by another, it must also allege that the first inventor was using reasonable diligence in adapting and perfecting it.³ When it denies the novelty of the invention, on the ground of prior use or knowledge, it must recite the names and residences of the persons using or having knowledge of the invention, and sufficiently describe the place of use to put the plaintiff in possession of the means of identifying such invention with his own.⁴ When

⁶ That a departure from the defence alleged in the answer is not allowed in equity when the plaintiff is entitled to an answer under oath, see *Russell & Erwin Mfg. Co. v. Mallory* (1872), 5 Fisher, 632; 2 O. G. 495; 10 Blatch. 140.

That an answer in equity is evidence as well as defence and cannot be made by attorney, though the objection is waived if not insisted on, see *Wooster v. Muser* (1884), 28 O. G. 286; 20 Fed. Rep. 162.

§ 1116. ¹ That in equity the special defences are set up in the answer, not by a notice, see *Bates v. Coe* (1878), 98 U. S. 31; 15 O. G. 337; *Pickering v. Phillips* (1876), 10 O. G. 420; 4 Clifford, 383; 2 Bann. & A. 417; *Agawam Co. v. Jordan* (1868), 7 Wall. 583; *Doughty v. West* (1865), 2 Fisher, 553; *Pitts v. Edmonds* (1857), 2 Fisher, 52; 1 Bissell, 168.

That the defence that the invention was not patentable need not be set up in the answer, see *Hendy v. Golden State & Miners' Iron Works* (1888), 127 U. S. 370; 43 O. G. 1117.

² That the notice at law and the answer of special defences in equity are governed by the same rules, see *Roemer v. Simon* (1877), 95 U. S. 214; 12 O. G. 796. Also §§ 993-1005, *ante*.

³ That an answer alleging that the patentee surreptitiously obtained a patent for what he knew was the invention of another must also allege that the first inventor was using due diligence to perfect it, see *Agawam Co. v. Jordan* (1868), 7 Wall. 583. This refers to the defence described in the act of 1836, not that under the act of 1793. See § 960 and notes, *ante*.

⁴ That the defence of want of novelty must be clearly and specifically set forth in the answer, see *Loom Co. v. Higgins*

it attacks the novelty of the invention, on the ground of a prior patent or a prior publication, it must disclose the name

(1882), 105 U. S. 580 ; 21 O. G. 2031 ; 21 O. G. 1784 ; 12 Fed. Rep. 140 ; 20 Guidet v. Barber (1873), 5 O. G. 149 ; Blatch. 426.
 Jordan v. Dobson (1870), 4 Fisher, 232 ; 2 Abbott, 398 ; 7 Phila. 533 ; Graham v. Mason (1869), 5 Fisher, 1 ; 4 Clifford, 88 ; Pitts v. Edmonds (1857), 2 Fisher, 52 ; 1 Bissell, 168.

That the defendant in equity must give notice in his answer of the names and residences of the persons whom he intends to prove possessed the knowledge of the invention, and of the place where it has been used, see Seymour v. Osborn (1870), 11 Wall. 516.

That a defendant who relies on a defence of prior use must set out in his answer the names of those who have invented or used the anticipating device, but not the names of his witnesses, see Allis v. Buckstaff (1882), 22 O. G. 1705 ; 13 Fed. Rep. 879 ; Roemer v. Simon (1877), 95 U. S. 214 ; 12 O. G. 796.

That depositions as to prior use cannot be read unless the persons using were named in the answer, see Colender v. Griffith (1873), 3 O. G. 689 ; 11 Blatch. 212.

That where an answer merely alleges prior knowledge, and does not set forth where and by whom the invention was used, evidence of prior knowledge and use is not admissible, see Searls v. Bouton (1882), 12 Fed. Rep. 140 ; 21 O. G. 1784 ; 20 Blatch. 426.

That evidence of prior use, given by witnesses not named in the answer, can be considered only to show the state of the art, see Stevenson v. Magowan (1887), 42 O. G. 1063 ; 31 Fed. Rep. 824 ; Richardson v. Lockwood (1873), 4 O. G. 398 ; 6 Fisher, 454.

That an answer alleging knowledge by certain persons of a certain place, but not at any specified place, does not open the way for evidence of knowledge at any place, see Searls v. Bouton (1882),

That an allegation by the defendant of a prior use, on his knowledge and belief, amounts to nothing unless his information is disclosed, see Young v. Lippman (1872), 2 O. G. 249 ; 5 Fisher, 230 ; 9 Blatch. 277.

That evidence as to a prior rejected application of a third person, his use and knowledge, is not admissible in equity unless these facts are set up in the answer, see Union Paper Bag Mach. Co. v. Pultz & Walkley Co. (1878), 15 O. G. 423 ; 15 Blatch. 160 ; 3 Bann. & A. 403.

That where the answer mentions a person who made a prior application for a patent, but gave no residence, he could not be examined as to prior knowledge and use, see Decker v. Grote (1873), 3 O. G. 65 ; 10 Blatch. 331 ; 6 Fisher, 143.

That unless the answer denying priority of invention gives notice of the persons and places of the previous use, evidence of foreign patents and other evidence in support of the answer is not regarded, see Earl v. Dexter (1874), 6 O. G. 729 ; Holmes, 412 ; 1 Bann. & A. 400.

That an answer in equity may be sufficient for an order to try the issue at law though it does not set out the names of prior users and the place of use, but the answer in the suit at law must set them out, see Orr v. Merrill (1846), 1 W. & M. 376 ; 2 Robb, 331.

That evidence of prior use abroad is not supported by notice of use in this country, see Dixon v. Moyer (1821), 4 Wash. 68 ; 1 Robb, 324.

That the answer denying priority of invention must cover the whole invention, not a part of it, see Parks v. Booth (1880), 102 U. S. 96 ; 17 O. G. 1089.

That machines not set up in the an-

of the patentee and the date of the patent, and give the volume, page, and date of the publication.⁵ An answer of abandonment must specifically aver the facts on which the defendant

answer cannot be offered in evidence nor considered on final hearing, see *Howe v. Williams* (1863), 2 Fisher, 395; 2 Clifford, 245.

That evidence of prior use, if taken without proper averments in the answer, and duly objected to, may be struck out on motion, see *Bragg v. City of Stockton* (1886), 27 Fed. Rep. 509; 11 Sawyer, 597; *Decker v. Grote* (1873), 6 Fisher, 143; 3 O. G. 65; 10 Blatch. 331.

That if evidence of prior use be taken without proper notice, the answer may sometimes be amended and the evidence may stand, see *Forbes v. Barstow Stove Co.* (1864), 2 Clifford, 379.

That evidence of prior use taken without proper notice will be allowed to stand unless a motion to strike it out is made, see *Elm City Co. v. Wooster* (1873), 4 O. G. 83; 6 Fisher, 452.

That evidence of prior use, taken under a general denial of priority without objection, is properly received both as to the state of the art and the priority of the invention, see *Zane v. Soffe* (1884), 110 U. S. 200; 26 O. G. 737; *Loom Co. v. Higgins* (1882), 105 U. S. 580; 21 O. G. 2031.

That evidence taken without due notice and against objections, but with full examination and cross-examination, may stand after amendment of the answer, see *Allis v. Buckstaff* (1882), 13 Fed. Rep. 879; 22 O. G. 1705.

That amendment after evidence taken under objection will not cure the defect unless the former omission was inadvertent and the plaintiff is not taken by surprise, see *Roberts v. Buck* (1873), 6 Fisher, 325; Holmes, 224; 3 O. G. 268.

That witnesses produced without proper notice must be objected to at the time or the defect will be waived, see

Roemer v. Simon (1874), 5 O. G. 555; 1 Bann. & A. 138.

That the improper admission of evidence of prior use without due notice cannot be excepted to in the Supreme Court on appeal, unless objection were made at the proper time, see *Loom Co. v. Higgins* (1882), 105 U. S. 580; 21 O. G. 2031.

That if the evidence of prior use were admitted without due notice against the plaintiff's objection, the Supreme Court on appeal will reverse the judgment, though the appeal did not rest on that ground, see *Blanchard v. Putnam* (1869), 8 Wall. 420.

That the Supreme Court may consult the evidence contained in the record in order to determine the scope of the invention, though prior use is not set up in the answer, see *Eachus v. Broomall* (1885), 115 U. S. 429; 33 O. G. 1265.

⁵ That defences of prior patent or prior publication must be set up in the answer, not by special plea, see *Carnrick v. McKesson* (1881), 19 Blatch. 369; 8 Fed. Rep. 807.

That copies of drawings of prior patents and evidence as to them are inadmissible to show priority unless set up in the answer, see *Earl v. Dexter* (1874), 6 O. G. 729; Holmes, 412; 1 Bann. & A. 400.

That the answer cannot allege any earlier date for a prior patent or publication than its actual issue, see *Kelleher v. Darling* (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438.

That a prior patent not set up in the answer can be used only to show the state of the art and so give a construction to the patent in question, see *Grier v. Wilt* (1887), 120 U. S. 412; 38 O. G. 1365.

That evidence of the state of the art

will rely, and if these facts consist of instances of public use and sale more than two years before the application they must be stated in a separate allegation from those which set up other methods of abandonment.⁶ Where the defence rests, wholly or in part, upon the fraud of the patentee in attempting to mislead the public by an imperfect or redundant specification, or in obtaining by deceit the issue of the patent, the answer must charge the fraudulent acts in terms distinct, particular, and positive.⁷ The departure of a re-issued patent from its original, or its unlawful grant by the Commissioner when the original was sufficient to protect the actual invention;⁸

is admissible without notice at law or mention in the answer in equity, see *Brown v. Piper* (1875), 91 U. S. 37; 10 O. G. 417.

⁶ That if abandonment is relied on it must be specially set up in defence, see *Wyeth v. Stone* (1840), 1 Story, 273; 2 Robb, 23.

That an answer of use and sale before application must allege an abandonment, or that the use and sale were more than two years before the application, see *Root v. Ball* (1846), 4 McLean, 177; 2 Robb, 513.

That an answer alleging that the invention was in use two years before the application need not also aver that the inventor consented to such use, see *Campbell v. New York* (1888), 35 Fed. Rep. 504.

That an answer alleging two years public use and sale before the plaintiff's invention is improper, no such defence being known to the law, see *Kelleher v. Darling* (1878), 4 Clifford, 424; 14 O. G. 673; 3 Bann. & A. 438.

That public use and sale and abandonment may be set up in the same answer, but not in the same allegation, as they depend on different principles, see *Jones v. Sewall* (1873), 6 Fisher, 343; 3 O. G. 630; 3 Clifford, 563.

That where no question as to novelty is made by the pleadings, and

the use relied on is a public use under the inventor or by him, there is no need to give notice of the persons using or the place where used, see *American Hide & Leather Splitting and Dressing Mach. Co. v. American Tool & Mach. Co.* (1870), 4 Fisher, 284; Holmes, 503.

⁷ That fraud must be set up in the answer by distinct and special allegations, see *Blake v. Stafford* (1868), 3 Fisher, 294; 6 Blatch. 195.

That an allegation that a re-issue was obtained under false pretences must be made in distinct language without equivocation, and be the subject of distinct proof, see *Doughty v. West* (1865), 2 Fisher, 553.

That an averment in the answer that the patent was obtained by "false and fraudulent representations to the Commissioner," and "is void in law," is too general to raise an issue, see *Clark v. Scott* (1872), 5 Fisher, 245; 2 O. G. 4; 9 Blatch. 301.

⁸ That the want of identity between an original and re-issue must be set up in the answer by distinct and special allegations, see *Blake v. Stafford* (1868), 3 Fisher, 294; 6 Blatch. 195.

That an answer in a suit on a re-issued patent, alleging that the original was not surrendered because it was inoperative or invalid or claimed too

the ambiguity of the Description or the Claim;⁹ unreasonable delay in filing a disclaimer;¹⁰ the failure of the plaintiff to stamp or label his patented articles when placed upon the market;¹¹ the issue of a joint patent for a sole invention;¹² the defendant's license or co-ownership;¹³ each of these, if insisted on by the defendant, must be so fully and exactly declared in the answer as to forewarn the plaintiff of the precise line of attack and enable him to make the necessary preparation to repel it.

§ 1117. Denial of Plaintiff's Title or of Defendant's Infringement in the Answer.

When the defendant disputes the title of a plaintiff in whom, according to the records of the Patent Office, the legal ownership resides, the answer must reveal the facts which qualify the record title or create antagonistic or exclusive interests in others.¹ If he himself claims to own the patent, as an equitable assignee, he must state the consideration which he paid for it, both in nature and amount, in such

much, and that the re-issue claims were broadened, puts in issue the lawfulness of the enlargement and the scope of the original, see *Searls v. Bouton* (1882), 22 O. G. 946; 12 Fed. Rep. 874; 20 Blatch. 528.

⁹ That an objection to the patent on account of an insufficient specification must be set up in the answer, or it will not be considered, see *Jennings v. Pierce* (1878), 15 Blatch. 42; 3 Bann. & A. 361; *Wonson v. Peterson* (1878), 13 O. G. 548; 3 Bann. & A. 249; *Rubber Co. v. Goodyear* (1869), 9 Wall, 788; *Goodyear v. Providence Rubber Co.* (1864), 2 Fisher, 499; 2 Clifford, 351.

¹⁰ That unreasonable delay in filing a disclaimer must be specifically alleged in the answer, see *Worden v. Searls* (1884), 21 Fed. Rep. 406; *Burden v. Corning* (1864), 2 Fisher, 477.

That an amendment of the application without authority need not be set up in the answer, see *Eagleton Mfg.*

Co. v. West, Bradley, & Cary Mfg. Co. (1880), 2 Fed. Rep. 774; 17 O. G. 1504; 18 Blatch. 218; 5 Bann. & A. 475.

¹¹ That an objection that "patented" is not stamped on the plaintiff's articles must be set up in the answer, see *Rubber Co. v. Goodyear* (1869), 9 Wall. 788.

¹² That the defence that joint patentees were not joint inventors must be specially set up, see *Butler v. Bainbridge* (1886), 29 Fed. Rep. 142; 37 O. G. 1124.

¹³ That in equity the defendant must specially allege his license or co-ownership, see *Puetz v. Bransford* (1887), 31 Fed. Rep. 458; 39 O. G. 1083.

§ 1117. ¹ That if the defendant denies the title of owners of record he must set up in his answer the facts which affect their title, or produce the proper proof, see *Washburn & Moen Mfg. Co. v. Haish* (1880), 19 O. G. 173; 4 Fed. Rep. 900; 10 Bissell, 65.

form that its adequacy or good faith can be denied.² The answer must traverse the allegation of infringement positively and without equivocation.³ This traverse may be couched in general terms, containing no precise description of the invention but referring to it as the one covered by the patent.⁴ Where the defendant admits the use of the invention, but excuses his infringing act on the ground of his subjection to authority, the answer must disclose his principal.⁵ If he justifies under a license, it must appear upon his answer that the license warrants the use that he has made of the invention.⁶ Facts which constitute an estoppel *in pais* should be set out in the answer with sufficient detail to indicate that if established by the evidence, and unexplained by counter proof from the plaintiff, they must operate as an equitable bar to the further prosecution of the action.⁷

² That a defendant, claiming to be the owner of the patent in controversy by purchase, must set forth the consideration he paid for it in amount and in such form that it can be traversed and that its adequacy may appear, if the record shows the title to be in the plaintiff, see *Secombe v. Campbell* (1880), 2 Fed. Rep. 357; 18 Blatch. 108; 5 Bann. & A. 429.

³ That if infringement is alleged in the bill the defendant must answer it distinctly and unequivocally, see *Jordan v. Wallace* (1871), 5 Fisher, 185.

That the answer must deny infringement specifically in order to allow evidence against it, unless a stipulation between counsel takes the place of the answer, see *Allis v. Buckstaff* (1882), 13 Fed. Rep. 879; 22 O. G. 1705.

That unless the defendant in his answer contests the infringement very slight proof will sustain the allegation, see *Spring v. Domestic Sewing Mach. Co.* (1881), 9 Fed. Rep. 505; 21 O. G. 633; *Goodyear v. Berry* (1868), 3 Fisher, 439; 2 Bond, 189.

⁴ That a denial that the defendants have practised the invention described

is sufficient without particularly setting forth the invention, or specifically contradicting the allegation in the bill, see *Miller v. Buchanan* (1880), 18 O. G. 1532; 5 Fed. Rep. 366.

That where the bill alleges a covenant on the part of the defendant not to infringe, an answer giving the history of such covenant is not responsive, see *Sargent v. Larned* (1855), 2 Curtis, 340.

⁵ That a claim that the defendant acted only as agent must disclose the principal, see *Morse v. Davis* (1862), 5 Blatch. 40.

⁶ That a defendant may answer that he was acting under a license, and may impeach the patent unless the covenants of his license estop him, see *National Mfg. Co. v. Meyers* (1881), 7 Fed. Rep. 355.

That an answer by an infringing user, alleging recovery against his vendor, does not state a defence unless it also avers satisfaction of the judgment, see *Fisher v. Consolidated Amador Mine* (1885), 11 Sawyer, 190; 25 Fed. Rep. 201.

⁷ That the answer must set out in

§ 1118. Effect of Admissions in the Answer.

Admissions in an answer are conclusive on the defendant, but have no effect beyond the necessary import of the words.¹ Thus the acknowledgment that the defendant has infringed admits but one act of infringement, and a joint answer containing such acknowledgment does not admit a joint infringing act, or a joint *status* on the merits of the case.² An indirect admission is as binding as one that is affirmatively expressed. An allegation in the answer that the defendant has patented the invention since the issue of the plaintiff's patent is a concession that it is both new and useful.³ The omission to notice in the answer any positive material allegation in the bill is a confession that the matters thus alleged are true.⁴ Admissions are not waived by the production of

detail the facts from which an estoppel is alleged to arise, see *Puetz v. Bransford* (1887), 39 O. G. 1083, 1427 ; 31 Fed. Rep. 458.

§ 1118. ¹ That admissions in the answer are conclusive, but go no further than the necessary import of the language, see *Jones v. Morehead* (1863), 1 Wall. 155.

² That the admission of "making and selling" implies only the making and selling of one article, unless the plural is used, when it implies two, see *Jones v. Morehead* (1863), 1 Wall. 155.

That a joint answer does not admit a joint infringement or a joint *status* on the merits, see *Elizabeth v. Pavement Co.* (1877), 97 U. S. 126.

³ That if a defendant in his answer avers that he has patented the invention, after the plaintiff's patent, as new and useful, he cannot claim that it is old, see *Morse Fountain Pen Co. v. Esterbrook Steel Pen Mfg. Co.* (1869), 3 Fisher, 515.

⁴ That where the bill avers and the answer does not deny but merely demands proof of the title of the plaintiff corporation, its corporate capacity is admitted by the pleadings, see *Stover v.*

Halsted (1875), 8 O. G. 558 ; 13 Blatch. 95 ; 2 Bann. & A. 98.

That an answer not denying infringement, but alleging that the defendant's device produces a different result from the plaintiff's, admits the infringement, see *Stuart v. Shantz* (1872), 6 Fisher, 35 ; 2 O. G. 524.

That if the bill avers, and the answer does not deny nor the evidence contradict, that the defendant uses a described device, the use is admitted, see *Ely v. Monson & Brimfield Mfg. Co.* (1860), 4 Fisher, 64.

That an answer denying the use of the invention "with the full knowledge of the premises in the bill and in violation of the complainant's exclusive rights secured by the patent of 1864" is an implied admission of actual use, and no further proof thereof is needed, see *Jordan v. Wallace* (1871), 5 Fisher, 185.

That an admission in the answer that the defendants bought the business in which the infringing device was used, and describing it as the "machine used by the defendants," is, in the absence of all other evidence, enough to show *prima facie* an infringement by them,

evidence in support of the same position on the part of the plaintiff.⁵

§ 1119. Answer : Whether under Oath : Effect of Sworn Answer.

The plaintiff is entitled to an answer under oath; but since the act of 1864, by which all parties were made competent witnesses, it is in most cases wiser not to require it. The defendant is limited in his defences to the matters set up in his answer, and is also bound by its admissions, whether or not he swears to its correctness; and if the plaintiff needs his testimony in support of any averments of the bill, he can procure it at the trial in the ordinary method. The principal advantage, therefore, of the oath in modern practice, except in a few special cases, is to compel the defendant to confine the allegations of his answer to facts whose existence he can verify, and thereby save the plaintiff from some fruitless inquiry. The disadvantage, however, is a great one. A sworn answer is still regarded as equivalent to the evidence of one competent witness, and is sufficient to sustain its various averments unless met by proof of corresponding weight upon the other side. It is thus equal to the testimony of the plaintiff, and when to it is added the evidence of the defendant on the trial, the burden of overcoming both is often greater than the plaintiff can sustain.¹ Hence it is customary as well as

see *Fischer v. Wilson* (1879), 16 O. G. 455; 16 Blatch. 220; 4 Bann. & A. 228.

That if the defendant denies the infringement, it is not proved by one reply of his, while testifying in reference to another matter, in which he seems to imply that he has infringed, see *Reay v. Rau* (1883), 23 O. G. 1928; 15 Fed. Rep. 749.

That want of consent to use the device need not be proved when it was alleged in the bill and not denied in the answer, see *Fischer v. Hayes* (1881), 6 Fed. Rep. 76; 20 O. G. 239; 19 Blatch. 26.

That an admission of the defendants in their answer that they have made large profits is to be understood in its

ordinary sense, and is entitled to weight in ascertaining the truth or falsehood of their showing before the master, see *Troy Iron & Nail Factory v. Corning* (1869), 3 Fisher, 497; 6 Blatch. 328.

⁵ That the adverse party does not waive an admission by going into evidence on the same matter, see *Jones v. Morehead* (1863), 1 Wall. 155.

§ 1119. ¹ In *Slessinger v. Buckingham* (1883), 17 Fed. Rep. 454, Sawyer, J.: (455) "The answer, so far as responsive to the bill, directly denying the matters alleged, not only makes an issue, but it is testimony in the case called for by complainant proving the issue for defendants; and it must be overthrown by the testimony of two

prudent for the plaintiff to dispense with this requirement, and to accept the answer as a simple pleading which gives him notice of the claims hereafter to be urged by the defendant. When an answer under oath is demanded the demand must be complied with, if the defendant has the capacity to take an oath. A bill against a corporation cannot contain this demand unless its officers are made parties, — the corporate body being unable to comply, although a corporation may be called upon to answer interrogatories and must give such replies as the knowledge of its officers permits.²

witnesses, or the testimony of one witness and circumstances equivalent to another, or, at least, sufficient to make a preponderance of testimony in favor of complainant. Solicitors, generally, in this circuit, seem to overlook the great disadvantages under which they often labor in not waiving an answer under oath in equity cases, now that the complainant and defendant are themselves both competent witnesses, and can be orally examined under Equity Rule 67, where the complainant can get the evidence of his opponent, fresh from him in person, under a sharp and pressing examination, instead of having it deliberately shaped by him, and cautiously arranged and shaded for him, by his solicitor at his leisure in his office. Besides, when examined orally as a witness, the defendant counts but one; and the complainant may offer himself in opposition as to matters within his knowledge, if he swerves in the least particular from the truth; while, if called upon to answer a bill of discovery under oath, the defendant's answer, if responsive to the allegations of the bill, must be overthrown by the evidence of two witnesses, or of one witness and other circumstances equivalent to a second. Besides, if complainant has other evidence sufficient to overthrow defendant's answer under oath, he has no occasion for a discovery. It would seem that a discovery by answer under

oath may now be advantageously waived by the complainant in at least a great majority of cases." 8 Sawyer, 469 (471).

² In *Colgate v. Compagnie Francaise* (1885), 23 Fed. Rep. 82, Wallace, J.: (83) "Undoubtedly, a corporation cannot be compelled to answer under oath to a bill in equity. It answers only under the seal of the corporation. It is for this reason the practice has obtained of making the officers of the corporation parties to the bill and requiring them to answer the interrogatories. This, however, does not excuse a corporation from answering, and the complainant is entitled to an answer from a corporation as well as from an individual, although the value of the answer as evidence may not be worth the expense of the experiment. Although no officer or agent is made a party to the bill, it is still the duty of the corporation to cause diligent examination to be made, and give in its answer all the information derived from such examination; and if it alleges ignorance without excuse a disposition on its part to defeat and obstruct the course of justice may be inferred which will justify the court in charging it with the costs of the suit. (*Attorney General v. Burgesses of East Retford*, 2 Mylne & K. 35.) There is nothing, therefore, in the fact that the defendant is a corporation to defeat the complainant's right to maintain a bill of discovery." 23 Blatch. 86 (88).

§ 1120. Answer Setting up Special Defences, when Filed: Joint Answers: Exceptions to Answer.

An answer, containing a statement of any defence of which special notice is required in actions at law, must be filed a sufficient time before the trial, or the plaintiff may insist on a continuance.¹ Each of the defendants may answer separately from the others, or where it can be done without confusion all may join.² A joint answer cannot be sworn to by a part of the defendants, though such an answer may be amended by erasing the non-juring parties and be allowed to stand as the reply of those who have made oath to its averments.³ A defendant who has neither joined in the answer of his co-defendants, nor filed a separate answer of his own, cannot appear and answer after a final decree, though no decree *pro confesso* has been passed against him.⁴ Objections to an answer on account of defects of form, or the omission of necessary allegations, or the insertion of scandalous and impertinent matter, must be taken by exceptions, and if these are sustained the answer must be amended by such alterations, expurgations, or additions as it may require.⁵ The filing of the answer, and its amendment if excepted to, is followed by the general replication, which puts the cause at issue without rejoinder or further pleadings upon either side.⁶

§ 1120. ¹ That a plea or notice at law setting up special defences under the statute must be served or filed at least thirty days before the term of trial or a continuance will be allowed, and that the rule in equity is substantially the same, see *Roemer v. Simon* (1877), 95 U. S. 214; 12 O. G. 796; *Seymour v. Osborn* (1870), 11 Wall. 516; *Phillips v. Comstock* (1849), 4 McLean, 525; 2 Robb, 724.

That the rules as to defences and notices are the same in equity as at law, see *Roemer v. Simon* (1877), 95 U. S. 214; 12 O. G. 796.

² That several defendants may answer severally, see Equity Rule 62; Story, Eq. Pl. § 848.

³ That an answer of three defendants

sworn to by two only must be erased or the third defendant omitted from it, see *Bailey Washing Mach. Co. v. Young* (1874), 12 Blatch. 199; 1 Bann. & A. 362.

⁴ That where one of several defendants did not appear, but no decree *pro confesso* was taken, he was not allowed to file an answer after final hearing and decree, see *Allen v. Mayor of New York* (1880), 7 Fed. Rep. 483; 18 Blatch. 239; 5 Bann. & A. 461.

⁵ Equity Rules 61, 63-65.

That objections to an answer for failure to name persons, &c., ought to be taken by exceptions, see *Graham v. Mason* (1869), 5 Fisher, 1; 4 Clifford, 88.

⁶ Equity Rule 66.

That a replication cannot go behind

§ 1121. Cross-Bills.

Where the defendant, in an action in equity, is entitled to relief against the plaintiff, in some matter connected with the suit, he may file a cross-bill with his answer setting up his claims and praying for the relief required.¹ A cross-bill cannot introduce new parties, or a new and independent controversy, but may be used for purposes of discovery or for the determination of any issue subordinate to that involved in the original bill.² It must aver all facts that are essential to sustain the defendant's right to the desired relief, and disclose the relation between the remedy it seeks and that which forms the object of the principal suit.³ Cross-bills cannot be filed without leave of the court upon due notice to the adverse party.⁴

the case made on the pleadings and add a different cause of action, see *Burdell v. Denig* (1883), 15 Fed. Rep. 397.

That where the defendants to a bill for infringement plead accord and satisfaction with the plaintiffs, and the plaintiffs reply that the defendants obtained their machines of third parties before the plaintiffs became owners of the patent and before the infringement claimed in the bill, the replication is a departure and bad, see *Burdell v. Denig* (1883), 15 Fed. Rep. 397.

That an excess in a replication is surplusage, and the rest may stand as a traverse, see *Wren v. Spencer Optical Mfg. Co.* (1879), 18 O. G. 857; 5 Bann. & A. 61.

That if the plaintiff instead of filing a replication sets down the case for a hearing on the bill and answer, it admits that all that is well pleaded in the answer is proved, see *Parton v. Prang* (1872), 2 O. G. 619.

That the want of a replication is waived by taking the evidence on both sides without objection, see *Fischer v. Wilson* (1879), 16 O. G. 455; 16 Blatch. 220; 4 Bann. & A. 228.

§ 1121. ¹ Equity Rule, 72.

² That a cross-bill cannot introduce

new parties, see *Sheilds v. Barrow* (1854), 17 How. 130.

That a cross-bill must relate to matters contained in the original bill, see *Forbes v. R. R. Co.* (1872), 2 Woods, 323; *Rubber Co. v. Goodyear* (1869), 9 Wall. 807; *Cross v. DeValle* (1863), 1 Wall. 1.

That a bill claiming a set-off against one of several plaintiffs is not a cross-bill, see *Rubber Co. v. Goodyear* (1869), 9 Wall. 807.

That a cross-bill is not the proper mode of raising a question as to the defendant's ownership of the plaintiff's patent, a demurrer covering such cases, see *Puetz v. Bransford* (1887), 32 Fed. Rep. 318; 41 O. G. 353.

³ That a cross-bill must disclose the grounds of the defendant's claim, and the connection between the matters averred and the original bill, see *Story*, Eq. Pl. § 401.

⁴ That cross-bills cannot be filed without leave of court, see *Loom Co. v. Short* (1876), 10 O. G. 1019; *Bronson v. LaCrosse R. R. Co.* (1863), 2 Wall. 283.

That cross-bills cannot be filed without due notice, see *Loom Co. v. Short* (1876), 10 O. G. 1019.

That on a bill against the defendants, setting up a license to some of the

After the original bill is answered the plaintiff must answer the cross-bill, and until this is done the cause will not be heard.⁵ If the plaintiff withdraws the action after a cross-bill has been filed and served upon him, a decree *pro confesso* on the cross-bill may be taken by the defendant.⁶

§ 1122. Supplemental Bills.

Whenever any action in equity becomes defective after the filing of the original bill, whether by a change of the persons interested in the subject-matter of the suit, or by the occurrence of events enlarging or diminishing the rights of the parties, or whenever the plaintiff discovers facts essential to the proper decision of the controversy concerning which he had no information at the commencement of the action, he may file a supplemental bill alleging the new matter and thereby making it a part of his original claim.¹ A supplemental bill must not vary the character of the suit or the cause of action; and can be filed only by leave of the court, for sufficient reasons and upon proper notice to the defendant.² In actions in equity for infringement this method of amending the proceedings to suit the changing circumstances of the case is frequently employed. Thus where the plaintiff becomes bankrupt or assigns his interest in the patent and the compensation for past infringements, pending suit, a supplemental bill is necessary on behalf of the trustee in insolvency or the assignee.³ Where

defendants as a measure of damages, if the licensed defendants file a cross-bill for a surrender of the license, there is no authority for a notice to non-residents by publication, see *Loom Co. v. Short* (1876), 10 O. G. 1019.

⁵ Equity Rule 72.

⁶ That a decree *pro confesso* will be entered on the cross-bill if the plaintiff, having been served or appearing to answer, withdraws the original bill, see *Lowenstein v. Glidewell* (1878), 5 Dillon, 325.

§ 1122. ¹ Equity Rule 57.

That a bill in the nature of a supplemental bill is proper where there has been a change of interest in the subject-

matter, see *Tappan v. Smith* (1863), 5 Bissell, 73; *Hoxie v. Carr* (1832), 1 Sumner, 173.

That matter subsequently occurring may be set up by supplemental bill, see *Copen v. Flesher* (1861), 1 Bond, 440.

² That the character of the suit cannot be changed after the hearing by a supplemental bill, see *Snead v. McCoull* (1851), 12 How. 407.

That leave of the court must be obtained and due notice given, see Equity Rule 57.

³ That if the plaintiff becomes bankrupt pending suit, a supplemental bill may be needed unless the plaintiff has re-acquired the right of action, see *Gear*

other persons than those named in the original bill are found to have been participants in the infringing acts, or where new persons become interested in the infringing enterprise, a supplemental bill brings them before the court and joins them as defendants in the original action.⁴ If the defendant has been guilty of additional infringements since the institution of the suit, these may be incorporated in the cause of action by a supplemental bill at any time before the plaintiff's evidence is closed.⁵ When the patent is extended during the litigation, and the infringement continues under the extension, a supplemental bill based on the extension may be filed, and the plaintiff can then recover for the entire injury in the single action.⁶ When the plaintiff obtains a rehearing after the dismissal of his bill, upon the ground of newly discovered evidence, a supplemental bill is necessary, setting up the evidence and showing that it is material and could not have been produced by reasonable diligence on the former trial.⁷ Whether a supple-

v. Fitch (1878), 16 O. G. 1231; 3 Bann. & A. 573.

That if the original complainant and assignor dies, the assignee may file a supplemental bill, see *Metal Stamping Co. v. Crandall* (1880), 18 O. G. 1531.

⁴ That when a plaintiff, on a motion for leave to file a supplemental bill to add a new defendant, avers that he is informed and believes that the new defendant has obtained an interest in the infringing devices and is using them it is sufficient, see *Parkhurst v. Kinsman* (1848), 2 Blatch. 72.

⁵ That new matters concerning the original defendants, and a prayer for discovery thereon, may be inserted in a supplemental bill to bring in a new defendant, see *Parkhurst v. Kinsman* (1848), 2 Blatch. 72.

That a subsequent bill, alleging new infringements since the original bill was filed, may be received after the answer is made and the plaintiff's *prima facie* case is proved, and the evidence already in will then be applied as far as

it is relevant, see *Turrell v. Spaeth* (1876), 9 O. G. 1163; 2 Bann. & A. 315.

⁶ That a supplemental bill is proper when an extension is granted during the suit, see *Reedy v. Scott* (1874), 23 Wall. 352; 7 O. G. 463.

That where a patent expired during suit and was extended, and a supplemental bill was filed, and then the patent was re-issued, and a supplemental bill was filed on the re-issue, and on the latter bill a hearing was had, the proceedings were allowed, see *Howe v. Williams* (1863), 2 Fisher, 395; 2 Clifford, 245.

⁷ That a supplemental bill, after the dismissal of the original, praying for a hearing on the ground of new evidence, etc., must allege and show that the evidence could not have been obtained before the former hearing with reasonable diligence, and that the evidence is material, see *Spill v. Celluloid Mfg. Co.* (1884), 22 Fed. Rev. 94; 22 Blatch. 441; 29 O. G. 773.

mental bill can be filed upon the re-issue of the patent, pending suit, has been disputed, — some decisions asserting that the action fails and an original bill on the new patent becomes necessary;⁸ others declaring that although no damages or profits can now be recovered for the infringement of the original patent, the plaintiff may avail himself of the presence of the parties in the court, and continue the action under a supplemental bill.⁹ The right to object to this mode of procedure, if such right exists, may, however, be waived by the defendant, and if he acquiesces in a hearing on the re-issue under a supplemental bill, he cannot afterwards take advantage of the error.¹⁰ The supplemental bill need not repeat the allegations of the original, but may contain additional averments of the same general character, and state new matters constituting the same cause of action.¹¹ The defendant may demur, plead, or answer to a supplemental bill in the manner and for the reasons heretofore described in reference to the original.¹²

§ 1123. Amendments to Bill or Answer.

Before the filing of the replication amendments may be made, as a matter of right, in the bill or answer, but after replication no material alteration in either is allowed, except by leave of the court upon notice to the adverse party.¹ Leave

⁸ That when a patent is re-issued pending suit, no supplemental bill can be filed on the re-issue, but the suit abates and a new bill must be filed, see *Fry v. Quinlan* (1875), 13 Blatch. 205; *Reedy v. Scott* (1874), 23 Wall. 352; 7 O. G. 463.

⁹ That a supplemental bill, counting on a re-issue, may be filed after the original patent has expired, if the original bill was filed during the life of the patent, see *Dental Vulcanite Co. v. Wetherbee* (1866), 3 Fisher, 87; 2 Clifford, 555; *Howe v. Williams* (1863), 2 Fisher, 395; 2 Clifford, 245.

That a bill may be amended to count on the last re-issue, see *Reay v. Rayner* (1884), 19 Fed. Rep. 308; 26 O. G. 1111; 22 Blatch. 13.

¹⁰ That when a patent is re-issued

pending suit, a supplemental bill setting up the re-issue cannot be filed, a new original bill being necessary unless the defendant acquiesces in a different course; but if a supplemental bill is filed and the hearing goes on without objection, the proceedings are valid, see *Reedy v. Scott* (1874), 23 Wall. 352; 7 O. G. 463.

That where a disclaimer pending suit does not materially change the nature of the cause, a supplemental bill and new motion for an injunction are not required, see *Libbey v. Mt. Washington Glass Co.* (1886), 26 Fed. Rep. 757; 36 O. G. 572.

¹¹ Equity Rule 58.

¹² Equity Rule 57.

§ 1123. ¹ Equity Rules 28, 29, 60.

That defects in a bill or answer must

to amend will not be granted where the proposed amendment could with reasonable diligence have been sooner introduced, nor where it changes the character of the pleading, or is evidently offered for the purpose of delay.² The authority to permit amendments is conferred upon the court for the furtherance of justice, and to relieve the parties from the consequences of their unavoidable ignorance or mistake, and this authority may be exercised at any stage of the proceedings when its necessity becomes apparent. Thus where the evidence discloses that the description of the parties in the bill is incorrect, or that a different re-issue is in force from the one recited in the bill, or where the allegations of a bill brought by an assignee are broad enough to embrace, but do not specifically mention, claims for past infringements, or where the answer and the defendant's proof set up new matter in avoidance of his liability for the infringing acts, the plaintiff may amend the bill by the correction of the error, the enlargement of the insufficient allegation, or the insertion

be cured by amendment not by special motion, see *Doughty v. West* (1865), 2 Fisher, 553.

That a bill counting on one of two patents which together cover the infringing invention may be amended to count on both and the evidence already taken will be applied thereto, see *Underwood v. Gerber* (1889), 37 Fed. Rep. 796.

² That a motion to amend the answer will be denied if the new matter is not relevant or material, or could by due diligence have been put in the original answer, see *Richardson v. Croft* (1881), 20 O. G. 372.

That there is no good cause for allowing an amendment, under the 60th and 29th rules in equity, so as to introduce a new defence into the answer, if the same matter could with reasonable diligence have been set up in the original, see *India Rubber Comb Co. v. Phelps* (1870), 4 Fisher, 315; 8 Blatch. 85.

That where the same search would have shown the same facts; before as

well as since the original answer was filed, there is no ground for an amendment, see *India Rubber Comb Co. v. Phelps* (1870), 4 Fisher, 315; 8 Blatch. 85.

That an amendment changing the character of the bill is not usually allowed after a hearing, or after the case is set down for a hearing, see *Tremaine v. Hitchcock* (1874), 23 Wall. 518; 7 O. G. 1055.

That where the new defence rests on parol evidence only, the courts will disfavor an amendment to introduce it, as tending to encourage the manufacture of testimony, see *India Rubber Comb Co. v. Phelps* (1870), 4 Fisher, 315; 8 Blatch. 85.

That a motion to amend the answer and for a commission to take evidence abroad will not be granted when the proof before the court shows that no evidence to sustain the amendment can be obtained, see *Hicks v. Otto* (1883), 17 Fed. Rep. 539.

of new facts to meet the evidence and answer of the defendant.³ In like manner, where the evidence shows that the answer is insufficient, as by its failure to state all the available defences, or to recite the names and residences of all the persons who made prior use of the invention, or that it contains unfounded admissions to the detriment of the defendant, amendments may be made to render the answer conformable to the proof, unless the other evidence clearly indicates that on the case, taken as a whole, the plaintiff cannot be defeated.⁴ The amendment of the pleadings does

³ That where the evidence shows that the *status* of parties has been misdescribed, it can be cured by amendment, see *Needham v. Washburn* (1874), 7 O. G. 649; 4 Clifford, 254; 1 Bann. & A. 537.

That where the bill set up one re-issue, but all the evidence and references were based upon a second re-issue, an amendment in the bill inserting the second re-issue will be allowed, see *Tre-maine v. Hitchcock* (1874), 23 Wall. 518; 7 O. G. 1055.

That an assignee of the patent, in a suit against an alleged infringer, can move, before the signing of the interlocutory decree, to amend his bill so as to include the subject of assigned claims for damages and profits which were due to *mesne* assignors, where it appears that the bill was brought, answered, and tried on the theory that a recovery on those assigned claims was sought, see *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.* (1884), 20 Fed. Rep. 505; 22 Blatch. 182.

That if the defendant pleads a license and the plaintiff claims that he has abandoned it, the plaintiff must amend his bill and set up the abandonment, see *Wilson v. Stolley* (1847), 4 McLean, 275.

⁴ That an answer may be amended by inserting a new defence on a motion offered before final argument, and a de-

creed may be entered subject to the finding on such new defence, see *Snow v. Tapley* (1878), 13 O. G. 548; 3 Bann. & A. 228.

That where the evidence clearly shows that the patent is invalid the court may permit the answer to be amended so as to give proper notice of it, see *Geier v. Goetinger* (1874), 7 O. G. 563; 1 Bann. & A. 553.

That a motion to insert new defences in the answer in equity will be denied after an answer has been made under oath and the evidence thereon is closed, unless the defendant is without fault, see *Loom Co. v. Higgins* (1876), 9 O. G. 965; 13 Blatch. 349.

That an answer failing to name the persons using, under a defence of prior use, may be excepted to and amended under special order, see *Graham v. Mason* (1869), 5 Fisher, 1; 4 Clifford, 88.

That an admission in the answer that the defendants had made certain articles which the plaintiff was seeking to enjoin may be struck out, if a denial of the validity of the patent is to be made and no testimony has yet been taken, and the defendants are not guilty of laches, see *Morehead v. Jones* (1860), 3 Wall. Jr. 306.

That a defendant having in a former stage of the suit defended on the ground that he owned the patent, and admitted its infringement and its extent, and

not render evidence admissible if when taken it was inadmissible and properly objected to; but evidence taken without objection in the presence of the adverse party may be received and considered under the amendment.⁵

§ 1124. Trial, Various Modes of.

Issues of fact, in actions in equity for infringement, are always determined by the court, in accordance with its own views as to the significance and weight of the evidence presented.¹ Various methods of investigating facts exist. The

been defeated, cannot amend his answer after account taken on the ground that such admission was a mistake, and contest the infringement or the extent of it before the master, see *Ruggles v. Eddy* (1874), 11 Blatch. 524; 1 Bann. & A. 92.

That a defendant who, in one suit between him and the plaintiff, has consented to a decree with substantial damages, and has given the plaintiff an agreement acknowledging the validity of the patent and the novelty and utility of the invention, cannot on the second suit amend his answer to insert a denial of novelty and attack the patent, see *Pentlarge v. Beeston* (1878), 15 Blatch. 347.

That after a verdict and refusal of new trial, a feigned issue may be ordered in equity on new evidence, and the answer may be amended to insert it, see *Foote v. Silsby* (1850), 1 Blatch. 545.

That where the evidence shows that the plaintiff's patent cannot be defeated on final hearing, a motion to amend the answer will be denied, see *Richardson v. Croft* (1880), 11 Fed. Rep. 800.

⁵ That an amendment of an answer under leave of court does not render evidence admissible which was properly objected to before the amendment, see *Allis v. Buckstaff* (1882), 22 O. G. 1705; 13 Fed. Rep. 879; *Roberts v. Buck* (1873), 3 O. G. 268; *Holmes*, 224; 6 *Fisher*, 325.

That evidence offered without notice and objected to may be admitted after amendment by agreement when the omission of notice was inadvertent and the plaintiff was not taken by surprise, see *Roberts v. Buck* (1873), 3 *Fisher*, 325; 3 O. G. 268; *Holmes*, 224.

That when evidence as to prior use was taken before the answer was amended to give proper notice of it, against objection but with full rebutting evidence and cross-examination, it was allowed to stand, see *Allis v. Buckstaff* (1882), 13 Fed. Rep. 879; 22 O. G. 1705.

That unless evidence not covered by the answer is objected to when offered, if the plaintiff is present, the defendant may amend his answer to cover it without costs, see *Brown v. Hall* (1869), 3 *Fisher*, 531; 6 Blatch. 401.

That an amendment of a plea making it double will not be allowed after long delay, see *Giant Powder Co. v. Safety Nitro-Powder Co.* (1884), 19 Fed. Rep. 509; 27 O. G. 99; 10 *Sawyer*, 23.

That a paper filed without leave to amend cannot be treated as an amendment of the original answer, see *Dental Vulcanite Co. v. Wetherbee* (1866), 2 *Fisher*, 87; 2 *Clifford*, 555.

§ 1124. ¹ This is equally true whatever be the mode of trial. If the court hears the evidence, either directly or through depositions, its decision upon the facts is at once primary and

court may hear the testimony of the witnesses orally, or it may be offered in the form of depositions.² Feigned issues may be framed and sent to a jury in a court of law, or submitted to a special jury impanelled in the court of equity.³ If the witnesses are examined in open court before the judge alone, the procedure is the same as in any other *viva voce* trial. Depositions are taken before some proper officer, or other person appointed for that purpose by the court or by the parties, and transmitted in the usual manner to the clerk for publication and for presentation to the court in connection with the arguments of counsel.⁴ The trial of feigned issues to a jury, whether in the court of equity or law, is a proceeding of a peculiar character, and in reference to patent cases is still of practical importance.

§ 1125. Trial by Jury on Feigned Issues.

In the earlier periods of patent litigation the courts of equity, in deference to the statute of Jac. I., referred all questions concerning the patentability of the invention, the validity of the patent, the title of the plaintiff, the fact of infringement, and the amount of damages, to the decision of the courts of law, and afforded equitable relief only for the protection of the plaintiff during the litigation and for the

final. Where the facts are first passed upon by a jury, whether on a feigned issue at law or under the act of 1875, the verdict is merely advisory, and may be departed from by the court. See *Watt v. Starke* (1879), 101 U. S. 247; 17 O. G. 1092; *Goodyear v. Providence Rubber Co.* (1864), 2 Fisher, 499; 2 Clifford, 351; *Ely v. Monson & Brimfield Mfg. Co.* (1860), 4 Fisher, 64.

² That the court may hear the testimony directly, see *Blease v. Garlington* (1875), 92 U. S. 1; *In re Clark* (1872), 9 Blatch. 372.

That evidence may be taken by depositions, see Equity Rules 67-69.

That a secret trial of a patent suit cannot be allowed, see Opinion Atty. Gen. (1820), 1 Op. Att. Gen. 376.

³ That a feigned issue may be ordered, see *Gray v. Halkyard* (1886), 28 Fed. Rep. 854; 38 O. G. 784; also § 1125 and notes, *post*.

That a special jury may be employed in patent cases in equity, see act of Feb. 16, 1875, Sec. 2.

That a jury trial under Sec. 2, act of 1875, is matter of discretion not of right, see *Keyes v. Pueblo Smelting and Refining Co.* (1887), 31 Fed. Rep. 560.

That priority and public use are questions of fact, and may properly be submitted to a jury by a court of equity, see *Gray v. Halkyard* (1886), 38 O. G. 784; 28 Fed. Rep. 854.

⁴ Equity Rules 67-69.

enforcement of the judgment after it had been obtained.¹ When, at a later period, equity assumed a more immediate jurisdiction over this class of cases it still regarded a jury as the proper tribunal, and a court of law as the proper forum, for the investigation of the most important issues, and therefore, having framed these issues in a form to suit its purposes, sent them into the court of law for trial and received the verdict of the jury as the determination of the matters it embraced.² But even this modification of the ancient practice has, during the past half-century, almost disappeared, and at the present day equity usually conducts its inquiries within its own tribunals. When it requires the assistance of a jury, as in some cases it still may do, the act of 1875 enables it to summon and impanel one consisting of not less than five nor more than twelve persons, to present to them such issues as it deems expedient, and to proceed upon their verdict in the same manner as if the issues had been tried at law.³ The submission of feigned issues to a jury is now a matter entirely within the discretion of the court, and no appeal will lie from its refusal, although on an appeal for other causes the court above may send the cause back for a jury trial, if it seems expedient.⁴ It is not ordered at the

§ 1125. ¹ As to the early relation of trials at law to equity proceedings in patent cases, see § 932 and notes, *ante*.

² As to the later relation of trials at law to patent cases in equity, see § 932, 1081-1084, and notes, *ante*.

³ Act of Feb. 16, 1875, Sec. 2.

⁴ In *Brooks v. Norcross* (1851), 2 Fisher, 661, Woodbury, J. : (662) "It is requested, as a preliminary favor or right, that the question of infringement in this case be tried by a jury. I am not aware of any trial of that kind which is allowed in any way in chancery, as a matter of right to a party, unless it be in case of a bill in chancery to abate a nuisance which is of a public character, and which some individual claims to injure himself specially. There, if the nuisance be denied, courts

will usually decline to sustain a private complaint to abate it, if the question of nuisance be not first settled at law and by a jury. (*Irwin v. Dixon*, 9 How. 10, and in cases cited there.) Such is not the class to which the present case belongs. Another set of instances, where a jury is ordered in chancery, is to try particular facts, and not to settle at law a question of right. It is, too, with a view to settle facts on which the court feels doubt, and itself wishes the aid of a jury to do it, and not where the party applies for a jury either as a right or a favor. This is the most numerous class of cases where a jury is used. (7 How. 227, *McLaughlin v. Bank of Potomac et al.* 3 Story R. 746.) In the argument of counsel, it seems to be conceded that the allowance of a jury to settle at

request of the parties, nor until the court finds itself unable otherwise to ascertain the facts, and this may not occur before the evidence has been published.⁵ It is more readily

law the question of infringement is regarded not as a right, but a matter in the sound discretion of the court. This, too, is the adjudged law in instances of that character. (*Pierpont v. Fowle*, 2 W. & M. 25, 37; *Saunders v. Smith*, 3 Mylne & Craig, 735; *Jacobs*, 311.) But this discretion must, of course, be regulated by sound reasons. And though an English Chancellor has said he remembered no case where the trial at law was refused when wished, it is certain there have been many. The chief test is, whether the chancery court entertains any reasonable doubt as to the law or fact, and wants them ascertained for its aid. (*Curtis on Pat.* 383; *Web. Pat. Cas.* 473.) And if a trial is ordered at law, to remove doubts or settle contested rights, before a final decision in chancery, the latter court will still often issue the temporary injunction, founded on long possession of the patent, or other *prima facie* evidence, till a decision is had at law. (*Web. Pat. Cas.* 730; *Curtis on Pat.* 381; 14 Ves. 130; 8 Merivale, 622.) Most of the patent cases where the court has deemed it proper to dissolve an injunction, or refuse one till the parties' rights are settled at law, are those where the defendant denies the plaintiff's right in his answer, and the recoveries against other persons, and numerous sales and long possession, have not been such as to raise a strong presumption that the patent is valid. (*Orr v. Littlefield*, 1 W. & M. 13; *Woodworth v. Edwards et al.*, 3 W. & M. 120, and cases there cited, 2 Eden, Ch. 137; *Curtis on Pat.* 339; *Web. Pat. Cas.* 472; *Hindmarch on Pat.* 30-37.)" See also *Ely v. Monson & Brimfield Mfg. Co.* (1860), 4 Fisher, 64.

That a feigned issue may be sent to

a jury on mere questions of fact, see *Gray v. Halkyard* (1886), 23 Fed. Rep. 854; 38 O. G. 784.

That feigned issues are not favored in our courts, see *Cochrane v. Deener* (1876), 94 U. S. 780; 11 O. G. 687.

That in the Federal courts, the judge being the same at law and in equity, there is no such reason for sending cases to the jury as in England, see *Brooks v. Norcross* (1851), 2 Fisher, 661.

That it is a matter of discretion, not jurisdiction, whether chancery will send a case to be tried at law, and a decision thereon is no ground of appeal, though if an appeal be taken on other grounds, and it appears that the case ought to be tried otherwise, it can be sent back for that purpose, see *Cochrane v. Deener* (1876), 94 U. S. 780; 11 O. G. 687.

⁵ That an issue at law will not be ordered on the mere request of the parties, see *Brooks v. Norcross* (1851), 2 Fisher, 661.

That an order for jury issues will not be granted when the truth of the matters in dispute can be conveniently and satisfactorily ascertained by the court itself, see *Goodyear v. Providence Rubber Co.* (1864), 2 Fisher, 499; 2 Clifford, 351; *Brooks v. Norcross* (1851), 2 Fisher, 661.

That no jury issue as to infringement will be ordered unless the court has doubts as to the identity of the devices, see *Van Hook v. Pendleton* (1846), 1 Blatch. 187.

That a suit at law may be ordered on an answer which does not set out the names of the persons in prior use or knowledge, but the pleadings in the suit at law must set them out, see *Orr*

allowed when the patent is recent, the novelty of the invention doubtful, the identity of the infringing process or device with that covered by the patent uncertain, and the proof conflicting or the credibility of the witnesses disputed.⁶ It is not often resorted to when the patent and the infringement have already been established by a verdict.⁷

§ 1126. Effect of the Verdict on a Feigned Issue.

During the trial of a feigned issue in a court of law equity will not interfere with the proceedings.¹ It may send with the record of such issues the depositions already taken to be used as evidence, but other depositions will not be admitted except when obtained in conformity with the ordinary rules of law.² The verdict of the jury is advisory only, and may

v. Merrill (1846), 1 W. & M. 376; 2 Robb, 331.

That an order for issues to the jury will not be made until the evidence is taken and publication has passed, see *Goodyear v. Providence Rubber Co.* (1864), 2 Fisher, 499; 2 Clifford, 351.

⁶ That equity grants a motion for jury issues when the patent is new and novelty uncertain, or when the case depends on conflicting evidence or the credibility of witnesses, see *Howe v. Williams* (1863), 2 Fisher, 395; 2 Clifford, 245.

⁷ In *Howe v. Williams* (1863), 2 Fisher, 395; Clifford, J.: (398) "Such a motion is sometimes granted, where the patent is recent, and where the case shows that the originality of the invention is doubtful; or where the merits of the controversy chiefly depend upon contradictory evidence, involving the credibility of witnesses; but where the patent is of long standing, and the inventor has had an exclusive possession under it, the motion is seldom received with any favor. (*Washburn et al. v. Gould*, 3 Story C. C. 169; *Hill v. Thompson*, 3 Meriv. 622; *Collard v. Allison*, 4 Mylne & Cr. 487.) Other examples where such a motion was

granted are also shown in some of the numerous cases cited by the respondent, but it is a sufficient answer to all such decisions, as applied to this case, to say that the motion ought not in general to be granted where it appears that a trial at law and a hearing in equity have already been had, and that both have resulted in favor of the complainant; and the motion is accordingly overruled. *Goodyear v. Day*, 2 Wall. Jr. 296." 2 Clifford, 245 (246).

§ 1126. ¹ That when chancery suspends, in order to allow a case to be tried at law, it does not interfere with the proceedings at law, see *Watt v. Starke* (1879), 101 U. S. 247; 17 O. G. 1092.

² That on the trial of feigned issues, depositions *de bene esse*, taken without notice to the opposite party, are not admissible unless they are sent down with the record of the issues framed on the equity side of the court, see *Cahoon v. Ring* (1861), 1 Clifford, 592.

That after a decree ordering jury issues and the sending of the record to the court of law, the court of law will not order any depositions taken in equity to be removed to the law court unless they were sent down with the

be discarded in the court of equity and a contrary judgment rendered.³ A motion for a new trial for a verdict against evidence must be made to the judge in chancery, and may be supported by the record and proof of the testimony as given in the court of law.⁴ After the verdict the defeated party may proceed in the cause in equity, and introduce further evidence unless the time for taking evidence is past; and for this purpose, where an order for feigned issues is made before the time for taking evidence expires, the time will be extended until after the verdict is rendered and a sufficient opportunity has been afforded for additional testimony.⁵

record, nor will they be admitted as evidence, see *Cahoon v. Ring*, (1861), 1 Clifford, 592.

That on the trial of feigned issues as to novelty Office copies of the plaintiff's correspondence with the Patent Office, as to the re-issue or its construction, are not admissible evidence, see *Cahoon v. Ring* (1861), 1 Clifford, 592.

That a respondent cannot be asked a question on the trial of a feigned issue, if the reply which it calls for would contradict an admission in his answer, see *Cahoon v. Ring* (1861), 1 Clifford, 592.

That if feigned issues present no question of fraud or mistake, and the bill is based on a re-issued patent, the original is not admissible, see *Cahoon v. Ring* (1861), 1 Clifford, 592.

³ That the verdict of a jury in a cause sent from chancery, being only advisory and never conclusive, may be disregarded, and a decree rendered contrary to it, see *Watt v. Starke* (1879), 101 U. S. 247; 17 O. G. 1092; *Goodyear v. Providence Rubber Co.* (1864), 2 Fisher, 499; 2 Clifford, 351; *Ely v. Monson & Brimfield Mfg. Co.* (1860), 4 Fisher, 64.

⁴ That when chancery sends an issue to law for a trial on the facts, a motion for a new trial must be made to the court of chancery, and notes of the pro-

ceedings and evidence at law must be submitted to the chancellor, see *Watt v. Starke* (1879), 101 U. S. 247; 17 O. G. 1092.

That a bill of exceptions cannot be taken on the trial of a feigned issue directed by a court of equity, or if taken can only be used on a motion for a new trial, see *Watt v. Starke* (1879), 101 U. S. 247; 17 O. G. 1092.

That the proceedings and evidence at law may be brought to the notice of the chancellor either by having them reported with the verdict or by moving the chancellor to send to the judge at law for his notes or by any other proper way, and they then become part of the record, see *Watt v. Starke* (1879), 101 U. S. 247; 17 O. G. 1092.

⁵ That the verdict on jury issues is never final, but the defeated party may proceed in the cause and if the evidence is not closed under the rules, or if the court grants leave, he may introduce further proof to support his claims, see *Goodyear v. Providence Rubber Co.* (1864), 2 Fisher, 499; 2 Clifford, 351.

That when feigned issues are ordered before the time for taking the evidence expires, no decree after verdict on such issues will be ordered until further time for taking evidence is given, see *Cahoon v. Ring* (1861), 1 Clifford, 592.

§ 1127. Evidence Admissible in Equity.

The evidence admissible in equity upon the various issues created by the bill and answer is the same as that receivable at law upon the corresponding issues.¹ The burden of proof rests upon the plaintiff as to all the material averments of his bill, and upon the defendant as to matters of avoidance or estoppel or the subordination of a legal to his equitable rights.² The parties are competent witnesses on either side, and neither, by summoning and examining the other waives

§ 1127. ¹ For the evidence admissible on each issue, see §§ 1022-1049, and notes, *ante*.

² That the court cannot notice what is merely alleged and not proved, see *Blandy v. Griffith* (1869), 3 Fisher, 609.

That the burden of proof on all matters necessary to sustain the action rests on the plaintiff, see § 1018 and notes, *ante*.

As to the *prima facie* evidence afforded by the patent, see § 1016 and notes, *ante*.

That whatever is averred in the bill and not denied in the answer is admitted, and need not be further proved, see §§ 1114-1118 and notes, *ante*.

That the burden of proof on the question of infringement rests on the appellant, and if he fails in it the decree will be affirmed, see *Price v. Kelley* (1881), 20 O. G. 1452; 13 Fed. Rep. 304.

That if the defendant denies infringement the plaintiff must prove it, see *Francis v. Mellor* (1871), 8 Phila. 157; 5 Fisher, 153; 1 O. G. 48.

That infringement may be found, as against the defendant's sworn denial in his answer, upon circumstantial evidence, though no direct act of infringement can be proved, see *Peterson v. Simpkins* (1885), 25 Fed. Rep. 486; 33 O. G. 1392.

That if the plaintiff does not object to the defendant's answer, on the ground that it merely denies information as to the validity of the patent and disputes

the damages, the plaintiff takes the burden of proving the infringement, see *Wooster v. Musser* (1884), 20 Fed. Rep. 162; 28 O. G. 286.

That defences set up in the answer, if the burden is on the defendant, are not noticed unless some proof is offered in their support, see *Cook v. Howard* (1870), 4 Fisher, 269.

That the burden of proving an equitable against a legal title is on the affirmant, and his pleadings must deny that the plaintiff is a *bona fide* holder for value without notice, see *Gibson v. Cook* (1859), 2 Blatch. 144.

That in equity the court may inspect a model of the invention, and upon inspection declare it unpatentable, see *Everett v. Thatcher* (1878), 16 O. G. 1046; 2 Flippin, 234; 3 Bann. & A. 435.

That a court of equity has power to order an inspection of infringing or controverted inventions, see *Wilson v. Keely* (1888), 43 O. G. 511.

That the plaintiff's affidavits offered in rebuttal must not strengthen his case as to the infringement, thus creating a danger of surprise to the defendant if allowed, see *Union Paper Bag Mach. Co. v. Binney* (1871), 5 Fisher, 166.

That exhibits not properly explained and applied will not be considered, see *Miller v. Smith* (1880), 5 Fed. Rep. 359; 18 O. G. 1047.

any claim against him.³ The plaintiff may compel the defendant to produce the books by which infringing sales are evidenced, but cannot, under the preliminary proof, force him to disclose the details of his business and give the names of confidential customers.⁴ One party, whose deposition is being taken by the other, has a right to decline to answer questions which he deems improper and his replies to which might prejudice his interests, and to refer his objections to the court to be decided before the examination can proceed.⁵ An answer under oath, if responsive to the bill, not only makes but proves the issue and requires two witnesses, or their equivalent, to overthrow it.⁶ An irresponsive answer is an admission of the truth of the averments of the bill, and an equivocal answer, especially on the question of infringement, affords such strong presumptions in favor of the plaintiff that little further evidence is necessary to support his allegations.⁷ Direct admissions in the answer are conclusive evidence against the defendant.⁸ A bill *in perpetuum* in one Federal court, with the

³ That the plaintiff does not waive his rights against the defendant by making him his witness, see *Jenkins v. Greenwald* (1857), 2 Fisher, 37 ; 1 Bond, 126.

⁴ That the books of the defendant may be ordered produced, see *Roberts v. Wolley* (1882), 14 Fed. Rep. 167.

That when the infringement and validity are denied the plaintiff cannot compel the defendant, on the preliminary proof, to give him the names of more than one of his confidential customers to whom he furnished articles covered by the patent, see *Roberts v. Wolley* (1882), 14 Fed. Rep. 167.

⁵ That an examiner has no power to rule on the evidence, and the defendant, when a witness, has the right to take the opinion of the court in a doubtful case, and when he acts in good faith under the advice of counsel he cannot be punished for contempt, see *Roberts v. Wolley* (1882), 14 Fed. Rep. 167.

⁶ For the effect of an answer under oath, see § 1119 and notes, *ante*.

⁷ That an answer is not evidence as to matter not responsive to the interrogatories, and if the allegations of the answer are not responsive to the interrogatories or sustained by other evidence, the plaintiff has judgment, see *Wren v. Spencer Optical Mfg. Co.* (1879), 18 O. G. 857 ; 5 Bann. & A. 61.

That unless the denial of infringement in the answer under oath is positive and unequivocal, the testimony of a single witness, with corroborating facts, is sufficient proof of the infringement, see *Goodyear v. Berry* (1868), 3 Fisher, 439 ; 2 Bond, 189.

⁸ As to the effect of admissions in the answer, see § 1118 and notes, *ante*.

That when the defendant by an answer in regard to date seemed to admit an infringement on which there was no other evidence, but denied the infringement constantly, the answer was not sufficient to prove it, see *Reay v. Rau*

evidence taken under it, may be received in any other.⁹ Evidence admissible at law only under a special notice cannot be introduced in equity unless the same notice has been given by the answer.¹⁰

§ 1128. Method of Producing Evidence in Equity: Objections: Exceptions.

When the trial of an action in equity is conducted in open court, whether with or without a jury, the methods of offering and objecting to evidence follow those which are pursued in courts of law. But when the testimony is taken by deposition, according to the usual practice in courts of equity, different rules prevail. In such cases the court fixes a period within which each party shall complete his evidence, and appoints some proper officer or other person as an examiner to receive the testimony and transmit it to the court.¹ Under this order, if the plaintiff fails to take his evidence within the time prescribed, and does not apply for an extension, the court may proceed with the cause and determine it upon the pleadings as they stand.² Evidence taken after the appointed time will

(1883), 15 Fed. Rep. 749; 23 O. G. 1928.

That the defendant does not admit his infringement by accepting service of an injunction, giving bond, and acknowledging the validity of the patent and the plaintiff's title, but the presumption arising from these acts may be rebutted, see *Byam v. Eddy* (1853), 24 Vt. 666; 2 Blatch. 521.

⁹ That a bill *perpetuam rei memoriam* to take evidence for the defendant of a witness over ninety on a matter twelve years before the patent issued, if the plaintiff will not sue at once, is proper, and the evidence thus taken in a Federal court is admissible in any other Federal court, see *New York & Baltimore Coffee Polishing Co. v. New York Coffee Polishing Co.* (1881), 20 Blatch. 174; 9 Fed. Rep. 578.

¹⁰ That the statutory defences of which notice is required at law must be

set up in equity in the answer, or evidence concerning them is inadmissible, see §§ 1114-1116, and notes, *ante*.

§ 1128. ¹ Equity Rules, 67-71.

That affidavits cannot be entitled in the cause before the bill is filed though they may be taken, see *Baldwin v. Bernard* (1872), 5 Fisher, 442; 2 O. G. 320; 9 Blatch. 509, note.

That affidavits not entitled in the cause are mere extra-judicial oaths and not receivable, see *Buerk v. Imhaeuser* (1876), 10 O. G. 907.

That when expert evidence is desired an application to put it in must be made before the first hearing, see *Hitchcock v. Tremaine* (1872), 1 O. G. 633; 5 Fisher, 537; 9 Blatch. 550.

² That if the plaintiff fails to take evidence within the prescribed time, and does not apply for an extension, the court will proceed to determine the case on the pleadings as they stand,

be considered, unless a motion to suppress it is presented; but if objected to the court will ordinarily reject it, though where no injury could result to the opposing party, it may be allowed to remain.³ Inadmissible evidence must be objected to when it is offered before the examiner, if the adverse party is then present, and the objection must be entered on the record of the testimony to be transmitted with it to the court.⁴ Every

see *Irwin v. Meyrose* (1881), 2 McCrary, 244; 7 Fed. Rep. 533.

³ That under Rule 69 no evidence taken after the time can be read at the hearing if the other party objects, see *Wooster v. Clark* (1881), 21 O. G. 264; 9 Fed. Rep. 854.

That when a defendant offers no evidence to sustain his defence of prior use, and after the evidence is closed and the plaintiff has made out his case, the defendant without amending his answer, or obtaining an extension of time, files affidavits of public use, they are too late and are not regarded, see *Union Paper Bag Mach. Co. v. Newell* (1874), 5 O. G. 459; 1 Bann. & A. 118; 11 Blatch. 549.

That if evidence is taken and filed out of time without any motion to suppress it, it may be considered, see *Matthews v. Spangenberg* (1882), 19 Fed. Rep. 823; 23 O. G. 92; 20 Blatch. 482.

That evidence taken without objection may stand on an amended answer, see *Babcock v. Pioneer Iron Works* (1888), 34 Fed. Rep. 338.

That under Rules 66 and 69 the court has discretion to direct that a replication filed and evidence taken after the time named in Rule 66 shall stand as if filed and taken within the time, see *Fischer v. Hayes* (1881), 20 O. G. 239; 6 Fed. Rep. 76; 19 Blatch. 26.

That when depositions were taken in conformity with a special order as to notice, and the adverse party had no time to confer with his counsel and attend, they

will be admitted on condition that the opposite party have a chance to take them over again and cross-examine, see *Aiken v. Bemis* (1847), 3 W. & M. 348; 2 Robb, 644.

⁴ That objections must be distinctly made when the evidence is presented or they will be waived, see *Barker v. Stowe* (1878), 15 Blatch. 49; 14 O. G. 559; 3 Bann. & A. 337.

That if a party is present at an examination of witnesses, and does not object to the evidence on the ground of a want of averment in the answer, he cannot take advantage of the defect at the hearing, see *Brown v. Hall* (1869), 3 Fisher, 531; 6 Blatch. 401.

That witnesses produced as to prior use without notice must be objected to when the testimony is taken or the evidence will be admitted, see *Roemer v. Simon* (1874), 5 O. G. 555; 1 Bann. & A. 138.

That if the defence of prior invention is not set out in the answer as it should be, and no objection is made at the proper time, it cannot be excepted to in the Supreme Court after appeal, see *Loom Co. v. Higgins* (1882), 105 U. S. 580; 21 O. G. 2031.

That objections to the admissibility of evidence must appear on the record, or they will be considered as waived, see *Fischer v. Neil* (1881), 19 O. G. 603; 6 Fed. Rep. 89.

That if there is no objection on the record to hearsay evidence the objection will be waived, see *Fischer v. Neil* (1881), 6 Fed. Rep. 89; 19 O. G. 603.

objection must specifically state the grounds on which it rests, and every ground not stated will be waived.⁵ Evidence not objected to can be employed only for purposes for which it is legally admissible.⁶ Objections to the competency of witnesses, or to their introduction under the pleadings as they are framed, or to the authenticity of documentary evidence, must be fully disclosed in order that, if possible, the obstacle may be removed.⁷ When the record of the testimony with the objections is returned to court, the inadmissible evidence may be struck out on motion; or if the inadmissibility arises from the want of proper averments in the bill or answer, the defects may be amended and the evidence may be then received or the cause sent back to the examiner for a repetition of the testimony.⁸ A motion to suppress the evidence of a

⁵ That a general objection to evidence is not considered unless the ground of objection is specified, and if the ground of objection is specified all other grounds are waived, see *Fischer v. Neil* (1881), 19 O. G. 603; 6 Fed. Rep. 89; *Brown v. Hall* (1869), 3 Fisher, 531; 6 Blatch. 401.

⁶ That evidence not objected to can only be used for the purpose for which it is admissible, see *Zane v. Soffe* (1880), 2 Fed. Rep. 229.

That under a general denial of the patentee's priority evidence of prior use taken without objection is competent at the final hearing, both as to the state of the art and the priority of the patent, see *Zane v. Soffe* (1884), 110 U. S. 200; 28 O. G. 737.

⁷ That an objection to the examination of a witness must state specifically the grounds of the objection so that it may be removed if possible, see *Woodbury Patent Planing Mach. Co. v. Keith* (1879), 101 U. S. 479; 17 O. G. 1031; 4 Bann. & A. 100.

⁸ In *Allis v. Buckstaff* (1882), 13 Fed. Rep. 879, Dyer, J. : (884) "It was held in *Roberts v. Buck*, 6 Fisher, 325, that where evidence of anticipations not set up in the answer had been taken,

and a motion was afterwards made to amend the answer, an amendment would not make that evidence admissible which was taken under objection before the amendment. After all, I suppose it to be discretionary with the court in such a case, especially after the objecting party has fully cross-examined the witnesses and taken rebutting proofs, either to let the testimony stand in the case, or to strike it out and permit the defence to take the testimony anew under the amended answer. So far as the state of the case in *Roberts v. Buck* is disclosed, in the opinion of the court there is ground for the inference that the objecting party stood on his objection and elected not to cross-examine the witnesses or to offer rebutting proofs. In the case at bar objection was made to the examination of the witnesses, but there was full cross-examination, and proofs in rebuttal of that particular evidence were offered, and I think it is a proper exercise of discretion to let the testimony, which is objected to as irregularly taken, stand in the case." 22 O. G. 1705 (1707).

Further, that the pleadings may be amended and the evidence allowed to

witness, on the ground that he was mistaken in its details, will not be entertained if the examination was in due form and after proper notice.⁹ No evidence can be used in argument before the court unless presented to the examiner and appearing on the record, except such documents as are equally accessible to both parties, and whose connection with the controversy is so apparent that their production by one can operate as no surprise upon the other.¹⁰ Upon the motion of either party, for sufficient cause, the court may refer the record back to the examiner for the introduction of additional evidence or the re-examination of the former witnesses, and in such reference the testimony must be limited to the points

stand, see *Babcock v. Pioneer Iron Works* (1888), 34 Fed. Rep. 338; *Forbes v. Barstow Stove Co.* (1864), 2 Clifford, 379.

That if a witness is objected to before the examiner on the ground that the notice is imperfect, the notice must be amended or the evidence though taken will not be considered, see *Kiesele v. Haas* (1887), 32 Fed. Rep. 794.

That evidence of prior use taken against objection before the examiner, without due notice or answer, will be struck out by the court, see *Bragg v. City of Stockton* (1886), 11 Sawyer, 597; 27 Fed. Rep. 509.

That where a witness's name was not stated in the answer but his application for a patent was referred to, a motion to strike out his evidence will be sustained, see *Decker v. Grote* (1873), 6 Fisher, 143; 3 O. G. 65; 10 Blatch. 331.

That evidence of prior use, &c., given by persons not named in the answer, will be considered on the hearing unless a motion is made to strike it out, although it was objected to when taken, see *Elm City Co. v. Wooster* (1873), 4 O. G. 83; 6 Fisher, 452.

That evidence of prior use taken without proper notice and objected to cannot be admitted under the answer when afterward amended on motion, unless

by agreement of the parties and where the omission of notice was inadvertent and the plaintiff was not taken by surprise, see *Roberts v. Buck* (1873), 6 Fisher, 325; 3 O. G. 268; *Holmes*, 224.

⁹ That a motion to suppress testimony, on the ground that the witness was mistaken as to the occasion named, is not allowed if the examination was in proper form and after due notice and on oath, see *Fischer v. Hayes* (1881), 20 O. G. 242; 6 Fed. Rep. 86.

¹⁰ That a patent not offered as evidence before the examiner, and not set up in the answer, cannot be introduced in equity, even upon a question of title, as the plaintiff has no opportunity for explanation, see *Grover & Baker Sewing Machine Co. v. Sloat* (1860), 2 Fisher, 112.

That prior patents, though generally referred to in the answer cannot be first introduced after the hearing is closed, see *Peterson v. Simpkins* (1885), 25 Fed. Rep. 486.

That the defendant may offer the original at the hearing to show that the re-issue departs from it, though it was not put in before the master, if it works no surprise to the plaintiff, see *Knapp v. Shaw* (1883), 15 Fed. Rep. 115; 23 O. G. 2236.

designated by the court.¹¹ When the evidence is thus complete and printed, and the briefs of counsel are prepared, the cause is argued and submitted to the decision of the court. After the hearing and submission neither party has the right to file any paper in the case without leave of the court, upon motion and due notice to the adversary.¹²

§ 1129. Practice and Procedure in Equity in Actions for Infringement.

The practice in equity, in actions for infringement, follows that of the English chancery as it existed before the "New Rules" were adopted, except where changed by express regulations.¹ The rules in equity prescribed by the Supreme Court of the United States are binding on the Circuit Court.² These rules were framed to conduct the cause to a hearing and have no effect upon it after it has been heard, unless steps are taken to bring it again within their operation. All privileges which they confer upon the parties, and all objections on the ground of their violation, must, therefore, be made available

¹¹ That if the case is referred back to the master to take new proof, and it relates to the same subject, it does not make out a new case, see *Wooster v. Simonson* (1884), 20 Fed. Rep. 316; 28 O. G. 918.

¹² In *Union Sugar Refinery v. Matthiesson* (1868), 3 Clifford, 146, Clifford, J. : (148) "When a suit in equity has been heard and submitted to the court for decision, neither party has a right to file any paper in the cause except by leave of the court. Such prohibition commences at the date of the submission of the cause to the court, and continues throughout the period that it remains upon the docket thereafter. The master may report back the cause to the court at any time when he has completed his investigations; and it would be the duty of the clerk to allow him to file his report without any new order from the court, as the right to do so is implied from the decree re-

ferring the cause to him for the purpose specified in the decree."

§ 1129. ¹ That equity practice, unless otherwise ordered by the Acts of Congress, or the Rules of the Supreme Court, is usually in accordance with the English chancery practice as it was before the "New Rules," see *Goodyear v. Providence Rubber Co.* (1864), 2 Fisher, 499; 2 Clifford, 351; *Parker v. Sears* (1850), 1 Fisher, 93; *Motte v. Bennett* (1849), 2 Fisher, 642.

² That the Circuit courts are bound by and cannot rescind the rules of equity made by the Supreme Court, see *Jenkins v. Greenwald* (1857), 2 Fisher, 37; 1 Bond, 126.

That Federal courts of equity follow the practice prescribed by the judiciary acts and their own rules, not the local law, see *United States v. American Bell Telephone Co.* (1886), 29 Fed. Rep. 17; 38 O. G. 1237.

before or at the hearing, or they will be waived.³ The stipulations of the parties, when properly evidenced, are recognized by the court, but parol stipulations made out of court, and concerning the terms of which dispute has arisen, will not be enforced.⁴

§ 1130. Decrees in Equity : Decrees Pro Confesso.

Decrees in equity in actions for infringement are of three kinds: Decrees *pro confesso*; Interlocutory Decrees; and Final Decrees. A decree *pro confesso* may be granted where the defendant, having been served with process, fails to appear within the time required, or having appeared fails to plead, demur, or answer according to the order of the court, or fails to answer after a former demurrer, plea, or answer has been overruled or declared insufficient.¹ Such a decree assumes the truth of the bill, and until rescinded is as binding as any solemn decree.² It concludes the defendant

³ In *Allen v. Mayor of New York* (1880), 7 Fed. Rep. 483, Wheeler, J. : (484) "The rules in equity are framed for bringing a cause to a hearing, and do not apply after a cause has been heard unless some proceedings are taken to bring it within their operation again, and to start it anew towards a hearing. When the cause is heard, without objection by either party, all steps not taken by either, which the other had a right to insist upon for the orderly bringing the cause to a hearing, must be considered as waived. Any other course would lead to re-opening causes, after hearing, for technical and unimportant defects, and greatly embarrass the prompt administration of justice by the courts, which is for the good of the people." 18 Blatch. 239 (240); 5 Bann. & A. 461 (462).

⁴ That written stipulations filed by the parties are recognized by the courts, see *Allis v. Buckstaff* (1882), 22 O. G. 1705; 13 Fed. Rep. 879.

That a stipulation cannot have the effect of a final decree until ratified by

the court, see *Roemer v. Neumann* (1886), 26 Fed. Rep. 332.

That parol stipulations of counsel made out of court are not noticed by the court so far as to decide upon the accuracy of recollection, or the terms of the agreement, or whether the court ought to enforce it, especially when the stipulation was made before the examiner and should appear on the record, see *American Saddle Co. v. Hogg* (1872), 6 Fisher, 67; 2 O. G. 595; Holmes, 177.

§ 1130. ¹ In *Thomson v. Wooster* (1885), 114 U. S. 104, Bradley, J. : (112) "By our rules a decree *pro confesso* may be had if the defendant, on being served with process, fails to appear within the time required; or if having appeared, he fails to plead, demur, or answer to the bill within the time limited for that purpose; or if he fails to answer after a former plea, demurrer, or answer is overruled or declared insufficient." 31 O. G. 913 (915).

² In *Thomson v. Wooster* (1885), 114 U. S. 104, Bradley, J. : (111)

as to the patentability of the invention, the validity of the patent, the title of the plaintiff, and the fact of his infringement, so far as these matters are supported by the allegations of the bill, in the same manner and to the same extent as if they had been proved, and cannot be questioned either in the Circuit court or on appeal, unless shown to be erroneous by other statements contained in the bill itself.³ During the term at which it is entered it is a decree *nisi*, and may be revoked upon sufficient grounds at the discretion of the court,⁴ but no such revocation will be ordered on account of

“ We may properly say, therefore, that to take a bill *pro confesso* is to order it to stand as if its statements were confessed to be true; and that a decree *pro confesso* is a decree based on such statements, assumed to be true (1 Smith's Ch. Pract. 153), and such a decree is as binding and conclusive as any decree rendered in the most solemn manner. It cannot be impeached collaterally, but only upon a bill of review, or [a bill] to set it aside for fraud. 1 Daniell Ch. Pr. 696, 1st ed.; Ogilvie v. Herne, 13 Ves. 563.” 31 O. G. 913 (915).

³ In Thomson v. Wooster (1885), 114 U. S. 104, Bradley, J. : (109) “ The bill, as we have seen, was taken *pro confesso*, and a decree *pro confesso* was regularly entered up, declaring that the letters-patent were valid, that Douglass was the original inventor of the invention therein described and claimed, that the defendants were infringing the patent, and that they must account to the complainant for the profits made by them by such infringement, and for the damages he had sustained thereby; and it was referred to a master to take and state an account of such profits and to ascertain said damages. The defendants are concluded by that decree, so far at least as it is supported by the allegations of the bill, taking the same to be true. Being carefully based on

these allegations, and not extending beyond them, it cannot now be questioned by the defendants, unless it is shown to be erroneous by other statements contained in the bill itself. A confession of facts properly pleaded dispenses with proofs of those facts, and is as effective for the purposes of the suit as if the facts were proved; and a decree *pro confesso* regards the statements of the bill as confessed.” 31 O. G. 913 (914).

That a decree *pro confesso* admits that the patent is valid for that suit, and the character of the inventive act cannot be attacked if the bill alleges infringement, see Dobson v. Hartford Carpet Co. (1884), 114 U. S. 439; 31 O. G. 787.

That after a decree *pro confesso* as to the validity of the patent, the defendant cannot deny its validity, or if it be a re-issue dispute the diligence of the plaintiff in obtaining it, see Thomson v. Wooster (1885), 114 U. S. 104; 31 O. G. 913.

That while a decree *pro confesso* stands unrevoked the defendant cannot set up anything in opposition to it either below or on appeal, except what appears on the face of the bill, see Thomson v. Wooster (1885), 114 U. S. 104; 31 O. G. 913.

⁴ That an interlocutory decree *pro confesso* is not definitive nor appealable,

the existence of a good defence where the defendant has already had an ample opportunity to appear and answer, nor where the cost of further litigation would exceed the amount demanded by the plaintiff.⁵ A decree *pro confesso* cannot be collaterally impeached, nor after it becomes absolute can it be reversed except by a bill of review or a petition to rescind it on the ground of fraud.⁶ The relief afforded by the decree does not necessarily conform to that actually required or prayed for by the plaintiff, but must be awarded in a degree and kind appropriate to the circumstances stated in the allegations of the bill.⁷ Whether, while a decree *pro confesso* remains in force, the defendant can appear before the master and be heard on the account for profits and the computation of damages, has been doubted; at all events, the inquiries of the master must be confined to the advantages derived by the defendant, and the loss suffered by the plaintiff, from the wrongful use of the invention.⁸

but lies in the control of the court, see *Roemer v. Neumann* (1886), 26 Fed. Rep. 332.

That after a decree *pro confesso* a motion to allow an answer to be filed is addressed to the discretion of the court, and there is no appeal from its refusal, see *Dean v. Mason* (1857), 20 How. 198.

⁵ That the existence of a meritorious defence gives no right to have a decree *pro confesso* set aside unless equity requires it, see *Andrews v. Denslow* (1877), 14 Blatch. 182; 2 Bann. & A. 587.

That after a decree *pro confesso* and the filing of the accounts, if the defendant moves for leave to file an answer and to open the account, and the plaintiff offers to take a judgment for less than the expense to the defendant of a trial, and it appears that the defendant has ceased to use the invention, the motion will be denied and the judgment entered for that amount, see *Andrews v. Denslow* (1877), 14 Blatch. 182; 2 Bann. & A. 587.

⁶ That an absolute decree *pro con-*

fesso cannot be collaterally impeached, nor directly attacked except by bill of review or for fraud, see *Thomson v. Wooster* (1885), 114 U. S. 104; 31 O. G. 913.

⁷ In *Thomson v. Wooster* (1885), 114 U. S. 104, Bradley, J.: (118) "It is thus seen that by our practice a decree *pro confesso* is not a decree as of course according to the prayer of the bill, nor merely such as the complainant chooses to take it; but that it is made (or should be made) by the court, according to what is proper to be decreed upon the statement of the bill, assumed to be true." 31 O. G. 913 (915).

⁸ That whether after a decree *pro confesso* the defendant is entitled to an order, permitting him to appear before the master and be heard, is doubtful, see *Thomson v. Wooster* (1885), 114 U. S. 104; 31 O. G. 913.

That after a decree *pro confesso* the master cannot inquire into the cost of producing results by other inventions, the sole question being as to the profits

§ 1131. Interlocutory Decrees.

An interlocutory decree is a decree in favor of the plaintiff upon the issues created by the bill and answer, and referring the cause to a master in chancery for an account of profits and an award of damages. To such a decree the plaintiff is entitled if in the judgment of the court the evidence sustains the patentability of the invention, the validity of the patent, the title of the plaintiff, the alleged infringement by the defendant, and the necessity for equitable relief.¹ Where the bill counts on several patents or on several Claims of the same patent, and either patent or any Claim is found to be valid and to have been violated, a decree must be granted and an account ordered upon such Claim or patent, although the others are invalid or have not been infringed.² The presence

made by using the plaintiff's invention, see *Thomson v. Wooster* (1885), 114 U. S. 104; 31 O. G. 913.

§ 1131. ¹ That where the validity of the patent and the fact of infringement are admitted or proved, the plaintiff is entitled to a decree and account as a matter of course, see *North American Iron Works v. Fiske* (1887), 30 Fed. Rep. 622; 39 O. G. 1086; *Western Electric Mfg. Co. v. Chicago Electric Mfg. Co.* (1882), 14 Fed. Rep. 691; 11 Bissell, 427; *Franz & Pope Knitting Mach. Co. v. Lamb Knitting Mach. Mfg. Co.* (1881), 19 O. G. 1000; *Cook v. Ernest* (1872), 2 O. G. 89; 5 Fisher, 396; *Carew v. Boston Elastic Fabric Co.* (1871), 1 O. G. 91; 5 Fisher, 90; 3 Clifford, 356; *Allen v. Blunt* (1849), 1 Blatch. 480.

That any infringement, however slight, entitles the plaintiff to a decree, see *Cary v. Wolff* (1885), 23 Blatch. 92; 32 O. G. 257; 24 Fed. Rep. 139.

That where the defendant in his answer declines to contest the suit and offers to pay a royalty, the plaintiff is entitled to a decree sustaining the patent and finding infringement, see *Globe Nail Co. v. Superior Nail Co.* (1886), 27 Fed. Rep. 454.

² That a decree will be passed where one Claim only of the patent is infringed, see *Tibbals v. Daby* (1880), 11 Fed. Rep. 903.

That the first Claim of the patent being abandoned, and the allegations of the second Claim not being denied, the plaintiff has a decree on the latter Claim, see *New York Coffee Polishing Co. v. Wilson* (1880), 2 Fed. Rep. 904.

That on a bill based on several patents, and alleging that the infringing structures were each covered in part by each patent, and on a plea denying this allegation and issue joined and proof taken, if it appears that two of the patents were not infringed, the plaintiff is entitled to a decree on those that were infringed, see *Matthews v. Lalance & Grosjean Mfg. Co.* (1880), 17 O. G. 1284; 2 Fed. Rep. 232; 18 Blatch. 84; 5 Bann. & A. 319.

That where a bill for the infringement of three patents states that "these several patents are applicable to the same process and are so used by the defendants," and damages cannot be awarded on two patents without the third, and the third is so near its expiration that an injunction could not be granted on it, the bill will not be

of excessive Claims does not impair the right to a decree upon a proper Claim of the same patent, on filing a disclaimer of the excess, unless such a disclaimer has already been unreasonably delayed.³ An interlocutory decree can cover only the patent and the patented articles in suit, though if the defendant justifies his use of the invention under a license, and succeeds in his defence, the court may order an account of overdue license fees instead of profits.⁴ A decree for profits may be entered where the bill merely prays for general relief, and should direct the defendant to account for all the profits made in violation of the plaintiff's rights by the employment of the patented inventions described in the bill.⁵ Where several defendants are charged

dismissed, the case differing from *Betts v. Gallais*, L. R. 10 Eq. 393, see *New York Grape Sugar Co. v. Peoria Grape Sugar Co.* (1884), 21 Fed. Rep. 878; 32 O. G. 138.

³ That where no unreasonable delay has occurred excessive Claims may be disclaimed and a decree entered on the valid Claims, see *Hake v. Brown* (1889), 37 Fed. Rep. 783; *Tyler v. Galloway* (1882), 12 Fed. Rep. 567; 20 Blatch. 445; 22 O. G. 2072; *Christman v. Rumsey* (1879), 17 Blatch. 148; 17 O. G. 903; 4 Bann. & A. 506; 58 How. Pr. 114; *Myers v. Frame* (1871), 4 Fisher, 493; 8 Blatch. 446; *Aiken v. Dolan* (1867), 3 Fisher, 197.

That unreasonable delay in disclaiming, or omission to disclaim, is a question of fact, and must be raised by the answer if it is to be made at all, see *Burden v. Corning* (1864), 2 Fisher, 477.

That where a patentee has assigned an undivided interest in the invention, and a joint suit in equity is afterward brought, a disclaimer by the patentee alone does not enure to the advantage of the parties to the bill, see *Wyeth v. Stone* (1840), 1 Story, 273; 2 Robb, 23.

That a recovery may be had on valid

Claims if there were no unreasonable delay, though the invalid Claims are not yet disclaimed, but no costs can be recovered, and the invalid Claims must be disclaimed before the decree will be granted, see *Burdett v. Estey* (1878), 15 O. G. 877; 15 Blatch. 349; 4 Bann. & A. 7.

That where a patent has several Claims, some of which are void, an action may be maintained on the valid Claims without previous disclaimer of the others, see *Cahart v. Austin* (1865), 2 Fisher, 543; 2 Clifford, 528.

⁴ That a decree does not cover any other patented articles or patent except those in suit, see *Buerk v. Imhaeuser* (1876), 11 O. G. 112; 2 Bann. & A. 465.

⁵ That under a prayer for general relief the court can decree an account of profits, see *Stevens v. Gladding* (1854), 17 How. 447.

That profits and damages may be decreed, though the right to an injunction may be lost, see *Kirk v. Du Bois* (1886), 28 Fed. Rep. 460; 37 O. G. 102.

That a decree for profits may be "for all the profits made in violation of the rights of the complainants under the patents aforesaid, by the respondents,

with joint and separate infringements, but no joint use is found, and the bill is not objected to for informality, a decree against each separately is proper, though where defendants, sued as partners, are proved to have been a corporation, the bill should be amended in order to warrant a decree against the corporation.⁶ A decree passed after the decision of the court upon the merits relates back to the date of such decision.⁷ An interlocutory decree for an account is always open to amendment upon motion, after due notice to the adverse party,⁸ and may be stayed by the court for any inequitable conduct of the plaintiff which prevents the defendant from embracing proper claims in his account.⁹

§ 1132. Final Decrees.

A final decree is a decree which terminates the litigation, either by awarding to the plaintiff the profits, damages, and other permanent relief to which he is entitled, or by deciding the cause upon its merits in favor of the defendant. A final decree for the plaintiff cannot be granted, where an account is necessary, until the account has been taken by the master and reported to and accepted by the court.¹ A final

from the manufacture, use, or sale of any of the articles named in the bill of complaint," see *Rubber Co. v. Goodyear* (1869), 9 Wall. 788.

⁶ That where defendants are sued as partners and proved to be a corporation, whether a decree can be entered against the corporation without amending the bill is doubtful, see *Needham v. Washburn* (1874), 7 O. G. 649; 4 Clifford, 254; 1 Bann. & A. 537.

⁷ That a decree entered after the decision on which it is based relates back to the date of such decision, see *Barker v. Stowe* (1882), 22 O. G. 259; 11 Fed. Rep. 303; 20 Blatch. 185.

⁸ That an interlocutory decree is always open to amendment and correction, see *Bell v. U. S. Stamping Co.* (1887), 32 Fed. Rep. 549; *De Florez v. Reynolds* (1880), 17 O. G. 503; 8 Fed. Rep. 434; 17 Blatch. 436; 5 Bann. & A.

140; *Magic Ruffle Co. v. Elm City Co.* (1877), 11 O. G. 501; 14 Blatch. 109; 2 Bann. & A. 506.

That a decree ordering an account on two patents one of which had expired before suit must be amended to exclude the latter, the court never having had jurisdiction, see *Creamer v. Bowers* (1887), 30 Fed. Rep. 185.

⁹ That where a plaintiff has obtained a decree for an account, and has begun suits against the same defendants in other circuits, the court will on motion stay the account unless the other suits are abandoned, but it cannot enjoin the plaintiff from prosecuting such other suits, especially after they have been allowed to proceed as far as the final hearing, see *Rumford Chemical Works v. Hecker* (1874), 5 O. G. 644; 11 Blatch. 552; 1 Bann. & A. 120.

§ 1132. ¹ That a decree with a ref-

decree for the defendant can be ordered at the conclusion of the hearing on the bill and answer, without further proceedings, and results in a dismissal of the bill. The defendant has a right to this decree wherever he sustains any one of his defences, whether against the patentability of the invention, the validity of the patent, the title of the plaintiff, the alleged infringement, or the equitable right of the plaintiff to maintain the action, except perhaps that of a license, where in some cases the court may still retain the cause and settle the account for unpaid royalties.² The court in rendering a decree for the defendant will not pass on such Claims of the plaintiff as in its judgment the evidence sustains, in order to establish precedents for future guidance, but will dismiss the bill and leave the plaintiff to his remaining remedies.³ Where, on its face, the patent is evidently void, a decree is

erence to a master is not a final decree, see *Reeves v. Keystone Bridge Co.* (1876), 9 O. G. 885; 2 Bann. & A. 256.

That the overruling of a demurrer is not a final decree on the validity of the patent, see *Wollensak v. Sargent* (1888), 33 Fed. Rep. 840.

That a decree absolute in its terms in favor of the defendant determines the controversy and is a bar to a further suit; nor can its force be qualified by any statement of the clerk of the court in favor of either party, see *Lyon v. Perin & Gaff Mfg. Co.* (1888), 125 U. S. 698; 43 O. G. 983.

That an interlocutory decree may be made final if the complainant signs a release of the profits, damages, and costs, see *Roemer v. Neumann* (1886), 26 Fed. Rep. 332.

² That the defendant is entitled to judgment if he proves any one of his special defences, see *Bates v. Coe* (1878), 98 U. S. 31; 15 O. G. 337.

That the bill will be dismissed if the evidence shows that the claimed invention was anticipated, see *Raymond v.*

Singer Mfg. Co. (1882), 11 Fed. Rep. 427.

That a bill based on void or expanded Claims in a re-issue will be dismissed, see *Cowell v. Sessions* (1883), 17 Fed. Rep. 450; 21 Blatch. 421.

That where on a suit based on five patents the court finds for the defendants on four, and is divided on the fifth, the bill will be dismissed without costs, see *American Wood Paper Co. v. Hest* (1867), 3 Fisher, 316.

That a bill counting on two patents cannot be discontinued as to one after evidence taken, but should be wholly dismissed and a new bill filed to which the evidence already taken may apply, see *Brush v. Condit* (1884), 28 O. G. 451; 20 Fed. Rep. 826; 22 Blatch. 246.

That a bill will not be dismissed without prejudice as to one defendant after proof taken in full, see *Archer v. Annd* (1887), 40 O. G. 1029. / 55;

³ That if no infringement is found the court will not pass on the questions of novelty and validity, see *Saxe v. Hammond* (1875), Holmes, 456; 7 O. G. 781; 1 Bann. & A. 629.

granted to the defendant without reference to the defences set up in his answer.⁴

§ 1133. Rehearings.

A rehearing may be ordered at any time between the interlocutory and the final decree for the purpose of admitting new evidence or additional defences, or on any other sufficient grounds.¹ A rehearing after final decree must be granted at the same term at which such decree is rendered, if the case can be appealed to the Supreme Court, otherwise it may be permitted during the next succeeding term.² When the period for a rehearing has expired, a final decree can be annulled or set aside only by an appeal or bill of review.³ The allowance of a rehearing is not a matter of right, but rests entirely in the discretion of the court.⁴ Any person interested in the action and conducting it at his expense, though not a party to the record, may move for a rehearing, and if he does not, will be bound by the decree.⁵

¹ That if the patent is void on its face, as where the want of novelty is apparent, the bill will be dismissed without regard to the answer, see *Slawson v. Grand St., Prospect Park, & Flatbush R. R. Co.* (1882), 107 U. S. 649; 24 O. G. 99; *Quirole v. Ardito* (1880), 1 Fed. Rep. 610; 17 Blatch. 400; 5 Bann. & A. 80.

§ 1133. ¹ That a case may be reopened after an interlocutory decree for further hearing, or to amend the answer, or to introduce a new subject-matter of defence, upon a proper petition and affidavit, see *Allis v. Stowell* (1880), 18 O. G. 465; 5 Bann. & A. 458.

That a rehearing may be had at any time before final decree, see *Reeves v. Keystone Bridge Co.* (1876), 9 O. G. 885; 2 Bann. & A. 256.

² That under Equity Rule 88, an application for a rehearing must be made at the same term as the final decree is entered and recorded, such cases being appealable to the Supreme Court, see

Barker v. Stowe (1879), 16 O. G. 807; 4 Bann. & A. 485.

³ That a motion for a rehearing will not be granted unless presented within the time fixed by law, see *Brown v. Deere* (1881), 19 O. G. 1217; 6 Fed. Rep. 487; 2 McCrary, 425.

That due diligence is required for a motion to re-open a decree, and four years' delay is too long, see *Bate Refrigerating Co. v. Gillett* (1887), 40 O. G. 1029; 31 Fed. Rep. 809.

⁴ That a rehearing after a decree for an injunction and account is in the discretion of the court, see *American Diamond Rock Boring Co. v. Sheldon* (1880), 1 Fed. Rep. 870; 18 Blatch. 50; 5 Bann. & A. 292.

That no rehearing will be allowed unless the matters presented would change the decree, see *Brown v. Deere* (1881), 19 O. G. 1217; 6 Fed. Rep. 487; 2 McCrary, 425.

⁵ That a party who furnishes the money to carry on a suit may apply

§ 1134. Rehearing on the Ground of Newly Discovered Evidence.

The principal ground for a rehearing is the discovery of new evidence since the termination of the trial. No rehearing upon this ground will be granted where the alleged new evidence is immaterial or cumulative, or would not lead to a change in the decree, or was known to the party or his counsel at the former hearing, or could then have been discovered and presented by the exercise of proper diligence.¹ That the

for a rehearing, and if he does not he will be bound by the decree, see *Miller v. Liggett & Myers Tobacco Co.* (1881), 7 Fed. Rep. 91; 19 O. G. 1138; 2 McCrary, 375.

That a case will not be re-opened after the hearing, against the objection of the plaintiff, in the interest of other persons not parties, though new evidence may exist which renders the decision worthless to the plaintiff as a guide in future cases, see *Schneider v. Thill* (1880), 3 Fed. Rep. 95; 18 Blatch. 241; 5 Bann. & A. 509.

§ 1134. ¹ That no rehearing will be granted to admit immaterial evidence, see *Hoe v. Kahler* (1885), 25 Fed. Rep. 271; 23 Blatch. 354; 34 O. G. 127; *Spill v. Celluloid Mfg. Co.* (1884), 29 O. G. 773; 22 Blatch. 441; 22 Fed. Rep. 94; *Munson v. Mayor of New York* (1882), 22 O. G. 586; 20 Blatch. 358; 11 Fed. Rep. 72; *Collins Co. v. Coes* (1881), 8 Fed. Rep. 517; 20 O. G. 1084; *Reeves v. Keystone Bridge Co.* (1876), 9 O. G. 885; 2 Bann. & A. 256.

That no rehearing will be ordered to admit cumulative evidence, see *Pfanschmidt v. P. H. Kelly Mercantile Co.* (1887), 41 O. G. 1501; 32 Fed. Rep. 667; *Blandy v. Griffith* (1873), 6 Fisher, 434.

That no rehearing will be granted unless the new evidence would change the result, see *Starling v. St. Paul Plow Works* (1887), 41 O. G. 818; 32 Fed. Rep. 290; *United States v. Gunning* (1885), 23 Fed. Rep. 668; 32 O. G.

1468; *Munson v. City of New York*, (1882), 22 O. G. 586; 20 Blatch. 358; 11 Fed. Rep. 72; *Coburn v. Schroeder* (1882), 22 O. G. 419; 20 Blatch. 392; 11 Fed. Rep. 425; *Collins Co. v. Coes* (1881), 8 Fed. Rep. 517; 20 O. G. 1084; *McCloskey v. Du Bois* (1881), 20 O. G. 1086; 9 Fed. Rep. 38; 20 Blatch. 7; *De Florez v. Reynolds* (1879), 16 Blatch. 397; 4 Bann. & A. 331; *Buerk v. Imhaeuser* (1876), 10 O. G. 907.

That no rehearing will be granted on the ground of newly discovered evidence of prior use, when the evidence is less persuasive than on the former trial, see *American Bell Telephone Co. v. People's Telephone Co.* (1885), 25 Fed. Rep. 725; 34 O. G. 561.

That a question of fact will not be reheard because the drawings first offered in evidence were defective, unless the new evidence is so clear and positive that an entirely different case is presented, see *Hayes v. Dayton* (1884), 20 Fed. Rep. 690.

That no rehearing will be granted where the evidence could have been before produced by proper diligence, see *Hoe v. Kahler* (1885), 25 Fed. Rep. 271; 34 O. G. 127; 23 Blatch. 354; *Willimantic Linen Co. v. Clark Thread Co.* (1885), 24 Fed. Rep. 799; 32 O. G. 1356; *Spill v. Celluloid Mfg. Co.* (1884), 29 O. G. 773; 22 Blatch. 441; 22 Fed. Rep. 94; *Hitchcock v. Tremaine* (1872), 5 Fisher 537; 1 O. G. 633; 9 Blatch. 550.

That a rehearing on the ground of

party was taken by surprise by the testimony offered by his adversary, but did not ask for a continuance in order to investigate and answer it, and has since discovered that it could have been successfully contradicted, or that expert evidence could have been but was not produced, or that new instances of prior use have been brought to his knowledge and can now be proved, does not warrant the opening of the decree and the rehearing of the testimony.² But where new facts have occurred since the former trial, which would have influenced the court in rendering its decree, or where material facts then existing, of which the party had no information or means of obtaining it until the former trial closed, have been since discovered, a rehearing will not be refused. Thus where a judgment has been rendered in another court between the same parties and on the same issues, since the trial of the present suit;³ or where the jurisdiction of the court is ques-

newly discovered evidence will not be allowed where the evidence is conflicting and of late discovery, and the excuses for delay are vague and unsatisfactory, see *Albany Steam Trap Co. v. Felthousen* (1886), 26 Fed. Rep. 318.

That a rehearing will be denied where the evidence could as well have been obtained before the former trial, especially in the defence of prior use, where the defendant can always make it appear that he has discovered new evidence, see *Hicks v. Ferdinand* (1884), 20 Fed. Rep. 111.

That no rehearing will be granted for new evidence if it were known to the party or his counsel at the time of the former trial, see *Colgate v. Western Union Telegraph Co.* (1884), 19 Fed. Rep. 828; 22 Blatch. 118.

That on a motion for a rehearing or a new trial the knowledge and diligence of counsel are regarded as those of the party, see *Ready Roofing Co. v. Taylor*, (1878), 15 Blatch. 94; 3 Bann. & A. 368.

That no new trial will be allowed on

the ground of new evidence where the evidence was not before offered because of the inexperience or ignorance of counsel, see *De Florez v. Reynolds* (1879), 16 Blatch. 397; 4 Bann. & A. 331.

² That if the plaintiff is surprised by the evidence of the witnesses, he may ask time to investigate on the ground that no notice had been given in the answer, but must not take the risk of a decision, see *Barker v. Stowe* (1879), 16 O. G. 807; 4 Bann. & A. 485.

That no rehearing will be granted on the ground that the defendant did not have proper expert evidence, unless the excuse is shown and the application is made before final hearing, see *Hitchcock v. Tremaine* (1872), 5 Fisher, 537; 1 O. G. 633; 9 Blatch. 550.

³ That where a decree in a former suit between the same parties on the same issues was filed after the present suit was begun, the pending case may be opened to let a copy of the decree be filed, see *Barker v. Stowe* (1882), 22 O. G. 259; 11 Fed. Rep. 303; 20 Blatch. 185.

tioned and the new evidence will tend to settle that dispute ;⁴ or where a prior patent offered to anticipate the invention of the plaintiff is now discovered to have actually been issued after his invention was conceived,⁵ — the case will be re-opened to allow the testimony to be offered and considered by the court. After a final decree no rehearing is allowed on the ground of new evidence if the evidence were known or could have been known before the decree was entered, or if it would not have been available to the party on the final hearing.⁶ The motion for rehearing must be signed by counsel, sworn to by the party, clearly allege the new evidence and its discovery, and state in detail the efforts which were made at the former hearing to ascertain and produce it.⁷ Due notice must be

⁴ That a decree may be opened and a rehearing granted after an interlocutory decree and a reference to the master, if the jurisdiction in equity is in question and new evidence has been discovered, see *Spring v. Domestic Sewing Mach. Co.* (1882), 22 O. G. 1445 ; 13 Fed. Rep. 446.

⁵ That the case will be opened for further evidence and rehearing when a foreign patent, supposed to be prior to the one in question, had been relied on and was afterward found to be subsequent, see *Baldwin v. Schultz* (1871), 5 Fisher, 75 ; 2 O. G. 319 ; 9 Blatch. 494.

That no rehearing will be allowed on the ground that a patent earlier than the plaintiff's, which was offered in evidence on the hearing, has been discovered by the defendant to have been twice re-issued, the last time being since the hearing, as this fact is immaterial, see *Hitchcock v. Tremaine* (1872), 5 Fisher, 537 ; 1 O. G. 633 ; 9 Blatch. 550.

That a rehearing may be granted at the discretion of the court on a claim of newly discovered evidence, in order that the cases may be completed and all points relating to the patent decided, though the petitioners may not be entitled to a rehearing as matter of right,

see *Railway Register Mfg. Co. v. Broadway & Seventh Avenue R. R. Co.* (1885), 32 O. G. 257.

⁶ That a petition to re-open the case and for leave to file a supplemental answer, setting up newly discovered evidence after final hearing and decree, will be granted only when such evidence would have availed the defendant if offered on the final hearing, see *Collins Co. v. Coes* (1881), 8 Fed. Rep. 517 ; 20 O. G. 1084.

That a rehearing will not be granted on the ground that the court misquoted the testimony, the misquotation not affecting the decision, see *Torrent v. Duluth Lumber Co.* (1887), 32 Fed. Rep. 229.

⁷ That a petition to re-open must be signed by counsel, sworn to before a disinterested magistrate, and must be clear in its allegations, fully disclose the new evidence and its discovery, and set forth the diligence used before the former hearing, see *Allis v. Stowell* (1880), 18 O. G. 465 ; 5 Bann. & A. 458.

That the petition must aver that due diligence was used, see *Spill v. Celluloid Mfg. Co.* (1884), 29 O. G. 773 ; 22 Blatch. 441 ; 22 Fed. Rep. 94.

That the petition must show why the evidence was not produced before,

given to the opposite party, and an opportunity to answer it afforded.⁸ If the court is satisfied that proper diligence has been exercised, and that the motion should be granted, a supplemental bill is filed containing the new evidence, on which the additional testimony with its counter-proof is taken, and the case is then presented to the court to be decided on the whole evidence together.⁹

§ 1135. Rehearing on the Ground of Newly Discovered Defences.

Another ground for a rehearing, often recognized by the court in actions for infringement, is the existence of a defence not set up in the answer, and consequently not hitherto presented to the court.¹ A rehearing will be granted upon this

see *Burdsall v. Curran* (1887), 31 Fed. Rep. 918 ; 42 O. G. 1167.

That a rehearing will not be granted on the affidavit of counsel that to the best of his information and belief the new evidence could not have been obtained, some positive proof as to this point being required, see *Page v. Holmes Burglar Alarm Telegraph Co.* (1880), 2 Fed. Rep. 330 ; 18 Blatch. 118 ; 5 Bann. & A. 439.

That an affidavit in support of a motion for a rehearing is not sufficient if it merely states that the party "made every effort" to obtain the testimony, "but was not aware that he could do so," for it must state what efforts he made, see *Barker v. Stowe* (1879), 16 O. G. 807 ; 4 Bann. & A. 485.

That a petition to re-open a case on the affidavit of one of two joint patentees that he was the sole inventor, and those of third persons that they had heard him so declare, will not be granted, see *Collins Co. v. Coes* (1881), 8 Fed. Rep. 517 ; 20 O. G. 1084.

⁸ That a petition for a rehearing after a decree is not *ex parte*, but requires a notice to the opposite party and a chance to answer, see *Giant Powder Co. v. California Vigorit Powder Co.* (1880), 6 Sawyer, 508.

⁹ That the practice in a rehearing is to petition for leave to file a supplemental bill setting out the newly discovered evidence, and for rehearing when the supplemental bill is in readiness to be heard, see *Reeves v. Keystone Bridge Co.* (1876), 9 O. G. 885 ; 2 Bann. & A. 256.

That in a motion for leave to file a new bill, after the case is once adjudged, on the ground that new facts have been discovered, the court will examine and consider the counter affidavits, and if the evidence is cumulative, or the application unreasonably delayed, the motion will be denied, see *Blandy v. Griffith* (1873), 6 Fisher, 434.

That the petitioner must satisfy the court that due diligence was used and that the new evidence is material, see *Reeves v. Keystone Bridge Co.* (1876), 9 O. G. 885 ; 2 Bann. & A. 256.

That where a rehearing is granted, and new evidence admitted, opening the whole record, the old and new evidence will be considered together, see *Reed v. Lawrence* (1887), 32 Fed. Rep. 228 ; *Henry v. Francetown Soapstone Co.* (1880), 17 O. G. 569 ; 2 Fed. Rep. 78 ; 5 Bann. & A. 108.

§ 1135. ¹ That an interlocutory decree may be opened on motion, without

ground only when the defence has come to the knowledge of the defendant since the former hearing, or having been known was then withheld for reasons which the court approves. When the defence is newly discovered, the court in determining the question of a rehearing is guided by the principles applied to cases of newly discovered evidence. If the defence were known and purposely withheld, the equity of the decree in view of the alleged defence and the defendant's reasons for neglecting to present it will control the court.² Thus a defence which if maintained could not change the ultimate result, or a defence withheld in pursuance of parol stipulations which are now disputed, or a defence which would have been urged had not the defendant negligently mistaken the real issue, or a defence incapable of positive and prevailing proof, affords no ground for opening the decree.³ The affidavits, which support the petition for a rehearing upon this ground, must state each of the new defences and account for the defendant's previous failure to present it.⁴ A rehearing will

a bill of review, to let in a new defence, but the motion must be supported by the same proof as the same attempt after final decree, see *Willimantic Linen Co. v. Clark Thread Co.* (1885), 24 Fed. Rep. 799 ; 32 O. G. 1356.

² That a rehearing will be ordered when the vital points in the case are not fully opened up in the former evidence, see *Rumford Chemical Works v. Lauer* (1872), 5 Fisher, 615 ; 3 O. G. 349 ; 10 Blatch. 122.

³ That a motion to re-open and let in a new defence based on a patent for a different invention will be denied, since it could not change the result, see *Adair v. Thayer* (1881), 20 O. G. 523 ; 7 Fed. Rep. 920.

That a case will not be re-opened to allow a defendant to put in a new defence not set up in his answer, when his claim so to do is based on an agreement with opposite counsel not entered of record and now disputed, see *American Saddle Co. v. Hogg* (1872), 6 Fisher, 67 ; 2 O. G. 595 ; *Holmes*, 177.

That ignorance or incapacity of counsel is no ground for new trial, see *De Florez v. Reynolds* (1879), 16 Blatch. 397 ; 4 Bann. & A. 331.

That a case will not be re-opened to admit the defence that a joint patent is invalid because the invention is sole, upon the claim of the sole inventor that he alone invented it, and where there is no admission to that effect by the other inventor and no proof except the statements of the alleged sole inventor to others, although another case is pending in which this defence may be set up and the patent adjudged void, see *Collins v. Coes* (1881), 20 O. G. 1084 ; 8 Fed. Rep. 517.

⁴ That on a motion for a rehearing the affidavits must set forth the particular defences to be urged and the reasons why they were not before presented, see *Day v. Schwab* (1880), 2 Fed. Rep. 544 ; 17 O. G. 1348 ; 5 Bann. & A. 389.

That after a final hearing and decree for the plaintiff the defendant cannot

not be granted in order that the case may be prepared anew, nor because the counsel were neglectful of their duties or were surprised by unexpected claims of their antagonists, nor for defects in the preliminary stages of the trial when no injustice has been done.⁵ Laches in applying for a rehearing will form a ground for its denial, even in cases where it might otherwise be granted.⁶ When further argument on the same facts might lead the court to different conclusions, a new hearing for that purpose may be properly allowed;⁷ and

have the case re-opened, and amend his answer by setting up a new defence of prior use, unless he alleges particular facts which show that he could not have discovered this defence by due diligence before the prior hearing, see *Hicks v. Otto* (1884), 22 Blatch. 122.

⁵ That a case will not be re-opened to allow it to be prepared anew for trial, see *Coburn v. Schroeder* (1882), 11 Fed. Rep. 425; 22 O. G. 419; 20 Blatch. 392.

That the case was not attended to by counsel is no reason for a rehearing, see *Day v. Schwab* (1880), 2 Fed. Rep. 544; 17 O. G. 1348; 5 Bann. & A. 389.

That no rehearing will be allowed on the ground that the petitioner was surprised by the unexpected claims of opposing counsel, see *Everest v. Buffalo Lubricating Oil Co.* (1884), 22 Fed. Rep. 252; 22 Blatch. 524.

That a case will not be re-opened on account of mere technical and unimportant defects in its preliminary steps, when no injustice has been done, all such defects being waived, see *Allen v. Mayor of New York* (1880), 7 Fed. Rep. 483; 18 Blatch. 239; 5 Bann. & A. 461.

That a decree will not be opened for a rehearing where the change of issue by filing a disclaimer limited the issue, and a chance to try the question has been already had, see *Coburn v. Schroeder* (1882), 22 O. G. 419; 20 Blatch. 392; 11 Fed. Rep. 425.

That the issues are not changed on a rehearing by a disclaimer of part of a Claim set up at a former hearing, the disclaimer narrowing the issue, not broadening it, see *Coburn v. Schroeder* (1882), 11 Fed. Rep. 425; 22 O. G. 419; 20 Blatch. 392.

That a rehearing may be denied on the ground that the new matter alleged is not material, see *Hoe v. Kahler* (1885), 23 Blatch. 354; 25 Fed. Rep. 271; 34 O. G. 127.

⁶ That a rehearing may be denied on the ground of laches, see *Hoe v. Kahler* (1885), 23 Blatch. 354; 25 Fed. Rep. 271; 34 O. G. 127.

That a delay of a year and a half after the new evidence is discovered before filing a motion for leave to offer it is too long, see *Blandy v. Griffith* (1873), 6 Fisher, 434.

That where a defendant, eleven months after paying the execution in full, moves to open the decree, he is too late, see *Doubleday v. Sherman* (1869), 6 Blatch. 513.

That when a decree has been entered by consent and the damages are paid, and after many terms the defendant applies for leave to file a supplemental bill on the ground of mistake of fact in giving such consent, the motion will be denied as being in effect a bill of review and too late, under rule 88, see *In re Pentlarge & Beeston* (1879), 17 Blatch. 306; 4 Bann. & A. 607.

⁷ That a motion for rehearing may

an award of excessive damages from some error in their mode of computation may be similarly reviewed.⁸ Evidence already taken under a decree may be ordered to stand for future use in case, upon rehearing, the decree should be affirmed.⁹

§ 1136. Profits in Equity Distinct from Profits at Law, both in Theory and in Mode of Computation.

The award of profits to the plaintiff in an action in equity for infringement rests upon an entirely different theory from an award of damages at law, though both are intended as a compensation for his injury.¹ It is true that in computing

be made on the ground of necessity for further argument and consideration, though no new facts are presented and the issues are unchanged, see *Celluloid Mfg. Co. v. Chrolithion Collar & Cuff Co.* (1885), 25 Fed. Rep. 482.

That a decree will not be reversed on rehearing upon the same facts and arguments, see *Gage v. Kellogg* (1886), 26 Fed. Rep. 242 ; 36 O. G. 234.

That a rehearing may be granted in view of recent decisions of the Supreme Court, but the testimony taken will stand for future use if necessary, see *American Diamond Rock Boring Co. v. Sheldons* (1885), 32 O. G. 1240 ; 24 Fed. Rep. 374 ; 23 Blatch. 286 ; *Wooster v. Handy* (1884), 28 O. G. 629 ; 22 Blatch. 307 ; 21 Fed. Rep. 51 ; *American Diamond Drill Co. v. Sullivan* (1884), 28 O. G. 811 ; 22 Blatch. 298 ; 21 Fed. Rep. 74.

That a rehearing will not be granted on the ground that a false allegation in the bill misled the defendant, after laches in applying, see *Willimantic Linen Co. v. Clark Thread Co.* (1885), 32 O. G. 1356 ; 24 Fed. Rep. 799.

That a rehearing will not be granted on the ground that the defendants were misnamed in the bill, were ignorant of the patent, or were mere nominal parties, if they appeared and answered without objection, see *Bate Refrigerating Co. v.*

Gillett (1887), 40 O. G. 1029 ; 31 Fed. Rep. 809.

⁸ That when an error has been committed in assessing damages a new hearing will be ordered, unless the plaintiff will remit the amount to nominal damages, see *Cowing v. Rumsey* (1870), 4 Fisher, 275 ; 8 Blatch. 36.

⁹ That a rehearing on the merits being granted after decree for account and partial hearing thereon, an order may be made that the evidence already taken on the account shall stand for future use, if needed, see *Campbell v. New York* (1888), 35 Fed. Rep. 504 ; *American Diamond Rock Boring Co. v. Sheldon* (1885), 23 Blatch. 286 ; 24 Fed. Rep. 374 ; 32 O. G. 1240.

That where a rehearing was granted on condition that the proceedings in account should stand if the decree were sustained, and the bill was dismissed, the dismissal was without prejudice to the proceedings in account if the decree of dismissal were reversed on appeal, see *American Diamond Rock Boring Co. v. Sheldon* (1885), 25 Fed. Rep. 768 ; 33 O. G. 1598.

§ 1136. ¹ That "profits" and "damages" are not convertible terms, see *Goodyear Dental Vulcanite Co. v. Van Antwerp* (1876), 9 O. G. 497 ; 2 Bann. & A. 252.

That "profits" refer to what the

damages the jury may refer to the defendant's profits as affording some indication of the loss sustained by the plaintiff; but even these profits in themselves are wholly distinct from profits when accounted for in equity, the former embracing only that pecuniary gain of the defendant which but for his infringement would have accrued to the plaintiff, the latter including all the benefits which the defendant has derived from the invention, without reference to the amount which the plaintiff might otherwise have received.² Scarcely a rule or doctrine belonging to the one idea of profits is thus fully applicable to the other; and each should therefore be examined and expressed as if the other never had existed, the interchange of propositions, in such cases of fundamental difference in theory, leading to hopeless confusion and perplexity.

§ 1137. Power of Equity to Compel an Infringer to Account for his Unlawful Gains.

The power of a court of equity to order the defendant to account for his unlawful gains by an infringement, in cases where on other grounds it had obtained jurisdiction over him, has never been questioned.¹ This power was exercised in the earli-

defendant has gained by the unlawful use of the invention, and "damages" refer to what the plaintiff has lost, see *Goodyear Dental Vulcanite Co. v. Van Antwerp* (1876), 9 O. G. 497; 2 Bann. & A. 252.

That a patentee cannot expect or receive a complete remedy, see *Spaulding v. Page* (1871), 4 Fisher, 641; 1 Sawyer, 702.

² For a discussion of the defendant's profits as a measure of the plaintiff's damages at law, see §§ 1062, 1063, and notes, *ante*.

That in equity both profits and damages are recoverable, see *Williams v. Rome, Watertown, & Ogdensburgh R. R. Co.* (1880), 17 O. G. 1447; 18 Blatch. 181; 2 Fed. Rep. 702; *Goodyear Dental Vulcanite Co. v. Van Antwerp* (1876), 9 O. G. 497; 2 Bann. & A. 252.

§ 1137. ¹ In *Steam Stone Cutter Co. v. Windsor Mfg. Co.* (1879), 17 Blatch. 24, Wheeler, J. : (26) "There was nothing in the statutes relating to the patents, before the act of 1870, providing expressly for the recovery of the gains and profits of an infringement of a patent by suit in equity. The right must have been derived from the application of the general principles of justice as administered in courts of equity to the relations between the owners of patents and infringers, created by the Patent Laws. The patentee owns the monopoly of the patented invention. When an infringer converts any part of the monopoly into money, or into anything else, the owner has the right to follow his property in its new form. The person in whose hands it is, becomes his trustee, — not because he was

est actions for infringement which were brought before the English chancery, and has been unhesitatingly applied in our own courts of equity. No statute authorized it until the act of 1870, adopting and sanctioning the uniform judicial practice, provided that not only profits but damages might be recovered by a successful plaintiff. The mode in which this power has been and is exerted resembles that employed when a trustee is forced to render an account of the trust estate confided to his care, and hence expressions have sometimes fallen from the lips of judges representing the defendant as a true trustee subject at all times to the supervision of the court.² But the defendant is not a trustee, nor, as we have already seen, does any fiduciary relation subsist between him and the plaintiff.³ He is a simple *tortfeasor*, who having become amenable to equity is there compelled to recompense the plaintiff for the injury in the manner best suited to the circumstances of the parties and the exigencies of the case. No analogy exists between it and any other form of remedy. The nature of the property appropriated by the defendant, its inseparable intermixture with the results of his own labor or expenditure, the impossibility of ascertaining in most cases with any reasonable certainty the precise pecuniary loss of the plaintiff, — all render necessary some peculiar and arbitrary method by which the amount of compensation may be finally determined; and this, which has been univer-

ever a trustee of the invention or monopoly, or had any right whatever to dispose of it for the owner, but because he had the money or other thing in his hands which the owner of the invention had the right to claim because the invention brought it. It is what is received for the invention that belongs to the owner of the patent, and when that is not mixed with what is received for anything else, there can be no difficulty about how much the owner of the patent is entitled to; when it is, the difficulty lies wholly in making separation." 4 Bann. & A. 445 (447).

² That the rule in equity is to treat the defendant as trustee for the profits

received, see *Birdsall v. Coolidge* (1876), 93 U. S. 64; 10 O. G. 748; *Packet Co. v. Sickles* (1873), 19 Wall. 611.

³ That there can be no trustee *de son tort* and no account unless the property is trust property, see *Sayles v. Richmond, Fredericksburg, & Potomac R. R. Co.* (1879), 3 Hughes, 172; 4 Bann. & A. 239; 16 O. G. 43.

That equity may treat the infringer as a trustee though he is not truly such, see *Tilghman v. Proctor* (1888), 125 U. S. 136; 43 O. G. 628.

For a discussion of the relation of the infringer to the patentee, as trustee or otherwise, see §§ 1086, 1091, and notes, *ante*.

sally employed in equity, is at least as certain and as just as that pursued at law. Resemblances, indeed, may be discovered between this mode of redress and others, both at law and equity, and in some cases these indicate a similarity in principle, as where one who has converted chattels and turned them into money is held accountable to the owner for the price received in the same manner as the defendant in infringement is compelled to pay the owner of the patent such a proportion of the results of his infringing sales as represents the value of the patented idea of means; but all these resemblances are misleading, and if on some occasions they give point to an argument or a decision, in others they obscure distinctions which reason and policy require to be preserved. The theory of profits in equity thus stands alone. It may be stated as follows: Equity, having acquired jurisdiction over the parties and the cause on other grounds, will give complete relief, including compensation for past infringements; in awarding this compensation it must pursue some method of computing and enforcing the payment of the amount which is in accordance with the established forms of equity procedure; and it has adopted the one now in use as that which is best fitted for the purpose, and which when properly employed preserves most perfectly the equitable rights of all the parties to the action. That this theory has in some instances been perverted, and this method abused, does not reflect upon the soundness of the one nor on the practical justice of the other. The mistakes which have been made, and the grounds of criticism which exist, relate to the details of practice and the significance given or denied to certain data of the account, rather than to the substantial principles on which the doctrine and the rule themselves are based.

§ 1138. Profits in Equity Defined: General Mode of Computation.

Profits in equity include all those pecuniary benefits which the defendant has derived from the infringement. These are regarded in equity as the property of the owner of the patent.¹

§ 1138. ¹ That the benefits derived by the defendant from the plaintiff's invention are a proper ground of recovery, see *Sargent v. Yale Lock Mfg. Co.* (1879), 17 O. G. 108; 17 Blatch. 249; 4 Bann. & A. 579. That where no benefits are received by the defendant there are no profits to

To ascertain their amount, and to compel its payment to the plaintiff, the defendant is ordered in the interlocutory decree to render an account, and in the final decree to pay the sum thus ascertained to the plaintiff; and these orders are enforced against the defendant's person or property by the usual measures known to courts of equity.² The account is taken before a master, who after due investigation reports to the court the value of the profits to which the plaintiff is entitled. In making his investigation, and forming his estimate of the net amount, the master is bound by certain rules from which he is not permitted to depart.³ These relate chiefly to the items with which the defendant must be charged, the items with which he must be credited, and the evidence by which the claims of the respective parties must be supported. With reference to these rules, all cases of infringement may be divided into two great classes: (1) Those in which the infringement consists in the unlawful use, or making and use, of the patented invention; (2) Those in which the infringement consists in the unlawful sale, or manufacture and sale, of the patented invention. These two classes are wholly distinct,—the items on each side of the account differing more

be accounted for, see *Calkins v. Bertrand* (1881), 8 Fed. Rep. 755; 10 *Bissell*, 445; *Burdett v. Estey* (1880), 3 Fed. Rep. 566; 19 *Blatch*. 1; 5 *Bann. & A.* 308; *Elizabeth v. Pavement Co.* (1877), 97 U. S. 126; *Vaughn v. Central Pacific R. R. Co.* (1877), 4 *Sawyer*, 280; 3 *Bann. & A.* 27.

That profits are not to be accounted for unless due to the invention covered by the patent, see *Brady v. Atlantic Works* (1878), 3 *Bann. & A.* 577; 15 *O. G.* 965.

That no profit can be decreed for the use of a void patent, see *Kennedy v. Hazelton* (1888), 128 U. S. 667.

That where the defendant has used the plaintiff's device it is presumed that there might have been some profits, and an account of them will be ordered, see *Andrews v. Creegan* (1881), 19 *O. G.* 1140; 19 *Blatch*. 113; 7 *Fed. Rep.* 477.

² That the plaintiff may recover the profits due to the use of his improvement on a bill praying for either general or special profits, see *Graham v. Mason* (1872), 5 *Fisher*, 290; 1 *O. G.* 609; *Holmes*, 88.

That an interlocutory decree directing an account of "gains, savings, and advantages," in addition to the profits, and awarding costs, is proper, see *Coburn v. Schroeder* (1881), 8 *Fed. Rep.* 521; 20 *O. G.* 1085; 19 *Blatch*. 493.

That a decree in an action for the infringement of a design-patent may order an account of the profits and damages resulting from making and selling the article containing the design, see *Dobson v. Dornan* (1886), 118 U. S. 10; 35 *O. G.* 750.

³ For the mode of taking the account, see §§ 1156, 1157, and notes, *post*.

or less as the infringement has assumed one or the other of these forms.¹ They will therefore be considered separately, the few general doctrines applicable to both being noticed in their appropriate place in each discussion; and as the rules which govern the account for an infringing sale are fewer and more simple, and naturally aid in the comprehension of those which govern the account for an infringing use, the former will be first reviewed, although the logical order of the subject is thereby reversed.

§ 1139. Computation of Profits where the Infringement Consists in the Sale, or Manufacture and Sale, of the Patented Invention.

The pecuniary benefits derived by the defendant from the unlawful sale, or manufacture and sale, of the patented invention are represented by the profits actually received by him upon the patented articles which he has sold.¹ Upon articles made and not sold, or upon articles sold and yet unpaid for, or upon articles sold and paid for at a price not exceeding the cost of production, no profit can, of course, have accrued to the defendant or have become in equity the property of the plaintiff.² Upon articles actually sold at a profit and paid for the profit is measured by the difference between the cost of making and selling and the price obtained.³ Hence in these cases the defendant must be charged with the amount received

¹ That the rule of profits is not uniform, see *Graham v. Mason* (1872), 1 O. G. 609; *Holmes*, 88; 5 *Fisher*, 290.

That if the invention is a product, the profits on the product will be allowed; see *Burdett v. Estey* (1880), 3 Fed. Rep. 566; 19 *Blatch.* 1; 5 *Bann. & A.* 308; *Elizabeth v. Pavement Co.* (1877), 97 U. S. 126.

§ 1139. ¹ That only profits actually received are to be accounted for, see *Tilghman v. Proctor* (1888), 125 U. S. 136; 43 O. G. 628; *Burdett v. Estey* (1883), 3 Fed. Rep. 566; 19 *Blatch.* 1; 5 *Bann. & A.* 308; *Calkins v. Bertrand* (1881), 8 Fed. Rep. 755; 10 *Bissell*, 445; *Elizabeth v. Pavement Co.* (1877), 97 U. S. 126; *Vaughn v. Central Pacific*

R. R. Co. (1877), 4 *Sawyer*, 280; 3 *Bann. & A.* 27; also § 1146, note 2, *post.*

² That profits on sales arise only when the goods are actually sold and paid for is evident, since while the goods remain unsold they are liable to become a source of loss to the owner, and when sold, though at an advantageous price, and not paid for, the profit is still contingent and may never be realized.

³ That profits are the difference between cost and yield, see *Burdett v. Estey* (1880), 3 Fed. Rep. 566; 19 *Blatch.* 1; 5 *Bann. & A.* 308; *Piper v. Brown* (1873), 6 *Fisher*, 240; 3 O. G. 97; *Holmes*, 196; *Rubber Co. v. Good-year* (1869), 9 *Wall.* 788.

for each article sold in violation of the patent. Against this must be credited the cost of manufacturing and marketing each article, the difference indicating the defendant's gain.⁴ Where these questions are uncomplicated with any others the only difficulty encountered pertains to the credits to be given to the defendant. Concerning these some difference of opinion has existed. That the cost of manufacture,⁵ including the price paid for materials and labor,⁶ the interest on the amount actually expended for machinery and power,⁷ the value of the use of tools,⁸ the loss occasioned by waste,⁹

⁴ That where the invention infringes as a whole all profits belong to the patentee, see *Ruggles v. Eddy* (1877), 12 O. G. 716; 2 Bann. & A. 627.

⁵ That profits can be ascertained only by deducting all elements of cost, see *Troy Iron & Nail Factory v. Corning* (1869), 3 Fisher, 497; 6 Blatch. 328.

That the cost of making the articles must be allowed, see *Zane v. Peck Bros.* (1882), 23 O. G. 191; 13 Fed. Rep. 475; *Rubber Co. v. Goodyear* (1869), 9 Wall. 788; *Wilbur v. Beecher* (1850), 2 Blatch. 132.

⁶ That the price paid for materials must be allowed, see *Gould's Mfg. Co. v. Cowing* (1882), 105 U. S. 253; 21 O. G. 1277; *Buerk v. Imhaeuser* (1876), 10 O. G. 907; 14 Blatch. 19; 2 Bann. & A. 452; *Rubber Co. v. Goodyear* (1869), 9 Wall. 788.

That wages paid for actual service are allowed, see *Steam Stone Cutter Co. v. Windsor Mfg. Co.* (1879), 17 Blatch. 24; 4 Bann. & A. 445; *American Nicholson Pavement Co. v. City of Elizabeth* (1874), 6 O. G. 764; 1 Bann. & A. 439.

That charges for extra work and materials may be allowed to the respondents on condition that they will assign the charges to the complainant, see *Brady v. Atlantic Works* (1878), 15 O. G. 965; 3 Bann. & A. 577.

⁷ In *Herring v. Gage* (1878), 15 Blatch. 124, Wallace, J. : (129) "Undoubtedly interest and cost of power

enter into the account of profits to be ascertained from a given manufacture. Profit is the gain made upon any investment when both receipts and payments are taken into the account. Where interest has been paid upon the capital invested, or where it is to be paid upon borrowed capital, it should be allowed in estimating profits; but I am not aware of any rule which requires that it should be deducted where it has not been actually paid or incurred. The allowance for cost of power is to be determined by the same rule. If expense has been actually incurred for power, it should be deducted. But if interest or expense for cost of power has not been incurred, there is no more reason why there should be a deduction therefor from the profits than that there should be for the personal service of the infringer in conducting the business." 2 Bann. & A. 396 (401).

See also as to allowance of interest when actually paid, *Rubber Co. v. Goodyear* (1869), 9 Wall. 788; *Wilbur v. Beecher* (1850), 2 Blatch. 132.

⁸ That the value of the use of tools must be allowed, see *Gould's Mfg. Co. v. Cowing* (1882), 105 U. S. 253; 21 O. G. 1277; *Troy Iron & Nail Factory v. Corning* (1869), 3 Fisher, 497; 6 Blatch. 328.

⁹ That loss by waste should be allowed, see *Gould's Mfg. Co. v. Cowing* (1882), 105 U. S. 253; 21 O. G. 1277.

the rental of buildings necessarily occupied in the manufacture,¹⁰ the reasonable salaries of superintendents or other higher employees,¹¹ the royalties paid upon machinery or processes used in producing the articles sold,¹² the decrease in cost of manufacture resulting from inventions made or owned by the defendant,¹³ and other ordinary running expenses, should be allowed is undisputed. It is equally certain that the time and services of the defendant, or, when the defendant is a corporation, of its stockholders unless as regular *bona fide* employees, the interest on capital invested in the general business, and the insurance on the property employed, cannot be credited.¹⁴ Whether the defendant may deduct the

¹⁰ That the value of real and personal estate employed in making the device, including repairs thereon, is part of its cost and is to be allowed, see *Steam Stone Cutter Co. v. Windsor Mfg. Co.* (1879), 4 Bann. & A. 445; 17 Blatch. 24; *Troy Iron & Nail Factory v. Corning* (1869), 3 Fisher, 497; 6 Blatch. 328.

¹¹ That reasonable salaries to superintendents and workmen are allowed, see *American Nicholson Pavement Co. v. City of Elizabeth* (1874), 6 O. G. 764; 1 Bann. & A. 439.

That extraordinary salaries are not allowed, see *Rubber Co. v. Goodyear* (1869), 9 Wall. 788.

¹² That a royalty paid by the defendant on another patented invention, if reasonable in amount, will be allowed, see *American Nicholson Pavement Co. v. City of Elizabeth* (1874), 6 O. G. 764; 1 Bann. & A. 439.

¹³ That where the defendant has cheapened the cost of producing the infringing device by an improvement of his own, he is entitled to a corresponding credit in ascertaining the profits, see *Mason v. Graham* (1874), 23 Wall. 261; 7 O. G. 833.

That where part of the selling price was due to an invention of the defendant, the profit thereon is not allowed to the plaintiff, nor its cost to the defend-

ant, see *Steam Stone Cutter Co. v. Windsor Mfg. Co.* (1879), 17 Blatch. 24; 4 Bann. & A. 445.

That if the defendants used other improvements of their own invention, and claim deductions on that account, they must prove them affirmatively, see *American Nicholson Pavement Co. v. City of Elizabeth* (1874), 6 O. G. 764; 1 Bann. & A. 439.

¹⁴ In *Williams v. Leonard* (1872), 5 Fisher, 381, Woodruff, J.: (383) "As to the 'salaries' of the defendants during the period in which they have been engaged in infringing, they have no title, as against the complainant. It would be very great injustice if the *quantum* of gains and profits recoverable by a complainant depended on the question how much of such gains and profits the defendants used for their own support, or the support of their families; or, as even more broadly claimed here by the defendants, how much they saw fit to appropriate to their own use. Infringers would rarely be required to pay over anything, if they could divide the gains and profits among themselves, under the name of salary, wages, or any other designation. Men work for gains and profits, but they are gains and profits still. support themselves and their families

amount of the usual manufacturer's profit has been doubted.¹⁶ The cost of marketing, comprising the price paid for freight, storage, commissions, the rental of warehouses and shops, the salaries of clerks, and the legitimate expense of collecting the amounts due for sales, should also be allowed.¹⁶ Where

out of their gains and profits, but that does not change their nature. If it were not so, inventors might, by reason of infringements, fail to obtain anything, and the infringers obtain what they see fit to term adequate salaries out of their piracy. What, in good faith, the defendants pay to others, as expenses, may be taken as the cost to them of their manufacture. What they take to themselves are gains. They might perhaps have earned and gained as much, or perhaps more, by laboring in some other business, in no violation of the rights of their neighbor; but they cannot be permitted to gain either wages or salary by a violation of such rights." 9 Blatch. 476 (478).

That the time and services of the infringers are not allowed, see *Piper v. Brown* (1873), 3 O. G. 97; *Holmes*, 196; 6 *Fisher*, 240.

That the expense of maintaining the insane infringer while under guardianship cannot be allowed after his restoration to sanity, see *Avery v. Wilson* (1884), 20 Fed. Rep. 856.

That where the defendant is a corporation the salaries paid by it to its stockholders as employees, in good faith and not as a mode of dividing profits, are to be allowed, see *Steam Stone Cutter Co. v. Windsor Mfg. Co.* (1879), 17 Blatch. 24; 4 Bann. & A. 445; *American Nicholson Pavement Co. v. City of Elizabeth* (1874), 6 O. G. 764; 1 Bann. & A. 439.

That interest on capital stock is not allowed, see *Rubber Co. v. Goodyear* (1869), 9 Wall. 788; *contra*, *Wilbur v. Beecher* (1850), 2 Blatch. 132.

That insurance on real and personal

estate employed in the business, and local taxes, are not to be allowed, see *Steam Stone Cutter Co. v. Windsor Mfg. Co.* (1879), 17 Blatch. 24; 4 Bann. & A. 445.

¹⁶ That the manufacturer's profit should be allowed, see *Simpson v. Davis* (1884), 22 Fed. Rep. 444; 22 Blatch. 113; *Buerk v. Imhaeuser* (1876), 10 O. G. 907; 2 Bann. & A. 452; 14 Blatch. 19; *contra*, *Rubber Co. v. Goodyear* (1869), 9 Wall. 788.

The manufacturer's profit occupies different positions in the account according to the mode of infringement. Where the infringement is by making and selling, the manufacturer's profit enters into the profit resulting from the sale, and is a direct advantage derived from and wholly dependent on the unlawful use of the invention. Like salaries or wages claimed by the infringer it should therefore be disallowed. But in cases where the infringement consists in the use of the invention and the sale of its products, the profits, under the present questionable doctrine, are represented by the difference in advantage between the invention used and that which the defendant had a right to use, and into this difference the manufacturer's profit does not enter unless it is greater or less when the patented invention is employed than it would otherwise be. In these cases, therefore, it may properly be allowed, either wholly or in part, as the evidence may show it to have been affected by the infringement.

¹⁶ That the cost of marketing the articles is to be allowed, see *Gould's Mfg. Co. v. Cowing* (1882), 105 U. S. 253; 21 O. G. 1277; *Zane v. Peck Brothers*

the defendant is engaged in a general business, the patented invention constituting only one department of his sales, the expenses of the business must be apportioned in the ratio of the respective sales of the infringing and the non-infringing articles, and the proportion of the former charged as the expenses of their sale.¹⁷ In this computation no allowance

(1882), 23 O. G. 191; 13 Fed. Rep. 475; *Rubber Co. v. Goodyear* (1869), 9 Wall. 788.

That if sales are large the cost of clerk hire, storage, freight, etc., are to be allowed, see *Zane v. Peck Brothers* (1882), 23 O. G. 191; 13 Fed. Rep. 475.

That commissions on the defendant's sales, where they have not paid any, cannot be allowed, see *Piper v. Brown* (1873), 3 O. G. 97; *Holmes*, 196; 6 *Fisher*, 240.

That a commission paid to an agent is a profit to be accounted for by the agent, not by the principal, see *Steiger v. Heidelberger* (1880) 18 O. G. 1463; 4 Fed. Rep. 455; 13 *Blatch*. 426.

That where the competition produced by the infringement increases the sales of the plaintiff by reason of the reduced prices, this fact is to be considered on the question of profits, see *Ingersoll v. Musgrove* (1878), 13 O. G. 966; 14 *Blatch*. 541; 3 *Bann. & A.* 304.

That where the defendants as makers sell to themselves as users, and are the largest users while other purchasers buy but little, it is proper to consider that the magnitude of the sales to themselves reduced the price below that to small buyers, see *Troy Iron & Nail Factory v. Corning* (1869), 3 *Fisher*, 497; 6 *Blatch*. 328.

¹⁷ In *Hitchcock v. Tremaine* (1872), 5 *Fisher*, 310, *Woodruff, J.*: (311) "The defendants are dealers in musical instruments, including pianos, melodeons, and organs with and organs without the *tremolo* attachment, which has been decreed to be an infringement of

the complainants' patent. (See *Hitchcock v. Tremaine*, 8 *Blatch. C. C.* 440; 4 *Fisher*, 508.) The conduct of their business necessarily involves certain general expenses, which are as truly expenses of dealing in one class of goods as of dealing in another class. Such expenses as general clerk hire, rent of store, salary of book-keeper, if any, and the like, concern the entire business, and in any estimate of gains and profits are properly apportionable to the several kinds of business done, or kinds of goods sold, when the profits of either are to be separately stated. . . . The gross proceeds of sales of each kind being ascertained, and a deduction from each being made of such special or peculiar expenses as in a *pro forma* account would be chargeable to each, there would remain for allotment to each account its proportionate share of the general expenses incurred for the benefit of all, — that is, for the maintenance and conduct of the business; and this distribution should be in the proportion of the several amounts of sales of each. It is not just to say, in respect to either, as is argued by the complainants here, that the general expenses are not increased by the presence of one class of goods, and would have been the same if the sales had been confined to the other classes. If that argument were supposed to prevail in an accounting for the profits of sales of one class, it would also prevail in each separate accounting, and so would be allowed in neither. In the present case, the dealing in organs having the *tremolo* at-

can be made for losses on infringing articles which have been sold at cost or less than cost, or which have not been paid for or remain unsold. The profits on articles sold at a profit and paid for are the only object of inquiry. Losses incurred by the defendant through his wrongful invasion of the patent are not chargeable to the plaintiff, nor can their value be deducted from the compensation which he is entitled to receive.¹⁸ Nor where the defendant has expended money in

attachment was a part of the general business of the defendants. These were not sold without involving a part of the general expenses of the business. It may be true that in a given case it costs the defendants no more to sell an organ containing the infringing attachment than it would have cost to sell an organ not containing the attachment; but *non constat* that if the organ sold had not contained such attachment, it would have been sold at all. The complainants are here demanding the profits of that sale. They must take them burdened with the just allowance for those disbursements which enable the defendants to offer the attachments to the public in a salable form, and to keep them in the market, before the eye and within the reach of customers, and generally to properly conduct the business of selling, and keep due account thereof. . . . On the other hand, the master very properly refused to apportion these expenses according to the amount of profits on sales. Whether the defendants made any profits on their whole business or not, is quite immaterial to these complainants. They are not to be deprived of the gains made by selling the infringing attachments because the defendants made less profits, or even no profits, on the sale of pianos, or as the case may be, of some other musical instruments. To allow this, would permit the defendants to violate the rights of the complainants, and use the profits thereby gained

to cover their losses on other sales." 9 Blatch. 385 (386).

See also *Brady v. Atlantic Works* (1878), 3 Bann. & A. 577; 15 O. G. 965; *Tremaine v. Hitchcock* (1874), 23 Wall. 518; 7 O. G. 1055.

¹⁸ In *Graham v. Mason* (1872), 5 Fisher, 290, Shepley, J. : (293) "In making up the account of profits, the master sometimes takes into account the cost of the whole number of infringing mechanisms or contrivances made by the defendant, and the proceeds of all the sales, and gives the patentee the net profits on the whole amount manufactured. This would be a correct rule in some cases, but it would not be just to the patentee in cases where the infringer had made profits on one fraction of the whole number made and sold, and through defective manufacture or unskilful management of his business had met with losses on a larger fraction, so that a correct account of the whole operation would show a loss on the total manufacture. In such a case, if the patentee, with a full knowledge of all the facts, should bring his bill declaring specifically for the infringement only by the manufacture of those specified mechanisms in the making and selling of which the infringer had made profits, he would certainly be entitled to recover the profits thus made. It is not easy to see why he is not entitled to such profits in a bill counting generally against the infringer without offset or

protecting his vendees from the plaintiff, or securing their release from liability, or given them guaranties of unmolested future enjoyment, can these expenses be considered or set off against the profits actually made.¹⁹

§ 1140. Computation of Profits where the Infringement Consists in Selling Articles in which the Patented Invention is Embraced and Added to the Profits of Each Sale.

The foregoing rule of computation is sufficient where the article sold is the exact patented invention. Where it embraces more than the patented invention, further distinctions become necessary. If the infringing article, as actually made and sold by the defendant, contains substantial features which contribute to its market value, but are not covered by the plaintiff's patent, it is evident that the price paid by the vendee is not based on the sole consideration of the patented invention, and that the difference between the price and the cost of manufacture is greater than the benefit derived by the defendant from his infringing act. In such cases an ad-

deduction for losses made in the manufacture and sale of other infringing mechanisms." 1 O. G. 609 (610); Holmes, 88 (90). See also *Tilghman v. Proctor* (1888), 125 U. S. 136; 43 O. G. 628.

That where the defendant has made and sold some infringing devices at a profit, he must account for them though he sold others without profit and has some on hand which he cannot dispose of, see *Steam Stone Cutter Co. v. Windsor Mfg. Co.* (1879), 17 Blatch. 24; 4 Bann. & A. 445.

That where business is carried on for one season at a profit and for the next at a loss, and no connection existed between the two, and the accounts were kept separate, no deductions from the profits of the former on account of the losses in the latter are to be allowed, see *Piper v. Brown* (1873), 3 O. G. 97; Holmes, 196; 6 Fisher, 240.

That bad debts are sometimes con-

sidered in estimating profits, see *Rubber Co. v. Goodyear* (1869), 9 Wall. 788; *Wilbur v. Beecher* (1850), 2 Blatch. 132. But not properly in an account for profits on sales, since no profits accrue except where goods sold are actually paid for, and since profits arising on sales where the price is collected are not diminished by losses on other sales.

¹⁹ That money paid to protect defendant's vendees from the plaintiff is not to be allowed in the account of profits, see *Mason v. Graham* (1874), 23 Wall. 261; 7 O. G. 833; *Graham v. Mason* (1872), 1 O. G. 609; Holmes, 83; 5 Fisher, 290.

That liabilities for and guaranties of title given to purchasers by the defendant are not allowed, all claims of the plaintiff against them being extinguished by his recovery of profits, see *Steam Stone Cutter Co. v. Windsor Mfg. Co.* (1879), 17 Blatch. 24; 4 Bann. & A. 445.

ditional investigation is required. The price of the patented invention and its cost must be separated from the total expenses and receipts in order that the deduction of the latter from the former may indicate the profit due to the invention.¹

§ 1140. ¹ In *Maier v. Brown* (1883), 17 Fed. Rep. 736, Brown, J. : (736) "There is no doubt whatever of the general proposition that the patentee of an improvement is limited in his recovery to such profits as may be properly apportioned to the use of his improvement. He can only recover profits upon the entire article when such article is wholly his own invention, or when its entire value is properly and legally attributable to the patented feature. (*Seymour v. McCormick*, 16 How. 480; *Mowry v. Whitney*, 14 Wall. 620; *Littlefield v. Perry*, 21 Wall. 205; *Elizabeth v. Pavement Co.*, 97 U. S. 126; *Garretson v. Clark*, 15 Blatch. 70; *Zane v. Peck*, 13 Fed. Rep. 475; *Fitch v. Bragg*, 16 Fed. Rep. 243.) The difficulty is in the application of this principle. Thus, if one discovers a new composition of matter, such as gun-cotton, nitro-glycerine, or vulcanized rubber, or invents some new machine, such as the telephone, or some new article of manufacture, such as barbed wire or a new pavement, he would obviously be entitled to damages arising from the manufacture and sale of the entire article. Upon the other hand, if his invention were limited to some particular part of a large machine, such as the cut-off of an engine, the axle of a wagon, or the seat upon a mowing machine, it is equally clear that his recovery must be limited to such profits as arise from the manufacture and sale of the patented feature. His damages, too, must be proved, and not left to conjecture; and the fact that it is impossible to separate the profits arising from the improvement from those incident to the manufacture of the whole machine, is an insufficient

reason for awarding the plaintiff more than he is justly entitled to receive. (*Philp v. Nock*, 17 Wall. 400; *Calkins v. Bertrand*, 8 Fed. Rep. 755; *Gould's Mfg. Co. v. Cowing*, 12 Blatch. 243.) In case he is unable to prove how much of the entire profit upon the machine is due to his patent, he can recover only nominal damages. *Blake v. Robertson*, 94 U. S. 728."

Further, that the profits on the exact invention, as distinguished from profits due to other features of the article as a whole, must be separated and alone accounted for, see *Fay v. Allen* (1887), 30 Fed. Rep. 446; *Roemer v. Simon* (1887), 31 Fed. Rep. 41; 40 O. G. 1456; *Everest v. Buffalo Lubricating Oil Co.* (1887), 31 Fed. Rep. 742; *Reed v. Lawrence* (1886), 29 Fed. Rep. 915; *Faulks v. Kamp* (1882), 22 O. G. 2244; 10 Fed. Rep. 675; *Gould's Mfg. Co. v. Cowing* (1882), 105 U. S. 253; 21 O. G. 1277; *Kirby v. Armstrong* (1881), 19 O. G. 661; 10 Bissell, 135; 5 Fed. Rep. 801; *Calkins v. Bertrand* (1881), 8 Fed. Rep. 755; 10 Bissell, 445; *Garretson v. Clark* (1879), 16 O. G. 806; 4 Bann. & A. 536; *Steam Stone Cutter Co. v. Windsor Mfg. Co.* (1879), 17 Blatch. 24; 4 Bann. & A. 445; 24 O. G. 703; *Garretson v. Clark* (1878), 14 O. G. 485; 15 Blatch. 70; 3 Bann. & A. 352; *Knox v. Great Western Quicksilver Mining Co.* (1878), 14 O. G. 897; 6 Sawyer, 430; 4 Bann. & A. 25; *Brady v. Atlantic Works* (1878), 3 Bann. & A. 577; 15 O. G. 965; *Ingersoll v. Musgrove* (1878), 13 O. G. 966; 14 Blatch. 541; 3 Bann. & A. 304; *Buerk v. Imhaeuser* (1876), 10 O. G. 907; 14 Blatch. 19; 2 Bann. & A. 452; *Robertson v. Blake* (1876), 94 U. S. 728; 11

The price paid for the patented invention is the price received for the whole article, less what it would have brought in open market had the patented invention been omitted. Its cost is the difference between the expense of making the article with it and without it. If the article is more expensive and brings a higher price when it includes the patented invention, the subtraction of the excess of cost from the excess of price will show whether a profit has been made, and its amount. When the price remains the same as if the patented invention were not used, and the expense of manufacturing the article is lessened, the profit is the decrease in its cost. If cost and price are unchanged by the introduction of the patented invention, or are increased or diminished in the same proportion, or the price decreases while the cost is still the same, there is no profit in the sale of any single article for which the plaintiff has a right to an account from the defendant, and whatever benefit exists must be occasioned by an increase of his sales. The rule, as thus far stated, presents certain difficulties, since if the presence of the patented invention adds nothing to the gains of the defendant, and the plaintiff has sustained no actual loss for which he can recover damages, the wrongful sale of the invention must go unredressed, except by nominal

O. G. 877; *Ingels v. Mast* (1875), 7 O. G. 836; 1 *Flippin*, 424; 2 *Bann. & A.* 24; *Gould's Mfg. Co. v. Cowing* (1874), 8 O. G. 277; 12 *Blatch.* 243; 1 *Bann. & A.* 375; *Graham v. Mason* (1872), 1 O. G. 609; *Holmes*, 88; 5 *Fisher*, 290.

That where part of the selling price was due to other matter than the plaintiff's invention, and he was allowed the whole profits, the cost of this other matter must be deducted, see *Steam Stone Cutter Co. v. Windsor Mfg. Co.* (1879), 17 *Blatch.* 24; 4 *Bann. & A.* 445.

That on a patent for a combination only the profits on the exact new features of the invention can be recovered, see *Ingels v. Mast* (1875), 7 O. G. 836; 1 *Flippin*, 424; 2 *Bann. & A.* 24.

That profits on the device alone, as

sold separately, do not measure the damages when it is part of a machine and enhances the value of the machine itself if applied to it, see *Gould's Mfg. Co. v. Cowing* (1882), 105 U. S. 253; 21 O. G. 1277.

That profits are to be allowed though the defendant has improved the shape and effectiveness of the device, see *Graham v. Mason* (1872), 1 O. G. 609; *Holmes*, 88; 5 *Fisher*, 290.

That the invention being a unit, the profits of the monopoly cannot be divided among its parts arbitrarily, see *Livingston v. Jones* (1861), 2 *Fisher*, 207; 3 *Wall. Jr.* 330.

That profits due to an element not patented, which enters into the composition of patented articles, are sometimes allowed, see *Rubber Co. v. Goodyear* (1869), 9 *Wall.* 788.

damages and future prohibition. But this rule leaves the plaintiff in no worse position than he would have occupied at law, and equity does not aim to give a higher compensation than the law, although its methods of procedure often so result.

§ 1141. Computation of Profits where the Infringement Consists in Selling Articles in which the Patented Invention is Embraced and Increases the Number and Amount of Sales.

Where the presence of the patented invention, though adding nothing to the profits of the defendant on a single article, increases the number of his sales, and thus augments the gains which he derives from the manufacture and sale of the articles as a whole, another mode of computation must be followed. Here it is evident that all the profits on those articles, which would not have been sold had they not contained the patented invention, are due to the infringement;¹ and if these articles can be separated from the rest, their profits can be ascertained by deducting the cost of manufacture from the price received. In many cases this separation may be impossible, and if so, no profits can be computed or recovered. But where the introduction of the patented invention into the article makes it available for new uses and in new lines of business, those whose market has depended on the presence of the patented invention are easily distinguishable from those which might as readily have been sold without it, and the estimate of profits due to the invention can be as accurately and intelligibly made as if the entire article were covered by the patent.

§ 1142. Computation of Profits where the Infringement Consists in Selling Articles which Embrace the Patented Invention, and thence Derive their Entire Market Value.

Where the article, though embracing other features than those covered by the patent, so far derives its marketability

¹ That where no sale would take place were not the patented invention incorporated in the article sold, the sale and consequent profit are due to the invention, see § 1142 and notes, *post*.

from the presence of the invention that articles from which it is absent would be totally unsalable, the entire profit on the sales must be attributed to the infringement.¹ This may

§ 1142. ¹ In *Gould's Mfg. Co. v. Cowing* (1882), 105 U. S. 253, Waite, C. J.: (255) "The rule applicable to this class of cases was well stated by Mr. Justice Strong, speaking for the whole court, in *Mowry v. Whitney* (14 Wall. 620). The subject-matter of that suit was a patent for an improvement in the process of manufacturing car-wheels, and in respect to the profits resulting to an infringer from the use of the patented process it was said, p. 651: 'The question to be determined . . . is, what advantage did the defendant derive from using the complainant's invention over what he had in using other processes then open to the public, and adequate to enable him to obtain an equally beneficial result. The fruits of that advantage are his profits.' It does not necessarily follow from this that where the patent is for one of the constituent parts and not for the whole of a machine, the profits are to be confined to what can be made by the manufacture and sale of the patented part separately. If without the improvements a machine adapted to the same uses can be made which will be valuable in the market and salable, then, as was further said in that case, the inquiry is 'what was the advantage in cost, in skill required, in convenience of operation, or marketability,' gained by the use of the patented improvement? If the improvement is required to adapt the machine to a particular use, and there is no other way open to the public of supplying the demand for that use, then it is clear the infringer has by his infringement secured the advantage of a market he would not otherwise have had, and that the fruits of this advantage are the entire profits he has made in that mar-

ket." 21 O. G. 1277 (1278); 11 Fed. Rep. 447 (447).

In *Whitney v. Mowry* (1886), 4 Fisher, 141, Swayne, J.: (145) "But it would seem to be very clear that if a party invents a machine, or anything else, that is perfectly valueless, having no salable commercial value, and which in every other respect is worthless because he cannot sell it, and then use in connection with that machine or structure, or article, whatever it may be, the invention of another, no matter how slight that invention may be, which gives it its entire market value, it would seem at first view that the amount to be recovered should be the entire amount of profit, because there is a proximate, inseparable connection between the old or useless article sold by means of the new invention which could not have been sold otherwise. In the case of a close monopoly, there is a profit made which, it would seem, at first view, is entirely due to the infringement of the patent right of another; and it would seem that the infringer ought not to be permitted to say, under such circumstances, that there should be an apportionment of the profits. But, on the other hand, take the case for instance of a railroad car, or anything else, the making of which involves a large expenditure of money; and then by the application of the invention of another, slight and trifling in its character, of very little cost, of no value except in connection with that structure, the application of that slight improvement is sufficient to turn the scale in the market so that nobody will buy the article except in connection with the patented invention. Suppose, in further illustration of this view of the subject, it be a

occur where an article previously in demand has been wholly superseded in the market by the same article containing a patented improvement. The original still preserves its former utility, and if marketable might become a source of profit to the seller. But if unsalable without the patented improvement no profit could arise, since in this form of infringement profits are the fruit of sales, not of utility, and, therefore, when made salable by the incorporation of the patented improvement, it is to this that both the sales and profits are due. Hence, in these cases, though with some hesitation on the part of certain judges, the entire profits on the sales are awarded to the plaintiff, notwithstanding the intrinsic value of the original invention, or its present usefulness to any one who might wish to employ it.²

railroad car, the cost of which is thousands of dollars, and some little invention is made in regard to the interior structure of the car or in its ornamentation, which is patentable under the act of 1861, yet the slight, the simple thing is such as to strike the public taste and judgment, and have such an effect in the commercial world that nobody will buy the article without that invention; yet it would seem to be a pretty hard measure of justice in a court of equity to say that the entire profits made on that large article should go into the pockets of the inventor and patentee of this small thing, which had been used without license or authority in connection with it."

Further, that where the plaintiff's device gives its entire value to the defendant's article, the profits of the entire article are to be accounted for, see *Hurlburt v. Schillinger* (1889), 130 U. S. 456; *Callahan v. Myers* (1888), 128 U. S. 617; *Fifield v. Whittemore* (1888), 33 Fed. Rep. 835; *Welling v. La Bau* (1888), 43 O. G. 115; *Fay v. Allen* (1887), 30 Fed. Rep. 446; *Reed v. Lawrence* (1886), 29 Fed. Rep. 915; *Root v. Lake Shore & Mich. Southern*

R. R. Co. (1882), 105 U. S. 189; 21 O. G. 1112; *Zane v. Peck Brothers* (1882), 23 O. G. 191; 13 Fed. Rep. 475.

That where the entire market value of a device depends on its infringing features, the profits are found by comparing the profits made by this device with those made by one not having the infringing features, see *Garretson v. Clark* (1879), 16 O. G. 806; 4 Bann. & A. 536.

² In reference to this point market value must not be confounded with salability. Market value is the price commanded by the article in open market. Salability may aid in fixing this price, and may determine what amount of profits may be derived from each sale and from all sales collectively. In infringements which consist in making and selling infringing articles all sales, and consequently all profits on sales, may depend upon the presence of the patented feature, however slight in itself the advantage thereby conferred. In the case of the railway car, used as an illustration in *Mowry v. Whitney*, *ante*, if the railway car were unsalable without the patented improvement, the sale itself, the price received, and the differ-

§ 1143. Burden of Proof Concerning the Amount of Profits Resulting from Infringing Sales.

The burden of proof concerning the receipt of profits by the defendant from the sale of the patented invention, and also concerning their precise amount, devolves upon the plaintiff.¹ While the defendant may be subjected to examination before the master, and while his books may be inspected and every other available method of investigation be pursued, it is still for the plaintiff to show by a preponderance of testimony the exact sum for which the defendant is accountable.² Profits are ascertained by computation, and computation requires certain data to which arithmetical processes may be applied with definite and invariable results. These are not a matter of speculation, or of compromise, or of arbitrary adjustment.³ The price received for the patented invention

ence between price and cost, would all be directly attributable to the presence of the patented improvement, and the profits would properly be accounted for to the patentee. This is the result which would be reached in an action at law, if it were shown that the cars made and sold by the defendant would have been sold by the plaintiff, the profits of the sale being in that case the measure of the plaintiff's damages; and that the same is true in equity on an account of profits seems certain, notwithstanding the doubts of the learned judge.

§ 1143. ¹ That the burden of proof as to the amount of damages or profits rests on the plaintiff, see § 1071 and notes, *ante*.

² That the defendant may be examined as a witness and his books inspected, see Equity Rule 77; *Foote v. Silsby* (1856), 3 Blatch. 507.

That the plaintiff must affirmatively show what profits are due to his invention, see *Tilghman v. Proctor* (1888), 125 U. S. 136; 43 O. G. 628; *Bell v. U. S. Stamping Co.* (1887), 32 Fed. Rep. 549; *Garretson v. Clark* (1884), 111 U. S. 120; 27 O. G. 524; *Schil-*

linger v. Gunther (1878), 14 O. G. 713; 15 Blatch. 303; 3 Bann. & A. 491.

That every intendment is against a wilful infringer and the plaintiff's proof of loss should be liberally construed in his favor, see *Bigelow Carpet Co. v. Dobson* (1882), 15 Phila. 476; 10 Fed. Rep. 385; 21 O. G. 1200.

³ That the evidence must show the amount of profits and not leave them open to conjecture, see *Ingersoll v. Musgrove* (1878), 13 O. G. 966; 14 Blatch. 541; 3 Bann. & A. 304.

That the right to recover profits rests on the principle that the defendant, having unlawfully appropriated benefits belonging to the plaintiff, is accountable for them, and these, being ascertainable by computation, do not rest in the discretion of the court or jury, see *Jenkins v. Greenwald* (1857), 2 Fisher, 37; 1 Bond, 126.

That an arbitrary award of one half the net profits on the whole article as due to the plaintiff's device is not proper, since the exact amount is to be ascertained by computation, see *Calkins v. Bertrand* (1881), 8 Fed. Rep. 755; 10 Bissell, 445.

That there is no presumption that

and the cost of producing it are the two factors which must affirmatively appear, that by the subtraction of one from the other the profit may be known. Thus when the article sold is entirely covered by the patent, or when though embracing other features it derives its marketability solely from the presence of the patented invention, the plaintiff must prove the amount of the receipts and the expenditures, the difference in that case being the profit due to the infringement. Where the article would be marketable without the patented invention, but sells for a higher price or is manufactured at less cost when it contains the features covered by the patent, the evidence must separate the patented invention from the other portions of the article, and disclose how much of the increased receipts or lessened cost arises from its presence, and what proportion of the profits on each article is properly attributable to its use.⁴ When, in the latter case,

the defendant's percentage of profit is the same as that of the plaintiff, but the amount must be specifically shown, see *Roemer v. Simon* (1887), 31 Fed. Rep. 41; 40 O. G. 1456.

That when the profits cannot be determined by evidence they cannot be recovered as damages, see *Blake v. Greenwood Cemetery* (1883), 16 Fed. Rep. 676; 21 Blatch. 222.

That profits are not allowed unless capable of measurement, see *Locomotive Safety Truck Co. v. Pennsylvania R. R. Co.* (1880), 2 Fed. Rep. 677; 5 Bann. & A. 514; 14 Phila. 432.

That royalties paid by the defendant or others do not afford a measure of profits, see *Tilghman v. Proctor* (1888), 125 U. S. 136; 43 O. G. 628; *Wooster v. Taylor* (1878), 14 Blatch. 403; 3 Bann. & A. 241; *Knox v. Great Western Quicksilver Mining Co.* (1878), 14 O. G. 897; 6 Sawyer, 430; 4 Bann. & A. 25.

That if the defendant offers evidence to show that no profits were realized and the plaintiff does not prove the contrary, only nominal damages are al-

lowed, see *Calkins v. Bertrand* (1881), 8 Fed. Rep. 755; 10 Bissell, 445.

⁴ In *Garretson v. Clark* (1884), 111 U. S. 120, Field, J.: (121) "When a patent is for an improvement, and not for an entirely new machine or contrivance, the patentee must show in what particulars his improvement has added to the usefulness of the machine or contrivance. He must separate its results distinctly from those of the other parts, so that the benefits derived from it may be distinctly seen and appreciated. The rule on this head is aptly stated by Mr. Justice Blatchford in the court below. 'The patentee,' he says, 'must in every case give evidence tending to separate or apportion the defendant's profits and the patentee's damages between the patented feature and the unpatented features, and such evidence must be reliable and tangible, and not conjectural or speculative; or he must show, by equally reliable and satisfactory evidence, that the profits and damages are to be calculated on the whole machine, for the reason that the entire value of the whole machine, as a marketable ar-

the relation between cost and receipts remains unchanged whether or not the article contains the patented invention, and whatever benefit may have accrued to the defendant from the infringement assumes the form of an increase in sales, the plaintiff must separate the sales due to the presence of his invention from those which would have taken place without it, and prove the amount of profits derived by the defendant from such separated sales. The evidence upon all these points must be direct; or, if circumstantial, the inferences drawn therefrom must be conclusive.⁵ The fact that an article containing the patented invention practically commands the market does not of itself show that all sales or profits are necessarily attributable to the infringement; nor does the fact that the defendant sold, at the same

article, is properly and legally attributable to the patented feature." 27 O. G. 524 (524).

Further that the plaintiff must prove that the entire profits of the defendant are due to his invention or he must separate the profits due thereto from all others, see *Tuttle v. Gaylord* (1886), 28 Fed. Rep. 97; 36 O. G. 604; *Calkins v. Bertrand* (1881), 8 Fed. Rep. 755; 10 Bissell, 445; *Kirby v. Armstrong* (1881), 5 Fed. Rep. 801; 19 O. G. 661; 10 Bissell, 135; *Schillinger v. Gunther* (1878), 14 O. G. 713; 15 Blatch. 303; 3 Bann. & A. 491; *Black v. Munson* (1877), 14 Blatch. 265; 2 Bann. & A. 623.

That where the plaintiff's device is an improvement he must show what proportion of the profits were due to it and to the original device, or only nominal damages will be allowed, see *Bosstock v. Goodrich* (1885), 25 Fed. Rep. 819; 34 O. G. 1047.

As to the application of this rule to the infringement of a design patent, see *Dobson v. Hartford Carpet Co.* (1885), 114 U. S. 439, where Blatchford, J., says: (445) "The rule in question is even more applicable to a patent for a design than to one for mechanism. A design or pattern in ornamentation or

shape appeals only to the taste through the eye, and is often a matter of evanescent caprice. The article which embodies it is not necessarily or generally any more serviceable or durable than an article for the same use having a different design or pattern. Approval of the particular design or pattern may very well be one motive for purchasing the article containing it, but the article must have intrinsic merits of quality and structure to obtain a purchaser, aside from the pattern or design; and to attribute, in law, the entire profit to the pattern, to the exclusion of the other merits, unless it is shown by evidence as a fact that the profit ought to be so attributed, not only violates the statutory rules of 'actual damages' and of 'profits to be accounted for,' but confounds all distinctions between cause and effect." 31 O. G. 787, (780). See also *Tomkinson v. Willetts Mfg. Co.* (1888), 34 Fed. Rep. 536; *Dobson v. Dornan* (1886), 118 U. S. 10; 35 O. G. 750.

⁵ That the evidence must afford all necessary data for the computation and be direct and positive, see § 1157 and notes, *post*.

profit, articles from which the patented elements were absent, determine that no portion of the profit on the infringing article was due to the unlawful use of the invention.⁶ The burden thus imposed upon the plaintiff may be difficult to bear, and may involve a tedious research and considerable expense without available results, but no other rule would be just to the defendant, or tend in any manner to protect the equitable rights of either party. And since the power to award damages has been conferred on courts of equity, all the redress obtainable in any forum by the plaintiff can be afforded him, although he fails to make his claim to profits good.

§ 1144. Computation of Profits where the Infringement Consists in the Use, or Manufacture and Use, of the Patented Invention.

In the second class of cases, where the infringing act consists in the unlawful use, or making and use, of the patented invention, the data for computation are less capable of definite ascertainment. The cost of using the invention may present little difficulty, but the benefit derived from its employment rarely assumes the form of a specific sum of money, like the price received for an article sold, and hence requires the application of different and more complicated rules for its detection. The benefit derived from the use of any art or instrument may manifest itself either in the increase of direct pecuniary receipts, or in the decrease of expenses. A process or machine whose products, though entailing the same cost of manufacture on the maker, command a higher price, confers upon its user an advantage measured by the increment of price received. An art or article whose use

⁶ That the fact that the machine, with the improvements, commands the market does not show that all the profits are due to the improvement, see *Garretson v. Clark* (1878), 14 O. G. 485; 15 Blatch. 70; 3 Bann. & A. 352; *Gould's Mfg. Co. v. Cowing* (1877), 12 O. G. 942; 14 Blatch. 315; 3 Bann. & A. 75.

That if the defendant sold the infringing device at a profit it is not affected by the fact that he sold other non-infringing devices at the same profit, as each stands by itself, see *Simpson v. Davis* (1884), 22 Fed. Rep. 444; 22 Blatch. 113.

results in lessening the expenses of a business, without increasing its receipts, is profitable to its employer in proportion to the saving it involves. Thus the profits from the unlawful use of a patented invention may assume different forms according to the nature of the invention and the circumstances under which it is used, and consist either in direct gains, or in savings, or in both together.

§ 1145. **Computation of Profits where the Infringement Consists in the Use, or Manufacture and Use, of the Patented Invention: Receipts and Savings Taken as the Minuend.**

In computing the profits derived from the unlawful use of a patented invention, the entire amount received or saved by the defendant cannot be taken as one factor of the problem, except in a few peculiar cases. If the defendant is paid a definite sum for using the invention, or if the product which he makes and sells can be produced only by the infringing process or machine, or if the saving in expense can be accomplished neither in the whole nor in part by any other method, then may the total receipts for the use of the invention or the sale of its products, or the total savings, be taken as the minuend, from which the cost being deducted the remainder may be properly regarded as the profit due to the infringement.¹ But, under the present doctrine of our courts upon this subject, where the product is producible by other means, or the saving might entirely or in part result from the use of other arts or instruments, the advantage derived by the defendant from the unlawful use of the patented invention cannot be measured by the difference between the gross amount of his receipts or savings and his expenses. The value of the use of an invention is held to be the value of the use of that new idea of means which the inventor has embodied and expressed in his article or process; and to which only the protection of his patent is extended, since whatever inventions exist in the arts, open to the public at the date

§ 1145. ¹ That when the article can be made only by the patented process the entire profits belong to the patentee, see *Mulford v. Pearce* (1877), 11 O. G. 741; 14 Blatch. 141; 2 Bann. & A. 542.

of his inventive act, may be employed by all, and to the whole community thus belongs already the entire benefit derivable from their unrestricted use. When any new invention is perfected, therefore, the benefit that it confers on its employer consists not of the whole advantage flowing from its use, but of the advantage it affords in excess of that obtainable by other means which have been previously bestowed upon the public.² Upon this doctrine rests the rule that where the defendant's savings or receipts could have been secured, to any extent, by the use of arts or articles which were open to the public at the date of the invention covered by the patent, the proportion of such savings or receipts which may enter into the computation of the profits due to the infringement is ascertained by deducting from their gross amount whatever would have been received or saved by the employment of such prior means.³ In the application of this rule no attention is

² In *Locomotive Safety Truck Co. v. Penna. R. R. Co.* (1880), 2 Fed. Rep. 677, Strong, J.: (679) "This rule is founded upon the soundest reason. It is only that which was previously not known, or, in other words, it is only the addition to human knowledge and convenience which a patentee has made, that he can be said to own. The Patent Laws give him an exclusive right to that addition, and to the advantages resulting from it, and to nothing more. Undoubtedly it may be a benefit to the community to have two modes of doing certain work instead of one, both equally economical and convenient, accomplishing the same result, and each still patentable; but, as was well remarked by the master: 'Unless a patentee can show such an absolute advantage in the use of his patent over results which could be reached by other processes in common and unrestricted use, there has been nothing really gained, no advance made by his invention. In such a case, though he may maintain a monopoly over his patented machine, process, or combination, and exact such damages as

he may be able to show he has suffered from an infringer, he cannot claim any portion of what has been realized as profits in any sense owing or due to him, for the reason that the infringer could just as well have obtained such product or result without his aid, or the benefit of his work or ideas.'" 14 Phila. 432 (432); 5 Bann. & A. 514 (515). But see § 1062, note 7, *ante*, where this doctrine is criticised and limited.

³ That the profits derived from the use of a patented invention are measured by the advantage gained by the infringer in excess of what he would have obtained by using means already open to the public and able to produce the same results, see *Coupe v. Weatherhead* (1888), 37 Fed. Rep. 16; *McMurray v. Emerson* (1888), 36 Fed. Rep. 901; *Shannon v. Bruner* (1888), 33 Fed. Rep. 871; *Creamer v. Bowers* (1888), 35 Fed. Rep. 206; *Tilghman v. Proctor* (1888), 125 U. S. 136; 43 O. G. 628; *Turrill v. Illinois Central R. R. Co.* (1880), 20 Fed. Rep. 912; *Knox v. Great Western Quicksilver Mining Co.* (1878), 14 O. G.

paid to the existence of other prior patented inventions which the defendant had or could have acquired the right to use, nor to any inventions subsequent to the one covered by the patent, whether or not they have been patented. The plaintiff's patent, if valid, secures to him the exclusive use of his invention, and those who use it without right cannot defend nor palliate nor in any wise escape the consequences of their unlawful acts upon the ground that they might, with equal advantage to themselves, have violated the rights of others, or have obtained other privileges under different patents, or have availed themselves of subsequent inventions.⁴ Having

897; 6 Sawyer, 430; 4 Bann. & A. 25; Mors v. Conover (1876), 11 O. G. 1111; Ingels v. Mast (1875), 7 O. G. 836; 1 Flippin, 424; 2 Bann. & A. 24; Black v. Thorn (1874), 7 O. G. 176; 12 Blatch. 20; 1 Bann. & A. 155; Turrill v. Illinois Central R. R. Co. (1873), 5 Bissell, 344; Mowry v. Whitney (1872), 14 Wall. 620; 5 Fisher, 494; 1 O. G. 492.

That no profits are recoverable where other methods in common use produce the same results with equal facility, see Black v. Thorn (1884), 111 U. S. 122; 27 O. G. 415.

⁴ In Turrill v. Illinois Central R. R. Co. (1883), 20 Fed. Rep. 912, Harlan, J. : (914) "If the position of defendants' counsel be tenable, a prior patent may be practically destroyed, and the owner deprived of all profits arising therefrom, by obtaining from a junior patentee a license to use his invention. If the latter be equally useful with the former, the claim of the prior patentee for profits realized from the actual use of his invention by an infringer can always be defeated by showing that the infringer was at liberty to use, although he did not use, the subsequent invention, and might have made thereby the same or greater profits at less cost. Indeed, upon the principle or theory asserted by defendants' counsel, the junior patentee may himself use the invention

of a prior patentee without liability to the latter for profits, provided he shows that had he used his own invention he would have accomplished the same or better results at the same or less cost. I do not believe such to be the law, although in several cases cited by counsel there are general expressions which seem to sustain that view. But, after close study of those cases, I am of opinion that in no one of them was the precise point now under consideration in the mind of the court, or necessarily involved in the decision."

In Herring v. Gage (1878), 15 Blatch. 124, Wallace, J. : (128) "In settling an account between a patentee and an infringer, the real inquiry is: What is the advantage which the infringer has derived from his use of the invention? If he has derived a profit attributable directly to the employment of the invention, that profit belongs to the patentee and is the measure of his recovery. Here the defendants saved a considerable quantity of flour by the use of the complainants' property, which, until they used it, had been lost. Their gain is directly traceable to the use of the invention. How is it important to ascertain what they might have saved, if, instead of using the complainants' property they had used some other device? How are they in a better position than

voluntarily selected his invention as their method of procuring receipts or effecting savings, they are accountable for whatever savings or receipts are due to its employment, though other means which might by wrong or by right have been acquired would have resulted in an equal or a greater benefit.

§ 1146. **Computation of Profits where the Infringement Consists in the Use, or Manufacture and Use, of the Patented Invention: Actual Receipts and Savings Alone Regarded.**

Into this factor of the computation, moreover, no element can enter unless it has been actually saved or received by the defendant, either in money or in some form of property or

they would be if there had been a different device which was patented, and they had acquired the right to use it from the patentee, but, instead of using it, saw fit to employ the complainants' device? *Mowry v. Whitney* was a case where the entire profit of the manufacture of an article made by the patented process was given upon an accounting, when that profit was largely due not to the advantage derived from the patented process, but from that of other processes actually used by the manufacturer, and which he had the right to use; and what was said in that case, pertinent to such a state of facts, is not to be assumed as the enunciation of the rule where the profit has been made directly by the use of the patentee's device. Such a rule would impose an extraordinary burden upon a patentee, because it would require him, when seeking for redress, to explore the whole realm of practical and theoretical mechanism, to ascertain and demonstrate that what was realized by the wrongful appropriation of his invention could not have been made by the use of any other device or substitute which the infringer might have employed. The infringer is, at the election of the patentee, treated

as a trustee, and as such, required to account for the profits actually made by the use of the patentee's property. It would be a novel defence to permit a trustee who has made a profit by the use of the money or property of his *cestui que trust*, to show that he would have made an equal profit if he had used the money or property of a third person, or if he had used his own money or property. It was quite unnecessary, in my judgment, to enter into any investigation of the savings which the defendants might have realized if they had used some other than the complainants' device, and the exception to the master's finding upon the question cannot avail the defendants." 3 Bann. & A. : 6 (400). See also *Burdett v. Estey* (1880), 3 Fed. Rep. 566; 19 Blatch. 1; 5 Bann. & A. 308; *Knex v. Great Western Quicksilver Mining Co.* (1878), 14 O. G. 897; 6 Sawyer, 430; 4 Bann. & A. 25; *American Nicholson Pavement Co. v. City of Elizabeth* (1874), 6 O. G. 764; 1 Bann. & A. 439.

That the fact that an equally useful invention might have been obtained at a less royalty may be considered, see *Ingels v. Mast* (1875), 7 O. G. 836; 1 Flippin, 424; 2 Bann. & A. 24. e

service which has a definite ascertainable money value.¹ What the defendant might have gained or saved by greater skill or diligence in the use of the invention, or with larger capital at his command, or if he had collected all his debts, is immaterial.² Equally unimportant is the fact that he enjoyed benefits of which no pecuniary estimate is possible, such as an increase in his physical comfort or his intellectual acquisitions.³ These savings and receipts must also be di-

§ 1146. ¹ In *Vaughan v. Central Pacific R. R. Co.*, (1877), 4 Sawyer, 280, Sawyer, J. : (282) "But in order to maintain a suit in equity for an account of profits, there must be actual profits resulting to the infringer susceptible of computation or estimation, of which the patentee could be deprived and with which the infringer can be charged as trustee. If from the character of the invention there can be nothing in the nature of profits of which the patentee can be deprived, there is no basis for charging the infringer with receiving profits for his benefit, and nothing for which he can be called upon to account. As the defendant's counsel well observe, if one should invent and patent a more comfortable bed than any heretofore existing, and another should infringe the patent by using it, the use of the bed might well be more agreeable, and afford greater comfort and satisfaction to the infringer than any other; yet it would be absurd to say that he derived any pecuniary profits from its mere use with which he could be charged as the trustee of the holder of the patent; or that there is any basis of profits in the legal sense of the term for which he could be called upon in a court of equity to account. It would be impossible to predicate profits in any just sense upon such an infringement. It could furnish no element for the basis of an account. The same is true of many inventions." 3 Bann. & A. 27 (29).

That where the profits are not in

money but in general advantage, and must be compensated for in an estimated sum, a bill for account is not proper, but the remedy is at law, see *Sayles v. Richmond, Fredericksburg, & Potomac R. R. Co.* (1879), 3 Hughes, 172; 4 Bann. & A. 239; 16 O. G. 43.

² That the exact profits or savings, as the defendant actually used the invention, are to be accounted for, see *Williams v. Rome, Watertown, & Ogdensburgh R. R. Co.* (1880), 17 O. G. 1447; 18 Blatch. 181; 2 Fed. Rep. 702; 5 Bann. & A. 423.

That where the profit consists in saving time, the question is not how much might have been saved but how much was saved, see *Munson v. City of New York* (1883), 16 Fed. Rep. 560; 21 Blatch. 342.

That profits are to be based on the actual production of the defendant's infringing articles, not on their productive capacity, see *Webster v. New Brunswick Carpet Co.* (1875), 9 O. G. 203; 2 Bann. & A. 67.

That no profits are recoverable where the defendant through his unskillfulness or unbusiness-like habits made none, see *Conover v. Mers* (1873), 6 Fisher, 506; 11 Blatch. 197.

That no profits should be charged on work for which the defendants cannot collect their pay, see *American Nicholson Pavement Co. v. City of Elizabeth* (1874), 6 O. G. 764; 1 Bann. & A. 439.

³ That an increase in comfort or convenience is not a profit, see *Vaughn v.*

rectly traceable to the employment of the patented invention, excluding all contingent or remote advantages whose dependence upon the infringing act is open to a reasonable doubt, and, therefore, may be due to other causes.⁴

§ 1147. Computation of Profits where the Infringement Consists in the Use, or Manufacture and Use, of the Patented Invention: Ascertainment of Receipts from the Unlawful Use of the Invention.

In estimating the proportion of receipts which are chargeable to the defendant as the profits arising from his use of the invention, the same general methods are pursued as in cases of unlawful sales. Such receipts consist either of compensation paid to the infringer for his use of the invention, or of prices obtained by him for products made by the infringing process or device. Where the receipts are compensation for his unlawful use of the invention, their gross amount less the expenses which attend the use are the profits due to the infringement.¹ Among these expenses are to be allowed

Central Pacific R. R. Co. (1877), 4 Sawyer, 280; 3 Bann. & A. 27.

⁴ In *Piper v. Brown* (1873), 3 O. G. 97, Shepley, J. : (98) "Where profits are recoverable by the owner of a patented invention against an infringer, they are such profits or gains as result directly or immediately from the wrongful act of the infringer. Remote and contingent profits or gains, depending upon the result of successful schemes or investments, are never allowed. The resultant profits are, ordinarily, best arrived at by determining the difference between the actual ascertained cost and the actual ascertainable value to the infringer, which value, in case of sales by him is the price obtained or the market value of the thing sold. Profits contingent upon future bargains or speculations, or future states of the market, are not estimated and are not recoverable. The distinction between such profits as are direct and immediate and

those which are remote and contingent is recognized in *Masterton v. Mayor of Brooklyn*, 7 Hill, 61, and the *Philadelphia, W. and B. Railroad v. Howard*, 13 Howard, 307." Holmes, 196 (197); 6 Fisher, 240 (241).

That where a large amount of merchandise is withdrawn from the market by the use of the patented process and the price of the remainder is thereby enhanced, the effect is too remote to be estimated upon as indicating profits, see *Piper v. Brown* (1873), 3 O. G. 97; Holmes, 196; 6 Fisher, 240.

§ 1147. ¹ The profits made by the sale of an infringing article, and the profits made where an exact sum is received as compensation for an infringing use, are practically identical in character and in their relation to the patented invention. In the former the invention is used as a means of obtaining a compensation measured by the difference between cost and receipts, in

the cost of the infringing device or of the materials consumed in the process, the sums paid for power, labor, salaries, and shop-rent, the value of the use of buildings, tools, and other property necessary to the performance of the infringing act, the current running expenses of the enterprise, and the loss by waste; but not the value of the time and skill of the infringer, nor any loss he may sustain in other branches of his business or in other employments of the patented invention.

§ 1148. Computation of Profits where the Infringement Consists in the Use, or Manufacture and Use, of the Patented Invention: Ascertainment of Receipts from the Sale of Products made by the Unlawful Use of the Invention.

When the receipts consist of prices obtained by the defendant for products made by the infringing process or device, inquiry must be first directed to the degree in which the market value of the product depends on the employment of the patented invention. Where the complete product is produced in marketable condition by the infringing art or instrument, or where although containing other elements its entire market value is derived from those which have resulted from the infringing process or device, the total receipts are evidently due to the unlawful use of the invention. But where these elements bestow upon the product a mere fraction of its market value, a division of the price obtained for the whole product must be effected, in the ratio of the market values due to these and to the extraneous elements, and only the amount attributable to the former must be regarded as

the latter the act of using the invention is sold for a specific price. The cost of making and marketing the article is the equivalent of the cost of performing the act of using; the profit on the article sold is the equivalent of the price received for the infringing use. The rules governing the charges and allowances in the account are, therefore, the same, so far as the different methods of infringement permit. Whatever expense is incurred by the defendant in performing

the act of using should be credited to him, and against it should be debited the specific sum received for the infringement. (See § 1139 and notes, *ante*, for these items in detail.) The only doubt attaches to the allowance of the cost of the infringing device, which still remains his property though he is unable to employ it, and which though an expense involved in the performance of the act of using is not one properly chargeable against the plaintiff.

received from the infringement.¹ Deducting from these receipts the expense of applying the invention to the manufacture of the product and its proportion of the cost of marketing, including the rental of the necessary buildings, the sums paid for machinery, power, materials, wages, storage, freight, and commissions, the value of the use of tools, repairs, waste, and a proper share of the current expenses of the business, the remainder constitutes that part of the receipts which may contribute toward the profits arising from the use of the invention.² If it appears at this stage of the computation that no profit has accrued to the defendant which can be carried to the credit of the patented invention, the inquiry into his receipts will terminate, unless the presence of the elements due to the infringing instrument or process has increased the sale of his products to a definitely measurable extent, in which case all the profit from such increment of sales must be attributed to the use of the invention.³ The net amount received from the unlawful use of the invention having been thus ascertained, the present rule seems to require that a comparison next be instituted between this net amount and that which would have been received by the de-

§ 1148. ¹ That the amount of the profits due to the use of the precise invention in question must be separated and distinguished from all others, see *Faulks v. Kamp* (1882), 22 O. G. 2244 ; 10 Fed. Rep. 675 ; *Kirby v. Armstrong* (1881), 19 O. G. 661 ; 10 Bissell, 135 ; 5 Fed. Rep. 801 ; *Garretson v. Clark* (1879), 16 O. G. 806 ; 4 Bann. & A. 536 ; *Garretson v. Clark* (1878), 14 O. G. 485 ; 15 Blatch. 70 ; 3 Bann. & A. 352 ; *Buerk v. Imhaeuser* (1876), 10 O. G. 907 ; 14 Blatch. 19 ; 2 Bann. & A. 452 ; *Robertson v. Blake* (1876), 94 U. S. 728 ; 11 O. G. 877.

That where the invention is an improvement the profits due to it must be separated from those due to the original, see *Kirby v. Armstrong* (1881), 19 O. G. 661 ; 10 Bissell, 135 ; 5 Fed. Rep. 801 ; *Garretson v. Clark* (1878), 14 O. G. 485 ; 15 Blatch. 70 ; 3 Bann. & A. 352 ;

Gould's Mfg. Co. v. Cowing (1874), 1 Bann. & A. 375 ; 8 O. G. 277 ; 12 Blatch. 243 ; *Graham v. Mason* (1872), 1 O. G. 609 ; *Holmes*, 88 ; 5 *Fisher*, 290.

That if the plaintiff's patent covers all that is meritorious in the device used by the defendant, the plaintiff should recover all that the defendant has made, while if other improvements contributed to it an allowance must be made for them, see *Hurlburt v. Schillinger* (1889), 130 U. S. 456 ; *American Nicholson Pavement Co. v. City of Elizabeth* (1874), 6 O. G. 764 ; 1 Bann. & A. 439.

² For the items allowed as the cost of manufacturing, see § 1139 and notes, *ante*.

³ For the rules governing profits arising from an increase of sales, see § 1062 and notes, *ante*.

fendant had he employed, in place of the infringing article or art, some instrument or process which was open to the public before the conception of the patented invention.⁴ If no such open process or device existed by which the product could have been produced, the net amount, arrived at as above described, is chargeable to the defendant as a profit for which he must account to the plaintiff. But if this open process or device would have produced a product substantially identical with that already made and sold by the defendant and having market value, the difference between the net amount arising from the sale of such a product and the net amount received by the defendant indicates the profit which he has derived from the infringement, through the sale of products made by his unlawful use of the invention.⁵

§ 1149. Computation of Profits where the Infringement Consists in the Use, or Manufacture and Use, of the Patented Invention: Ascertainment of Savings.

The profit derived through savings is less susceptible of direct computation than that accruing through receipts. A saving in the expense of manufacturing and marketing a product is included in the estimate of the profits resulting from its sale.¹ If its cost and price are equal, as the product is actually made and sold, a saving in the cost is an escape from an amount of loss equivalent to the saving, and under the presumption that at all events the product would have been

⁴ That the infringer of a process must account for the advantage derived from it over what he would have obtained without it, but not for all the profits of the manufacture, see *Mowry v. Whitney* (1872), 14 Wall. 620; 1 O. G. 492; 5 Fisher, 494.

See, also, as to the same subject, §§ 1062, 1145, and notes, *ante*.

⁵ That the true rule would, in this case, give the entire net amount of profit to the plaintiff, unless the process or device were a mere improvement on the one open to the public, see § 1062, note 7, *ante*.

§ 1149. ¹ That advantage in the re-

duction of cost is a profit, see *Knox v. Great Western Quicksilver Mining Co.* (1878), 14 O. G. 897; 6 Sawyer, 430; 4 Bann. & A. 25.

That savings in cost by infringement may be recovered as profits, see *Campbell v. James* (1880), 18 O. G. 1111; 18 Blatch. 92; 2 Fed. Rep. 338; 5 Bann. & A. 354; *Herring v. Gage* (1878), 15 Blatch. 124; 3 Bann. & A. 396; *Tilghman v. Mitchell* (1871), 4 Fisher, 599; 9 Blatch. 1.

That a saving is not a profit unless it increases a gain or diminishes a loss, see *Bell v. U. S. Stamping Co.* (1887), 32 Fed. Rep. 549.

produced and put upon the market, is properly regarded as a profit.² But where the business carried on by the defendant is of a general character, consisting not in the manufacture of specific products but in service to the public, and the saving is distributed over numerous items in the cost of the whole enterprise, while it may be perfectly apparent that the defendant has been benefited largely by the use of the invention, the amount of his pecuniary advantage may be beyond the possibility of exact discovery or calculation. What can be shown in such cases, either by direct evidence or by fair inference from the nature of the enterprise and the general effect of the employment of the patented invention on its profits as a whole, to have been saved by the infringement, is to be credited to the plaintiff as his profit. And where the enterprise has been conducted at a loss, any excess of loss which would have been incurred without the use of the infringing art or instrument is also to be reckoned as a profit and accounted for by the defendant.³

² That profits are recoverable for the improvement though the whole device was unprofitable, see *Graham v. Mason* (1872), 5 Fisher, 290; 1 O. G. 609; *Holmes*, 88.

³ In *Elizabeth v. Pavement Co.* (1878), 97 U. S. 126, Bradley, J.: (138) "But one thing may be affirmed with reasonable confidence, that if an infringer of a patent has realized no profit from the use of the invention, he cannot be called upon to respond for profits; the patentee, in such a case, is left to his remedy for damages. It is also clear that a patentee is entitled to recover the profits that have been actually realized from the use of his invention, although, from other causes, the general business of the defendant, in which the invention is employed, may not have resulted in profits,— as where it is shown that the use of his invention produced a definite saving in the process of a manufacture. (*Mowry v. Whitney*, 14 Wall. 434; *Cawood Patent*, 94 U. S. 695.) On the contrary, though the defendant's

general business be ever so profitable, if the use of the invention has not contributed to the profits, none can be recovered. The same result would seem to follow where it is impossible to show the profitable effect of using the invention upon the business results of the party infringing. It may be added, that where no profits are shown to have accrued, a court of equity cannot give a decree for profits, by way of damages, or as a punishment for the infringement. (*Livingston v. Woodworth*, 15 How. 559.) But when the entire profit of a business or undertaking results from the use of the invention, the patentee will be entitled to recover the entire profits, if he elects that remedy. And in such a case, the defendant will not be allowed to diminish the show of profits by putting in unconscionable claims for personal services or other inequitable deductions. *Rubber Co. v. Goodyear*, 9 Wall. 788."

Further, that profits may exist though the business is generally unprofitable,

§ 1150. Burden of Proof on the Plaintiff to Show the Amount of Receipts or Savings.

Whether an estimate of profits proceeds upon the basis of receipts or savings, it is the duty of the plaintiff to establish their existence and amount by reliable and tangible proof. The difficulty in procuring testimony by which this can be done may be insuperable, but no dilemma of the plaintiff warrants the master or the court in arbitrarily assuming any other measure of the profits than that which is determined by the evidence.¹ Each stage of the computation must be reached by arithmetical processes employing data furnished by the testimony, and fixing that proportion of receipts or savings which is due to the infringing use of the invention; and what the plaintiff cannot thus disclose he cannot claim as profits.² The presumptions of law are, however, in his favor in all cases of wilful infringement, and the rule requiring complete proof will not be strained against him. If from the data furnished a reasonable calculation can be made, he will not be denied relief upon the ground that a higher degree

see *Tilghman v. Proctor* (1888), 125 U. S. 136; 43 O. G. 628; *Knox v. Great Western Quicksilver Mining Co.* (1878), 14 O. G. 897; 6 Sawyer, 430; 4 Bann. & A. 25; *Illinois Central R. R. Co. v. Turrill* (1876), 94 U. S. 695; 12 O. G. 709; *Mers v. Conover*, (1876), 11 O. G. 1111; *Conover v. Mers* (1873), 6 Fisher, 506; 11 Blatch. 197; *Hitchcock v. Tremaine* (1872), 5 Fisher, 310; 9 Blatch. 385.

§ 1150. ¹ As to the duty of the plaintiff in proving the amount of profits, and the evidence on which the computation must be based, see § 1143, and notes, *ante*, and § 1157 and notes, *post*.

² That the plaintiff must apportion the defendant's profits, and show how much resulted from his own invention by reliable and tangible proof, or else he must show that all the profits were due to his invention, see *Calkins v. Bertrand* (1881), 8 Fed. Rep. 755; 10

Bissell, 445; *Kirby v. Armstrong* (1881), 5 Fed. Rep. 801; 19 O. G. 661; 10 *Bissell*, 135.

That where the patent covers only one feature of the defendant's device the proof must separate the profit due to the patented invention, or only nominal damages can be awarded, see *Tuttle v. Gaylord* (1886), 28 Fed. Rep. 97; 36 O. G. 694; *Garretson v. Clark* (1884), 111 U. S. 120; 27 O. G. 524; *Schillinger v. Gunther* (1878), 3 Bann. & A. 491; 14 O. G. 713; 15 Blatch. 303; *Black v. Munson* (1877), 14 Blatch. 265; 2 Bann. & A. 623.

That on a suit for infringing one Claim of a patent the plaintiff must confine the profits to the Claim infringed, and cannot show that the invention as an entirety was better and more profitable than any other in use, unless its whole advantage resided in the feature embraced in this Claim, see *Fischer v. Hayes* (1884), 22 Fed. Rep. 529.

of certainty might be desirable, especially where the uncertainty arises from the defendant's concealment or neglect.³

§ 1151. Computation of Profits from Subordinate Methods of Infringement: Commissions on Sales: Repairs, &c.

Profits may be derived from the unlawful use of an invention in other ways, subordinate to those already noticed. A defendant who does not manufacture the infringing article or sell it on his own account, but on commission, receives therefrom a profit measured by the amount of the commission less that proportion of his general expenses which constitutes the cost of sale.¹ Wages received for the repairing of infringing articles or of their integral parts, deducting the expense incurred by the repairer, but not the value of his personal services, may leave a residue of profit which should be credited to the invention.² But where the purchaser of an infringing article pays to the wrongful maker and vendor the same price which the plaintiff would have charged, the advantages derived from its enjoyment contain no element of profit due to the infringement, the lawful and unlawful use of the invention resulting in the same measure of expense and benefit to the defendant, whose liability for the infringing use is therefore in the form of damages, and not of profits.³

³ That reasonable certainty is all that is required from the plaintiff, where the facts are peculiarly within the defendant's knowledge, see *Creamer v. Bowers* (1888), 35 Fed. Rep. 206; *Lewis v. Standard Laundry Mach. Co.* (1883), 21 Blatch. 184.

That the doctrine of confusion of goods does not apply where there is mere confusion of accounts and the articles themselves cannot be mixed, see *National Car Brake Shoe Co. v. Terre Haute Car Mfg. Co.* (1884), 28 O. G. 1007; 19 Fed. Rep. 514.

That an infringer is liable for all the profits on an article used as an entirety unless he can show that a part resulted from the employment of something else, see *Elizabeth v. Pavement Co.* (1877), 97 U. S. 126.

§ 1151. ¹ That one who sells upon commission is accountable for his commissions on his sales, and may be enjoined, when he makes a profit distinct from that of his employers, see *Steiger v. Heidelberger* (1880), 4 Fed. Rep. 455; 18 O. G. 1463; 18 Blatch. 426.

That a commission agent may be sued for infringement in one district though a suit may be pending against his principal in another, see *Steiger v. Heidelberger* (1880), 18 O. G. 1463; 4 Fed. Rep. 455; 18 Blatch. 426.

² That the profits made by repairing infringing devices, or on parts sold for such repairs, are to be accounted for, see *Graham v. Mason* (1872), 1 O. G. 609; *Holmes*, 88; 5 *Fisher*, 290.

³ That where a city hired infringing contractors to pave, and paid them as

§ 1152. Computation of Profits as Determined by the Duration of the Infringement: Interest.

The plaintiff is entitled to recover all profits derived by the defendant through his infringing acts, from the date of the issue or re-issue of the patent to the date of the accounting, irrespective of the price paid by the plaintiff for the patent or the royalties due from him to his licensor.¹ Whether he can recover interest on such profits, and if so for what period it must be computed, depends upon the mode in which the profits have accrued. In certain cases where profits are taken as a measure of damages in a court of law they are treated as unliquidated until ascertained by verdict, and,

much as it would have had to pay the plaintiff, it was held that the city had made no profit, and was liable for none, but might be liable in damages, see *Elizabeth v. Pavement Co.* (1877), 97 U. S. 126.

§ 1152. ¹ That when the bill limits the time of the infringement the account cannot go beyond it, see *Creamer v. Bowers* (1888), 35 Fed. Rep. 206.

That profits are to be accounted for to the time of taking the account, however derived from the invention, see *Knox v. Great Western Quicksilver Mining Co.* (1878), 14 O. G. 897; 6 Sawyer, 430; 4 Bann. & A. 25; *Tatham v. Lowber* (1857), 4 Blatch. 86.

That the value of an infringement is its value at the date of infringement, see *National Car Brake Shoe Co. v. Terra Haute Car Mfg. Co.* (1884), 28 O. G. 1007; 19 Fed. Rep. 514.

That when the patent was antedated under the Act of 1836, the defendant was liable for all profits after the time to which it was antedated, see *Burdett v. Estoy* (1880), 3 Fed. Rep. 566; 19 Blatch. 1; 5 Bann. & A. 308.

That where the Supreme Court has held the patent invalid and has afterwards sustained it, the infringer is liable for profits arising from his use of

the invention after the first decision, see *Tilghman v. Proctor*, (1888), 125 U. S. 136; 43 O. G. 628.

That an account for profits accruing after the suit commenced will be ordered only where the infringement began before the suit and was continued afterwards, see *Marsh v. Nichols* (1888), 128 U. S. 605.

That an assignee can recover the entire profits whatever royalty arrangements he may have with the patentee, see *Elizabeth v. Pavement Co.* (1877), 97 U. S. 126.

That the amount paid by other persons for past infringements is no guide to the profits now to be awarded, see *Rude v. Westcott* (1889), 130 U. S. 152; *Cornely v. Marckwald* (1889), 131 U. S. 159; *Westcott v. Rude* (1884), 19 Fed. Rep. 830; 27 O. G. 719.

That the profits are to be accounted for without reference to the usual royalty, see *Williams v. Rome, Watertown & Ogdensburgh R. R. Co.* (1880), 2 Fed. Rep. 702; 17 O. G. 1447; 18 Blatch. 181; 5 Bann. & A. 423; *Wooster v. Taylor* (1878), 14 Blatch. 403; 3 Bann. & A. 241; *Knox v. Great Western Quicksilver Mining Co.* (1878), 14 O. G. 897; 6 Sawyer, 430; 4 Bann. & A. 25.

therefore, not subject to interest.² But in equity, profits are regarded as a debt due by the defendant to the plaintiff from the time when they appear as money or as money value in the hands of the defendant, and consequently bear interest from that time until the date of payment.³ Thus where the defendant receives the price for products sold, such a proportion of that price as represents the profit due to the infringement is the property of the plaintiff, and interest should be allowed thereon while it remains in the possession of the defendant.⁴ Where the profit results from savings which do not enter into the cost of products sold, and are not recognized as money or as its equivalent until the annual balance of accounts, the computation of interest on the savings may then properly begin.⁵ Upon these questions the decisions are not uniform; but the principle is clear, and if the distinctions between the profits arising from different modes of infringement are kept in mind, its application presents little difficulty.⁶ Interest on the entire sum found by the

² For the rule regarding interest on damages in actions at law, and on profits when taken as the measure of such damages, see § 1066 and notes, *ante*.

³ That profits are not regarded as unliquidated damages, see *Jenkins v. Greenwald* (1857), 2 Fisher, 37; 1 Bond, 126.

That in equity the profits of an infringement are not damages, but money had and received, and are a claim against the bankrupt estate of the infringer, see *Watson v. Holliday* (1882), L. R. 20 Ch. D. 780; *contra*, *Gordon v. St. Paul Harvester Works* (1885), 23 Fed. Rep. 147; *In re Boston & Fairhaven Iron Works* (1885), 23 Fed. Rep. 880.

⁴ That profits bear interest from the time they were unlawfully detained, see *Burdett v. Estey* (1880), 3 Fed. Rep. 566; 19 Blatch. 1; 5 Bann. & A. 308.

That interest on royalties is allowed from the date of the infringement to the date of the decree, see *Locomotive Safety*

Truck Co. v. Pennsylvania R. R. Co. (1880), 2 Fed. Rep. 677; 5 Bann. & A. 514; 14 Phila. 432.

⁵ That in some cases interest is to be computed each year on the profits, see *Tilghman v. Mitchell* (1871), 4 Fisher, 599; 9 Blatch. 1.

⁶ Among the statements of the courts on this subject are the following, most of which will, however, be found reconcilable with the doctrine laid down in the text, if the exact facts in issue are carefully examined:

That interest is not allowed on profits any more than on unliquidated damages, see *Illinois Central R. R. Co. v. Turrill* (1884), 110 U. S. 301; 26 O. G. 917; *Locomotive Safety Truck Co. v. Penna. R. R. Co.* (1880), 14 Phila. 432; 2 Fed. Rep. 677; 5 Bann. & A. 514; *Parks v. Booth* (1880), 102 U. S. 96; 17 O. G. 1089.

That interest may be allowed as damages, though damages do not carry interest as such, as where a sum became

master to be due as profits is reckoned from the date of his report, or from the time at which the account is terminated.⁷ Counsel fees and other expenses of litigation are not included in the estimate of profits.⁸ Profits cannot be trebled by the court as damages may be.⁹

§ 1153. Liability of Infringer to Account: Partial Liability of Several Infringers: Corporate Liability.

The defendant is equally liable for the profits whether the invention is adapted to general use or is available only in his own personal or official occupation.¹ Though he is the mere

due properly before judgment, see *Bates v. St. Johnsbury & L. C. R. R. Co.* (1887), 32 Fed. Rep. 628.

That profits are really damages and are unliquidated until the decree, see *Mowry v. Whitney* (1872), 14 Wall. 620; 5 Fisher, 494; 1 O. G. 492.

That interest is not to be computed on profits unless under special circumstances, see *Parks v. Booth* (1880), 102 U. S. 96; 17 O. G. 1089; *Holbrook v. Small* (1878), 17 O. G. 55; 3 Bann. & A. 625; *Brady v. Atlantic Works* (1878), 15 O. G. 965; 3 Bann. & A. 577; *American Nicholson Pavement Co. v. City of Elizabeth* (1874), 6 O. G. 764; 1 Bann. & A. 439.

That interest on profits is not allowed before the decree, especially when the defendant has acted in good faith under his own patent, see *Mowry v. Whitney* (1872), 14 Wall. 620; 5 Fisher, 494; 1 O. G. 492.

That interest is to be allowed on profits to the date of the master's report, see *Tatham v. Lowber* (1857), 4 Blatch. 86.

That interest is to be allowed on profits from the time of the interlocutory decree, see *Steam Stone Cutter Co. v. Windsor Mfg. Co.* (1879), 17 Blatch. 24; 4 Bann. & A. 445.

⁷ That interest should be allowed on profits from the time the report is in

proper form for exceptions, see *Tilghman v. Proctor* (1888), 125 U. S. 136; 43 O. G. 628; *Illinois Central R. R. Co. v. Turrill* (1884), 110 U. S. 301; 26 O. G. 917; *Turrill v. Illinois Central R. R. Co.* (1880), 20 Fed. Rep. 912.

⁸ That counsel fees are not allowed in assessing damages or profits, see *Parks v. Booth* (1880), 102 U. S. 96; 17 O. G. 1089; *Philp v. Nock* (1873), 17 Wall. 460; *Teese v. Huntingdon* (1859), 23 How. 2; *Blanchard's Gun Stock Turning Factory v. Warner* (1848), 1 Blatch. 258; *Stimpson v. Railroads* (1847), 1 Wall. Jr. 164; 2 Robb, 595; *Boston Mfg. Co. v. Fiske* (1820), 2 Mason, 119; 1 Robb, 320; *Whittemore v. Cutter* (1813), 1 Gallison, 429; 1 Robb, 28.

⁹ That profits cannot be trebled as damages may, see *Holbrook v. Small* (1878), 17 O. G. 55; 3 Bann. & A. 625.

§ 1153. ¹ That although the invention was useless except to the defendant, and he might use it or not as he chose without materially affecting his business, he is still liable for profits, see *Campbell v. James* (1880), 18 O. G. 1111; 18 Blatch. 92; 2 Fed. Rep. 338; 5 Bann. & A. 854.

That if an officer of the government voluntarily uses an invention, which is of no value except for governmental purposes, he must account for the

delegate of a superior authority, to whom all his receipts are payable, yet if the infringement is his voluntary act he must account for its advantages even where he has paid the entire sum to his superior.² Where there are several defendants, some of whom are interested in the enterprise during a portion only of the period of the infringement, their liability for profits is limited to the amount accruing while they were engaged in the infringing acts.³ Profits received by one corporation are not collectible from its successor, whatever may be their identity of enterprise or membership.⁴ The death of an infringer does not bar the right of the owner of the patent to an account from his estate, and if his death occur during the action a bill of revivor will continue the proceedings against his personal representative.⁵ After a decree for profits the defendant cannot be enjoined from paying them to the plaintiff, at the suit of a third party who claims to be the owner of the patent.⁶ A plaintiff, being the sole owner of

profits, see *Campbell v. James* (1880), 18 O. G. 1111; 18 Blatch. 92; 2 Fed. Rep. 338; 5 Bann. & A. 354.

That where the United States is the real defendant, and has made no profits to itself except by saving expense otherwise to be incurred, its officers are liable, see *Campbell v. James* (1880), 18 O. G. 1111; 18 Blatch. 92; 2 Fed. Rep. 338; 5 Bann. & A. 354.

² That although the defendant, as an officer of the United States, has paid over the savings to the government, he is still liable, see *Campbell v. James* (1880), 18 O. G. 1111; 18 Blatch. 92; 2 Fed. Rep. 338; 5 Bann. & A. 354.

But see as to the foregoing case *James v. Campbell* (1882), 104 U. S. 356; 21 O. G. 337.

³ That if not all the defendants are infringing during the whole time, the profits are to be apportioned accordingly, see *Tatham v. Lowber* (1857), 4 Blatch. 86.

That when a copartnership consisted of three members profits were awarded against the three jointly, up to the time

when one retired, then against the remaining two, though a new partner had been taken in who was not made a defendant, see *Herring v. Gage* (1878), 15 Blatch. 124; 3 Bann. & A. 396.

⁴ That a defendant corporation is not accountable for the profits made by a preceding corporation, see *Sayles v. Dubuque & Sioux City R. R. Co.* (1878), 5 Dillon, 561; 3 Bann. & A. 219.

⁵ That the estate of an infringer is liable for profits after his death, see *Smith v. Baker's Adm'rs* (1874), 5 O. G. 496; 10 Phila. 221; 1 Bann. & A. 117.

That a bill of revivor will lie where the infringer dies pending suit, see *Hohorst v. Howard* (1888), 37 Fed. Rep. 97; *Kirk v. DuBois* (1886), 28 Fed. Rep. 460; 37 O. G. 102; *Smith v. Baker's Adm'rs* (1874), 5 O. G. 496; 10 Phila. 221; 1 Bann. & A. 117.

⁶ That a defendant, after a decree for profits, cannot be enjoined from paying such profits to the plaintiff, upon the motion of a third party who claims title to the patent adversely to the

the patent, may recover the whole profits, though they belong to him in common with his partners by virtue of the partnership agreement.⁷

§ 1154. Damages in Equity.

Damages, as such, were not recoverable in equity in cases of infringement until the act of 1870, which conferred upon the Circuit courts the power to award them in addition to the profits. The purpose of this act was to afford the plaintiff adequate compensation for his injury in actions in equity, although the evidence on the accounting might show that the defendant had made no profits, or that the profits which he had received were insufficient to cover the whole loss that the plaintiff had sustained, and thus relieve him from the necessity of discontinuing his equitable proceedings and seeking his redress in damages at law.¹ Construing the act in this

plaintiff, see *Secombe v. Campbell* (1880), 5 Fed. Rep. 804; 5 Bann. & A. 632.

⁷ That the plaintiff may recover profits, though part of them may belong to his copartners in business, he being owner of the patent, see *Sargent v. Yale Lock Mfg. Co.* (1879), 17 Blatch. 244; 4 Bann. & A. 574; 17 O. G. 105.

§ 1154. ¹ That prior to the act of July 8, 1870, profits and damages were not recoverable in a single suit, but the former might be obtained in equity, the latter at law, see *Willimantic Thread Co. v. Clark Thread Co.* (1886), 27 Fed. Rep. 865; *Williams v. Leonard* (1872), 9 Blatch. 476; 5 Fisher, 381; *Perry v. Corning* (1870), 7 Blatch. 195; *Livingston v. Jones* (1861), 2 Fisher, 207; 3 Wall. Jr. 330.

That the act of 1870 (Sec. 4921, Rev. Stat.), authorizes equity to give damages as well as profits, see *Willimantic Thread Co. v. Clark Thread Co.* (1886), 27 Fed. Rep. 865.

That the act of 1870 enlarged equity jurisdiction by allowing damages in ad-

dition to profits to be recovered, but did not restrict the right to recover for any gains, savings, or advantages recoverable before, see *Coburn v. Schroeder* (1881), 20 O. G. 1085; 8 Fed. Rep. 521; 19 Blatch. 493.

That Sec. 55, act of 1870, merely confers on a court of equity the power to award or multiply damages, in addition to its decree for an account, see *Root v. Lake Shore & Michigan Southern R. R. Co.* (1882), 105 U. S. 189; 21 O. G. 1112.

That the right to recover damages as well as profits does not rest wholly on Sec. 4921 of the Revised Statutes, see *Coburn v. Schroeder* (1881), 20 O. G. 1085; 8 Fed. Rep. 521; 19 Blatch. 493.

That on a bill in equity brought before July 8, 1870, no damages beyond the actual profits of the defendant could be recovered, see *American Nicholson Pavement Co. v. City of Elizabeth* (1874), 6 O. G. 764; 1 Bann. & A. 439.

That no damages are recoverable in a suit in equity begun before July 8, 1870, though a supplemental bill is filed and a re-issue granted after that date, see

spirit, the courts have held that wherever the plaintiff has suffered an injury by the infringement greater than the amount of profits made by the defendant, whether because the defendant has made no profits or less than a fair profit through his unskillfulness or unwise conduct of his business, or because the wrongs inflicted on the plaintiff lie outside the scope of the mere loss of profits on the patented invention, the plaintiff is entitled to recover in excess of profits such a sum in damages as, taken with the profits, will give him complete compensation for the injury.² The rule of damages in equity is otherwise the same with that at law.³ Their amount must

Sarven v. Hall (1872), 5 Fisher, 415 ; 1 O. G. 437 ; 9 Blatch. 524.

That the provisions of the act of July 8, 1870, apply to suits begun after that date for injuries previously committed, see *Union Paper Bag Mach. Co. v. Newell* (1873), 6 Fisher, 582 ; 5 O. G. 173 ; 11 Blatch. 379.

² That profits and savings are still the measure of recovery in equity unless the extent of the plaintiff's loss requires an additional allowance of damages, see *Willimantic Thread Co. v. Clark Thread Co.* (1886), 27 Fed. Rep. 865 ; *Birdsall v. Coolidge* (1876), 93 U. S. 64 ; 10 O. G. 748.

That if the profits do not fully compensate the plaintiff, damages may be awarded in addition; see *Simpson v. Davis* (1884), 22 Fed. Rep. 444 ; 22 Blatch. 113 ; *Brady v. Atlantic Works* (1878), 3 Bann. & A. 577 ; 15 O. G. 965 ; *Birdsall v. Coolidge* (1876), 93 U. S. 64 ; 10 O. G. 748 ; *Buerk v. Imhaeuser* (1876), 10 O. G. 907 ; 14 Blatch. 19 ; 2 Bann. & A. 452 ; *Carew v. Boston Elastic Fabric Co.* (1871), 1 O. G. 91 ; 3 Clifford, 356 ; 5 Fisher, 90.

That damages may be recovered in equity though the defendant made no profit, see *Yale Lock Co. v. Sargent* (1886), 117 U. S. 536 ; 35 O. G. 497 ; *Burdett v. Estey* (1880), 19 Blatch. 1 ; 3 Fed. Rep. 566 ; 5 Bann. & A. 308.

That where the defendant conducts his business so carelessly as to make no profits, damages may be allowed, see *Brady v. Atlantic Works* (1878), 3 Bann. & A. 577 ; 15 O. G. 965 ; *Marsh v. Seymour* (1877), 97 U. S. 348 ; 13 O. G. 723.

That where the defendant made no profits because he reduced his prices in order to drive the plaintiff from the market, damages may be awarded, see *Brady v. Atlantic Works* (1878), 3 Bann. & A. 577 ; 15 O. G. 965.

That a decree for profits does not authorize the allowance of damages, see *Livingston v. Woodworth* (1853), 15 How. 546.

That where the plaintiff cannot show any advantage in the use of his invention over others which are open to the public, he cannot recover profits though he may recover damages, see *Locomotive Safety Truck Co. v. Pennsylvania R. R. Co.* (1880), 2 Fed. Rep. 677 ; 5 Bann. & A. 514 ; 14 Phila. 432.

That only net profits are allowed and no damages where the infringement was not wilful or malicious, see *Ford v. Kurtz* (1882), 12 Fed. Rep. 789 ; 11 Bissell, 324.

³ For the rule of damages at law and evidence thereon, see §§ 1049-1071 and notes, *ante*.

be established by evidence, not conjectured; and the court, if it deem necessary, may treble them.⁴ Interest cannot be reckoned till after the decree.⁵ On a bill *pro confesso* nominal damages may be awarded, where neither damages nor profits can be proved.⁶

§ 1155. Account Ordered if Infringement Proved: By whom Taken.

The defendant may be ordered to account whenever he has been found guilty of infringement. The fact that he has practised the invention raises a presumption that its use was beneficial, and this presumption is not overcome by an assertion in his answer that the infringement was unprofitable. Having for his own advantage unlawfully appropriated the property of the plaintiff, he must now incur the trouble and expense of a full disclosure of the enterprise, since if no gains or savings have been made an estimate and award of damages may be required.¹ An account, when ordered, is

⁴ That the damages must be proved by evidence, not left to conjecture, see *Ingersoll v. Musgrove* (1878), 13 O. G. 966; 14 Blatch. 541; 3 Bann. & A. 304.

That when the profits cannot be fixed by evidence they cannot be recovered as damages, see *Blake v. Greenwood Cemetery* (1883), 16 Fed. Rep. 676; 21 Blatch. 222.

That the court may treble the damages in equity as well as at law, see *Carew v. Boston Elastic Fabric Co.* (1871), 1 O. G. 91; 3 Clifford, 356; 5 Fisher, 90.

That where an infringement is flagrant the damages will be trebled, see *Lyon v. Donaldson* (1888), 34 Fed. Rep. 789.

That where the defendant evidently believed himself to be right, the court will not increase the damages on the ground that he fought vigorously, or refuse to increase them on the ground that the patent is apparently void where that claim was not made in due season

in the defence, see *Welling v. La Bau* (1888), 35 Fed. Rep. 302.

That if the patent is really void, though no such defence were made, the damages will not be increased, see *Welling v. La Bau* (1888), 35 Fed. Rep. 302.

⁵ That no interest is to be allowed on the damages until the date of the decree, see *American Nicholson Pavement Co. v. City of Elizabeth* (1874), 6 O. G. 764; 1 Bann. & A. 439.

That where a license fee is the measure of damages, interest on the amount may be allowed from the date of the interlocutory decree, see *Graham v. Geneva Lake Crawford Mfg. Co.* (1881), 24 Fed. Rep. 642; 32 O. G. 1603.

⁶ That where the bill is taken *pro confesso*, and on the reference to the master no satisfactory proof of damages and profits is given, the plaintiff can recover only nominal damages, see *Fisk v. West, Bradley, & Cary Mfg. Co.* (1880), 19 O. G. 545.

§ 1155. ¹ In *Andrews v. Creegan*

taken by a master appointed for that purpose by the court, who, having given notice to the parties or their counsel of the day fixed for the hearing, receives the evidence presented, and from it makes his computation of the profits which the defendant has received or the damage which the plaintiff has sustained. The failure of the defendant to appear at the day named for the accounting does not delay nor prevent the hearing, unless his evidence or his books are needed, in which case a continuance is granted and an order to be present at a certain future day is personally served upon him, followed by an attachment for contempt if he should then be absent.² When the master has arrived at his conclusions

(1881), 7 Fed. Rep. 477, Wheeler, J. : (478) "The defendant denies any profits, and insists that none are proved to lay the foundation of an accounting. None are proved beyond the presumption arising from the fact of the putting the well down so that it could be used. This would raise a presumption that there were, or might have been, some profits, and the allegation that the transaction was not profitable would not meet the presumption so as to defeat an accounting. The plaintiff would have the right to have the account taken, however it might result, left to him. Besides this, the act of 1870 (Rev. St. § 4921), provides for an accounting for damages as well as profits, and there may be damages to be accounted for in this case." 19 O. G. 1140 (1140); 19 Blatch. 113 (114). See also *Urner v. Kayton* (1883), 17 Fed. Rep. 539; 24 O. G. 1178; 21 Blatch. 428; *Motte v. Bennett* (1849), 2 Fisher, 642.

That an account may be ordered though no injunction or bond would be required, see *Smith v. Baker's Adm'rs* (1874), 5 O. G. 496; 1 Bann. & A. 117; 10 Phila. 221.

² In *Kerosene Lamp Heater Co. v. Fisher* (1880), 1 Fed. Rep. 91, Lowell, J. : (92) "The practice which we approve is this: The master appoints a

day for proceeding with the reference, and gives notice, by mail or otherwise, to the parties or their solicitors. We think the solicitor should be notified, whether the party is or not; though probably, under Rule 75, notice to the party is a good notice. If the defendant does not appear, the master proceeds, *ex parte*, and makes out the profits and damages, if he can, from the evidence produced by the plaintiff. If it appears that an account of profits is necessary to a just decision of the cause, and is desired by the plaintiff, he makes an order that the defendant furnish an account by a certain day, and adjourns the hearing to that day. The defendant should be served personally with a notice of this adjournment, and of the order to produce his account, if it is intended to move for an attachment in case he fails to appear. The service may be made by any disinterested person, and need not be by the marshal. If the defendant then fails to appear and account, he will be in contempt." 5 Bann. & A. 78 (79).

That a disclosure of gains and profits is incidental to an accounting under a decree in an infringement suit, see *Gordon v. Anthony* (1879), 16 O. G. 1135; 16 Blatch. 234; 4 Bann. & A. 248.

from the testimony they are embodied in a draft report, and filed in court or submitted to the parties. To this report the parties make objections as they deem advisable; and thereupon the master reconsiders the matter involved in such objections, modifies or affirms his previous conclusions, and in a final report presents them to the court. Either party may file exceptions to this report based on his previous objections, and may have the entire evidence as taken by the master laid before the court, and the court may then review the questions of fact as well as of law involved in the accounting, and recommit, or set aside, or alter, or reverse the report as in its judgment the law and evidence require.³ Throughout this proceeding the master must be guided by the terms of the decree which orders the account, and if these are ambiguous he may call upon the court for more definite instructions.⁴ It is his duty also to forward the accounting as rapidly as circumstances will permit, although the court may stay the hearing when the pendency of other suits in other jurisdictions between the same parties, or any facts within its knowledge, render such a stay desirable.⁵

³ Equity Rules 73-84.

⁴ That if the decretal order is ambiguous the master can report the case back for specific instructions, see *Union Sugar Refinery v. Matthiesson* (1868), 3 Clifford, 146.

That the master may act beyond the territorial jurisdiction of the court, and even in foreign countries, see *Bate Refrigerating Co. v. Gillette* (1886), 28 Fed. Rep. 673.

That the master must choose the best and cheapest method of taking evidence, see *Bate Refrigerating Co. v. Gillette* (1886), 28 Fed. Rep. 673.

⁵ That in a proper case properly presented the court may suspend a suit against the users until the suit against the maker is ended, since if the maker pays the user is not liable, provided it appears that the thing used is the very one for which the maker is sued, see *Allis v. Stowell* (1883), 16 Fed. Rep. 783.

That a suit against the dealer who sells will not be kept open indefinitely to await the decision of an appeal from a judgment in favor of the manufacturer, see *Grain Drill Mfg. Co. v. Reinstedler* (1885), 25 Fed. Rep. 198.

That where priority is in issue and an interference was declared, and three different and variant decisions were rendered in the Patent Office and the District court, and a bill for repeal is now pending in the Circuit court, the present case will be retained until the latter suit is tried and decided, see *Lockwood v. Cutter Tower Co.* (1882), 11 Fed. Rep. 724.

That an accounting will not be stayed on the ground that another case is pending in the Supreme Court on different issues, or that another court has held the patent invalid on different facts, see *Celluloid Mfg. Co. v. Comstock & Cheney Co.* (1886), 27 Fed. Rep. 358; 36 O. G. 1356.

§ 1156. Procedure in Taking an Account.

In taking the account the master has no right to consider the question of infringement or the scope and meaning of the patent, but must accept these matters as they have been already settled by the court.¹ All inquiries into the damages or profits resulting from the infringement are within his powers, and in pursuing these he may be led into numerous investigations as to the state of the art at the time of the invention, or other kindred subjects, and may inspect the articles sold or used by the defendant in connection with those covered by the patent for the purpose of determining what proportion of the defendant's gains or savings is attributable to the latter; but otherwise he has no occasion to explore their history or origin.²

§ 1156. ¹ That a master taking an account has no business with the question of infringement or the scope or extent of the patent, but must apply the principles laid down by the court, and though he may inspect the two devices he has no concern with their history, see *Turrill v. Illinois Central R. R. Co.* (1873), 5 Bissell, 344; *Whitney v. Mowry* (1870), 4 Fisher, 207.

That a decree finding infringement binds the master as to everything substantially like the infringing device, though he may inquire whether specific articles are covered by the decree, see *Wooster v. Thornton* (1886), 26 Fed. Rep. 274; 34 O. G. 560.

That a re-issue being sustained by the interlocutory decree or decree *pro confesso*, its validity or divergence from the original cannot be considered by the master, see *Thomson v. Wooster* (1885), 114 U. S. 104; 31 O. G. 913.

That in a suit on a re-issue the defendant cannot for the first time offer to the master, on the accounting, the original as evidence that the re-issue, if identical therewith, had not been infringed, see *Wooster v. Thornton*

(1886), 26 Fed. Rep. 274; 34 O. G. 560.

That on a bill for infringement against a railroad company for using the invention on other roads than their own under a license to use on roads "owned or operated" by them, the legal right of the defendants to operate such other roads cannot be questioned, see *Matthew v. Pennsylvania R. R. Co.* (1881), 8 Fed. Rep. 45.

That a decree in equity for profits only does not authorize the allowance of damages, see *Livingston v. Woodworth* (1853), 15 How. 546.

² That on the question of profits the state of the art at the date of the invention is always material, see *Locomotive Safety Truck Co. v. Pennsylvania R. R. Co.* (1880), 2 Fed. Rep. 677; 5 Bann. & A. 514; 14 Phila. 432.

That evidence may be offered before the master on an accounting to show that certain articles of the defendant did not embrace the infringing features, see *Welling v. La Bau* (1885), 23 Blatch. 305; 32 Fed. Rep. 293.

That all questions as to whether gains or savings are due to the infringement, and are to be accounted for, arise

§ 1157. Evidence on the Accounting.

The evidence admissible before the master is indicated by the rules which are to govern his estimate of the profits and the damages. The plaintiff must furnish sufficient testimony to enable him to arrive at definite conclusions, and cannot rely upon him to suggest what proof may be required.¹ The master must receive all relevant and material evidence, and by collating and comparing it must ascertain the data for his computation, and formulate their result in the award of a specific sum as damages or profits.² The plaintiff may compel the presence of the defendant, and the production of his books, and subject them to examination, but if the books disclose the sale or use of various articles, some of which may not have been covered by the patent, the plaintiff must by other testimony separate those by which his rights have been infringed.³ Admissions in the answer as to the extent

on the accounting, see *Coburn v. Schroeder* (1881), 20 O. G. 1085; 19 Blatch. 493; 8 Fed. Rep. 521.

That the confusion of accounts is not a confusion of the goods sold, and, as some may infringe while others do not, those which do must be separated by evidence, see *National Car Brake Shoe Co. v. Terre Haute Car & Mfg. Co.* (1884), 19 Fed. Rep. 514; 2 O. G. 1007.

That in taking the account the master is not limited to the date of entering the decree, but may extend it down to the time of hearing before him, see *Rogers v. Reissner* (1887), 39 O. G. 832; *Rubber Co. v. Goodyear* (1869), 9 Wall. 788.

That pending the accounting no suit at law for subsequent infringements by the same defendant can be brought without leave of the court, see *Morss v. Knapp* (1888), 35 Fed. Rep. 218.

§ 1157. ¹ That the plaintiff must furnish evidence enough to enable the master to make the computation, see *Brady v. Atlantic Works* (1878), 15 O. G. 965; 3 Bann. & A. 577.

That neither the master nor the court

are bound to suggest what proof is needed, but the plaintiff must furnish enough to show the profits or damages, see *Garretson v. Clark* (1879), 16 O. G. 806; 4 Bann. & A. 536.

² That the master is to sift out the evidence and get at the profits as best he may, see *Herring v. Gage* (1878), 15 Blatch. 124; 3 Bann. & A. 396.

³ That the master taking an account may examine the defendants and inspect their books, see *Brady v. Atlantic Works* (1878), 15 O. G. 965; 3 Bann. & A. 577.

That on a bill in equity for an account on a re-issue a *subpoena duces tecum* will issue to compel the defendants to produce all their books, etc., which can show the number of articles sold since the re-issue, see *Turrell v. Spaeth* (1875), 8 O. G. 986; 2 Bann. & A. 185.

That if the defendant's books are needed by the plaintiff he should move for them, or the case will not be sent back to the master for review, see *Fischer v. Hayes* (1883), 16 Fed. Rep. 469; 24 O. G. 304.

That where on the accounting the

of the infringement, and the benefits therefrom derived, are taken in their ordinary sense, and may be considered in determining the truth or falsehood of the testimony given by the defendant.⁴ The evidence must be positive and certain.⁵ The opinions of witnesses concerning the value of the invention to the defendant, or the amount of injury to the plaintiff, are of little weight.⁶ Evidence of sums paid in settlement or as license fees by other parties does not tend to show the profit made by the defendant, nor does it serve as any guide to the loss suffered by the plaintiff, unless the settlement was voluntary on both sides and for an exactly similar infringement, or unless the license fee is universally established.⁷ But the amount which the defendant has himself expended for other processes or instruments, performing

plaintiff testified to the cost of making and selling, the defendant has a right to the production of the plaintiff's books, though the plaintiff may refuse and withdraw the evidence already offered, see *Wisner v. Dodds* (1883), 14 Fed. Rep. 655.

⁴ That admissions in the answer are taken as usually understood and may be considered by the master, see § 1118 and notes, *ante*.

⁵ That the evidence must definitely fix the amount of profits, see *Ingersoll v. Musgrove* (1878), 13 O. G. 966; 14 Blatch. 541; 3 Bann. & A. 304.

That evidence not sufficiently definite to show the amount of profits will not warrant an award either of profits or of damages, see *Blake v. Greenwood Cemetery* (1883), 16 Fed. Rep. 676; 21 Blatch. 222.

⁶ That the mere opinion and estimate of two witnesses may not be sufficient to show the value of the use of the invention to the defendant, see *Sargent v. Yale Lock Mfg. Co.* (1879), 17 O. G. 106; 17 Blatch. 249; 4 Bann. & A. 579.

That the report cannot be sustained where the only evidence was the opinion of a witness that the amount awarded

could have been saved by the defendant, see *Munson v. City of New York* (1883), 16 Fed. Rep. 560; 21 Blatch. 342.

⁷ That the amount paid by others for past infringements is no guide to the profits due on the present one, see *Rude v. Westcott* (1889), 130 U. S. 152; *Cornely v. Marckwald* (1889), 131 U. S. 159; *United Nickel Co. v. Central Pacific R. R. Co.* (1888), 36 Fed. Rep. 186; *Westcott v. Rude* (1884), 19 Fed. Rep. 830; 27 O. G. 719.

That the recovery of one dollar damages, on a stipulation leaving that matter to the court on the evidence taken, is no guide to the value of the invention, see *Blake v. Greenwood Cemetery* (1883) 16 Fed. Rep. 676; 21 Blatch. 222.

That where the evidence before the master does not show an established license fee, and his finding is based upon damages not upon profits, reference to a settlement in another suit with different circumstances cannot be allowed, see *Greenleaf v. Yale Lock Mfg. Co.* (1879), 17 O. G. 625; 17 Blatch. 253; 4 Bann. & A. 583.

That profits cannot be measured by a license-fee but must be accounted for, see *Williams v. Rome, Watertown, & Ogdensburgh R. R. Co.* (1880), 2 Fed.

the same work or effecting the same saving as the patented invention, is a fair measure of its worth to him, and may, therefore, be proved.⁸ If the plaintiff's testimony supports his claims concerning the damages and profits, and the defendant has an opportunity to contradict or qualify it and he fails to do so, it is presumed to be impregnable.⁹ During the hearing the case is pending before the master and all papers must be filed with him and not in court.¹⁰ Objections to the evidence presented must also be taken to him as the evidence is offered, although he has no power to finally decide upon them, but must note both the objection and his ruling, to be reviewed in due time by the court.¹¹ Reference to the court as each question arises is improper.¹² The record of

Rep. 702; 17 O. G. 1447; 18 Blatch. 181; 5 Bann. & A. 423.

That damages may be shown by an established license fee, see *Cary v. Zell Mfg. Co.* (1889), 37 Fed. Rep. 354; *United Nickel Co. v. Central Electric R. Co.* (1888), 36 Fed. Rep. 187; also § 1059 and notes, *ante*.

That where a license fee is established with reference to the entire patent, and only certain Claims are infringed, the master must apportion the license fee according to the value of the Claims, if possible, unless the remaining Claims are merely structural, and the burden of proof is on the plaintiff to show the value of the infringed Claims, see *Willimantic Thread Co. v. Clark Thread Co.* (1886), 27 Fed. Rep. 865.

That the master must determine whether a license fee is the fair measure of the value of the invention, where the infringement took place before the license fee was established, see *Wcooster v. Thornton* (1886), 26 Fed. Rep. 274; 34 O. G. 560.

That on the question of profits evidence to show what open methods there are and their degree of advantage, is admissible, see *Black v. Thorne* (1874), 7 O. G. 176; 12 Blatch. 20; 1 Bann. & A. 155.

⁸ That the amount afterwards paid by the defendant for another device answering the same purpose as the plaintiff's may show the value of the latter to him, see *Sargent v. Yale Lock Mfg. Co.* (1879), 17 O. G. 106; 17 Blatch. 249; 4 Bann. & A. 574.

⁹ That where the plaintiff makes out a *prima facie* case as to the amount of profits and the defendant has an opportunity to vary it, but does not, the presumption is that he cannot, see *Lewis v. Standard Laundry Mach. Co.* (1883), 21 Blatch. 184.

¹⁰ That after a reference to a master for account, papers are to be given to him, and not filed in court except by special order, see *Union Sugar Refinery v. Matthiesson* (1868), 3 Clifford, 146.

¹¹ That objections to the rulings of the master on the admissibility of evidence must be taken when the ruling is made, see *Troy Iron & Nail Factory v. Corning* (1869), 3 Fisher, 497; 6 Blatch. 328.

¹² In *Lull v. Clark* (1884), 22 Blatch. 207, Coxe, J. : (208) "He [the master] occupies, for the time being, the position of the court, and is not to be continually interfered with while discharging his duties to the best of his ability. It would create intolerable de-

the proceedings, which accompanies his report, must bring them all at once to the attention of the court, that at the hearing on the exceptions all may be determined.¹³ After the draft report is filed no evidence can be received.¹⁴

§ 1158. **Exceptions to the Report of the Master concerning the Amount of Profits.**

Having submitted his draft report to the parties, and having heard their objections and reconsidered his conclusions, the master may file his final report at any time without an order from the court.¹ Exceptions to the final report cannot be made on any question which was closed by the decree referring the case to the master, nor on any ruling as to the admissibility of evidence, unless the objection was duly entered on the record, and was urged before the master after the filing of his draft report.² Errors not affecting the decisions

lays and confusion, besides putting an unnecessary burden upon the court, to hold that each time the master makes a ruling the aggrieved party may, by special motion, have it reviewed. The orderly, and it seems the generally accepted, procedure is to present all the questions arising before the master by objections and exceptions to his report." 20 Fed. Rep. 454 (455).

Further, that the rulings of the master, except in extreme cases, will not be reviewed by the court pending a reference, see *Bate Refrigerating Co. v. Gillette* (1886), 28 Fed. Rep. 673; *Welling v. La Bau* (1885), 23 Blatch. 305; 32 Fed. Rep. 293; *Union Sugar Refinery v. Matthiesson* (1868), 3 Clifford, 146.

That the examiner cannot rule on evidence, and the defendant if a witness has a right to the opinion of the court before he answers, and is not in contempt if acting under advice he refuses to answer till he has that opinion, see *Roberts v. Walley* (1882), 14 Fed. Rep. 167; 26 O. G. 107.

¹³ That the master should finish his hearing and file his draft report, and

objection can then be made, see *Union Sugar Refinery v. Matthiesson* (1868), 3 Clifford, 146.

¹⁴ That no evidence can be introduced after the master has submitted a draft of his report to one of the parties, see *Piper v. Brown* (1873), Holmes, 196; 6 Fisher, 240; 3 O. G. 97.

§ 1158. ¹ Equity Rule 83.

² In *Troy Iron & Nail Factory v. Corning* (1869), 3 Fisher, 497, Shipman, J. : (501) "But let us take the rulings of the master that were formal and peremptory, overruling or sustaining objections to the admission of evidence at the time they were made. What are the rules of practice to be observed by the party who desires to revise such rulings? First, we think an exception should always be taken on the spot to each ruling of the master which a party intends to contest. It need not then be drawn up in form, but it should be taken by giving notice to the master, and it is his duty to note the facts in his minutes. This is a familiar rule, constantly applied in other trials, and we see no reason why it

of the master afford no ground for exceptions, nor can exceptions be sustained when the report conforms to the decree,

should not be adhered to in hearings before masters. . . . The reason of this rule is founded in the interest of justice, as its observance tends to narrow the limits of controversy; for if the party in whose favor a ruling is made is notified that an exception is taken, and the question is to be revised, he can waive the point and admit or withdraw the evidence, as the case may be, and thus avoid future controversy and delay over it. It may be said that this can have no application to the instances on this hearing, where the master admitted evidence objected to, and reserved the questions arising on the objections. As we have already intimated, it is not always easy to determine what precise disposition was made by the master of many of these reserved questions. But if he omitted to decide them, or ultimately decided them incorrectly, the first opportunity should have been taken to except to his omissions or alleged errors in this particular. This opportunity, if not presented before, occurred when the draft report was served, and the parties filed their objections thereto. None of these errors are embraced in the objections then filed. Exceptions to these rulings appear for the first time among those presented to the master's final report, although some of them were made years before either the draft or final report was drawn up. It would seem from the authorities that if it is proper to except at all to the master's final report, for rulings admitting or rejecting evidence, this can only be done where objections of the same kind have been made to the draft report." 6 Blatch. 328 (331).

In *Union Sugar Refinery v. Matthieson* (1868), 3 Clifford, 146, Clifford, J. : (148) "The better practice, as the court thinks, is for the master to complete

his investigations under the rules prescribed by the Supreme court, and in accordance with the usual course of proceeding in equity cases in this circuit. The usual course is that the master allow both parties, if they desire, to introduce testimony upon the subject of damages. He hears them fully, and when he has taken all the testimony, heard the parties, and come to a conclusion, he makes a draft of his report in the promises, and shows it to the parties, or files it in the clerk's office, and gives time for the parties respectively, if they see fit, to make their objections to the drafted report. When those objections are made it becomes his duty to consider or reconsider, as the case may be, the questions involved in those objections; and if, upon full consideration, he is still of the opinion that he was right in the conclusions formed and stated in the drafted report, he then makes his final report, and the parties have a right to file their exceptions to the final report, founded upon the previous objections made to the draft report; and then the whole matter comes back to the Circuit court for adjudication upon the master's report. Either party may set down the case for hearing upon the exceptions to the master's report. Both parties may except; both may object in the first instance to the draft report, and both parties may afterwards except to the final report. They are entitled to be heard upon all the questions which have arisen before the master, provided they are embraced in their objections and in their exceptions. When the exceptions are filed, if either party desires the evidence to be reported, they request the master to report it in whole or in part, as the case may be. It is the usual course for the master to comply with such a request; but if

though the decree itself may be amended when erroneous, and the report then correspondingly corrected.³ Exceptions must point out the defects in the report, and must direct the attention of the court to those portions of the evidence or the record in which they appear.⁴ The conclusions of the master concerning matters of fact cannot be reviewed, unless the entire testimony is presented to the court.⁵

neither party makes the request, it is not incumbent upon the master to report the evidence at all. He may or may not, in his discretion, as he sees fit. If he does report the evidence at the request of one or both parties, it then becomes the duty of the court, if there be proper exceptions, to review the questions of fact embraced in the report as well as the questions of law. But if the evidence is not reported, the court does not review the facts, but simply re-examines the questions of law. Such has been the practice in this circuit as far back as the knowledge of the justices now holding the court extends; and there has been no departure from the practice since either of us came into the court, within the recollection of either member of it."

That an exception to a principal finding by a master is not waived by not making the exception before the master, see *Jennings v. Dolan* (1887), 29 Fed. Rep. 861; 38 O. G. 1018.

That where the master notified counsel that the draft reports were ready for inspection and verbal objections had been made but not written out, and the exceptions to the report are the same, these objections may be filed with the master *nunc pro tunc*, see *Fischer v. Hayes* (1883), 16 Fed. Rep. 469; 24 O. G. 304.

³ That errors not affecting the conclusions of the master's report are no ground for exceptions, see *Gottfried v. Crescent Brewing Co.* (1884), 22 Fed. Rep. 433; 30 O. G. 892.

That the report of the master, being the deputy clerk of the court, will not

be set aside on the ground that no "special reason" for his appointment is alleged under the act of March 3, 1879, if the appointment was made by consent of parties and acted on, but the consent will be entered of record as such "special reason" after the report is filed, see *Fischer v. Hayes* (1884), 22 Fed. Rep. 92; 22 Blatch. 505.

That evidence as to allowances not finally allowed is properly taken by the master and must be objected to by a motion to suppress the testimony, not by exceptions to the master's report, see *American Nicholson Pavement Co. v. City of Elizabeth* (1874), 6 O. G. 764; 1 Bann. & A. 439.

That no exception can be taken when the master's report conforms to the decree, but the decree if erroneous may be resettled, see *Williams v. Leonard* (1872), 5 Fisher, 381; 9 Blatch. 476.

That on a hearing on a master's report presented for acceptance or rejection, no matter will be considered which was closed by the decree referring the case to the master, see *Whitney v. Mowry* (1870), 4 Fisher, 207.

⁴ That exceptions to the master's report must point out his errors, or the counsel must direct attention to the evidence showing them, or they will be overruled, see *Turrill v. Illinois Central R. R. Co.* (1873), 5 Bissell, 344.

⁵ That questions of fact or computation which are for the master to decide will not be reviewed on exceptions to the report, see *Hammacher v. Wilson* (1887), 32 Fed. Rep. 796.

That the report of the master will

§ 1159. **Recommittal of Report for Further Hearing or Amendment.**

The court has power to recommit the report to the master for a further hearing, or for an amendment, when it is erroneous in principle, or when the master takes a wrong view of the invention, or when it fails to complete the computation, or exhibits any other misconception in law or fact which an additional investigation may correct.¹ No recommitment will be ordered to allow either party to avail himself of objections

not be set aside on the ground that he erroneously decided a complicated question of fact where the evidence is doubtful, see *Welling v. La Bau* (1885), 32 Fed. Rep. 293; 23 Blatch. 305.

That the finding of the master on a question of fact will not be reviewed unless the whole evidence is reported, see *Piper v. Brown* (1873), 6 Fisher, 240; 3 O. G. 97; Holmes, 196.

§ 1159. ¹ That the court has power to set aside the master's report for any error in law or in fact, or to recommit it for further proceedings, or correct it when there is anything to correct it by, see *Steam Stone Cutter Co. v. Windsor Mfg. Co.* (1879) 17 Blatch. 24; 4 Bann. & A. 445.

That proceedings before a master are of nearly the same solemnity as those before the court, and his finding will not be set aside unless against the weight of evidence, see *Tilghman v. Proctor* (1883), 125 U. S. 136; 43 O. G. 628; *Welling v. La Bau* (1888), 43 O. G. 117.

That on a supplemental accounting the master may use his report on the first accounting for all proper purposes without having it offered in evidence, see *Reed v. Lawrence* (1886), 29 Fed. Rep. 915.

That if the master's report is erroneous in principle it will be sent back for further hearing and correction, see *Faulks v. Kamp* (1882), 22 O. G. 2244; 10 Fed. Rep. 675.

That where the master takes a wrong view of the invention, and so mistakes the profits, the report will be sent back for further evidence, see *Ruggles v. Eddy* (1877), 12 O. G. 716; 2 Bann. & A. 627.

That a re-accounting will not be granted on account of trifling errors by the master as to the items of the account, see *Zane v. Peck Bros.* (1882), 23 O. G. 191; 13 Fed. Rep. 475.

That where the master's report shows the percentage of profit, but not the amount on which the percentage should be calculated, the case must be sent back for further evidence, see *Conover v. Mers* (1873), 6 Fisher, 506; 11 Blatch. 197.

That when the master's report shows that further investigation is needed, the court will order it, see *Magic Rusflo Co. v. Elm City Co.* (1877), 11 O. G. 501; 14 Blatch. 109; 2 Bann. & A. 506.

That a master's report may be re-committed in order that it may so complete the case as to raise all questions which might be found material, see *McKay v. Jackman* (1883), 24 O. G. 1177; 17 Fed. Rep. 641.

That on a reference of his report back to the master for excessive damages, he may find a license fee and report that as the measure, see *Wooster v. Simonson* (1884), 28 O. G. 918; 20 Fed. Rep. 316.

which he has already waived, or to produce testimony which he has once advertently omitted.² Before the hearing by the court on the report evidence properly objected to and inadmissible may be suppressed.³ A report awarding to the plaintiff a substantial sum, but showing on its face that no account of damages or profits which can be taken will be legally sustainable, may be set aside.⁴ When the report or the accompanying evidence discloses both the error and the means for its correction, the court may rectify the mistake without a recommittal.⁵

§ 1160. Acceptance of Report : Final Decree.

The acceptance of a report of the master, in favor of the plaintiff, is followed by a final decree awarding him the sum found by the master to be due to him as damages or profits, or both, and granting a perpetual injunction or such other equitable relief as may be necessary. Where there are several plaintiffs the decree also provides for the distribution to each of a share of the award proportioned to his interest in

² That the report of the master will not be referred back to him if there has been no inadvertence, and if no further evidence is to be had, and the objectionable evidence was duly excepted to, see *Garretson v. Clark* (1878), 14 O. G. 485 ; 15 Blatch. 70 ; 3 Bann. & A. 352.

That a finding of the master based in part on his personal examination of the apparatus at the request of the parties, and in their presence, will not be reversed, see *Piper v. Brown* (1873), *Holmes*, 196 ; 6 *Fisher*, 240 ; 3 O. G. 97.

That where the evidence as to extent of infringement is conflicting, and sufficient to warrant either conclusion, the finding of the master will not be disturbed, see *Wooster v. Thornton* (1886), 26 *Fed. Rep.* 274 ; 34 O. G. 560.

That a motion to recommit the report to the master, that he may take an account of the profits to the date of the final decree on machines enjoined subsequent to the interlocutory decree,

is not granted, since it would hinder an appeal, but the decree is so drawn as to show to what date the account was taken, see *Union Metallic Cartridge Co. v. United States Cartridge Co.* (1881), 8 *Fed. Rep.* 446.

³ That inadmissible evidence, duly objected to, may be reached by motion to suppress, see *American Nicholson Pavement Co. v. City of Elizabeth* (1874), 6 O. G. 764 ; 1 *Bann. & A.* 439.

⁴ That before the act of 1870, where an interlocutory decree gave both damages and profits and the defendant excepted to the master's report concerning them, the exception was not allowed, but the damages were struck out, see *Williams v. Leonard* (1872), 5 *Fisher*, 381 ; 9 *Blatch.* 476.

⁵ That if the evidence before the master does not sustain a charge allowed by him, it will be struck out, and such evidence must appear on the face of the report, see *American Nichol-*

the patent or the amount of his injury.¹ A report in favor of the plaintiff does not, however, bind the court nor compel it to ratify that finding on the merits which was contained in the interlocutory decree. The final decree may depart from both, and dismiss the bill for reasons apparent on the pleadings or in the evidence adduced before the master.² A final decree can be amended only during the term at which it was entered.³

§ 1161. Appeal to the Supreme Court.

Errors of law or fact committed by Federal courts of equity are corrected by an appeal to the Supreme Court of the United States.¹ This appeal lies only on a final decree dismissing the bill, or awarding damages or profits or other relief to the plaintiff after the acceptance of the master's report; but all prior orders and decrees, on matters not within the discretion of the court, are thereby brought up for review.² An appeal may be taken in any case arising under

son Pavement Co. v. City of Elizabeth (1874), 6 O. G. 764; 1 Bann. & A. 439.

§ 1160. ¹ That the final decree should provide for the distribution of the profits or damages awarded to the respective parties in interest, see *Campbell v. James* (1880), 18 Blatch. 92; 5 Bann. & A. 354; 18 O. G. 1111; 2 Fed. Rep. 338.

That a decree will not issue against the officers of a corporation as individuals where the corporation is solvent, and they do not as individuals violate or threaten to violate the patent, see *Howard v. St. Paul Plow Works* (1888), 45 O. G. 1067.

That the defendant will not be ordered to deliver up the infringing articles to be destroyed, except perhaps in some peculiar cases, see *American Bell Telephone Co. v. Kitsell* (1888), 35 Fed. Rep. 521.

² That although an interlocutory decree is given for the plaintiff, yet if on the return of the master's report it ap-

pears that he ought not to recover, the final decree may be for the defendant, see *Steam Stone Cutter Co. v. Sheldon* (1884), 22 Blatch. 484; 21 Fed. Rep. 875; *Spill v. Celluloid Mfg. Co.* (1884), 22 Blatch. 441; 29 O. G. 773; 22 Fed. Rep. 94; *Wooster v. Handy* (1884), 22 Blatch. 307; 28 O. G. 629; 21 Fed. Rep. 51.

That if a re-issue is improper, the bill will be dismissed even after the report of the master on an interlocutory decree for the plaintiff, see *American Diamond Drill Co. v. Sullivan Mach. Co.* (1884), 22 Blatch. 298; 28 O. G. 811; 21 Fed. Rep. 74.

That the dismissal of a bill, after evidence taken, on the stipulation that such evidence may be used in any future suit on that patent, is allowable, and is not a dismissal on the merits, see *Brush v. Condit* (1884), 22 Blatch. 246; 28 O. G. 451; 20 Fed. Rep. 826.

³ See Equity Rule 88.

§ 1161. ¹ Sec. 692, Rev. Stat.

² That appeal lies only from a final

the Patent Laws without reference to the amount involved, unless the questions at issue relate merely to the taxation of costs, concerning which no appeal is entertained if the costs in controversy are less than two thousand dollars.³ Any party aggrieved by the alleged error, and having a distinct interest, may move for an appeal within two years after the entry of the final decree; but if the appeal is to operate as a *supersedeas*, the motion must be made within sixty days, and security be given by the appellant sufficient to cover the award, if any, to the prevailing party, with his costs and damages for the delay.⁴ A notice to the adverse party to appear

decree, see *Hayes v. Fischer* (1880), 102 U. S. 121.

That a decree cannot be appealed from until after the return of the master's report, see *Potter v. Mack* (1868), 3 Fisher, 428.

That a decree referring the case to a master for an account or damages, but not dismissing the bill or decreeing costs, is not a final decree from which appeal lies to the Supreme court, though a perpetual injunction was granted, see *Barnard v. Gibson* (1849), 7 How. 650.

That the decision of the Circuit court, affirming or denying simply, is a judgment from which an appeal lies to the Supreme court, see *Barker v. Stowe* (1882), 22 O. G. 259; 11 Fed. Rep. 303; 20 Blatch. 185.

That the damage caused by a perpetual injunction does not make it the subject-matter of an appeal, see *Barnard v. Gibson* (1849), 7 How. 650.

³ That in patent cases an appeal lies without reference to the amount, see *Philip v. Nock* (1871), 13 Wall. 185; *Wilson v. Sandford* (1850), 10 How. 99; *Allen v. Blunt* (1846), 2 W. & M. 121; 2 Robb. 530.

That the Supreme court will not examine into the merits of any decree, on an appeal by the plaintiff, where the only question is one of costs, see *Elastic Fabrics Co. v. Smith* (1879), 100 U. S. 110.

That an appeal will lie to the Supreme court on a question of costs, not involving the interpretation of the Patent Laws, only when the amount is over two thousand dollars, see *Sizer v. Many* (1853), 16 How. 98.

⁴ That any party aggrieved may appeal though he has been added since proceedings commenced, see *Ex parte Jordan* (1876), 94 U. S. 248; *Ex parte Cutting* (1876), 94 U. S. 14; *Sage v. Central R. R. Co.* (1876), 93 U. S. 412.

That any defendant can appeal to the Supreme court though the defendants in previous cases have not done so, see *Potter v. Whitney* (1866), 3 Fisher, 77; 1 Lowell, 87.

That after the Supreme court has passed on one case on its merits it will not hear arguments on technical points of pleading in another branch of the same case in another State, between those who were privies to the former case, see *Smith v. Ely* (1853), 15 How. 137.

That if an appeal does not operate as a *supersedeas*, security should be required of the appellant in twice the amount of the costs that the appellee may recover, but if the appeal does operate as a *supersedeas* then the security should be twice the value of all that is to be recovered unless it is otherwise secured, see *American Nicholson Pavement Co. v. City of Elizabeth*

is necessary, unless the appeal is taken in open court during the term at which the decree was granted.⁵ No error of law will be considered in the court above except those apparent on the record and duly and specifically assigned.⁶ Questions of fact are heard and determined upon the evidence sent up with the record from the court below;⁷ or an agreed statement of facts may be submitted presenting the points on which the judgment of the court is sought.⁸ Collusive appeals, how-

(1874), 6 O. G. 772; 1 Bann. & A. 463.

That an appeal may be taken within two years unless it is to operate as a *supersedeas*, see Sec. 1008, Rev. Stat.

That where an appeal operates as a *supersedeas* it must be moved for within sixty days, see Secs. 1007, 1012, Rev. Stat.

⁵ That notice of the appeal must be given to the adverse party, see *R. R. Co. v. Blair* (1879), 100 U. S. 661.

That if the appeal is taken in open court at the same term no citation is necessary, see *Milner v. Meek* (1877), 95 U. S. 252.

⁶ That on appeal no error can be assigned unless it is apparent on the record, see *Bates v. Coe* (1878), 98 U. S. 31; 15 O. G. 337; *Roemer v. Simon* (1877), 95 U. S. 214; 12 O. G. 796.

That an assignment of error that the "patent is invalid," without pointing out the defect, is insufficient, see *Marsh v. Seymour* (1877), 97 U. S. 348; 13 O. G. 723.

⁷ That on an appeal a patent not introduced below cannot be offered, see *Thomson v. Wooster* (1885), 114 U. S. 104; 31 O. G. 913.

That on appeal to the Supreme court only the printed matters can be used at the hearing, and delay will not be granted for the printing of papers which ought not to have been sent up at all, see *Craig v. Smith* (1879), 100 U. S. 226; 17 O. G. 145.

That the lower court should send up

what was read or inspected below, not what was merely presented, like the affidavits in support of a bill of review, see *Craig v. Smith* (1879), 100 U. S. 226; 17 O. G. 145.

That affidavits taken before the master or the court below as grounds of application to open proofs cannot be taken as evidence before the court on appeal, see *Thomson v. Wooster* (1885), 114 U. S. 104; 31 O. G. 913.

That copies only should be sent up and the originals kept in the court where they belong, unless in the opinion of the court below they require inspection above, see *Craig v. Smith* (1879), 100 U. S. 226; 17 O. G. 145.

That papers which ought to have been copied into the transcript and are sent up as originals will not be noticed, see *Craig v. Smith* (1879), 100 U. S. 226; 17 O. G. 145.

That the record for the Supreme court must set out the account of profits if any has been taken, see *Illinois Central R. R. Co. v. Turrill* (1876), 94 U. S. 695; 12 O. G. 709.

That the Supreme court may consult the evidence contained in the record in order to determine the scope of the invention, though prior use is not set up in the answer, see *Eachus v. Broomall* (1885), 115 U. S. 429; 33 O. G. 1265.

⁸ That cases may be brought to the Supreme court on an agreed statement of facts, see *Stimpson v. Baltimore & Susquehanna R. R. Co.* (1850), 10 How. 329.

ever, are not tolerated; and if, pending an appeal taken in good faith, such compromises are effected between the parties as to leave no real contest subsisting, the court will refuse further cognizance of the appeal.⁹ Unless dismissed on these or other grounds of impropriety, an appeal results in the affirmation of the decree of the Circuit court, or in its modification or reversal, whereupon a mandate issues to the court below, in pursuance of which further proceedings are conducted.¹⁰

§ 1162. **Costs in Equity: when Taxed and in Whose Favor.**

In equity costs are divided, awarded, or denied by the court as justice may require.¹ They do not follow the judgment as a matter of right, and, unless granted in the decree, they cannot be recovered.² *Prima facie*, however, the prevailing party is entitled to his costs, and the burden of proof rests upon his adversary to show that such allotment would be inequitable.³ A full taxation of the costs cannot take

⁹ That where the appellants, pending the appeal, purchased the opposing patents and gave the parties stock in the defeated corporation, but did not compromise the damages, the appeal was dismissed, there being no longer any real controversy, see *Wood Paper Co. v. Heft* (1869), 8 Wall. 333.

That when it appears that an appeal is collusive, the decree of affirmance in the Supreme court will be set aside, and the order to the Circuit court recalled, see *Gardner v. Goodyear Dental Vulcanite Co.* (1873), 3 O. G. 295; 6 Fisher, 329.

¹⁰ That on an appeal if the Supreme court reverses the decision of the Circuit court, sustaining the patent, it may also reverse such orders and judgments for contempt as embrace an award of damages or profits to the plaintiff, see *Worden v. Searls* (1887), 121 U. S. 14; 39 O. G. 359.

That where no notice was given of the defence of priority and the evidence

was heard as to it against the plaintiff's objection, judgment will be reversed in the Supreme court, though the plaintiff did not appeal on that ground, see *Blanchard v. Putnam* (1869), 8 Wall. 420.

That an appeal from a final decree providing for payment of the master's fees does not suspend the order for their payment, see *Myers v. Dunbar* (1874), 8 O. G. 321; 1 Bann. & A. 565; 12 Blatch. 380.

§ 1162. ¹ That in equity the court will divide, award, or deny costs as justice requires, see *Troy Iron and Nail Factory v. Corning* (1872), 6 Fisher, 85; 10 Blatch. 223.

² That in equity costs do not follow as a matter of right, and must be awarded in the decree or they will not be recoverable, see *Coburn v. Schroeder* (1881), 8 Fed. Rep. 521; 20 O. G. 1085; 19 Blatch. 493.

³ That costs are always awarded to the successful party unless his own con-

place until the final decree, though special costs may be allowed on interlocutory orders during the course of the proceedings.⁴ Full costs will be decreed in favor of the plaintiff when the substantive issues raised on the accounting were decided in accordance with his claims; though where the defendant was willing, at the outset, to pay the net profits, and the costs of the accounting have thus been unnecessarily made by the plaintiff, each party is compelled to bear his own costs and one-half the master's fee.⁵ The same division of the

duct would render it inequitable and unjust, see *Bunker v. Stevens* (1885), 26 Fed. Rep. 245; 36 O. G. 345.

That in equity costs are *prima facie* taxable to the prevailing party, but not if inequitable in whole or in part, though the burden of proof rests upon the party objecting to them, see *Hovey v. Stevens* (1846), 3 W. & M. 17; 2 Robb, 567.

That no costs will be taxed in equity when neither party fully prevails, see *Hayes v. Bickelhaupt* (1885), 29 O. G. 368; 21 Fed. Rep. 567.

* That costs cannot be fully taxed or execution issue until final decree, and an appeal or *supersedeas* will stay the execution, see *Cohurn v. Schroeder* (1881), 20 O. G. 1085; 8 Fed. Rep. 521; 19 Blatch. 493.

That in taxing costs a "final hearing" is the submission of a case for judgment after issue, see *Goodyear Dental Vulcanite Co. v. Osgood* (1878), 13 O. G. 325; 2 Bann. & A. 529.

That equity may allow costs on interlocutory orders before final decree, see *Avery v. Wilson* (1884), 20 Fed. Rep. 856.

⁶ That if the plaintiff prevails in the issues raised on the accounting, the defendant must pay the whole cost, see *Urner v. Kayton* (1883), 17 Fed. Rep. 845.

That where the plaintiff prevails on one of two patents in suit he must have a decree, but costs are at the discretion

of the court, and may be apportioned, see *Pennsylvania Diamond Drill Co. v. Simpson* (1886), 37 O. G. 218; 29 Fed. Rep. 288.

That a bill being dismissed as to one patent and sustained as to the other, costs were allowed to neither party, see *Schmid v. Scovill Mfg. Co.* (1889), 39 Fed. Rep. 345; *Fay v. Allen* (1885), 24 Fed. Rep. 804; 32 O. G. 1355; *Everest v. Buffalo Lubricating Oil Co.* (1884), 28 O. G. 1101; 20 Fed. Rep. 848; *Adams v. Howard* (1884), 26 O. G. 825; 19 Fed. Rep. 317; 22 Blatch. 47.

That when a re-issue is held invalid in part, costs may be divided, see *Yale Lock Co. v. Sargent* (1886), 117 U. S. 536; 35 O. G. 497.

That if the defendants have infringed and there has been no unreasonable delay in disclaiming, a disclaimer may be filed, and an injunction issue, and an account be ordered, but no costs can be recovered, see *Hake v. Brown* (1889), 37 Fed. Rep. 783; *Electrical Accumulator Co. v. Julien Electric Co.* (1889), 38 Fed. Rep. 117; *Hayes v. Bickelhaupt* (1885), 23 Fed. Rep. 183; 32 O. G. 135; *Myers v. Frame* (1871), 4 Fisher, 493; 8 Blatch. 446.

That a plaintiff disclaiming pending suit cannot recover costs, but may have an injunction, each party paying his own costs, without previous record of the disclaimer in the Patent Office, see *Aiken v. Dolan* (1867), 3 Fisher, 197.

That one Claim being disclaimed, a

costs is ordered where the plaintiff, by exaggerating his demands, has wasted time in the accounting, and has finally recovered but a small amount.⁶ When the master reports no profits or substantial damages, and nominal damages alone are, therefore, given to the plaintiff, costs are allowed him up to and including the interlocutory decree, while the costs of the accounting are awarded to the defendant; one being set off against the other, and the balance recovered by the proper party.⁷ A similar disposition of the costs is made when a report of damages or profits is reversed.⁸ The de-

decree without costs may be had on the others, see *Christman v. Rumsey* (1879), 17 Blatch. 148; 17 O. G. 903; 4 Bann. & A. 506; 58 How. Pr. 114.

That where one Claim of a re-issue is too broad, a decree may be had on the other without costs, on filing a disclaimer, see *Tyler v. Galloway* (1882), 20 Blatch. 445; 22 O. G. 2072; 12 Fed. Rep. 567.

That where the patent claims old features, the disclaimer must be filed before suit or no costs will be allowed, see *Tuck v. Bramhill* (1868), 3 Fisher, 400; 6 Blatch. 95; *Singer v. Walmsley* (1860), 1 Fisher, 558.

That if the defendants were willing at the outset to pay the net profits, and the plaintiff has made the costs, each party must pay his own costs and one half the master's fee, see *Ford v. Kurtz* (1882), 12 Fed. Rep. 789; 11 Bissell, 324.

⁶ That where the plaintiff exaggerated his claims, and wasted much time, and recovered only a small amount, costs were allowed to fall on each party, and the master's fee was paid by both equally, see *Troy Iron and Nail Co. v. Corning* (1872), 10 Blatch. 223; 6 Fisher, 85.

That though the patent is sustained and an accounting is had, if the plaintiff knew that nothing could be allowed him as profits or damages, he must pay

the cost of the accounting, see *Hill v. Smith* (1887), 32 Fed. Rep. 753.

⁷ That where nominal damages are allowed, costs will be taxed for the plaintiff up to the reference to the master, after that for the defendant, see *Kirby v. Armstrong* (1881), 19 O. G. 661; 5 Fed. Rep. 801; 10 Bissell, 135; *Ingersoll v. Musgrove* (1878), 13 O. G. 966; 14 Blatch. 541; 3 Bann. & A. 304.

That when the master reports only nominal damages on a decree *pro confesso*, and the plaintiff excepts to the report, and the exceptions are overruled, costs will be allowed him only up to and including the interlocutory decree, and the defendant will be allowed costs thereafter, the one to be set off against the other and the balance only recovered, see *Fisk v. West, Bradley, & Cary Mfg. Co.* (1880), 19 O. G. 545.

That on an award of nominal damages the cost of the reference, the master's fees, and the hearing on the report, fall on the plaintiff, see *Everest v. Buffalo Lubricating Oil Co.* (1887), 31 Fed. Rep. 742.

That where nominal damages are allowed, costs will be awarded according to the circumstances of the case, see *Calkins v. Bertrand* (1881), 8 Fed. Rep. 755; 10 Bissell, 445.

⁸ That when the assessment of dam-

defendant has his costs on the dismissal of the bill either at the interlocutory or the final hearing, unless the cause has been to his advantage by defining his rights and protecting him from future interference, and the action was in good faith instituted by the plaintiff.⁹ No costs are thus taxed in his favor when the patent is found invalid, and the bill is dismissed, on the ground of the inventor's acquiescence in more than two years' public use or sale while ignorant of his legal rights.¹⁰ When evidence not covered by the notice in the answer is admitted on amendment by agreement, and the defendant finally prevails, the costs which had accrued to him before the hearing cannot be recovered.¹¹ On the dismissal of a bill and cross-bill, the costs, being equal, are not taxed for either party.¹² All persons who are entered on the record as plaintiffs or defendants are liable for any costs that may be decreed against them. Claims not in issue will not be adjudicated merely to settle questions as to costs.¹³

ages is reversed the plaintiff will be allowed costs up to and including the interlocutory decree, and the defendant afterwards, see *Dobson v. Hartford Carpet Co.* (1885), 114 U. S. 439 ; 31 O. G. 787.

⁹ That no costs will be allowed to the defendant when the bill is dismissed, if the defendant is really benefited by it, as when his own rights are definitely settled, see *Smith v. Woodruff* (1873), 4 O. G. 635 ; 6 Fisher, 476.

That costs may be denied the defendant where his own conduct led the plaintiff into the controversy, see *Bunker v. Stevens* (1885), 26 Fed. Rep. 245 ; 36 O. G. 345.

¹⁰ That where the patent is found invalid, and the bill is dismissed on the ground of the plaintiff's acquiescence in the public use and sale of his invention, in ignorance of his legal rights and duties, no costs will be taxed against him,

see *Sisson v. Gilbert* (1871), 5 Fisher, 109 ; 9 Blatch. 185.

¹¹ That where evidence not covered by the notice is admitted upon an amendment of the notice by agreement, the defendant can have no costs up to the hearing, see *Roberts v. Buck* (1873), 3 O. G. 268 ; Holmes, 224 ; 6 Fisher, 325.

¹² That no costs will be allowed on dismissing the bill and cross-bill, they being nearly equal, see *Prime v. Brandon Mfg. Co.* (1879), 16 Blatch. 453 ; 4 Bann. & A. 379.

¹³ That claims not in issue will not be contested merely to settle costs, see *American Bell Telephone Co. v. Spencer* (1881), 20 O. G. 299 ; 8 Fed. Rep. 509.

That a decree will not be reviewed on appeal for the mere purpose of settling a question of costs, see *Union Paper Bag Mach. Co. v. Nixon* (1882), 105 U. S. 766 ; 21 O. G. 1275.

§ 1163. Items of Taxable Costs.

The items of costs recoverable in equity are substantially identical with those taxable at law, so far as the essential differences in procedure will permit. The fees of the clerk, the marshal, and the witnesses, the cost of the pleadings, the expenses incurred for models or copies of models in the Patent Office, or for transcripts of assignments when procured by the defendant, and for necessary telegraphing, are among the items usually allowed.¹ A docket-fee is taxed in every case where a final decree is entered after a replication has been filed, and though several cases are by agreement heard together and one decree is passed deciding all, a docket-fee in each case may be awarded.² Depositions taken in another case and in the present one admitted by consent, the cost of printing the pleadings, evidence, or arguments for the convenience of the court, the expense of making or procuring copies of models not on deposit in the Patent Office, or copies of patents or drawings obtained as evidence for his own use by the defendant, are not included in the items taxed.³ The

§ 1163. ¹ As to the usual items taxed as costs, see § 1080 and notes, *ante*.

² That any final decree after replication is a final hearing under Sec. 284, Rev. Stat., for the purpose of a docket-fee, see *Goodyear Dental Vulcanite Co. v. Osgood* (1877), 13 O. G. 325; 2 Bann. & A. 529.

That where several cases are heard together by agreement and one decree is entered for all, a docket-fee will be taxed in each case, see *Goodyear Dental Vulcanite Co. v. Osgood* (1877), 13 O. G. 325; 2 Bann. & A. 529.

That where a case is dismissed on motion of the plaintiff after issue and interlocutory decree on the merits, a docket-fee will be taxed, see *Goodyear Dental Vulcanite Co. v. Osgood* (1877), 13 O. G. 325; 2 Bann. & A. 529.

That no docket-fee will be taxed for an attorney who did not enter on the docket before the filing of the general

replication, or who has not been admitted to the Supreme court or to some Circuit court, see *Goodyear Dental Vulcanite Co. v. Osgood* (1877), 13 O. G. 325; 2 Bann. & A. 529.

That no attorney's docket-fee is to be taxed for attendance on an order of reference to a master, see *Doughty v. West, Bradley & Cary Mfg. Co.* (1870), 4 Fisher, 318; 8 Blatch. 107.

That a docket-fee and certified copies of file-wrappers, &c., are not taxable for the defendant where the bill is dismissed after the cause was at issue and noticed for hearing, see *Ryan v. Gould* (1887), 41 O. G. 1392.

³ That officers of an infringing corporation who appear as witnesses on an accounting, cannot have their mileage and attendance taxed as costs, see *American Diamond Drill Co. v. Sullivan Mach. Co.* (1885), 32 Fed. Rep. 552.

That when evidence is taken to be

master's fee is payable by the defendant on the return of the report, and may be recovered by him from the plaintiff if the bill is finally dismissed; though in some districts it is the custom to charge it to the plaintiff, and tax it in his costs against the defendant.⁴

used in two cases its cost will be divided between them, see *Thayer v. Hart* (1884), 80 O. G. 776.

That depositions taken in another case against other defendants and admitted in the present one by consent, though under the same patent, were not taxed, but a solicitor's fee of \$2.50 was allowed in each, see *Wooster v. Handy* (1885), 23 Fed. Rep. 49; 23 Blatch. 113. See this case for several other rulings on items of cost.

That the expense of printing evidence for the convenience of the court will not be taxed against the losing party, see *Spaulding v. Tucker* (1871), 4 Fisher, 633.

As to other items not taxed, see § 1080 and notes, *ante*.

⁴ That the master's fee may be collected, in the first instance, from the defendant by order of court, and by him recovered as costs on a final decree in his favor, see *Urner v. Kayton* (1883), 24 O. G. 1178; *Myers v. Dunbar* (1874), 8 O. G. 321; 12 Blatch. 380; 1 Bann. & A. 565.

That the order of court for payment of the master's fees and such other costs must be literally obeyed, see *Myers v. Dunbar* (1874), 8 O. G. 321; 12 Blatch. 380; 1 Bann. & A. 565.

That the fees of the master are not to exceed the fees allowed by the statutes to a commissioner in a like reference, though in some difficult cases it may be greater, see *Doughty v. West, Bradley & Cary Mfg. Co.* (1870), 4 Fisher, 318; 8 Blatch. 107.

That ten dollars a day may be allowed

the master in peculiar cases, see *Doughty v. West, Bradley & Cary Mfg. Co.* (1870), 4 Fisher, 318; 8 Blatch. 107.

That the clerk has no power to fix the compensation of the master, see *Doughty v. West, Bradley, & Cary Mfg. Co.* (1870), 4 Fisher, 318; 8 Blatch. 107.

That where the interlocutory decree for the plaintiff is set aside on rehearing or final decree, the master's fees paid by the defendant are taxable as costs against the plaintiff, but the court, not the clerk, should tax them, see *American Diamond Drill Co. v. Sullivan Mach. Co.* (1885), 32 Fed. Rep. 552.

That in Massachusetts the master's fee for taking the account is charged in the first instance to the plaintiffs, and recovered by him as costs against the defendant if he prevails, see *Macdonald v. Shepard* (1882), 10 Fed. Rep. 919.

That the master is an officer of the court and is entitled to his compensation irrespective of the result of the suit, see *Myers v. Dunbar* (1874), 8 O. G. 321; 1 Bann. & A. 565; 12 Blatch. 380.

That costs being once equitably taxed by consent, the consent cannot be withdrawn when the master's report comes in, see *Holbrook v. Small* (1878), 17 O. G. 55; 3 Bann. & A. 625.

That no costs will be taxed as to the exceptions to a master's report when all were overruled by the court, see *Troy Iron & Nail Factory v. Corning* (1872), 6 Fisher, 85; 10 Blatch. 223.

§ 1164. Bill of Review.

A final decree in equity, if unappealed from or affirmed upon appeal, permanently concludes the parties on all matters covered by its terms, unless reversed by a bill of review. A bill of review may be filed, by leave of the court, for errors of law apparent on the record, and without leave of the court for errors in fact disclosed by the discovery of new evidence.¹ When based upon alleged errors of law, the bill serves the same purpose, and is governed by the same general principles, as a writ of error, and must be filed within the time allowed for that proceeding.² If intended to correct errors in fact, and for that end to introduce new evidence, it occupies the same position and is guided by the same rules as an application for a new trial.³ On such a bill the court may permit additional testimony to be offered, and new instances of prior use to be alleged and shown; but if the party, although duly notified, was voluntarily absent from the former trial, or if the new evidence suggested could have been discovered by diligent attention to the matters brought out in the previous hearing, the bill will be dismissed and the relief denied.⁴ A decree by consent cannot be reversed on a bill of review, unless the consent has been obtained by fraud.⁵ The bill must show that the new facts to be produced are material

§ 1164. ¹ As to the nature and object of a Bill of Review, see Story Eq. Pl. §§ 403-428.

² That a bill of review based on errors of law follows the rules governing writs of error, see *Clark v. Killian* (1880), 103 U. S. 766.

³ That a bill of review based on errors of fact is governed by the same rules as a petition for a new trial, see Story Eq. Pl. §§ 412-419.

⁴ That courts may, in their discretion, allow newly discovered evidence to be introduced on a bill of review, but the power is to be exercised cautiously and only when necessary to justice, see *Craig v. Smith* (1879), 100 U. S. 226; 17 O. G. 145.

That on a bill of review new instances

of prior use may be alleged and shown, if the bill is filed more than thirty days before the final submission, see *Craig v. Smith* (1879), 100 U. S. 226; 17 O. G. 145.

That if the plaintiff fails to appear at the trial and the court examines the pleadings, proofs, and exhibits, and decrees for the defendant, a bill of review cannot be sustained unless it alleges new matter or an error on the record, see *Irwin v. Meyrose* (1381), 2 McCrary, 244; 7 Fed. Rep. 533. This case contains a discussion of bills of review and decisions thereon.

⁵ That a decree by consent cannot be set aside by a bill of review, see *In re Pentlarge & Beeston* (1879), 17 Blatch. 306; 4 Bann. & A. 607.

to some issue covered by the decree; that, if the testimony is received, the decree upon this issue will be more favorable to the petitioner; and that he had employed due diligence in the investigation and presentation of his evidence at the former trial.⁶ If the bill is sustained, the decree is opened and a new hearing takes place, upon which the decision, and if necessary the new reference and accounting, will proceed.

§ 1165. Bill of Revivor.

When by the death of either of the parties a suit-in equity becomes abated, a bill of revivor will restore it and permit the court to proceed to its determination.¹ A bill of revivor can be filed only by or against the personal representatives, as distinguished from the assignee or devisee, of the deceased party, and only when the death does not prevent the court from granting the desired relief.² Thus if the original bill prays for an injunction and account, and the defendant dies before the final decree, though an injunction is no longer possible, a bill of revivor will perpetuate the suit against his representatives and enable the plaintiff to secure his damages and profits against the estate.³ A devisee, although

⁶ That a petition for leave to file a supplemental bill in the nature of a bill for a review must show that the petitioner could not with reasonable diligence have discovered the alleged new matters before the hearing and decision, and that the new matter is material, see *Spill v. Celluloid Mfg. Co.* (1884), 22 Blatch. 441; 29 O. G. 773; 22 Fed. Rep. 94.

That a bill of review will not be granted when the petitioner could, by diligent attention to the exhibits attached to the original bill, have found out what he now relies on as new matter, or where the court is satisfied that the decree will be the same, see *Rubber Co. v. Goodyear* (1869), 9 Wall. 805.

§ 1165. ¹ Equity Rule 56.

That where the defendant dies pending suit, a bill of revivor may be filed against his representatives, see *Hohorst*

v. Howard (1888), 37 Fed. Rep. 97; *Kirk v. Du Bois* (1886), 28 Fed. Rep. 460; 37 O. G. 102; *Smith v. Baker's Adm'rs* (1874), 5 O. G. 496; 10 Phila. 221; 1 Bann. & A. 117.

² That a bill of revivor is not to be filed by the assignee of the original complainant, but only by the legal representatives of a deceased party, see *Metal Stamping Co. v. Crandall* (1880), 18 O. G. 1531.

That a bill of revivor will lie only where the cause of action would survive, see *Story Eq. Pl. § 356*.

³ That where a decree fixing the liability of a defendant is rendered during his lifetime, the suit will survive, see *Atterbury v. Gill* (1877), 13 O. G. 276; 2 Flippin, 239; 3 Bann. & A. 174.

That on the death of a defendant, pending a bill for an injunction and account, a bill will lie against his rep-

unable to avail himself of a bill of revivor, may file an original bill of the same character, and obtain thereby the benefit of the previous proceedings.⁴ An action abated by any other event than the death of a party, if the cause of action still exists, may be restored in a similar manner by a bill in the nature of a bill of revivor.⁵

§ 1166. Bill to Perpetuate Testimony.

Auxiliary to actions for infringement are two other equitable proceedings: a Bill to Perpetuate Testimony, and a Bill of Discovery. A bill to perpetuate testimony is required whenever it becomes apparent that on a future action, which the proper plaintiff refuses to commence or which he cannot yet begin, certain evidence will be important, and that, though now available, this evidence may at that time be beyond the reach of the petitioner.¹ Upon this bill, its allegations being sustained by proof, the court will cause the testimony to be taken in some suitable manner, and preserved among the records of the court, until it may be needed at the trial.²

§ 1167. Bill of Discovery.

A bill of discovery is a bill praying for the compulsory disclosure of certain facts within the knowledge of the re-

presentatives to revive the suit and obtain an account, see *Smith v. Baker's Admrs.* (1874), 5 O. G. 496; 1 Bann. & A. 117; 10 Phila. 221.

That under Rule 56 a bill of revivor filed by an administrator when the defendant died after the interlocutory decree against him, and while the case was before the master for an award, does not revive the case unless the court so orders, see *Atterbury v. Gill* (1877), 13 O. G. 276; 2 Flippin, 239; 3 Bann. & A. 174.

⁴ That a devisee is unable to obtain a bill of revivor, though he may have relief and the benefit of the prior proceedings on filing an original bill in the nature of a bill of revivor, see *Story Eq. Pl. §§ 377-379.*

⁵ Equity Rule 56.

That the death of a patentee after an appeal does not abate the suit, see *Illinois Central R. R. Co. v. Turrill* (1884), 110 U. S. 301; 26 O. G. 917.

§ 1166. ¹ As to the object and nature of a Bill to Perpetuate Testimony, see 2 *Story Eq. Jur. §§ 1505-1516.*

That a bill for the perpetuation of testimony will not be granted where a suit can at once be brought by the petitioner, see *New York & Baltimore Coffee Polishing Co. v. New York Coffee Polishing Co.* (1881), 9 *Fed. Rep.* 578; 20 *Blatch.* 174.

² As to the form of and proceedings in a Bill to Perpetuate Testimony, see *Story Eq. Pl. §§ 300-310.*

spondent, or the production of certain documents or other articles within his custody or control.¹ It is ordinarily employed only in aid of suits at law, or as collateral or introductory to other equitable proceedings.² The bill must aver some right in the petitioner which the discovery might help to vindicate, and demand information which might constitute a ground for some claim or defence in the principal action.³ The respondent named must be a party to such action, and not simply a witness.⁴ A corporation may be called upon for a discovery by this proceeding and must answer; but if a disclosure under oath is to be ordered, its officers must also be made parties.⁵ Under a mere bill of discovery, the petitioner can obtain no other assistance than the disclosure for which he asks; but if his bill contains a prayer for general

§ 1167. ¹ As to the nature and object of a Bill of Discovery, see 2 Story Eq. Jur. §§ 689-691, 1480-1504; Equity Rules, 40-44.

For a discussion of the value and employment of bills of discovery, see *Colgate v. Compagnie Française* (1885), 23 Blatch. 86; 23 Fed. Rep. 82.

² That a bill of discovery of royalties due is not allowable except in aid of an action at law, the legal remedy being sufficient, see *Perkins v. Hendryx* (1885), 23 Fed. Rep. 418.

That a court of law cannot compel the defendant to allow an inspection of his methods as equity can, and thus a bill of discovery in aid of a suit at law is proper, see *Colgate v. Compagnie Française* (1885), 23 Fed. Rep. 82; 23 Blatch. 86.

That a bill of discovery will lie in the Circuit court, as ancillary to a suit for infringement, irrespective of citizenship, see *Kendall v. Winsor* (1860), 6 R. 1. 453.

³ That a bill of discovery must aver a title to be aided by the discovery, and if it is imperfect it cannot be treated as a bill for general relief, see *Young v. Colt* (1852), 2 Blatch. 373.

That a defendant cannot demand a discovery from the plaintiff as to his title and its source and validity by a cross-bill, unless he alleges title in himself, see *Young v. Colt* (1852), 2 Blatch. 373.

That discovery in patent cases is of the nature of an inspection, and is more effective than adverse testimony, see *Colgate v. Compagnie Française* (1885), 23 Blatch. 86; 23 Fed. Rep. 82.

For the requisites of a Bill of Discovery, see Story Eq. Pl. §§ 311-325.

⁴ That discovery can be obtained only from one who is a party to the bill, see Equity Rule 40.

⁵ That a corporation may be defendant on a bill of discovery in aid of a suit at law for infringement, and must make answer, though it cannot answer under oath, see *Colgate v. Compagnie Française*, (1885), 23 Fed. Rep. 82; 23 Blatch. 86.

That where a corporation is defendant in a bill of discovery the officers must be made parties, if the discovery is to be on oath, see *Vaughn v. East Tennessee, Virginia, & Georgia R. R. Co.* (1877), 11 O. G. 789; 1 Flippin, 621; 2 Bann. & A. 537.

relief, and the discovery is made, the court may grant whatever remedy the facts disclosed require.⁶

SECTION V.

OF INFRINGEMENT: INJUNCTIONS.

§ 1168. Value of Preventive Equitable Action in Cases of Expected Infringement.

The exercise of its preventive jurisdiction by a court of equity, in cases of infringement, is the most potent and most valuable of all the methods provided by the law for the protection of the owner of a patent.¹ It removes from him the danger of an irremediable injury, precludes the necessity of innumerable suits for his successive wrongs, and interposes in the path of the infringer an obstacle which he cannot overcome.² It is the proper complement of that legislative

⁶ That under a bill for discovery only, the plaintiff is not entitled to an account, see *Magic Ruffle Co. v. Elm City Co.* (1877), 11 O. G. 501; 14 Blatch. 109; 2 Bann. & A. 506.

That a bill in equity, stating approximately the amount of the defendant's gains and praying for a disclosure, is not a bill of discovery or a bill praying for a discovery, see *Gordon v. Anthony* (1879), 16 O. G. 1135; 16 Blatch. 234; 4 Bann. & A. 248.

That the admission of counsel as to the object of a bill is disregarded, for if the bill appears to be a bill for a discovery, it is such, see *Perry v. Corning* (1868), 6 Blatch. 134.

That a bill praying for an answer on oath and an account, though it does not allege that a discovery is necessary or contain interrogatories, or pray for an injunction, is a bill for a discovery and account and is sufficient, see *Perry v. Corning* (1868), 6 Blatch. 134.

That where a discovery is necessary and granted, the court may take entire

jurisdiction and give complete relief, see *Magic Ruffle Co. v. Elm City Co.* (1877), 11 O. G. 501; 14 Blatch. 109; 2 Bann. & A. 506.

That under a bill for discovery and other equitable relief, if the object of the plaintiff is to obtain damages, the discovery being had the court will give relief in damages, see *Magic Ruffle Co. v. Elm City Co.* (1877), 11 O. G. 501; 14 Blatch. 109; 2 Bann. & A. 506.

§ 1168. ¹ That there can be no injunctions at law, see *Motte v. Bennett* (1849), 2 Fisher, 642.

That only equity can prevent an invasion of rights, see *McMillin v. Barclay* (1871), 5 Fisher, 189; 4 Brews. (Pa.) 275.

That a court of equity may decree a final remedy, and also protect property during litigation, see *Potter v. Dixon* (1863), 2 Fisher, 381; 5 Blatch. 160.

² That the purpose of an injunction is to prevent infringements and a multiplicity of suits, see *Brooks v. Miller* (1886), 28 Fed. Rep. 615; *Brooks v.*

action which confers upon the inventor his exclusive privilege, — the one prohibiting all interference with his monopoly, the other practically enforcing this prohibition against individual transgressors; and could the patentee be always forewarned of the intended invasions of his rights, and were he vigilant in seeking this form of relief, no other litigation would ever be required. An injunction is thus the strong arm of the court, at once prompt in its action and effective in its results,³ never to be employed when other remedies are adequate, but applied unhesitatingly and without restriction wherever the plaintiff cannot otherwise escape irreparable or repeated injuries.⁴

§ 1169. Classes of Injunctions: Preliminary Injunctions and Perpetual Injunctions.

Injunctions in actions for infringement, as in other cases, may be either preliminary or perpetual. A preliminary injunction issues at the commencement, or during the pendency, of other proceedings in equity or at law. It is intended to compel the defendant to desist from his alleged infringing acts until it becomes evident that they do not invade the plaintiff's patent, and thus preserve affairs in *statu quo* while the necessary investigation is in progress in the courts.¹ A perpetual injunction is a decree upon the merits of the contro-

Norcross (1851), 2 Fisher, 661; *Motte v. Bennett* (1849), 2 Fisher, 642.

³ That an injunction is the strong arm of equity and is never to be used unless the court is convinced of its real necessity, see *Potter v. Schenck* (1866), 3 Fisher, 82; 1 Bissell, 515.

⁴ That an injunction will issue whenever it is needed to protect rights, see *Wilson v. Barnum* (1849), 2 Fisher, 635; 1 Wall. Jr. 347; 2 Robb, 749.

That it is the duty of the court to protect the plaintiff's clear rights by an injunction and thus prevent a multiplicity of suits, see *Ely v. Monson & Brimfield Mfg. Co.* (1860), 4 Fisher, 64.

That an injunction is often the only available remedy, see *Potter v. Muller* (1864), 2 Fisher, 465.

§ 1169. ¹ That the object of an injunction is to preserve matters *in statu quo* till the court has investigated them, and if it is of no importance thus to preserve them no injunction will issue, see *Westinghouse Air Brake Co. v. Carpenter* (1887, 32 Fed. Rep. 484; *American Nicholson Pavement Co. v. City of Elizabeth* (1870), 4 Fisher, 189.

That an injunction is granted to preserve the existing order of things, not to disturb it, even though rights may be doubtful, see *Singer Mfg. Co. v. Union Button Hole & Embroidery*

versy, after a trial in equity and a judgment for the plaintiff, permanently prohibiting the defendant from the performance of those acts which have been proved and adjudged to be violations of the patent. Its purpose is to put an end to the manufacture, use, or sale of the invention by the defendant, until the exclusive privilege of the inventor has expired.

§ 1170. Preliminary Injunction: Discretion of the Court in Granting it Guided by Established Rules.

A preliminary injunction is not, like a perpetual injunction, a matter of course, nor can its issue be governed by any formulated and established rules. Its allowance or refusal depends neither upon the plaintiff's right nor on the defendant's wrong, but upon innumerable qualifying circumstances of varying importance, affecting the minds of different judges in a different manner, and rendering each case emphatically a case by itself, whose decision rests entirely with the individual court to which it is presented.¹ Nevertheless, there are certain principles by which the courts are guided in the grant of these injunctions, and certain facts which operate as arguments for or against their issue. These facts and principles require detailed discussion, and in the following paragraphs their character and bearing on preliminary injunctions will therefore be considered. So far as the same principles or facts are applicable to perpetual injunctions they will be hereafter noticed.

Co. (1873), 4 O. G. 553; 6 Fisher, 480; Holmes, 253.

That the purpose of an injunction is to disturb the existing order of things and set them right, see *Cook v. Ernest* (1872), 5 Fisher, 396; 2 O. G. 89.

That an injunction does not impair the right of trial by jury, but merely aids the party having a legal title to protect it till such trial can be had, see *Woodworth v. Rogers* (1847), 3 W. & M. 135; 2 Robb, 625.

§ 1170. ¹ That on a motion for an injunction the only question is whether

the plaintiff presents an undebatable case, see *Goodyear v. Hills* (1866), 3 Fisher, 134.

That a motion for an injunction depends on its own facts, and the court must decide so as to accomplish the ends of justice and the purposes of its jurisdiction, see *Potter v. Crowell* (1866), 3 Fisher, 112; 1 Abbott, 89.

That on a motion for an injunction the court will carefully consider the rights of parties, and protect the patentee during the litigation, see *Morris v. Lowell Mfg. Co.* (1866), 3 Fisher, 67.

§ 1171. Preliminary Injunction: Grantable only to Prevent Prospective Injury where no other Adequate Remedy Exists.

A preliminary injunction is intended to prevent a prospective injury, and must be confined to the purpose for which it is designed.¹ It cannot be employed for the punishment of past infringements, nor as a method of compelling the defendant to compromise existing controversies, nor to restrain third parties from contracting with the alleged infringer.² It is exclusively an auxiliary and collateral remedy, applied only in cases where the right is probable and the invasion of the right apparent, and contemplates a trial of the principal action on its merits, in which the existence, nature, and extent of the infringement will be definitely ascertained.³ Hence where the right is doubtful, or the wrong uncertain, or where some other mode of temporary protection is equally beneficial to the plaintiff and less injurious to the defendant, or where the object of the plaintiff is not protection to himself but punishment or coercion to the defendant, the injunction ought to be and is refused.⁴

§ 1172. Preliminary Injunction: Grant or Refusal not Subject to Appeal.

The issue or refusal of a preliminary injunction is always within the discretion of the court, and from its judgment

§ 1171. ¹ In *American Nicholson Pavement Co. v. City of Elizabeth* (1870), 4 Fisher, 189, Strong, J. : (194) "A preliminary injunction is always an extraordinary exercise of judicial powers. Its purpose is to preserve the existing state of things until the rights of the parties can be fairly investigated. It is not to be used for any other purpose. It looks forward to a trial, and when it is of no importance to preserve things as they are, when the injunction is asked for, it will not be granted. It ought never to be issued unless the right of a patentee is an established or admitted one, and unless the alleged

invasion of the right is proved beyond reasonable doubt."

² See § 1196 and notes, *post*.

³ That the act of Feb. 15, 1819, does not alter the principles on which injunctions are granted, see *Sullivan v. Redfield* (1825), 1 Paine, 441 ; 1 Robb, 477.

⁴ That an injunction, though needed, is not to be granted without great caution before a final decree on the merits, see *Goodyear v. Dunbar* (1859), 1 Fisher, 472 ; 3 Wall. Jr. 810.

That an injunction will only issue *nisi* if the defendants are ready to stop infringing and the validity of the patent

there is no appeal.¹ The law presumes that, as the circumstances of cases differ, so judges will inevitably disagree in the views they take of the same circumstances, and in the significance which they attach to the particular facts which enter into their decisions. The widest liberty is necessarily conceded to the courts in the exercise of this authority, and action in accordance with their best discretion is all that is required.² Discretion is not, however, prejudice or arbitrary whim. It involves the obligation to determine each case by what has been done by equity in like cases, in conformity with the practice in equity and the principles on which equity decides.³ To do exact justice between the parties, according to

is doubtful, see *Margot v. Schnetzer* (1883), 15 Fed. Rep. 118; 24 O. G. 101.

§ 1172. ¹ That the grant of an injunction rests in the discretion of the court, see *Irwin v. Dane* (1871), 4 Fisher, 359; 2 Bissell, 442; *Potter v. Whitney* (1866), 3 Fisher, 77; 1 Lowell, 87; *Ayling v. Hull* (1865), 2 Clifford, 494.

That courts have, under Sec. 4921, Rev. Stat., a larger discretion as to injunctions in patent cases than in others, see *Yuengling v. Johnson* (1877), 1 Hughes, 607; 3 Bann. & A. 99.

² In *Earth Closet Co. v. Fenner* (1871), 5 Fisher, 15, Knowles, J. : (20) "The motion is one of that class addressed, in technical parlance, to the discretion of the court. For precedents, in any recognized sense of that word, it is, therefore, idle to search. By one judge an injunction may be granted to-day under a given state of facts, and by another be refused to-morrow upon identically the same state of facts, and yet neither functionary be chargeable with even error in judgment. The law makes the judge's discretion the rule, not unheeding that, in the qualities of mind which give character to an exercise of discretion, individuals differ scarcely less than in form and features. The judge is bound to de-

cide a question of this kind as, in his judgment upon the particular case before him, the principles of equity, and the practice of its courts warrant or dictate,—and this, whether his decision be in accord or at variance with that of his brother officer, of whatever grade or whatever locality. The largest liberty imaginable is his, 'with no rules to restrain, no after reckoning to dread.' Neither upon appeal, nor by writ of error, nor even by petition for revisory action, can a judge's rulings or findings upon a motion for a preliminary injunction be subjected to correction or even criticism on the part of his superiors in official rank or in judicial acumen."

That the best exercise of discretion is all that can be expected, see *Potter v. Whitney* (1866), 3 Fisher, 77; 1 Lowell, 87.

³ In *Motte v. Bennett* (1849), 2 Fisher, 642, Wayne, J. : (645) "By discretion, of course, is meant an obligation upon judges in chancery to determine each case, as nearly as it can be done, by what has been the course in chancery in like cases, as well as to prescribe the practice to be observed in each case, and the principles by which the right is to be determined between the parties in controversy. It never means will or authority in the

the condition of the litigation, the nature of the invention, the character and extent of the infringement, and the effect of the injunction on the interests of the plaintiff and defendant, must be the motive and endeavor of the court, and in the effort to accomplish this the analogy of precedents and the established rules of equity must be the acknowledged and controlling guide.⁴ While these are followed, the weight of evidence, the bearing of the facts, and the justice of the antagonistic claims are for the judge alone.

§ 1173. Preliminary Injunction: Granted only when the Patent is Valid, the Title is in the Plaintiff, and there is Danger of an Infringement by the Defendant.

A preliminary injunction will be granted only when the court is satisfied: (1) That the patent is valid; (2) That the plaintiff is the owner of a legal or equitable interest therein; and (3) That the defendant is about to commit an act of infringement.¹ It will be denied if reasonable doubt exists on any one of these points, and even when they are established if other circumstances render its allowance inexpedient or inequitable. Upon an application for a preliminary injunction, an exhaustive hearing as to these essential points

judge, but both restrained by decided cases or long-standing rules."

⁴ That though a preliminary injunction is a matter of discretion, not of precedent, the discretion is to be exercised as the rules of equity and the practice of the courts may require in the case at bar, see *Earth Closet Co. v. Fenner* (1871), 5 Fisher, 15.

§ 1173. ¹ In *Motte v. Bennett* (1849), 2 Fisher, 642, Wayne, J.: (659) "In equity, where the case is clear and without reasonable doubt, where the bill states a clear right to the thing patented which, together with the alleged infringement is verified by affidavit, and where the plaintiff has been in possession of it by having sold or used it in part or in the whole, the court will grant an injunction and continue it till the hearing or further order with-

out sending the plaintiff to law to try his right. And the rule applies as well to a bill brought by an assignee as by the original inventor." See also *Wise v. Grand Avenue R. R. Co.* (1888), 33 Fed. Rep. 277.

Further, that an injunction will issue only when the validity of the patent, the right of the plaintiff, and infringement, actual or prospective, by the defendant, are shown to the satisfaction of the court, see *Shelly v. Brannan* (1870), 4 Fisher, 198; 2 Bissell; 315; *Goodyear v. Hills* (1866), 3 Fisher, 134; *Potter v. Muller* (1864), 2 Fisher, 465; *Goodyear v. Day* (1852), 2 Wall. Jr., 283.

That no injunction will issue on a theory unsupported by proof, see *American Diamond Rock Boring Machine Co. v. Sullivan Mach. Co.* (1877), 14 Blatch. 119; 2 Bann. & A. 522.

is not, however, usually permitted. The court will not anticipate the trial on the merits by an extended examination of the testimony then to be produced, but in cases involving obscure propositions of law, or disputed and intricate questions of fact, will refuse the injunction until these matters come up for investigation in their proper order.² This necessary attitude of the courts toward these applications has led to the adoption of peculiar rules of evidence, by which the plaintiff is required to furnish certain special forms of proof, or in their absence to await the final hearing before invoking this preventive power.

§ 1174. Preliminary Injunction : Proof of Validity of Patent : Prior Judgment in its Favor : Public Acquiescence : Admissions of Defendant.

Under these rules of evidence the validity of the patent must be proved either by the judgment of some competent tribunal, or by the long-continued acquiescence of the public in the exclusive privilege which it confers, or by some other act or fact equivalent thereto.¹ The judgment of a compe-

² That on a motion for an injunction the court will only examine far enough to see whether the plaintiff's equitable rights require such protection during the litigation, see *Sickels v. Young* (1855), 3 Blatch. 293.

That a motion for a preliminary injunction is not designed to adjudicate disputed points not previously discussed, see *Gold & Stock Telegraph Co. v. Commercial Telegraph Co.* (1885), 22 Fed. Rep. 838.

That on a motion for a preliminary injunction, the court is not bound to decide difficult questions of law or disputed issues of fact, nor to order an injunction till after a full hearing, see *Parker v. Sears* (1850), 1 Fisher, 93.

§ 1174. ¹ In *Brown v. Hinkley* (1873), 3 O. G. 384, Longyear, J. : (384) "To entitle a patentee to the extraordinary writ of injunction, it is not sufficient for him merely to show

his patent and an infringement of it. His right must be further substantiated in one of two ways: first, by a possession accompanied by an actual use and enjoyment of it for a sufficient length of time to afford a reasonable presumption of the acquiescence of the public in its validity; or, second, by a judgment in his favor in a trial at law. The latter, however, is never necessary where the former exists; but I understand it to be essential in all cases that there should be a trial at law in the absence of such use and enjoyment. This has been the rule in England for more than a century, and it has always been the rule in the United States. The decisions by which the rule is established, and the reasons upon which it is based, are too numerous to be cited here." 6 Fisher, 370 (373).

In *Toppan v. National Bank Note Co.* (1861), 2 Fisher, 195, Shipman,

tent tribunal sustaining a patent is the highest evidence of its validity. It is not only conclusive upon the parties to the

J.: (108) "This extraordinary relief is never granted as matter of course. It is never granted on filing a bill and producing a patent. The patent itself, although in a certain sense it is *prima facie* evidence of the validity of the grant, is never sufficiently strong *per se* to warrant the relief asked for in this motion. The title of the patentee must, in order to obtain this relief, always be strengthened by exclusive possession for some period of time, or by an adjudication in which the validity of the patent has been sustained." 4 Blatch. 509 (511).

In *Grover & Baker Sewing Mach. Co. v. Williams* (1860), 2 Fisher, 133, Sprague, J.: (135) "In such a hearing it is not sufficient for a plaintiff, in order to make out a *prima facie* case, merely to produce his patent. The court will not, upon the mere production of a patent, entertain this motion for a preliminary injunction. The *prima facie* right under the patent must be strengthened; and that is done in one of two ways, by a judgment or decree after a judicial investigation, or by exclusive possession for some time, or, in other words, by the acquiescence of the public in the claims which the plaintiff has set up under his patent to a monopoly."

In *Orr v. Littlefield* (1845), 1 W. & M. 13, Woodbury, J.: (15) "It is not enough that a party has taken out a patent, and thus obtained a public grant, and the sanction or opinion of the Patent Office in favor of his right, though that opinion, since the laws were passed requiring some examination into the originality and utility of inventions, possesses more weight. But the complainant must furnish some further evidence of a probable right; and though it need not be conclusive evi-

dence, — also additional hearing on the bill would thus be anticipated and superseded, — yet it must be something stronger than the mere issue, however careful and public, of the patent conferring an exclusive right; as in doing that, there is no opposing party, no notice, no long public use, no trial with any one of his rights. The kind of additional evidence is this. If the patentee, after the procurement of his patent conferring an exclusive right, proceeds to put that right into exercise or use for some years without its being disturbed, that circumstance strengthens much the probability that the patent is good, and renders it so likely as alone often to justify the issue of an injunction in aid of it. . . . After that it becomes a question of public policy no less than private justice whether such a grant of a right, exercised and in possession so long, ought not to be protected until avoided by a full hearing and trial." 2 Robb, 323 (326).

Further, that no injunction will be granted unless the patent has been sustained by a judgment, or acquiescence in a long exclusive use, or its equivalent, see *Edward Barr Co. v. New Haven Automatic Sprinkler Co.* (1887), 43 O. G. 392; 32 Fed. Rep. 79; *Foster v. Crossin* (1885), 23 Fed. Rep. 400; *Kirby Bung Mfg. Co. v. White* (1880), 17 O. G. 974; 1 Fed. Rep. 604; 1 McCrary, 155; 5 Bann. & A. 263; *Hockholzer v. Kager* (1873), 2 Sawyer, 361; *Doughty v. West* (1865), 2 Fisher, 553; *Orr v. Littlefield* (1845), 1 W. & M. 13; 2 Robb, 323; *Ogle v. Ege* (1826), 4 Wash. 584; 1 Robb, 516.

That the decisions of the courts sustaining patents do not ratify the defects in them, see *Ex parte Murray* (1873), 3 O. G. 659.

controversy in which the judgment was rendered, but often constitutes so strong a general presumption in favor of the patent that, for the purposes of a preliminary injunction, no other persons are allowed to contradict it.² The universal recognition of the patent as creating a legitimate monopoly, and the consequent submission of the public, against their interest, to the claims which it asserts, is evidence in its support whose weight and value are surpassed only by those afforded by a judgment.³ Admissions by the defendant acknowledging or implying an acknowledgment that the patent is valid, and other facts of similar significance and force, may be received when public acquiescence and judgments are both wanting.⁴ All these forms of proof are definite, easily procured and presented, and usually preclude contradiction, — characteristics which render them especially suitable for the purposes of a preliminary hearing.⁵

² That a judgment sustaining the patent is evidence of its validity for the purposes of an injunction, see *Putnam v. Keystone Co.* (1889), 38 Fed. Rep. 234; *Stuart v. Thorman* (1888), 37 Fed. Rep. 90; *Wells v. Gill* (1872), 2 O. G. 590; 6 Fisher, 89. Also §§ 1175-1184, and notes, *post*.

That a current of decisions sustaining a patent is not to be departed from without good reason, see *American Bell Telephone Co. v. Wallace Electric Telegraph Co.* (1889), 37 Fed. Rep. 672; *Hammerschlag Mfg. Co. v. Spalding* (1888), 35 Fed. Rep. 67.

That an injunction will be granted on proof of infringement only, if the patent has been sustained by repeated judgments, especially where the defendant was interested in the prior defences, see *Robertson v. Hill* (1873), 6 Fisher, 465; 4 O. G. 132.

That an injunction will issue where a patent has but a short time to run, and has been fully sustained by judgments, see *Cary v. Domestic Spring Bed Co.* (1885), 27 Fed. Rep. 299.

That an injunction will issue under an extension, if the original had been

established by adjudication, see *Clum v. Brewer* (1855), 2 Curtis, 506.

³ That acquiescence in the monopoly is evidence to prove the validity of the patent, on a motion for an injunction, see *McCoy v. Nelson* (1887), 121 U. S. 484; 39 O. G. 831; *Miller v. Androscoggin Pulp Co.* (1872), 1 O. G. 409; 5 Fisher, 340; *Holmes*, 142; *Goodyear v. Railroad* (1853), 1 Fisher, 626.

Also §§ 1185-1188, and notes, *post*.

⁴ That admissions by the defendant and other evidence may supply the place of judgments and acquiescence, see § 1189 and notes, *post*.

⁵ In stating the evidence on which preliminary injunctions will be granted or refused, courts often combine two or more of these forms, or even assert that one without the other is insufficient. A number of these statements are here cited, not merely as illustrations of the practice, but that the cases themselves may be examined in connection with the more accurate enunciations referred to in the notes to this and the succeeding paragraphs.

That an injunction will be refused where the patent has not been adjudi-

§ 1175. **Preliminary Injunction: Prior Judgment as Evidence of Validity: Circumstances Determining the Weight of Prior Judgments.**

The weight to be attached to any judgment in favor of a patent, as evidence of its validity in future actions, depends

cated and patentability is doubtful, see *Baldwin v. Conway* (1887), 32 Fed. Rep. 795.

That a jury trial has not been a prerequisite to an injunction in England since 1761, if the court is satisfied of the infringement, though the validity of the patent is disputed, see *Motte v. Bennett* (1849), 2 Fisher, 642.

That an injunction will be granted if there has been long acquiescence in the patent and judgments sustaining it, and clear infringement, see *Schneider v. Missouri Glass Co.* (1888), 36 Fed. Rep. 582; *American Shoe Tip Co. v. National Shoe Toe Protector Co.* (1877), 11 O. G. 740; 2 Bann. & A. 551.

That where many licenses had been taken, the invention fully examined in the Office, and a *quasi* judgment rendered in its favor in a neighboring circuit, an injunction was issued, the injury to the defendant being trifling as compared with plaintiff's if it were refused, see *Hat Sweat Mfg. Co. v. Davis Sewing Mach. Co.* (1887), 32 Fed. Rep. 401; 41 O. G. 1273.

That an injunction will issue if the patent is of long standing, has been extended in the face of opposition, and sustained by the Federal courts, unless some other tribunal has declared it invalid, see *Putnam v. Weatherbee* (1875), 8 O. G. 320.

That an injunction will issue if the patent has been used for eleven years, been sustained by the courts, and been extended, see *Cook v. Ernest* (1872), 2 O. G. 89; 5 Fisher, 396.

That an injunction may be granted when the infringement is clear and the plaintiff's right is evidenced by a judg-

ment or decree in his favor and an extensive public acknowledgment, see *American Nicholson Pavement Co. v. City of Elizabeth* (1870), 4 Fisher, 189.

That an injunction will issue if there has been long possession, or frequent recoveries, unless the patent appears to be void, see *Woodworth v. Hall* (1846), 1 W. & M. 248; 2 Robb, 495.

That an injunction will be granted where there has been an infringement, a long enjoyment of the patent, and its validity is not disproved, see *Miller v. Androscoggin Pulp Co.* (1872), 5 Fisher, 340; 1 O. G. 409; Holmes, 142.

That an injunction will be granted where priority and infringement are not questioned, and where the public have generally acquiesced and admitted the novelty of the invention, though no prior judgment has sustained the patent, see *Weston v. White* (1876), 13 Blatch. 447; 2 Bann. & A. 364.

That an injunction will be granted where the patent, being supported by the oath of the inventor, the action of the Patent Office, and an undisturbed enjoyment, has also been sustained by judgments and enforced by prior injunctions, see *Hussey v. Whitely* (1860), 1 Bond, 407; 2 Fisher, 120.

That an injunction will be granted when there exist undisputed use and infringement, see *Chase v. Wesson* (1873), Holmes, 274; 4 O. G. 476; 6 Fisher, 517.

That if the novelty and infringement are clear, an injunction may issue though the patent has never been judicially sustained, see *Foster v. Crossin* (1885), 23 Fed. Rep. 400.

That no injunction will issue where

upon the identity of parties, the identity of issues, the identity of testimony, and the authority of the tribunal by which the former controversy was decided.¹ The judgment of a court of last resort, in a suit between the same parties, on the same issues, and on the same or equivalent evidence, is conclusive. The decision of an inferior tribunal, in a litigation between different parties or upon different issues, and without a full examination of the facts or law, is of slight or no importance. A judgment sustaining a patent may thus possess any degree of weight as proof of its validity, from absolute

there has been no judgment, and no acquiescence, unless the plaintiff's right is clear and the infringement proved, see *North v. Kershaw* (1857), 4 Blatch. 70.

That where the defendant denies the validity of the patent unless it is construed as he claims, no injunction will issue until the plaintiff shows a prior judgment or its equivalent, see *Dickerson v. De La Vergne Refrigerating Mach. Co.* (1888), 35 Fed. Rep. 143.

That an injunction will be refused unless there has been an exclusive possession or public acquiescence, or a trial at law, see *Muscan Hair Mfg. Co. v. American Hair Mfg. Co.* (1858), 1 Fisher, 20; 4 Blatch. 174.

That no injunction will issue until after a trial at law unless the plaintiff shows a clear and unquestionable right, or such an exclusive possession for so long a time as to raise a presumption of such right, see *Thomas v. Weeks* (1827), 2 Paine, 92, and notes.

That no injunction will be granted where there has been neither long exclusive possession, nor any judgment, nor irreparable injury, see *Earth Closet Co. v. Fenner* (1871), 5 Fisher, 15.

That where a patent is sustained only by acquiescence, no injunction will issue unless the infringement is palpable, see *Burleigh Rock Drill Co. v. Lobdell* (1875), 7 O. G. 836; *Holmes*, 450; 1 Bann. & A. 625.

These decisions are, for the most part, substantially correct, but are stated too broadly, or with unnecessary restrictions, or with indefiniteness, — rendering them unsafe guides except where interpreted by more accurate expressions of the law.

§ 1175. ¹ That an injunction will be granted, after a judgment against the defendant, without any further proof of the right or its violation, see *Poppenhusen v. New York Gutta Percha Comb Co.* (1858), 2 Fisher, 74; 4 Blatch. 184.

That if a former suit on the same patent between the same parties, with the same prayer for relief and raising the same issues, was dismissed, the present one must also be, see *Barker v. Stowe* (1882), 11 Fed. Rep. 303; 22 O. G. 259; 20 Blatch. 185.

That after a judgment against the defendant in a former suit on an issue of novelty he cannot, in a second suit, raise the same issue, see *Dubois v. Philadelphia, Wilmington, & Baltimore R. Co.* (1871), 5 Fisher, 208.

That a decree in favor of the plaintiff in one suit is no proof of public acquiescence in another suit against a defendant who was a stranger to the first suit, though it may be considered on a motion for a preliminary injunction, see *Matthews v. Iron Clad Mfg. Co.* (1884), 19 Fed. Rep. 321; *Buck v. Hermance* (1848), 1 Blatch. 322.

demonstration to a mere suggestion, according as these attributes exist, concur, and co-operate to augment or reduce its value as a precedent.

§ 1176. Preliminary Injunction: Prior Judgment as Evidence of Validity: Identity of Parties.

The identity of parties is a question for the court before which the subsequent action is conducted.¹ Parties include not only those whose names appear upon the record, but all others who participate in the litigation by employing counsel, or by contributing toward expenses, or who in any manner direct the course of the proceedings, as well as those who derive their rights from persons primarily interested in the suit.² Thus where several defendants, by agreement, contest

§ 1176. ¹ That the court trying a case is to determine conclusively who are parties and privies, see *Miller v. Liggett & Myers Tobacco Co.* (1881), 19 O. G. 1138; 7 Fed. Rep. 91; 2 McCrary, 375.

That the rules governing injunctions as to parties to suits at law are not the same as in patent cases, see *Motte v. Bennett* (1849), 2 Fisher, 642.

² That both parties and privies are concluded by a judgment, see *Miller v. Liggett & Myers Tobacco Co.* (1881), 19 O. G. 1138; 7 Fed. Rep. 91; 2 McCrary, 375.

That a person is bound by a decision when he has had all the rights of a party to it, see *Miller v. Liggett & Myers Tobacco Co.* (1881), 7 Fed. Rep. 91; 19 O. G. 1138; 2 McCrary, 375.

That a privy, to be concluded, must be privy in such sense that he can control the litigation by making motions, offering evidence, examining witnesses, and taking an appeal, see *Miller v. Liggett & Myers Tobacco Co.* (1881), 19 O. G. 1138; 7 Fed. Rep. 91; 2 McCrary, 375.

That a person who furnished money to pay counsel and carry on the suit,

under contract with the party to the record, can protect his own interest in the suit and is bound by the decree, see *Miller v. Liggett & Myers Tobacco Co.* (1881), 7 Fed. Rep. 91; 19 O. G. 1138; 2 McCrary, 375.

That one who employs counsel and pays the expenses of a suit, though not a party thereto, is concluded by the judgment, see *United States & Foreign Salamander Felting Co. v. Asbestos Felting Co.* (1880), 19 O. G. 362; 4 Fed. Rep. 816; 18 Blatch. 310; 5 Bann. & A. 622.

That when the patent has been sustained, after great litigation, against a defendant who is intimately connected with the present defendant, an injunction will be granted unless such evidence is offered as would probably have changed the result in the other case, see *Colgate v. Gold & Stock Telegraph Co.* (1879), 16 O. G. 583; 16 Blatch. 503; 4 Bann. & A. 415.

That an injunction will be granted when the patent has already been sustained in a suit to the defence of which the present defendants contributed, although they now claim to have a new witness to prove prior use, see *Birdsall v. Hagerstown Agricultural Implement*

one of the actions in their joint behalf, all become thereby parties to the suit, and are equally concluded by the judgment; and in an application for an injunction against either, this decision has controlling weight upon the issues then determined, unless new evidence is offered, or the former court is of inferior authority.³

§ 1177. Preliminary Injunction: Prior Judgment as Evidence of Validity: Identity of Issues.

A judgment is a precedent only upon the issues which it expressly, or by necessary implication, has determined.¹ This

Mfg. Co. (1874), 6 O. G. 604; 1 Bann. & A. 426.

That an injunction will be granted where parties, whose defence was conducted by the present defendant, were found guilty of an infringement on the same issues, see *Yale & Towne Mfg. Co. v. Consolidated Time Lock Co.* (1889), 38 Fed. Rep. 917; *United States & Foreign Salamander Felting Co. v. Asbestos Felting Co.* (1876), 10 O. G. 828.

That one who takes an assignment of a junior patent, pending proceedings in another circuit, is bound by the judgment there rendered, see *Tyler v. Hyde* (1851), 2 Blatch. 308.

That a former judgment between the same parties as to title is *res adjudicata*, see *Puetz v. Bransford* (1887), 41 O. G. 353; 32 Fed. Rep. 318.

That a verdict for one grantee is not evidence in a suit by another, though it will be considered on a motion for an injunction, see *Buck v. Hermanca* (1848), 1 Blatch. 322.

³ That where there are several suits against different defendants, one of which is made a test case, and after its decision in favor of the plaintiff, and an appeal, the appeal is abandoned in pursuance of an agreement with the defendant by the plaintiff, and the other cases are dismissed, the other defend-

ants are not bound by that decision, see *McMillan v. Conrad* (1883), 16 Fed. Rep. 128; 5 McCrary, 140.

That a servant or agent, separately sued, is not personally bound by a judgment against the principal, see *Hayes v. Bickelhaupt* (1885), 32 O. G. 136; 24 Fed. Rep. 806.

That where two different suits in different districts are brought on interfering patents under Sec. 4918, and the defendant in the second defended in the first, and the issues were the same, the former record is proper evidence and the former judgment is binding on the defendant, see *United States & Foreign Salamander Felting Co. v. Asbestos Felting Co.* (1880), 4 Fed. Rep. 813; 18 Blatch. 310; 5 Bann. & A. 624; 19 O. G. 363.

§ 1177. ¹ That courts render judgments only on the issues presented and between the litigant parties, see *Page v. Holmes Burglar Alarm Telegraph Co.* (1880), 2 Fed. Rep. 330; 18 Blatch. 118; 5 Bann. & A. 439.

That prior judgments sustaining the patent avail only within the scope of the points decided, see *Carey v. Miller* (1888), 34 Fed. Rep. 392.

That precedents are to be read in the light of circumstances, and are not authoritative unless the facts are the same, see *Wilson v. Coon* (1880), 19

is especially true in patent litigation, since a decision in favor of a patent does not assert its validity in all respects, but in those merely which have been the subject of attack. When each of the sixteen distinct defences which can be set up against a patent is advanced, and the patent is sustained in spite of all, the judgment is a complete and final vindication of the patent between the contesting parties, unless new evidence is offered which leads the later court to different conclusions. But when the former judgment covered no question which is involved in the subsequent litigation, the fact that it upheld the patent is of no significance, although the parties were the same, except so far as it can be presumed that the defences now alleged would have been urged on that occasion had they not been known to be entirely destitute of merit.² A judgment offered as evidence to support a patent upon an application for an injunction must, therefore, either show upon its face, or be accompanied by written or oral testimony to prove, that it decided the same issues which are now in con-

O. G. 482 ; 6 Fed. Rep. 611 ; 18 Blatch. 532.

That the Circuit courts follow prior decisions, where the same questions are raised on the same evidence, see *American Bell Telephone Co. v. Wallace Electric Telegraph Co.* (1889), 37 Fed. Rep. 672 ; *Spring v. Domestic Sewing Mach. Co.* (1881), 9 Fed. Rep. 505 ; 21 O. G. 633 ; *Edgerton v. Furst & Bradley Mfg. Co.* (1881), 21 O. G. 261 ; 10 Bissell, 402 ; 9 Fed. Rep. 450.

² That the effect of a former judgment may be avoided by showing that the plaintiff's title was not then in controversy, or that some material fact was then unknown or overlooked, see *Parker v. Brant* (1850), 1 Fisher, 58.

That a decision in a former suit avails nothing on the question of infringement, when the same facts are not in controversy, see *Worswick Mfg. Co. v. City of Kansas* (1889), 38 Fed. Rep. 239 ; *Clarke v. Johnson* (1879), 17 O. G. 1401 ; 16 Blatch. 495 ; 4 Bann. & A. 403.

That the defendant, on a motion for an injunction, may show that a former judgment did not decide the point now in controversy, or that the point was not then fairly in dispute, or that material facts have been since discovered, see *National Hat Pouncing Mach. Co. v. Hedden* (1886), 38 O. G. 1129 ; 29 Fed. Rep. 147.

That a judgment of the Supreme court is not conclusive on a motion for an injunction, unless the points now in issue were therein decided, see *Consolidated Safety Valve Co. v. Ashton Valve Co.* (1886), 26 Fed. Rep. 319.

That only a direct and affirmative judgment, determining the validity of the patent, affects parties in other courts, see *Tyler v. Hyde* (1851), 2 Blatch. 308.

That when the validity of the patent was not contested, though threatened, in the former suit, and judgment was obtained without collusion, the presumption in favor of the patent is very strong, see *Potter v. Holland* (1858), 1 Fisher, 382 ; 4 Blatch. 238.

troverſy.³ Thus if the former ſuit were based on ſeveral patents, or on ſeveral Claims in the ſame patent, or upon an original which has been ſince re-issued with additional Claims, it muſt appear that thoſe which were ſuſtained embraced the one whereon the preſent judgment turns.⁴ And where the defendant in the previous action confined himſelf to certain objections to the patent, making no effort to defeat it upon other grounds, the nature and extent of his objections, and their connection or identity with thoſe now offered, muſt be proved.

³ That a judgment is not *res adjudicata* unleſs the parties are the ſame, and the ſame precise matter was involved and determined in the judgment, and if this does not appear on the record it may be ſhown by extrinsic evidence, ſee *Ruſſell v. Place* (1876), 94 U. S. 606 ; 12 O. G. 53.

That where ſeveral matters may have been litigated, and it is uncertain which have been decided, all are open to diſpute, ſee *Ruſſell v. Place* (1876), 94 U. S. 606 ; 12 O. G. 53.

That where a patent covered both a general and a ſpecial proceſs, and it is uncertain on which Claim the former judgment was rendered, both are open to all defences, ſee *Ruſſell v. Place* (1876), 94 U. S. 606 ; 12 O. G. 53.

That unleſs the prior judgment ſhows which Claim of the patent was con- teſted, the ſcope of the patent and the fact of infringement are open for inquiry, ſee *Coburn v. Clark* (1883), 24 O. G. 899 ; 15 Fed. Rep. 804 ; 5 McCrary, 99.

That a judgment that a ſenior patentee is not the firſt inventor cannot affect the rights of a junior patentee, where the inventions are not identical, ſee *Brush v. Naugatuck R. R. Co.* (1885), 32 O. G. 894 ; 24 Fed. Rep. 371 ; 23 Blatch. 277.

That a decree ſuſtaining re-issue Claims will not be followed as a precedent, if a ſtricter rule of law has been

ſubſequentially recognized, ſee *National Wire Mattreſs Co. v. N. Y. Braided Wire Mattreſs Co.* (1884), 28 O. G. 96 ; 20 Fed. Rep. 119.

⁴ In *Coburn v. Clark* (1883), 15 Fed. Rep. 804, Treat, J. : (807) " A more ſearching inquiry is needed for preliminary injunctions than a mere perfunctory order covering, in an indefinite manner poſſibly, all the Claims of a patent, and all poſſible infringements of valid or invalid Claims, when it is impoſſible to determine from a final decree what was in detail decided. The true rule ſhould require it to be ſhown what Claim was held to be valid ; the validity of that ſpecific Claim having been brought into queſtion. It may be that the court on final hearing paſſed on only one of many Claims, and that the alleged infringement in ſuch a caſe pertained only to that ſpecific Claim. How is it as to other Claims on which no decision has been made ? Muſt a court, on a motion for a provisional injunction for alleged infringement of ſome other Claim, deem itſelf concluded when no court has paſſed upon the ſpecific inquiries ? There ſhould be a careful investigation of the precise points decided, and of the alleged infringement ; otherwiſe great wrongs may be perpetrated againſt one or the other of the parties litigant. Preliminary injunctions are not to be granted, it may be deſtructively to defendants, merely

§ 1178. Preliminary Injunction: Prior Judgment as Evidence of Validity: Identity of Available Testimony.

The judgment of a court upon any issue of fact is always liable to error, and therefore always open to revision. Although the action in which it is rendered may be finally concluded, and no further contest be allowed on the same pleadings, yet the fact itself is never settled or beyond investigation. In other actions, even between the same parties, and sometimes in proceedings supplemental to the former action, it may be again examined, if the discovery of new evidence or any alteration in the attitude of the litigants toward each other should render it expedient.¹ Hence when a previous judgment upon such an issue is offered and accepted as a precedent, it is only on the supposition that on a new trial of the question the same testimony would be pro-

because an indefinite decision has been made by some court whose views are not disclosed in its decree; and, on the other hand, when plaintiff's rights have been fairly determined, should piracy be tolerated *pendente lite*?" 24 O. G. 899 (900); 5 McCrary, 99 (102).

That one patent is not aided by acquiescence or judgments sustaining a different patent, unless they were so legally connected as to have been covered by the judgments, see *Hovey v. Stevens* (1846), 1 W. & M. 290; 2 Robb, 479.

That a judgment obtained without contest on several patents is not of as much weight as if only the one now in question had been sued on, see *Grover & Baker Sewing Mach. Co. v. Williams* (1860), 2 Fisher, 133.

That where the former judgment does not show what claims are held valid there are two questions open: (1) What does the patent cover? (2) Has the defendant infringed? see *Coburn v. Clark* (1883), 15 Fed. Rep. 804; 24 O. G. 899; 5 McCrary, 99.

That in citing patent cases the facts of the cases are especially to be considered, see *Bevin v. East Hampton Bell*

Co. (1871), 5 Fisher, 23; 9 Blatch. 50.

That an injunction will be granted upon the plaintiff's bill averring infringement, supported by a judgment sustaining the patent, unless the defendant avers facts not passed upon by the former judgment, see *Cary v. Domestic Spring Bed Co.* (1886), 26 Fed. Rep. 38; 34 O. G. 1158.

§ 1178. ¹ That circuit courts are guided by prior decisions only when the same questions were raised on the same evidence, see *Edgerton v. Furst & Bradley Mfg. Co.* (1881), 21 O. G. 261; 10 Bissell, 402; 9 Fed. Rep. 450; *Spring v. Domestic Sewing Mach. Co.* (1881), 21 O. G. 633; 9 Fed. Rep. 505.

That where a patent has been sustained by previous decisions against the same defendant, the patent will now be construed as it was in such former actions, and if its validity might then have been disputed on the same evidence as now offered the injunction will be granted, see *Clarke v. Johnson* (1879), 17 O. G. 1401; 16 Blatch. 495; 4 Bann. & A. 403.

duced and the same result be reached.² And if in opposition to the judgment the defendant urges that the former trial did not properly disclose the facts, or that evidence not then introduced has since become attainable, the court may hear the testimony anew, and if convinced that error was committed may disregard the judgment, and decide *de novo* on the question of validity.³

§ 1179. Preliminary Injunction: Prior Judgment as Evidence of Validity: Judgments between Different Parties.

In the absence of identity of the parties, the value of the judgment as a precedent depends upon the nature of the questions it decides. Certain matters relating to the validity of a patent are governed by established rules of legal definition and construction, and their determination is the same in every case, without reference to the parties, and sometimes without reference to the testimony. Whether or not the patented invention has resulted from inventive skill, whether it is embraced in either of the classes protected by the statute, whether the Claims of a re-issue are identical with those of its original, whether the patent is formally sufficient, and what it claims as the invention patented,—are points which, once being carefully considered and decided, may be regarded as permanently settled for all purposes of future litigation. True, in these matters even, the judges are not bound to follow the decisions of tribunals of inferior or co-ordinate jurisdiction; but the judicial comity which always must prevail among courts representing the same government and

² That an injunction will be granted after an adjudication in favor of the patent upon final hearing and full consideration of exhaustive evidence, unless there is opposing and cogent evidence in addition to that offered on the former hearing, see *Jones v. Merrill* (1875), 8 O. G. 401.

³ That where a former judgment against a different defendant is urged, it may always be shown that the same matters are not in controversy, or that material facts were not then known or

considered, or that other relevant matters were not passed upon, see *Page v. Holmes Burglar Alarm Telegraph Co.* (1880), 2 Fed. Rep. 330; 18 Blatch. 118; 5 Bann. & A. 439.

That on a motion for an injunction the validity of the patent will be considered anew, although it has been sustained on similar hearings before other judges, if it is alleged that new facts are in proof and that the merits of the case were not fairly presented on the other hearings, see *Blake v. Rawson*

administering the same laws, requires that judgments upon points like these should not be departed from without grave reasons for declaring them to be erroneous.¹ On other questions, whose decision is necessarily contingent on the evidence produced, such as priority, novelty, utility, abandonment, the sufficiency of the description, or the good faith of the inventor, no party can or should be prejudiced by the imperfect presentation of the law or evidence except in cases over which he had control.² Judgments involving these points are

(1872), 3 O. G. 122; 6 Fisher, 74; Holmes, 200.

That where the court is convinced that a former judgment was radically erroneous, it will be disregarded, see *Wells v. Gill* (1872), 6 Fisher, 89; 2 O. G. 590.

That new and additional evidence on the same points may deprive a former judgment of its weight, see *Lockwood v. Faber* (1886), 27 Fed. Rep. 63.

§ 1179. ¹ In *Potter v. Whitney* (1866), 3 Fisher, 77, Lowell, J.: (80) "Although it is the duty of the judge, in every case of this nature, where the defendant has not been a party to any former suits, to examine the case anew and exercise his discretion upon the questions presented, yet when questions are in fact the same as in former cases, he cannot but admit those decisions as having great weight, as much as in any other case arising for instance in admiralty or at common law, in which the point in controversy has been passed upon and decided." 1 Lowell, 87 (89).

That the judicial construction given to a patent by one court will usually be followed in another, see *Consolidated Safety Valve Co. v. Kunkle* (1883), 23 O. G. 630; 14 Fed. Rep. 732.

That all previously adjudicated matters are *prima facie* established against the defendant, see *American Nicholson Pavement Co. v. City of Elizabeth* (1870), 4 Fisher, 189; *Goodyear Dental*

Vulcanite Co. v. Evans (1868), 3 Fisher, 390; 6 Blatch. 121.

That a judgment sustaining the patent in a contested case, and without collusion, is sufficient evidence of its validity on a motion for an injunction, see *Coburn v. Brainard* (1883), 16 Fed. Rep. 412; 5 McCrary, 215; *Coburn v. Clark* (1883), 15 Fed. Rep. 804; 24 O. G. 899; 5 McCrary, 99.

That a former judgment or decree sustaining the patent, though between other parties, raises a strong presumption that the patent is valid, see *American Nicholson Pavement Co. v. City of Elizabeth* (1870), 4 Fisher, 189; *Potter v. Fuller* (1862), 2 Fisher, 251.

That an adjudication on an original patent is no ground for an injunction on the re-issue where the inventions are different, or the re-issue is broader than the original, see *Poppenhusen v. Falke* (1861), 2 Fisher, 181; 4 Blatch. 493.

² That decisions in former cases, offered to prove priority, are not conclusive except between the same parties and privies, see *Day v. Combination Rubber Co.* (1880), 17 O. G. 1347; 2 Fed. Rep. 570; 5 Bann. & A. 385.

That the question of infringement cannot be regarded as settled by prior judgments, see *Goodyear Dental Vulcanite Co. v. Evans* (1868), 3 Fisher, 390; 6 Blatch. 121.

That no injunction will issue where the judgment by which the patent is supported was obtained on contradictory

indeed of weight where no effectual attempt is made to prove their error, but the defendant on an application for an injunction may claim a reconsideration of these questions upon the evidence and arguments which he presents.³

§ 1180. Preliminary Injunction: Prior Judgment as Evidence of Validity: Judgments of Supreme Court.

The influence of the decisions of one tribunal over the conclusions of another depends mainly upon the relations established between them by the law. A judgment of the Supreme Court of the United States is binding on all other courts until reversed or modified; and its decision that a patent is valid must, therefore, be received as plenary proof of such validity between the same parties and on the same issues, unless it can be shown that the judgment was obtained by fraud, or that new evidence has been discovered which, if presented at the former trial, would have produced a different result. On questions of interpretation or definition the judgment of the Supreme Court must be followed even although the parties

claims, or where the plaintiff's title is in doubt, or where possession is vaguely stated in the bill, and is met by counter-claims and proofs for the defendant, see *Parker v. Sears* (1850), 1 Fisher, 93.

That an injunction will issue when the novelty of the invention is established, see *Hussey v. Whitely* (1860), 2 Fisher, 120; 1 Bond, 407.

That an injunction will be granted when the patent has been sustained after a full hearing and the infringement is clear, and especially when the very form of the device used by the defendant has been passed upon in the former case, although the defendant is responsible and willing to give security, see *Conover v. Mers* (1868), 3 Fisher, 386.

³ In *Page v. Holmes Burglar Alarm Telegraph Co.* (1880), 2 Fed. Rep. 330, Blatchford, J.: (336) "It is well settled that even after the validity of a patent has been established in a suit, and not-

withstanding the presumption thereby raised that the patent is valid, it may always be shown in another suit on the patent against another defendant, and even in answer to an application for a preliminary injunction in such suit, that the right claimed by the plaintiff in the new suit was not, either as to its nature or its extent, fairly in controversy in the former suit, or that material facts were not known or considered when the former suit was tried, or that there are relevant matters which were not adjudicated in the former suit. *American Nicholson Pavement Co. v. City of Elizabeth*, 4 Fisher's Pat. Cas. 189." 18 Blatch. 118 (125); 5 Bann. & A. 439 (446).

That where the defendant was not a party to the former suit he is entitled to a hearing *de novo*, but past decisions on the same facts have much weight, see *Potter v. Whitney* (1866), 3 Fisher, 77; 1 Lowell, 87.

may be different; and on all matters its determinations are entitled to the highest deference, in view of the wide research, the learned argument, and the careful scrutiny by which they are preceded.¹ Thus when, on any ground, this court sustains a patent, a presumption in its favor is created which only proof can overcome.

§ 1180. ¹ In *American Middlings Purifier Co. v. Christian* (1877), 4 Dillon, 448, Miller, J.: (452) "The decision which is brought to our notice in this case is a decision of the Supreme court of the United States, the court whose judgments are final upon all questions of Patent Law; whether the parties in interest now were before it or not, its decision as to what is law in the case governs the decision of all the other courts in the United States. Where the question is one of complicated facts, and the facts may be controverted, and are controverted in the Supreme court of the United States, with regard to the validity of the patent, of course the decision of that court upon those facts is conclusive, so far as the facts are the same; and in addition to that it is a very fair presumption that wherever the validity of the patent is a question which is brought to the attention and consideration of the Supreme court of the United States, all the questions concerning that patent which could possibly be before the court were before it, and were fully and well considered, and received its full and careful attention." 3 Bann. & A. 42 (44).

That a patent sustained by the Supreme court of the United States is valid for the purposes of an injunction unless the decree is collusive, see *American Middlings Purifier Co. v. Atlantic Milling Co.* (1877), 4 Dillon, 100; 3 Bann. & A. 168.

That Supreme court decisions are binding though none of the parties are the same, see *Richardson v. Lockwood* (1870), 4 Clifford, 128.

That if a judgment has been acquiesced in, or has been affirmed by the Supreme court of the United States, any doubts as to the validity of the patent or the originality of the invention, which might arise in a new case, are removed, see *Wells v. Gill* (1872), 6 Fisher, 89; 2 O. G. 590.

That Supreme court decisions are binding though new evidence is offered, unless it affects the legal rights of the parties, see *Richardson v. Lockwood* (1870), 4 Clifford, 128.

That when the Supreme court of the United States has held the original patent invalid, no injunction will be granted on the re-issue as if it were a new patent, for if the original were void for want of novelty the re-issue must be, see *Jones v. McMurray* (1877), 2 Hughes, 527; 13 O. G. 6; 3 Bann. & A. 130.

That an injunction will be refused where the patent, having been held by the Supreme court not to cover the defendant's device, was re-issued to cover it and the plaintiff's judgment was based on the re-issue, see *Wells v. Jacques* (1871), 5 Fisher, 136.

That where the Supreme court has limited a doctrine since a decision involving it in a Circuit court on the same patent that decision may be departed from, see *Rubber & Celluloid Harness Trimming Co. v. India Rubber Comb Co.* (1888), 44 O. G. 343.

That on questions of Patent Law the decisions of the Circuit courts and the Patent Office are not binding on the Supreme court, see *Andrews v. Hovey* (1888), 124 U. S. 694; 42 O. G. 1285.

§ 1181. Preliminary Injunction: Prior Judgment as Evidence of Validity: Judgments of Circuit Courts.

A judgment in the Circuit court of the same circuit, sustaining the patent between the same parties and upon the same issues, is sufficient evidence of its validity for the purposes of a subsequent injunction. Where the parties are different, the value of the judgment as a precedent depends upon the nature of the questions therein decided and the thoroughness with which they were examined. Matters which fall within the province of the court, either as involving legal definitions or the construction or comparison of written instruments, do not vary with a change of parties; and consequently, when once settled by the court, are not reviewed in future actions unless in cases of palpable mistake.¹ On other questions its determinations will be reconsidered whenever new evidence or new arguments indicate that they have been erroneous, though in the absence of good reasons to the contrary they raise a presumption in favor of the patent which is suffi-

§ 1181. ¹ That doctrines once established will not be reconsidered except in special cases where justice requires it, see *Tilghman v. Mitchell* (1871), 4 Fisher, 615; 9 Blatch. 18.

That the former judgment of a Circuit court sustaining the patent will not be followed if the test of patentability as since defined by the Supreme court would make the patent invalid, see *Rubber & Celluloid Harness Trimming Co. v. India Rubber Comb Co.* (1888), 44 O. G. 343.

That if a patent has once been deliberately and carefully construed by a court and sustained, the court on motion for an injunction will adhere to that construction, see *Mallory Mfg. Co. v. Hickok* (1884), 20 Fed. Rep. 116.

That the judicial definition of a patent is usually a limited one, and looked at in another light the patent may be different, and hence such definitions cannot be final and binding in different cases, see *Wilson v. Barnum* (1849), 2 Fisher, 635.

That decisions as to the validity of a patent are binding in future cases in the same circuit on the same patent, see *Meyer v. Goodyear's India Rubber Glove Mfg. Co.* (1881), 22 O. G. 681; 11 Fed. Rep. 891; 20 Blatch. 91.

That one decision in a case is to be followed by other judges in deciding the same points in subsequent stages of the case, see *Bate Refrigerating Co. v. Gillett* (1887), 40 O. G. 1029; 31 Fed. Rep. 809.

That where it has once been decided in the same circuit that a re-issue is invalid because the same matter was covered by an earlier patent, no further argument against it will be heard, see *Meyer v. Goodyear's India Rubber Glove Co.* (1881), 11 Fed. Rep. 891; 22 O. G. 681; 20 Blatch. 91.

That a decision in the same court, though with other parties, on the same questions will not be disturbed without good reasons, see *Odorless Excavating Apparatus Co. v. Clements* (1878), 16 O. G. 854; 4 Bann. & A. 540.

cient for the grant of an injunction. The judgment of a Circuit court in another circuit has no controlling authority. All Circuit courts are of equal judicial rank, and each is entitled to decide its causes in accordance with its own conclusions.² The comity of courts, however, gives to the judgments in another circuit a degree of weight measured by the character and number of the judgments, the eminence of the judges, and the care with which the questions were considered.³ A judg-

² That no Circuit court is bound by the decisions of other Circuit courts, see *Blake v. Robertson* (1874), 6 O. G. 297.

That a judgment in another circuit is not *res adjudicata*, unless the controversy is ended, and the decree finally settles all questions, leaving none open for future decision, see *Rumford Chemical Works v. Hecker* (1876), 10 O. G. 289; *Beebe v. Russell* (1856), 19 How. 283.

That although a court owes respect to the decisions of co-ordinate courts, it must decide on its own convictions, see *Schillinger v. Crauford* (1885), 37 O. G. 1349.

That an injunction may be refused where the court is in doubt as to infringement, though previous decisions have sustained the patent, see *Hammer-schlag Mfg. Co. v. Judd* (1886), 28 Fed. Rep. 621.

³ In *Searls v. Worden* (1882), 21 O. G. 1955, Brown, J.: (1956) "Upon general questions of law we listen to the opinions of our brother judges with deference and with a desire to conform to them if we can conscientiously do so; but we do not treat them as conclusive. In patent causes, however, where the same issue has been passed upon by the Circuit court sitting in another district, it is only in case of a clear mistake of law or fact, of newly discovered testimony, or upon some question not considered by such court, that we feel at liberty to review its findings." 11 Fed. Rep. 501 (502).

In *American Middlings Purifier Co. v. Christian* (1877), 4 Dillon, 448, Miller, J.: (451) "I think that the uniform course of decisions in the courts of the United States, where a previous decision has been had by a Circuit court with regard to the validity of a patent, has been to treat it as of the very highest nature, and as almost conclusive in an application for injunction in another case founded on the same patent. No one pretends, no one argues, that such a decision, even by a Circuit court, is absolutely conclusive on a final hearing on the merits of the case; but since patents are of such extensive and general operation all over the country, and since the litigation in regard to patents has been found so expensive and so wearisome to the courts, it has become almost a matter of necessity, after the validity of a patent, as distinguished from the question of infringement, has been passed upon by a competent tribunal upon a fair hearing, to treat that decision, in any future application in other courts and against other parties, as strongly persuasive of the validity of the patent; and this is especially so on the question of a preliminary injunction, and there is reason for it. The decision of the Circuit court (I am saying nothing about the Supreme court of the United States) in such cases is generally, — I may add always, except where there are cases of collusion, — the result of careful and deliberate consideration, either of a protracted trial before

ment in another circuit on the same issues and between the same parties, if rendered after due deliberation, is usually

a jury, or of a careful and full hearing upon depositions before a court. The presumption, therefore, that the title to the patent itself, and its validity (if that were brought in question in one of these suits), was more critically and more thoroughly looked into, and decided upon better hearing and more mature consideration, than it can be in a preliminary injunction, is very strong. Therefore I think I may state it, fairly and correctly, that wherever a patent has been established, even by the decision of the Circuit court, under a careful consideration, in a subsequent application, either before the same court or any other, for a preliminary injunction or for any preliminary relief, that decision is of very great weight." 3 Bann. & A. 42 (43).

In *Goodyear Dental Vulcanite Co. v. Willis* (1874), 7 O. G. 41, Emmons, J.: (41) "We think the learned counsel for the defendant much underrated the effect which it is our duty to give to judgments pronounced by co-ordinate courts, where precisely the same points are brought in litigation before us. The learning upon this subject is familiar, but the motives with which we discuss these matters at all will be subserved by referring to a few of the leading judgments upon this subject here. Those to which we refer have applied the principle in patent cases, but it is by no means peculiar to them. It is a principle of general jurisprudence, a disregard of which would produce a conflict of opinion in the Federal judiciary, alike unseemly and impolitic. In 3 Story, 133, *Washburn v. Gould*, Justice Story, sitting in the Massachusetts circuit, said: 'The rule of comity always observed by the Justices of the Supreme court in cases which admitted of being carried before

the whole court was to conform to the opinions of each other, if any had been given.' Justice McLean had previously given a ruling upon the same point in the Ohio circuit in 3 McLean, 250, *Brooks v. Bicknell*, and Justice Story therefore said: 'Although his mind was not without much difficulty on this point, he should rule for the plaintiffs, in accordance with the opinion of Mr. Justice McLean.' In 3 Fisher, 363, *Am. Wood Paper Co. v. Fibre Disintegrating Co.*, before Benedict, J., Eastern district of New York, there had been previous suits on the same five patents in other districts, and especially a suit in the Eastern district of Pennsylvania, which decided the points in issue as to two of the patents. Judge Benedict said, as to these two patents, 'The determination of the court in the case referred to furnishes an authority from which I should not feel at liberty, had I the inclination, to dissent.' In 3 Fisher, 443, *Goodyear v. Berry*, Leavitt, J., Southern district of Ohio, a patent had been sustained in several other circuits. Judge Leavitt says: 'In so far as principles involving the validity of these patents have been settled by these decisions, they will be regarded as final and authoritative on this court.' In 4 Fisher, 624, *Tilghman v. Mitchell*, Southern district of New York, Blatchford, J., quotes with approbation our remark in *Tilghman v. Werk*, Southern district of Ohio, 1868, in which it is said, 'Although the record in this case, in reference to some views which a superior court may possibly take, contains some material additional proofs, still they are not such as to authorize the same court to overrule its former deliberate adjudications, and to disregard the judgments of a co-ordinate one in a case in all respects

adopted unless evidently incorrect. A concurrence of judgments in other circuits on the same issues but between dif-

substantially like it.' In 6 Pat. Office Gaz., p. 154, *Goodyear Dental Vulcanite Co. v. Root*, Justice Hunt, sitting in the Northern district of New York, considers as authoritative the previous decisions in Massachusetts on the same patent. To the support of the generality sustained by these judgments it is unnecessary to say that numerous citations might be added, all showing that, in the opinion of the most enlightened jurists, we should be guilty of grossly violating well established judicial usage and propriety should we disregard the adjudications already made in reference to the validity of the patent before us. The principle which inclines a court to adhere to its own decision of a similar point although subsequently convinced it was erroneous, though not in all respects applicable here, furnishes a strong analogy, and a reason on which our own actions should be based. (See *Ram on Legal Judgment*, 203 *et seq.*) It there abundantly appears that the adherence to decisions is by no means confined to those which precede it in the same tribunal. Those of co-ordinate courts are equally influential. The Queen's Bench, Common Pleas, and the Exchequer, where there is a common appellate court to review the decisions of each, follow with the utmost respect each other's adjudications. Upon reasons having much influence here, appellate courts often follow a series of adjudications made by subordinate tribunals where they have been acquiesced in, and have become in some sense a rule of property. It is not because they are obligatory, but from the unfitness of shifting rules. This is by no means closely applicable here, where judgments are recent and refer to the individual rights of the complainant. But many of the evils, it is quite ap-

parent, which this class of judgments seeks to avoid would be produced should we disregard the rule. In the elaborate treatment of this general subject in the book to which we have referred, both by the English and American authors, it is significant that they make no distinction between prior decisions of the same, and co-ordinate tribunals. It is enough to call for the application of the principle that the courts have the same jurisdiction under the same government to decide the same points, that there is a common appellate court finally to adjust the difference between them. If one system of co-ordinate courts more than another calls for the application of this general principle it is that of the Circuit courts of the United States. They all have similar special jurisdiction, and are all, in an eminent degree, looked to for all those rules of right and property created under the Federal statutes, and in reference to the subjects coming within the Federal Constitution. Although divided in jurisdiction geographically, they constitute a single system; and when one court has fully considered and deliberately decided a question, every suggestion of propriety and fit public action demand it should be followed until modified by the appellate court. The comment of the bar upon this subject assumed that the final decrees and elaborately reasoned decisions of Circuit judges, with full citations and criticisms of authorities, often involving the entire history of the law upon the subject discussed, are to be ranked with what are termed *nisi prius* decisions. They are in all respects judgments *in banc*. They not only have the deliberation and care of judgments in the high courts of chancery in England and this country, but the court of itself bears the same relation to the whole

ferent parties; the decision of any judge of recognized ability upon a question of legal definition or interpretation; a series

judicial system that such courts do to those in which they exist. There is but one appellate court above them. A superior tribunal also reviews the judgments of the English Chancery, and so of nearly all the like State tribunals. Although we would by no means confine our acquiescence in the decisions of our brother judges to cases where the particular patent has been adjudged to be valid, or that a particular device infringes upon it, still we think that eminently beyond other cases is the rule applicable to them. The right of the complainant is a special franchise granted by the political power. A special organism is created for the purpose of ascertaining his right to the grant. When issued, the several Federal courts are authorized to review the rectitude of this action, and from their determination an appeal lies to the court of last resort. It is an indivisible system for ascertaining the rightfulness and the limits of the patent, and when, in any co-ordinate department of it, judgment has been pronounced, that duty should be deemed performed until reversed by an appellate tribunal. It would present an unseemly spectacle for the same governmental grant to receive half a dozen different constructions in as many co-ordinate courts, all authorized to define it and inform the citizens what it means, and all having the force of law contemporaneously under the same government. We cannot speak with great certainty, but do affirm with much confidence that the expenses paid in our country for patent litigations are rapidly approximating the entire sum demanded for royalties. Until some special tribunal is instituted for the determination of these questions, and some general mode of reviewing these public grants, which shall test definitely the rightfulness

ness of the grants, it will result in a large saving of money to the great masses of our citizens who are using these improvements to let them and their advisers of the profession understand that a fair and full examination in one court, followed by a judgment, will, in the other co-ordinate tribunals, be acquiesced in as law, if there is no appeal and reversal." 1 Flippin, 388 (390); 1 Bann. & A. 568 (570).

That one court does not review or reverse the judgment of a court of co-ordinate jurisdiction, see *Hayes v. Dayton* (1884), 20 Fed. Rep. 690.

That the decision of a co-ordinate court will be followed, unless good reason for departing therefrom is shown, where the issues, pleadings, and evidence are the same, see *Hancock Inspirator Co. v. Register* (1888), 35 Fed. Rep. 61; *Worswick Mfg. Co. v. Philadelphia* (1887), 30 Fed. Rep. 625; *Steam Gauge & Lantern Co. v. McRoberts* (1886), 36 O. G. 822; 26 Fed. Rep. 765; *American Bell Telephone Co. v. National Improved Telephone Co.* (1886), 27 Fed. Rep. 663; *Cary v. Domestic Spring Bed Co.* (1886), 26 Fed. Rep. 38; 34 O. G. 1158; *Cary v. Lovell Mfg. Co.* (1885), 32 O. G. 1009; 24 Fed. Rep. 141; *Field v. Ireland* (1884), 28 O. G. 284; 19 Fed. Rep. 835; *Coburn v. Clark* (1883), 24 O. G. 899; 5 McCrary, 99; 15 Fed. Rep. 804; *American Ballast Log Co. v. Cotter* (1882), 11 Fed. Rep. 728; 21 O. G. 1030.

That co-ordinate courts should be followed on questions of validity and construction until overruled by the Supreme court, see *Hammerschlag Mfg. Co. v. Bancroft* (1887), 40 O. G. 1339.

That the judgment of a co-ordinate court should be followed unless new evidence is offered or an obvious mistake was made in the law, see *Cary v.*

of decisions, or even one decision, sustaining the patent against attacks in which all conceivable objections have been urged, — each of these is of sufficient influence to govern future rulings until its error is discovered.⁴

Lovell Mfg. Co. (1887), 31 Fed. Rep. 344; 40 O. G. 1239.

That a decision sustaining the patent in another circuit will be followed on motion for injunction, unless such new evidence is presented as would have led the other court to a different conclusion, see *Ladd v. Cameron* (1885), 25 Fed. Rep. 37.

That prior decisions in other courts as to the validity of the patent are regarded as final, see *Goodyear v. Berry* (1868), 3 Fisher, 439; 2 Bond, 189.

That a former decision will be presumed correct though in another court, if no new evidence is introduced and no new question is raised, see *Worden v. Searls* (1884), 21 Fed. Rep. 406.

That where one Circuit court sustains a patent, after full discussion, another court should follow it on the same evidence, unless in cases of plain mistake, see *Hammerschlag v. Garrett* (1881), 9 Fed. Rep. 43; *Goodyear v. Honsinger* (1867), 3 Fisher, 147; 2 Bissell, 1.

That when the patent has been sustained by other courts the only open question is that of infringement, see *Goodyear v. Rust* (1868), 3 Fisher, 456; 6 Blatch. 229.

That a judgment rendered in one circuit is evidence in another where the matter in dispute is the same, and the defendant in the later suit paid the expenses and employed the counsel in the former, though he was not a nominal party, see *United States & Foreign Salamander Felting Co. v. Asbestos Felting Co.* (1880), 19 O. G. 362; 18 Blatch. 310; 4 Fed. Rep. 816; 5 Bann. & A. 622.

⁴ That there is a strong presumption

that former decisions are correct when four different Circuit courts have made the same ones without appeal, see *Blake v. Robertson* (1874), 6 O. G. 297.

That where the same issues have been often presented and decided, agreeing in the construction of the patent, such decisions will be accepted as final until the Supreme court overrules them, unless new features are presented, see *Green v. French* (1882), 11 Fed. Rep. 591; 21 O. G. 1351.

That where the patent has already been sustained in three cases, in one of which the defendant was interested, the validity of the patent is established and the only question open is infringement, see *Robertson v. Hill* (1873), 4 O. G. 132; 6 Fisher, 465.

That where four judgments have been rendered sustaining the patent, one of which was against the defendant, and an extension has also been granted, the validity of the patent and the infringement are taken as established for the purposes of an injunction, see *Tilghman v. Mitchell* (1871), 4 Fisher, 615; 9 Blatch. 18.

That a patent twice sustained by the courts will be regarded as valid for the purposes of an injunction, where there is no reason to doubt the correctness of the decisions, see *Cary v. Lovell Mfg. Co.* (1885), 32 O. G. 1009; 24 Fed. Rep. 141.

That an answer denying that a decision was rendered "after full consideration" contains no imputation on the court and is neither impertinent nor scandalous, see *Miller v. Buchanan* (1880), 18 O. G. 1532; 5 Fed. Rep. 366.

That a decision sustaining a patent, after a contest covering all the usual

§ 1182. Preliminary Injunction : Prior Judgment as Evidence of Validity : Judgments of Circuit Courts : Judgments on Hearings, by Consent, by Collusion, etc.

The authority of a judgment in the Circuit court depends to some extent upon the mode in which its conclusions were attained. A decree based upon a hearing, in which all questions of fact as well as of law were submitted to the judge and by him were examined and decided, is of greater weight than one based on the verdict of a jury on a feigned issue, or than a judgment on a verdict in a court of law.¹ A decree by consent, if without collusion, binds the defendant in the same circuit, but has no effect on other parties, nor against him in other circuits, unless his first surrender is shown to have resulted from his knowledge that he had no adequate defence.²

defences, is almost conclusive, see *Cary v. Domestic Spring Bed Co.* (1885), 27 Fed. Rep. 299.

§ 1182. ¹ That the decision of a court of equity on final hearing furnishes an authority for the action of courts of co-ordinate jurisdiction, see *American Wood Paper Co. v. Fibre Disintegrating Co.* (1868), 3 Fisher, 362 ; 6 Blatch. 27.

That the conclusions of a judge on a patent case are more reliable than those of a jury, see *Buchanan v. Howland* (1863), 2 Fisher, 341 ; 5 Blatch. 151.

That the discussion of a patent by the court in a former suit is of some weight on a motion for an injunction, see *Consolidated Bunging Apparatus Co. v. Peter Schoenhofen Brewing Co.* (1886), 37 O. G. 786 ; 28 Fed. Rep. 428.

That on a motion for an injunction a decree in chancery is of more weight than the verdict of a jury, see *Goodyear v. Mullee* (1868), 3 Fisher, 420.

That the final decree of a court, if without collusion, is good ground for an injunction, see *Kirby Bung Mfg. Co. v. White* (1880), 1 Fed. Rep. 604 ; 17 O. G. 974 ; 1 McCrary, 155 ; 5 Bann. & A. 263.

That a hearing before a master is not a final hearing, see *Doughty v. West, Bradley & Cary Mfg. Co.* (1870), 4 Fisher, 318 ; 8 Blatch. 107.

That a dismissal of the bill, for failure to prove infringement, is no bar to another suit between the same parties, see *Steam Gauge & Lantern Co. v. Meyrose* (1886), 36 O. G. 1477 ; 27 Fed. Rep. 213.

That a dismissal of a bill for repeal on its merits is not a judgment necessarily importing that the patents in question did not interfere, or that the earlier one was void, see *Tyler v. Hyde* (1851), 2 Blatch. 308.

² That a judgment, without contest, sustaining the patent in the absence of collusion, is equally good proof of validity with any other judgment, see *McWilliams Mfg. Co. v. Blundell* (1882), 22 O. G. 177 ; 11 Fed. Rep. 419.

That a decree by consent in a prior suit, declaring the patent valid and the complainant sole owner, is binding as to all questions determined thereby in the second suit between the same parties, see *Tomkinson v. Willetts Mfg. Co.* (1884), 23 Fed. Rep. 895 ; 31 O. G. 918 ; 32 O. G. 382.

That a decree by consent merely

Collusive decrees are of no value against any party.³ A decision on an application for a preliminary injunction is of less weight than a decree.⁴ The verdict of a jury in a court of

shows the acquiescence of that defendant in that decision, see *Hayes v. Leton* (1881), 5 Fed. Rep. 521.

That where the present device of the defendant differs only in form from that concerning which he consented to a decree, an injunction will issue, see *United States Metallic Packing Co. v. Tripp* (1887), 39 O. G. 1554; 31 Fed. Rep. 350.

That a defendant is estopped by a decree by consent in a suit where the present plaintiff's assignor was plaintiff, see *United States Metallic Packing Co. v. Tripp* (1887), 39 O. G. 1554; 31 Fed. Rep. 350.

That a decree by consent in one circuit does not lay the foundation for an injunction in another, see *Warner v. Bassett* (1881), 7 Fed. Rep. 468; 19 Blatch. 145.

That a decree *pro forma* on the merits is not ground for an injunction in other courts, see *Kirby Bung Mfg. Co. v. White* (1880), 17 O. G. 974; 1 Fed. Rep. 604; 1 McCrary, 155; 5 Bann. & A. 263.

That a decree by consent is not effective against others not parties thereto, and has very little weight in any other court in favor of the patent, see *Spring v. Domestic Sewing Mach. Co.* (1879), 16 O. G. 721; 4 Bann. & A. 427.

That an injunction will not issue against third parties on the ground of a former judgment by consent against others, or where the former defendants abandoned their case and a decree was entered without a hearing, see *Hayes v. Leton* (1881), 5 Fed. Rep. 521.

That an injunction will not be issued where infringement is denied, solely on the ground that a judgment was rendered in another circuit on a mere motion, see *Sargent Mfg. Co. v. Woodruff* (1879), 5 Bissell, 444.

³ That collusive decrees are not ground for an injunction, see *Kirby Bung Mfg. Co. v. White* (1880), 17 O. G. 974; 1 Fed. Rep. 604; 1 McCrary, 155; 5 Bann. & A. 263.

That a suit is collusive if one party pays the fees of counsel on both sides, below and on appeal, though the fees were charged to the party primarily liable, see *Gardner v. Goodyear Dental Vulcanite Co.* (1873), 6 Fisher, 329; 8 O. G. 295.

That collusion in a former suit must be fully proved, not conjectured or suspected, see *Seibert Cylinder Oil Cup Co. v. Beggs* (1887), 32 Fed. Rep. 790.

⁴ That a decision on a motion for a preliminary injunction is of no controlling authority in another circuit, see *Cornell v. Littlejohn* (1876), 9 O. G. 837, 922; 2 Bann. & A. 324.

That the denial of an injunction by one court is some ground for its denial by others, see *Thompson v. Rand Avery Supply Co.* (1889), 38 Fed. Rep. 112.

That the issue of injunctions by other courts may also be considered, see *Schneider v. Missouri Glass Co.* (1888), 36 Fed. Rep. 582.

That the decision of a motion for an injunction does not settle the identity of two machines, though it may be an admission of the parties that there was an infringement, see *Florence Sewing Mach. Co. v. Singer Mfg. Co.* (1870), 4 Fisher, 329; 8 Blatch. 113.

That a refusal to grant an injunction against a vendor by one court, though with leave to renew the motion, is a reason for its refusal by another court against his vendee, see *Hicks v. Beardslay* (1887), 41 O. G. 235; 32 Fed. Rep. 281.

That the user may be enjoined in one circuit though the maker is being sued

law is a sufficient warrant for the grant of an injunction, but may be disregarded by the court even when not so clearly contrary to the evidence that a new trial would have been allowed.⁵ A pending bill of exceptions, or a writ of error, or

in another, see *Thompson v. American Bank Note Co.* (1888), 45 O. G. 347; 35 Fed. Rep. 203.

⁵ In *Wells v. Gill* (1872), 2 O. G. 590, Strong, J. : (591) "Ordinarily a verdict and judgment sustaining a patent are controlling over the discretion of a judge when he is asked to award a provisional injunction. They relieve him from the necessity of inquiring into the validity of the patent, and if he is satisfied there has been an infringement, the injunction may be said to be almost a thing of course." 6 Fisher, 89 (91).

In *Day v. Hartshorn* (1855), 3 Fisher, 32, Pitman, J. : (36) "It was argued before me that if I was not satisfied with the verdict, yet if I would not have set it aside if a motion had been made for a new trial, that then I ought to grant the injunction. If I have the right, in a court of equity, to examine the evidence in a cause which is tried before me at law, and to draw my own conclusions when I am asked to grant an injunction, and ought to refuse it if I am not satisfied with the verdict, then, though I might hesitate to set the verdict aside because I was not satisfied with the same, especially after the modern decisions on this subject, yet it would not follow that I ought to grant an injunction. The jury draw their own conclusions from the evidence, and it is their right so to do; and because I might not draw the same conclusions, this of itself is not sufficient to justify me in setting the verdict aside, if they have evidence to judge from. If I should do so, I should substitute myself as judge of the facts, in a trial at law, which the parties and

the law have submitted to the jury. But when I am applied to in equity, where I am judge of the facts as well as law, and required to perform an act which calls upon me to draw my own conclusions from the evidence which I heard upon the trial, there my own judgment upon the law and the evidence must determine my action, and not the judgment of the jury. I will not set aside a verdict because I differed from the jury upon the evidence, because the verdict is theirs, and they act upon their conscience. But when I have to act upon my own conscience, then I cannot suffer the jury to control me in my province, for the same reason that I should deem it improper for me to control them in their province. There are cases where, though I might be dissatisfied with the verdict, yet not so much so but that I might think it proper to suffer the verdict to be the basis for an injunction."

Contra, That when a judge disregards a former verdict his reasons for so doing should be sufficient to lead him to grant a new trial, see *Parker v. Brant* (1850), 1 Fisher, 58.

That the verdict of a jury is not conclusive on motion for injunction, but the court will examine the whole case, see *Sickels v. Youngs* (1855), 3 Blatch. 293; *Many v. Sizer* (1849), 1 Fisher, 31.

That a verdict in an uncontested case, without collusion, is of as great weight as one after a full trial, see *Potter v. Fuller* (1862), 2 Fisher, 251.

That a verdict on an issue out of chancery, and a trial for damages on an amended specification, are not the same matter, and the former is no bar

a petition for another trial impairs the force of such a verdict, and the court should not receive it as a ground for an injunction without a further inquiry into the merits of the case.⁶

§ 1183. Preliminary Injunction : Prior Judgment as Evidence of Validity : Judgments in the Patent Office.

A decision in the Patent Office, though not binding on the courts, has more or less weight according to the subject-matter of the judgment, and the violence of the contest by which it was preceded.¹ The award of a patent, without objection, is

to an injunction when no judgment was rendered on the verdict or on the merits of the bill, see *Allen v. Blunt* (1846), 2 W. & M. 121 ; 2 Robb, 530.

That on a motion for an injunction after a verdict at law, the facts found by the verdict will be considered as established for the purposes of the motion, see *Poppenhusen v. New York Gutta Percha Comb Co.* (1858), 2 Fisher, 74 ; 4 Blatch. 184.

⁶ That an injunction will be refused where the judgment, on the strength of which it has been asked, has been appealed from and seems doubtful, see *Many v. Sizer* (1849), 1 Fisher, 31.

That an injunction may be denied when the judgment at law was followed by a bill of exceptions, see *Furbush v. Bradford* (1858), 1 Fisher, 317.

That after a judgment at law and a bill of exceptions the court must exercise its own judgment on the questions involved in the bill of exceptions, and determine whether the title is clear enough to warrant an injunction, see *Furbush v. Bradford* (1858), 1 Fisher, 317.

That a judgment is not conclusive on a motion for an injunction, if a writ of error is pending, see *Wells v. Gill* (1872), 2 O. G. 590 ; 6 Fisher, 89.

That an injunction will generally be refused if the case has been tried at law and motion was made for a new trial, or a bill of exceptions and writ of error

have been filed, though even then the injunction may be ordered, see *Morris v. Lowell Mfg. Co.* (1866), 3 Fisher, 67 ; *Day v. Hartshorn* (1855), 3 Fisher, 32.

That when a new trial has been granted in a suit wherein the patent was held invalid, but on grounds not affecting validity, an injunction may be refused, see *Keyes v. Pueblo Smelting & Refining Co.* (1887), 31 Fed. Rep. 560.

§ 1183. ¹ That a decision in the Patent Office is not binding on the courts, see *Celluloid Mfg. Co. v. Chrolithian Collar & Cuff Co.* (1885), 32 O. G. 383 ; 24 Fed. Rep. 275 ; *Wilson v. Barnum* (1849), 2 Fisher, 635 ; 1 Wall. Jr. 347 ; 2 Robb, 749.

That a decision of the Patent Office does not bind the courts when steps are taken to contest its validity, see *Minneapolis Harvester Works v. McCormick Harvesting Mach. Co.* (1886), 28 Fed. Rep. 565 ; 37 O. G. 566.

That a decision of the Patent Office, after long contest and full examination of the art, is of weight on a motion for an injunction, see *Consolidated Bunting Apparatus Co. v. Peter Schoenhofen Brewing Co.* (1886), 28 Fed. Rep. 428 ; 37 O. G. 786.

That the construction given to a patent in the Patent Office, and on the strength of which it was granted, will be followed in the courts, see *Geis v. Kimber* (1888), 36 Fed. Rep. 105.

of some authority, yet it alone does not empower the court to interfere for the protection of its owner.² But a judgment in an interference, awarding priority to one rival claimant, is sufficient ground for an injunction in his favor against the other;³ a finding that the patented invention will accomplish

² In *Yuengling v. Johnson* (1877), 1 Hughes, 607, Hughes, J.: (613) "It is true that the issuing of patents is not conclusive upon the courts. Patents are subject to review by the courts. Suits in a very large proportion of patent cases are but means of appeal to the courts from the action of the Patent Office. Yet, while this is so, that action must always carry great weight with the courts. It is always very strongly persuasive with them. Patents are the results, generally, of contests between accomplished experts, and after such contests of the matured judgment of officers selected and appointed by the President for their extraordinary competency and skill, I think it is hardly going too far to say, following Mr. Justice Grier, in *N. E. Car Company v. Dunbar*, 1 Fisher, that the action of the Patent Office is sufficient to make such a *prima facie* case as to justify the action of a court on almost any motion for a preliminary injunction. If, indeed, in any case the general unanimous testimony of experts united in condemning the action of the Patent Office, in such case a court might well hesitate to treat that action as constituting a *prima facie* case for or against a preliminary injunction. But when, as in the present case, the weight of expert testimony is nearly evenly balanced, a court may safely presume that the action of the Patent Office, taken after a sharp contest between patent lawyers and experts, is *prima facie* correct." 3 Bann. & A. 99 (104).

That the grant of a patent is only an *ex parte* adjudication, see *Potter v. Stevens* (1861), 2 Fisher, 163.

That the decision of the Patent Office in issuing the patent has some weight but is not controlling, see *Jones v. Merrill* (1875), 8 O. G. 401. See also § 1016, and notes, *ante*.

That the action of the Patent Office in allowing a re-issue is of weight on a motion for an injunction, see *Consolidated Bunting Apparatus Co. v. Peter Schoenhofen Brewing Co.* (1886), 37 O. G. 786; 28 Fed. Rep. 428.

That a re-issue granted to correct a mistake made by an attorney in accepting an amended Claim is of too doubtful validity to aid an injunction, see *Arnheim v. Finster* (1885), 32 O. G. 256; 24 Fed. Rep. 276.

³ That an interference judgment is *res adjudicata* between the parties, see *Shuter v. Davis* (1883), 24 O. G. 303; 16 Fed. Rep. 564.

That the action of the Commissioner of Patents on an interference makes a *prima facie* case for an injunction, see *Yuengling v. Johnson* (1877), 1 Hughes, 607; 3 Bann. & A. 99.

That an interference decision raises no presumption against any person except the defeated party and his privies, see *Edward Barr Co. v. N. Y. & N. H. Automatic Sprinkler Co.* (1887), 32 Fed. Rep. 79.

That an interference judgment, if appealed from, is not operative as a judgment, see *Minneapolis Harvester Works v. McCormick Harvesting Mach. Co.* (1886), 37 O. G. 566; 28 Fed. Rep. 565.

That a decision in interference, not appealed from, though not conclusive is strongly persuasive, see *Kirk v. Du Bois* (1887), 42 O. G. 297.

That an interference judgment will

practical results avails the plaintiff in his efforts to enjoin the party who denied it;⁴ a decision that patentable differences exist between the patented invention and another art or instrument is a sufficient answer to the latter when urged against the novelty of the invention;⁵ and an extension of

warrant an injunction against the defeated party, see *Celluloid Mfg. Co. v. Chrolithian Collar & Cuff Co.* (1885), 32 O. G. 383; 24 Fed. Rep. 275; *Holliday v. Pickhardt* (1882), 22 O. G. 420; 12 Fed. Rep. 147.

That a decision of the Patent Office on an interference is ground for an injunction, so far as the question of priority is concerned, see *Smith v. Halkyard* (1883), 16 Fed. Rep. 414; 23 O. G., 1833.

That an interference decision affects only the matter of priority and is not evidence of validity, see *Dickerson v. De la Vergne Refrigerating Mach. Co.* (1888), 35 Fed. Rep. 143.

That an injunction will be granted against the defeated party to an interference if he had knowledge of the state of the art at the date of his application, and is in bad faith, see *Smith v. Halkyard* (1883), 16 Fed. Rep. 414; 23 O. G. 1833.

That an injunction will be granted against the defeated party to an interference unless the want of novelty is clearly shown, see *Smith v. Halkyard* (1883), 16 Fed. Rep. 414; 23 O. G. 1833.

That an interference decision, though not conclusive on the parties, is sufficient to warrant an injunction, and any claim by defendant that both he and the plaintiff were anticipated by others will be disregarded if known at the time he was seeking a patent, unless now clearly established, see *Celluloid Mfg. Co. v. Chrolithian Collar & Cuff Co.* (1885), 24 Fed. Rep. 275; 32 O. G. 383; *Smith v. Halkyard* (1883), 16 Fed. Rep. 414; 23 O. G. 1833.

That a defendant who acquiesced in

an interference decision between himself and the plaintiff, and limited his own patent accordingly, is bound by it in the courts, and though he may set up priority in others against the plaintiff's patent, yet if this priority were known to him at the time of his application, the action of the Patent Office in allowing the plaintiff's patent is of great weight against him, see *Peck, Stow & Wilcox Co. v. Lindsay, Sterritt & Co.* (1880), 18 O. G. 63; 2 Fed. Rep. 688; 5 Bann. & A. 390.

That a judgment against a party in an interference is not conclusive upon him, see *Smith v. Halkyard* (1883), 16 Fed. Rep. 414; 23 O. G. 1833; *Perry v. Starrett* (1878), 14 O. G. 599; 3 Bann. & A. 485; *Union Paper Bag Mach. Co. v. Crane* (1874), Holmes, 429; 6 O. G. 801; 1 Bann. & A. 494.

That a party to an interference, not appealing, is bound by a decision on priority, for the purposes of an injunction, see *Greenwood v. Bracher* (1880), 1 Fed. Rep. 856; 17 O. G. 1151; 5 Bann. & A. 302.

⁴ That a decision of the Patent Office, on an issue there raised between the same parties, that the invention is practicable is sufficient ground for an injunction, see *Holliday v. Pickhardt* (1882), 22 O. G. 420; 12 Fed. Rep. 147.

⁵ That the court will consider the fact that the Patent Office found patentable differences between two devices, see *Putnam v. Weatherbee* (1875), 8 O. G. 320; Holmes, 497; 2 Bann. & A. 78.

That the decision of the Patent Office in an interference case, as to the identity of the inventions, is sufficient

the patent after persistent opposition is evidence of its validity which only strong counter-proof can overcome.⁶

§ 1104. Preliminary Injunction: Summation of Rules Concerning Prior Judgments as Evidence of Validity.

The foregoing doctrines concerning the effect of prior judgments sustaining the patent, as evidence on an application for an injunction, may be summed up as follows: A judgment of the Supreme Court, or of the Circuit court of the same circuit, upon the same issues and against the same defendant, is conclusive proof of the validity of the patent, unless new evidence has since been discovered or the judgment has been overruled or was originally obtained by fraud. A judgment in another circuit against the same defendant on the same issues is not conclusive, but is of high authority and can be overcome only by convincing evidence that the former tribunal was mistaken or insufficiently informed, — except where a decree was rendered by consent, which is without authority unless it also appears that no defence against the patent could have been maintained. A judgment in the Patent Office in a contested case, if well considered, is of great weight against the party there defeated, and in the absence of opposing testimony is sufficient proof of the validity of the successful patent. No judgment is conclusive against persons who were neither parties nor privies to the suit; but where in any of these tribunals certain questions of law relating to the existence, scope, or validity of the patent have been once decided, after full examination and careful scrutiny, these decisions command more or less respect in other courts and causes, although the defendant was not interested in the prior action. Such a decision rendered by the Supreme Court, or the same Circuit court, is not departed from without clear evidence of error. If emanating from the Circuit court of another circuit,

prima facie evidence that the makers of the defeated invention infringe, see *Holliday v. Pickhardt* (1882), 22 O. G. 420; 12 Fed. Rep. 147.

That a decision of the Commissioner is not conclusive as to novelty, utility, or inventive skill, see *Reckendorfer v.*

Fabor (1875), 92 U. S. 347; 10 O. G. 71.

⁶ That a special act of extension is conclusive on a motion for injunction, though alleged to have been procured by fraud, see *Gibson v. Gifford* (1850), 1 Blatch. 529.

except on decrees by consent, it has a value measured by the ability and experience of the judge, and the completeness of the presentation of the arguments against it. When it results from a contest in the Patent Office, it raises a presumption in favor of the patent on that question, which, in the absence of better reasons to the contrary, the courts will usually maintain. But in all cases where the prior judgment does not operate as an estoppel upon the defendant, the issue on the application for an injunction is open for fresh inquiry and determination, the judgment being merely evidence in favor of the plaintiff, and controlling the decision of the court only when not opposed by more convincing proof. Judgments against the patent are, for obvious reasons, of higher value and a wider influence, since a patent invalid upon any ground is invalid against all the world, and therefore any decision declaring it void, though in a different tribunal and between other parties, affords a presumption of its invalidity which the plaintiff can with difficulty overcome.¹ When conflicting judgments have been rendered, the court must follow those which, in view of all the tests of authority, appear to have the higher value, and if the question is still doubtful, and no other evidence is offered, it must decide in favor of the patent.² For though the patent, unsupported by a judgment, is

§ 1184. ¹ That where the same Claims have in a former suit been adjudged to have been anticipated the suit will be dismissed, see *Crandall v. Dare* (1881), 11 Fed. Rep. 902.

That a decree of invalidity in the Federal courts is conclusive on the parties, see *Hawks v. Swett* (1875), 4 Hun, 146 ; 6 Thomp. & C. 529.

That a decision in one circuit that a patent is void for want of novelty will be followed in others, see *Kidd v. Ransom* (1888), 35 Fed. Rep. 588.

That an injunction will not be granted after successive defeats at law, where the novelty and infringement are in dispute and no public acquiescence appears, unless the plaintiff makes out a clear case, but the defendant will be ordered to try the case at the next

term under penalty of an injunction, see *Serrell v. Collins* (1857), 4 Blatch. 61.

That an injunction will be refused when several suits were brought against several defendants, and were all defended by one party, and injunctions have already been denied in some of them, and the defendant's case is ready for trial, see *Wooster v. Howe Mach. Co.* (1879), 16 O. G. 314 ; 4 Bann. & A. 319.

² That an injunction may be granted where some judgments have sustained the patent though one has been adverse to its validity, see *United States Stamping Co. v. King* (1879), 17 Blatch. 55 4 Bann. & A. 469 ; 17 O. G. 1399 ; 7 Fed. Rep. 860.

That an injunction will be granted

not sufficient proof of its own validity for the purposes of an injunction, yet when sustained by judgments it outweighs all other judgments of an equal value.

§ 1185. Preliminary Injunction: Public Acquiescence as Evidence of Validity: Acquiescence Defined.

Where no judgment sustaining the patent upon the issues presented on the application for an injunction can be offered, or where if offered the judgment is of doubtful value, the deficiency may be supplied by proof of a public acquiescence in the claims of the patent of sufficient definiteness and duration to afford a reasonable presumption of its validity.¹

though the patent has been declared invalid in one suit, if it has been sustained in several others and new evidence in its favor is now at hand, see *United States Stamping Co. v. King* (1879), 17 O. G. 1399; 7 Fed. Rep. 860; 17 Blatch. 55; 4 Bann. & A. 469.

That an injunction will be granted when the patent has been sustained in a former trial in the same circuit though other suits are still pending in the courts of other circuits, see *Atlantic Giant Powder Co. v. Goodyear* (1877), 13 O. G. 45; 3 Bann. & A. 161.

That where there have been an arbitration and award the court will presume them correct till the contrary is shown, see *Reedy v. Scott* (1874), 23 Wall. 352; 7 O. G. 463.

See also as to former judgments in the Federal courts § 1017 and notes, *ante*.

That no regard will be paid to the decision of a State court concerning the contract relations of the parties, see *Oliver v. Rumford Chemical Works* (1883), 109 U. S. 75; 25 O. G. 784.

That the judgment of a Probate court of competent jurisdiction confirming a sale is conclusive as to the right of the vendee, see *May v. Mercer Co.* (1887), 41 O. G. 815; 30 Fed. Rep. 246.

§ 1185. ¹ In *Kirby Bung Mfg. Co. v. White* (1880), 5 Bann. & A. 263, Treat, J.: (265) "For the purposes of a provisional injunction under the Patent Law two things, or either of two things, may exist, — to wit, as in this case, a court, after full consideration of the matter, has rendered a final decree, upholding the validity of the patent. That is sufficient basis in itself for an injunction or some form of a restraining or accounting order, provided the party defendant in the particular case has infringed the patent. In other words, the court, on a motion for a provisional injunction, does not go into the merits to ascertain the validity of the patent. *Prima facie* the patent is valid. But under the uniform rulings of the courts of the United States for more than half a century, if there has been no decision as to the patent by a United States court on the merits, the party is driven to show that his patent went into use undisputed for a sufficient time to raise a *prima facie* case in his favor. But if the court, after a due consideration of the matter, has reached the conclusion that the patent is valid, on this provisional matter the inquiry is not open." 17 O. G. 974 (974); 1 Fed. Rep. 604 (606); 1 McCrary, 155 (157).

In *Hockholzer v. Eager* (1873), 2 Sawyer, 361, Hillyer, J.: (362) "Some-

Acquiescence, in reference to this subject, is a voluntary submission, against interest, to an asserted right. In the first

thing more than a grant of letters-patent must be shown; something which, in the absence of a trial at law, may take its place in establishing, or presumptively establishing, the validity of the patent. This may be done by showing an exclusive possession and exercise of the right granted. In proof of such possession it must appear that the patentee after the grant of his exclusive right has proceeded to exercise that right for some years without being disturbed. (*Orr v. Littlefield*, 1 W. & M. 13.) This he may prove by showing that he has manufactured and sold machines repeatedly, or has sold to others the right to make, vend, and use the thing patented, and if the public acquiesce in this exclusive exercise of his right, it affords some ground for presuming that the patent is valid."

In *Potter v. Muller* (1864), 2 Fisher, 465, Leavitt, J.: (467) "The rule as to granting or continuing injunctions in patent-right cases is now well settled by the modern usages of the courts of the United States. They are now granted without a previous trial at law in cases where the owner of the patent shows a clear case of infringement, and has been in the possession and enjoyment of the exclusive right for a term of years without any successful impeachment of its validity. Such possession and enjoyment, aided by the presumptions arising from the patent itself, are usually regarded as sufficient to warrant an injunction to restrain infringement."

In *Orr v. Littlefield* (1845), 1 W. & M. 13, Woodbury, J.: (16) "If the patentee, after the procurement of his patent conferring an exclusive right, proceeds to put that right into exercise or use for some years, without its being disturbed, that circumstance strength-

ens much the probability that the patent is good, and renders it so likely as alone often to justify the issue of an injunction in aid of it." 2 Robb, 323 (326).

See also *Brown v. Hinkley* (1873), 3 O. G. 384; 6 Fisher, 370; *Miller v. Androscoggin Pulp Co.* (1872), 1 O. G. 409; 5 Fisher, 340; Holmes, 142; *Guidet v. Palmer* (1872), 6 Fisher, 82; 10 Blatch. 217; *Sargent v. Carter* (1857), 1 Fisher, 277; *Sargent v. Seagrave* (1855), 2 Curtis, 553; *Brooks v. Norcross* (1851), 2 Fisher, 661; *Thomas v. Weeks* (1827), 2 Paine, 92 and notes; *Sullivan v. Redfield* (1825), 1 Paine, 441; 1 Robb, 477; *Isaacs v. Cooper* (1821), 4 Wash. 259; 1 Robb, 332.

That acceptance by the public is evidence of patentability, see *Strobridge v. Lindsay* (1880), 18 O. G. 62; 2 Fed. Rep. 692; 5 Bann. & A. 411.

That acquiescence must indicate a recognition of the validity of the plaintiff's patent, and this, in the absence of a judgment of validity, is important, see *Sargent v. Seagrave* (1855), 2 Curtis, 553.

That an injunction will issue when sufficient acquiescence is shown if the plaintiff's interest requires it, though some doubt as to the validity of the patent may remain, see *Sargent v. Seagrave* (1855), 2 Curtis, 553.

That an injunction will issue where the plaintiff has been for years in the undisputed use of his patents with the acquiescence of the public, unless special facts take the case out of the general rule, see *McKay v. Dibert* (1881), 5 Fed. Rep. 587; 19 O. G. 1351.

That the use and sale of the invention by the plaintiff before he applied for a patent, and the acquiescence of the public in his exclusive claims, is to be

place, the right must be asserted. The issue of a patent is not, of itself, such an assertion. Where the patentee alone employs the invention, in secret or on his own premises, without competition or attracting public notice, or where he neither exposes his monopoly to violation nor vindicates it when it is attacked, there is no right asserted in which the public or an individual can acquiesce.² Again, the asserted right must be antagonistic to the public interest, at least to the interest of that portion of the public who are generally benefited by the use of such inventions. If the invention is without utility, or if through some mistake as to its character the public are convinced that it is worthless, and there is no demand for or desire to use it, their passive indifference to the exclusive claim of the inventor indicates no public rec-

considered on a motion for an injunction, see *Sargent v. Seagrave* (1855), 2 Curtis, 553.

That previous user by the inventor and others is not necessary where the patent has been sustained by the courts, especially where the patent is for a process, see *American Middlings Purifier Co. v. Christian* (1877), 4 Dillon, 448; 3 Bann. & A. 42.

² In *Tappan v. National Bank Note Co.* (1861), 2 Fisher, 195, Shipman, J.: (198) "The principle that exclusive possession for a time strengthens the title of a patentee is founded on the idea that as it is a claim of right adverse to the public, and the public acquiesce in that claim, such acquiescence raises a presumption that the claim is good. But no such presumption can be raised in this case. There is no evidence that the public, or that small portion of it who would be likely to avail themselves of this invention knew even of its existence, much less of the existence of an exclusive grant to this patentee or to any one else. Nor, in this view of the case, can I take into account the possession of the right and the use of the invention *before* the ap-

plication or grant of the patent. This is sometimes done on the principle laid down in *Sargent v. Seagrave*, 2 Curtis, 555. But, of course, the use, in such a case, must be a *public* one under an avowed claim of a right to a patent; otherwise, there is no exclusive possession as against the public, and no claim in which the public can acquiesce." 4 Blatch. 509 (512).

That proof showing that the plaintiff, while manufacturing under his own patent in his own shop, met with no competition does not establish acquiescence, see *Grover & Baker Sewing Mach. Co. v. Williams* (1860), 2 Fisher, 133.

That on motion for injunction it is important that the invention has never been put in the market, nor the patent litigated, nor its validity accepted, see *Irwin v. McRoberts* (1879), 16 O. G. 853; 4 Bann. & A. 411.

That an injunction will be denied unless the scope of the patent has been defined by the courts, or by the acquiescence of that part of the public who are cognizant of the monopoly, see *Steam Gauge & Lantern Co. v. Miller* (1881), 8 Fed. Rep. 314; 20 O. G. 889.

ognition of its validity.³ Moreover, the submission must be voluntary. There is no acquiescence where the monopoly is constantly invaded or the rights of its owner are respected only under the compulsion of adverse judgments or continual injunctions.⁴ Submission after a single contest, which serves to define the limits of the patented invention, is stronger evidence of the validity of the patent as defined than if its scope were still undetermined, but the general resistance of the public to the patentee's demands, though provoking numerous actions in all of which he is successful, is inconsistent with the idea that they regard his patent as valid. His judgments may be evidence to prove the existence and the lawfulness of his monopoly; but the conduct of the infringing public is its perpetual denial.

³ In *Grover & Baker Sewing Mach. Co. v. Williams* (1860), 2 Fisher, 133, Sprague, J.: (136) "Acquiescence is taken as evidence of the plaintiff's right, and may in some cases in a great degree strengthen the presumption created by the patent itself. If a party set up an exclusive right to the manufacture and use of an article which others are desirous of manufacturing or using, and it would manifestly be for their interest to do so, and they would do so did they not think themselves prohibited by the patent-right of another, then their acquiescence, their abstaining from making that which it is morally certain they would do but for such patent, shows the conviction of those who are interested adversely to it, and who, from being interested in it, may be presumed to have knowledge on the subject,—shows that they are convinced of the patentee's right, and that they have sacrificed their interest to their conviction. But if there be no adverse interest, no person who would be desirous of using it, whether it were patented or not, then their not using it

cannot afford a presumption of the right and would not strengthen it. . . . (138) But it would not necessarily follow, because there were certain persons carrying on an art or manufacture at their own manufacturing establishment, and others did not enter into competition with them, that that abstaining from competition was owing to the belief that they had the exclusive right. It may be so, and it may not be. Persons set up the manufacture of a new article; others may not enter into competition because they do not believe it for their interest; they may not believe it to be profitable, and in that case there would be no evidence that they believed they were excluded from it by a monopoly in possession of those persons."

⁴ That no injunction will issue where the patent has not been sustained by the courts, and there has been only a limited acquiescence, and the defendants have for years openly denied its validity, see *Fish v. Domestic Sewing Mach. Co.* (1882), 12 Fed. Rep. 495; 22 O. G. 1207.

§ 1186. Preliminary Injunction: Public Acquiescence as Evidence of Validity: Weight of such Evidence, how Measured.

As the fact of acquiescence depends on the assertion of the right, on the restriction which it places on the public interest, and on the willingness of their submission, so its value, as proof of the validity of the patent, is measured by the degree and the duration of such submission and restraint.¹ That a patent covering an invention of slight utility, or desirable by but a small fraction of the public, remains inviolate, affords little proof that the right of the inventor to its exclusive use was recognized; while if the invention were of great importance, affecting the whole course and practice of the art, the absence of infringement can be attributed only to a compliance with the prohibitions of the patent.² The significance of the duration of the acquiescence is not estimated by the mere lapse of time.³ No period can be specified within which such submission shall be insufficient to establish the validity of the patent.⁴ The public must have had an opportunity to

§ 1186. ¹ In *Potter v. Whitney* (1866), 3 Fisher, 77, Lowell, J.: (79) "These cases being tried, as I have said, on *ex parte* evidence, must be decided on broad views of the rights of the parties. It is usual to present proof either of long and general acquiescence in the plaintiff's exclusive rights, or of their having been sustained by the courts. The ground on which acquiescence is important is that it shows exclusive possession, which, if it has been of long standing, open, and notorious, is a clear foundation of a presumption of title. It is not always, however, so satisfactory as positive adjudications, because it may have arisen from the comparatively small commercial value of the invention, and in that case shows only that no one has thought it worth infringing." 1 Lowell, 87 (89).

² That an injunction is seldom refused where there has been exclusive possession for some time, though not

for a long period, and where large and numerous sales were had without dispute, and the defendant does not deny the validity of the patent, see *White v. Heath* (1882), 22 O. G. 500; 10 Fed. Rep. 291.

³ That mere lapse of time shows no acquiescence, but facts must appear which indicate that the public would not have acquiesced had they not considered the patent valid, and the nature of the invention and all attendant circumstances must be regarded, see *Guidet v. Palmer* (1872), 6 Fisher, 82; 10 Blatch. 217.

⁴ In *Foster v. Moore* (1852), 1 Curtis, 279, Curtis, J.: (286) "It is not possible to fix any precise term of years during which the exclusive possession must have continued. The reason for the presumption in favor of the validity of the grant is the acquiescence of the public in the exclusive right of the patentee, which, it may reasonably be

become acquainted with the merits of the invention, and to be informed of the asserted rights of the patentee, and must have voluntarily refrained, against their manifest interest, from appropriating the invention for such a time as makes it evident that their forbearance is the result of knowledge and deliberation.⁶ All circumstances which tend to show the value of the invention to the public and their consequent motive to inquire into the validity of the patent which protects it are here important, — a short period of voluntary submission in reference to some inventions being of greater weight upon this question than years of acquiescence in regard to others.

§ 1187. Preliminary Injunction: Public Acquiescence as Evidence of Validity: Acquiescence, how Manifested.

The acquiescence of the public in the monopoly created by a patent may be manifested in different modes, corresponding to those which the patentee adopts for its enjoyment. Where he makes and uses the invention in his own business, or manufactures it for sale, the omission of infringing acts is a sufficient recognition of his patent.¹ When he grants li-

assumed, would not exist unless the right was well founded. And it is obvious that this public acquiescence is entitled to more or less weight according to the degree of utility of the machine, and the number of persons whose trade or business are affected by it."

That though the duration of enjoyment necessary to constitute possession and acquiescence cannot be fixed by rule, it must be long enough to raise a presumption that the patent is valid, see *Potter v. Muller* (1864), 2 Fisher, 465.

⁶ That the length of time necessary for acquiescence depends on the duration and extent of the use and sale by the patentee, or the degree of utility, or the number of persons whose interest it is to infringe the patent, and the completeness of the acquiescence, see *Sargent v. Seagrave* (1855) 2 Curtis, 553.

That the exclusive possession for eight years of a device affecting the business of a large class of persons is enough to make an injunction proper, see *Foster v. Moore* (1852), 1 Curtis, 279.

That no injunction will be granted a few months only after the issue of the patent, when its validity is denied, the infringement is disputed, and the defendant is responsible, see *McGuire v. Eames* (1878), 15 Blatch. 312; 3 Bann. & A. 499; *Jones v. Field* (1875), 12 Blatch. 494; 2 Bann. & A. 39.

That a year is too short a period for a patent to acquire a construction by acquiescence, and an injunction based on any given construction will not be warranted thereby, see *Johnston Ruffler Co. v. Avery Mach. Co.* (1886), 28 Fed. Rep. 193; 36 O. G. 1043.

§ 1187. ¹ That an omission to infringe, when the invention is of public

censes to others, the general acceptance of his licenses and the payment of substantial fees constitutes the requisite submission.² Licenses issued and received on nominal royalties, or without consideration, afford no indication of public acquiescence. The acknowledgment of his exclusive right to an article or process which embodies several inventions, each the subject of a different patent, does not admit the validity of either patent nor that all the patents are of equal force.³ The departure of the defendant from the universal acquiescence of the public does not tend to weaken the presumption of validity, but rather adds to its importance, since it shows their knowledge of the value of the invention and the advantage they might gain by its infringement.⁴ Acquiescence in an original patent avails the plaintiff on a re-issue for the same precise invention, but not where new claims are inserted of which the public could have had no previous notice.⁵

value, indicates acquiescence, see *Grover & Baker Sewing Mach. Co. v. Williams* (1860), 2 Fisher, 133.

That acquiescence may be shown by extensive manufacture, many licenses, the settlement of prior suits, and general recognition by the trade, see *Hat Sweat Mfg. Co. v. Davis Sewing Mach. Co.* (1887), 41 O. G. 1273; 32 Fed. Rep. 401.

² In *Grover & Baker Sewing Mach. Co. v. Williams* (1860), 2 Fisher, 133, Sprague, J.: (138) "If they [the public] had paid for licenses, that would be a palpable and manifest sacrifice of their interests to their conviction of the plaintiffs' right, because it shows a desire to make the machine and abstaining from it, paying the plaintiffs and thus making a pecuniary sacrifice for the sake of getting the right from the plaintiffs."

That an acquiescence by infringers, as shown by their taking licenses rather than contest the patent, is as strong evidence as voluntary submission, see *Hat Sweat Mfg. Co. v. Davis Sewing Mach. Co.* (1887), 32 Fed. Rep. 401; 41 O. G. 1273.

³ That acquiescence in a manufacture protected by several patents does not show that all the patents were supposed by the public to be equally valid, or that any particular one was conceded to be valid, especially if any one of them had been sustained by the courts, see *Upton v. Wayland* (1888), 36 Fed. Rep. 691; *Grover & Baker Sewing Mach. Co. v. Williams* (1860), 2 Fisher, 133.

⁴ That an unsuccessful attempt to interrupt the patentee's possession strengthens the presumption in his favor, see *Sargent v. Seagrave* (1855), 2 Curtis, 553.

That an injunction will be granted where the plaintiffs enjoyed the patent ten years, and were never interfered with except by the defendant, whom they promptly notified, see *Collignon v. Hayes* (1881), 20 O. G. 447; 8 Fed. Rep. 912.

⁵ In *Grover & Baker Sewing Mach. Co. v. Williams* (1860), 2 Fisher, 133, Sprague, J.: (144) "Undoubtedly there may be cases in which the original patent relates to and covers probably the same

§ 1188. Preliminary Injunction: Comparative Weight of Prior Judgments and Public Acquiescence as Evidence of Validity.

The acquiescence of the public in the exclusive privilege of the patentee is of less weight, although usually of wider application, than a judgment.¹ Judgments, except in extraordinary cases, are confined to certain issues, and when they sustain a patent sustain it only on the grounds which have been made the subject of dispute. Acquiescence, on the other hand, is an admission of the validity of the patent as against all conceivable objections, and in its scope is therefore equal to a judgment upon all the issues which the law permits to be presented. Its weight, however, is by far inferior, since in the absence of all litigation it never can be known what causes might be shown for the avoidance of the patent, nor whether each defence might not be successfully maintained. It is received as evidence on applications for injunctions on account of its general nature and comparative facility of proof, and because, though not equal to a judgment, it may rank next to judgments as a basis for presumptions. Where it can be strengthened by a judgment, even in a coordinate or lower court, its value as evidence of validity is much increased.²

thing that is in the re-issued patent ; and if it does, and the public have acquiesced in the claim made in the original patent for the same thing that is claimed in the re-issued patent, it is evidence to show that they believe that the patentee had an exclusive right to it. But if the original patent did not claim the same thing, and, therefore, the public had no notice that it was the patentee's invention, and, if it was his invention, had no notice that he claimed it, — or, at all events, that he had any exclusive right to it, — then the acquiescence in the original patent cannot be construed as acquiescence in that which he did not then claim, but which sometime afterward he did."

That on a motion for an injunction,

a re-issue containing claims not in the original patent is treated as a new patent so far as the questions of acquiescence and public acceptance are concerned, see *Irwin v. McRoberts* (1879), 16 O. G. 853 ; 4 Bann. & A. 411.

§ 1188. ¹ That public acquiescence is only important to show exclusive possession and create a presumption of title, and is of less weight than a prior adjudication, see *McWilliams Mfg. Co. v. Blundell* (1882), 11 Fed. Rep. 419 ; 22 O. G. 177 ; *Potter v. Whitney* (1866), 3 Fisher, 77 ; 1 Lowell, 87.

² That the presumption from acquiescence is aided by judgments either at law or in equity, see *Potter v. Muller* (1864), 2 Fisher, 465.

That where the plaintiff produced his patent, proved an uninterrupted use

§ 1189. Preliminary Injunction: Admissions of Defendant as Evidence of Validity.

Where neither judgments nor public acquiescence can be offered to support the patent, the conduct of the defendant may still furnish sufficient evidence to authorize the court to find this point in favor of the plaintiff. The failure of the defendant to deny the validity of the patent, in his answer to the application, is an admission which serves all the ends of proof.¹ Although he does deny it, his past acts may contradict his pleadings, and practically estop him from insisting upon his denial. The compromise of a previous action after expensive litigation, in which he has admitted his infringement of the patent; his express contract, unrescinded, obliging him to acknowledge its validity; his covenant on due consideration binding him not to urge his only possible defence; his former union with the plaintiff in the enjoyment

without infringement for eleven years, and had recovered a judgment in a trial at law, during which every defence known to the law could have been set up, and had also received an extension in spite of opposition, an injunction will issue, see *McComb v. Ernest* (1871), 1 Woods, 195.

That an injunction may be refused, though acquiescence be shown, if there is reasonable doubt as to validity, see *Bradley & Hubbard Mfg. Co. v. Charles Parker Co.* (1883), 24 O. G. 995; 17 Fed. Rep. 240.

§ 1189. ¹ That an injunction will be granted when the defendant's answers are equivocal and evasive, or disclose facts which show that the conclusions from them are erroneous and founded on a mistake of law, see *Parker v. Sears* (1850), 1 Fisher, 93.

That an injunction will issue if the questions as stated admit the facts and their solution depends on the construction of the patent, see *Goodyear v. Railroad* (1853), 1 Fisher, 626.

That an injunction will be granted where the validity of the original patent

is not disputed by the defendant, where capital is invested in the manufacture and a successful business has been established, and where large and numerous sales have taken place without dispute, and exclusive possession has for some time existed, see *White v. Heath* (1882), 10 Fed. Rep. 291; 22 O. G. 500.

That where an injunction has been granted against one defendant, and upon a new motion for an injunction against another the latter does not deny, either by his own affidavit or that of any expert, that his device is identical with that of the former defendant or that he infringes, and his counsel makes affidavit merely that his client and experts tell him there is no infringement, and asks time to show it, the injunction will be granted and the defendant's device be presumed to infringe, see *Conover v. Mers* (1868), 3 Fisher, 386.

That where a defendant abandons his case and confesses judgment, the judgment is sufficient unless collusive, see *Goodyear v. Railroad* (1853), 1 Fisher, 626.

of the monopoly and in enforcing it against all others, — such are some examples of the conduct which on an application for an injunction may be treated by the court as proof sufficient to sustain the patent.²

² That a compromise and admission of infringement after expensive litigation, coupled with the opinion of a circuit judge in another case giving a broad construction to the patent, goes far to answer the purposes of a prior adjudication on the question of a preliminary injunction, see *Steam Gauge & Lantern Co. v. Miller* (1881), 20 O. G. 889 ; 8 Fed. Rep. 314.

That a verbal admission of infringement and a promise to desist is a strong circumstance against the defendant on a motion for a preliminary injunction, see *Morse Fountain Pen Co. v. Esterbrook Steel Pen Mfg. Co.* (1869), 3 Fisher, 515.

That where a defendant in a suit at law agreed for a valuable consideration to cease making the device, and suffered judgment to be entered against him, but continued to sell a different and still infringing device, and upon a bill in equity being brought against him it appeared that all the defences set up were known to him at the time of the former suit, he was held bound by his agreement, and estopped from denying the validity of the patent, see *Brooks v. Moorhouse* (1878), 13 O. G. 499 ; 3 Bann. & A. 229.

That a defendant will be enjoined if he has covenanted not to further infringe, unless he can show reasons for a release from his covenants, see *Sargent v. Larned* (1855), 2 Curtis, 340.

That an injunction will be granted where the defendant is estopped by express contract from setting up the only defence he could make, see *McKay v. McKnight* (1881), 5 Fed. Rep. 593.

That where a firm is composed of the defeated and the successful applicants

for a patent, and the firm sold and advertised the articles under the patent, and after the dissolution of the firm the defeated parties still made and sold the articles, their former acquiescence was held sufficient to warrant an injunction, see *Pentlargo v. Beeston* (1877), 14 Blatch. 352 ; 3 Bann. & A. 142.

That a defendant corporation whose officers until recently were occupying positions of trust under the plaintiff, asserting the validity of his patent and enjoying its benefits, may be held to stricter accountability than an ordinary infringer, see *Steam Gauge & Lantern Co. v. Ham Mfg. Co.* (1886), 28 Fed. Rep. 618.

That a former part-owner of a patent is estopped from denying its validity on a motion for an injunction against a firm of which he is now a member, if he assigned his interest in the patent to the plaintiff for value, see *Parker v. McKee* (1885), 24 Fed. Rep. 808 ; 32 O. G. 137.

That on a motion for an injunction the defendant cannot deny validity if he has been a licensee and owner of the patent, and has dealt extensively in the articles as patented under it, see *Burr v. Kimbark* (1886), 28 Fed. Rep. 574 ; 37 O. G. 1480.

That an inventor and assignor is estopped to deny that he was the true inventor, when defendant on a motion for an injunction, see *American Paper Barrel Co. v. Laraway* (1886), 28 Fed. Rep. 141 ; 37 O. G. 674.

That a defendant, by taking a license and acting under it, admits the validity of the patent for the purpose of an injunction, though no judgment exists, if the patent is not challenged, see

§ 1190. Preliminary Injunction : Proof of Plaintiff's Title.

The second point to be established by the applicant for an injunction is his ownership of a legal or equitable interest in the patent alleged to be infringed.¹ As this is a matter capable of direct proof and usually without extensive investigation, the courts require a higher degree of certainty in the evidence presented than is necessary in regard to the validity of the patent. If the plaintiff holds the legal title as patentee or assignee or grantee, the instruments themselves, or certified copies, must be offered, disclosing the precise condition of the ownership. When the interest of the plaintiff is merely equitable, it must be proved by the production of the written contract upon which it rests, or by parol testimony of the facts and circumstances out of which it grows.

§ 1191. Preliminary Injunction : Proof of Intended Infringement.

Upon the third point the plaintiff must satisfy the court that the defendant intends to make, use, or sell, or to authorize or directly profit by the manufacture, use, or sale, of some

Brown v. Lapham (1886), 27 Fed. Rep. 77 ; 23 Blatch. 475 ; 37 O. G. 676.

That a licensee openly repudiating his license and denying validity, cannot afterwards be enjoined on the ground of his former acquiescence in the patent, see *Brown v. Lapham* (1886), 23 Blatch. 475 ; 27 Fed. Rep. 77 ; 37 O. G. 676.

That a patentee cannot deny the validity of the patent or its re-issues in a suit against him by his assignee, though the re-issues were granted after the assignment, and the assignee ought to have known that they were void, see *Burdsall v. Curran* (1887), 31 Fed. Rep. 918 ; 42 O. G. 1167.

That a person who induced a plaintiff to acquire a patent and commence business under it is estopped to deny its validity on a motion for an injunction, see *Time Telegraph Co. v. Carey* (1884), 26 O. G. 826 ; 22 Blatch. 34 ; 19 Fed. Rep. 322.

That one who knowingly permits another to take out a patent for an

invention, and then himself obtains a patent for a different invention, cannot claim that he is the inventor of the prior invention, see *Fraim v. Keen* (1885), 34 O. G. 1048 ; 25 Fed. Rep. 820.

That a defendant who has profited by an infringement cannot deny the utility of the invention, see *La Rue v. Western Electric Co.* (1887), 31 Fed. Rep. 80 ; 40 O. G. 576.

That a patentee cannot aver against his assignee that the invention was worthless or abandoned, see *Many v. Jagger* (1848), 1 Blatch. 372.

§ 1190. ¹ That an injunction may issue notwithstanding a denial of the plaintiff's title, see *Clum v. Brewer* (1855), 2 Curtis, 506.

That an injunction will be refused where the plaintiff has only a doubtful equitable title and that is being contested in the local courts, see *Continental Store Service Co. v. New York Store Service Co.* (1885), 31 O. G. 1561.

art or instrument identical with that covered by his patent.¹ Where the identity has already been established in prior actions, the judgments therein rendered may be offered in the same manner as upon the issue of validity.² If the invention is an instrument, and the defendant has in his possession or under his control the alleged infringing articles, the court may personally inspect and compare them, and without further proof determine their substantial agreement or dissimilarity.³ When these modes of investigation are unavailable, such evidence must be introduced as the plaintiff is able to obtain.⁴ The intention of the defendant to practise the in-

§ 1191. ¹ That no injunction will issue unless infringement clearly appears, see *Brooks v. Miller* (1886), 28 Fed. Rep. 615; *Steam Gauge & Lantern Co. v. St. Louis Railway Supplies Mfg. Co.* (1885), 25 Fed. Rep. 491; 33 O. G. 889; *Allis v. Stowell* (1883), 15 Fed. Rep. 242; 23 O. G. 1033; *Coburn v. Clark* (1883), 15 Fed. Rep. 804; 24 O. G. 899; 5 *McCrary*, 99; *Hardy v. Marble* (1882), 10 Fed. Rep. 752; 23 O. G. 438; *Marks v. Corn* (1881), 11 Fed. Rep. 900; 23 O. G. 94; *Pullman v. Balt. & Ohio R. R. Co.* (1881), 19 O. G. 224; 5 Fed. Rep. 72; 4 *Hughes*, 236; *White v. Harris & Sons Mfg. Co.* (1880), 3 Fed. Rep. 161; 5 *Bann. & A.* 571; *American Middlings Purifier Co. v. Atlantic Milling Co.* (1877), 4 *Dillon*, 100; 3 *Bann. & A.* 168; *Burleigh Rock Drill Co. v. Lobdell* (1875), 7 O. G. 836; *Holmes*, 450; 1 *Bann. & A.* 625; *Dodge v. Card* (1860), 2 *Fisher*, 116; 1 *Bond*, 393.

That no injunction will issue unless it has been shown that the defendant has used the invention, or employed others to use it, or has profited by its use, see *Woodworth v. Hall* (1846), 1 *W. & M.* 248; 2 *Robb*, 495.

That an injunction may be granted though infringement is not proved beyond reasonable doubt, see *Doughty v. West* (1865), 2 *Fisher*, 553.

That the question of infringement

must be determined anew upon each motion for an injunction, though the validity of the patent be sustained by prior judgments, see *Hammerschlag Mfg. Co. v. Judd* (1886), 28 Fed. Rep. 621.

² That on a motion for an injunction all questions adjudicated in previous cases are regarded as settled, see *Good-year Dental Vulcanite Co. v. Evans* (1868), 3 *Fisher*, 390; 6 *Blatch.* 121.

³ That disputed infringement may be settled by inspecting the two devices without any prior adjudication, see *Crowell v. Harlow* (1878), 18 O. G. 466; 3 *Bann. & A.* 478.

That in case of a simple mechanism a bare inspection of the two machines is often enough to show an infringement for the purposes of a preliminary injunction, see *Morse Fountain Pen Co. v. Esterbrook Steel Pen Mfg. Co.* (1869), 3 *Fisher*, 515.

That the refusal of a defendant to exhibit his device raises a presumption of infringement, see *Piper v. Brown* (1873), *Holmes*, 196; 6 *Fisher*, 240; 3 O. G. 97; *Union Paper Bag Mach. Co. v. Binney* (1871), 5 *Fisher*, 166.

⁴ That on a motion for an injunction the fact of a difference of expert opinions will be regarded, see *American Nicholson Pavement Co. v. City of Elizabeth* (1870), 4 *Fisher*, 189.

That affidavits of the makers of a

vention, in violation of the plaintiff's rights, may be shown from his past acts of infringement in reference to the same invention, or from his threats or preparations to infringe.⁶ Where the defendant has once knowingly invaded the exclusive domain of the plaintiff, there is a strong presumption that the wrong will be repeated, although he may have since desisted and promised to refrain, or even sworn that it is his purpose no further to infringe.⁶ This presumption arises,

composition outweigh those of mere dealers on the question of infringement, see *Gutta Percha & Rubber Mfg. Co. v. Goodyear Rubber Co.* (1875), 8 Sawyer, 542; 2 Bann. & A. 212.

⁶ That an injunction will be granted before a wrong is committed when the right is clear and the wrong is threatened, or when the wrong has once been committed and there is good reason to fear its repetition, see *Sherman v. Nutt* (1888), 35 Fed. Rep. 149; *Poppenhusen v. New York Gutta Percha Comb Co.* (1858), 2 Fisher, 74; 4 Blatch. 184.

That an injunction will be granted where there have been no actual sales but only prospective ones, see *White v. Heath* (1882), 22 O. G. 500; 10 Fed. Rep. 291.

That where an injunction has been denied on the ground that the defendant before suit abandoned the infringement, and he since makes a different infringing device, a new injunction will be granted covering all the devices, see *Odell v. Stout* (1884), 22 Fed. Rep. 159; 29 O. G. 862.

⁶ In *Potter v. Crowell* (1866), 3 Fisher, 112, *Withey, J.*: (115) "Perhaps as safe a criterion of what is to be apprehended from defendants as can be obtained is to look at that which they have done, and in their answer justify the right to do, rather than to look to the fact of their having discontinued the alleged injury, and their declaration of want of intention of renewing the same. The court is not prepared to say that no

occasion for the exercise of its restraining power is shown in this case, when it is apparent that there was such occasion when the suit was commenced; that it has but recently ceased; that it may, if defendants feel disposed, be renewed at any time; and that the complainants claim that they apprehend a continuance of the wrong." 1 Abbott, 89 (91).

In *Jenkins v. Greenwald* (1857), 2 Fisher, 37, *Leavitt, J.*: (43) "These authorities seem decisive on the point referred to. They establish the position that if the party proceeded against as an infringer of the exclusive right of the person having the title to the patent admits the infringement, but asserts that after notice or service of the injunction he had refrained from the use of the thing patented, and asserts that he will not afterward infringe, it is no reason why an injunction should not issue, and be made perpetual. The complainant in such a case is not obliged to rest his interests on the mere asseveration of the party that he will not repeat the act of infringement. Having once been a wrong-doer, the law supposes the possibility of his being so again, and will impose the proper restraint to prevent the repetition of the wrongful act." 1 Bond, 126 (133).

See also *Facer v. Midvale Steel-Work Co.* (1888), 38 Fed. Rep. 231; *Celluloid Mfg. Co. v. Arlington Mfg. Co.* (1888), 34 Fed. Rep. 324; 42 O. G. 828; *North American Iron Works v.*

whatever may have been the extent of the infringement or the damage thence resulting to the plaintiff.⁷ An innocent infringement, abandoned upon notice of the patent, is of comparatively little weight as evidence of this intention, though not wholly disregarded by the court. Assertions of his right to practise the invention, the possession of infringing machines capable of operation or of marketable articles covered by the patent, or other indications of ability and readiness to enter into unlawful competition with the plaintiff, are also competent evidence of such intention.⁸

§ 1192. Preliminary Injunction: May be Granted on other Proof or Withheld though the Foregoing Proof is Presented.

The requirement of the foregoing modes of proof is not designed to exclude all others, or to prohibit the court from granting an injunction though none of these may be pre-

Fiske (1887), 39 O. G. 1086; 30 Fed. Rep. 622; *Wollensak v. Reiher* (1886), 38 O. G. 108; 28 Fed. Rep. 427.

That ceasing to use the device is no reason for denying an injunction, since the plaintiff is entitled to future protection, see *Goodyear v. Berry* (1868), 3 Fisher, 439; 2 Bond, 189; *Sickels v. Mitchell* (1857), 3 Blatch. 548.

That an injunction is not withheld on account of an assertion under oath by the defendant that he does not intend to infringe during the suit, see *White v. Heath* (1882), 22 O. G. 500; 10 Fed. Rep. 291.

⁷ That for the purposes of a preliminary injunction the extent of the defendant's infringement is immaterial, see *Brickill v. Mayor of New York* (1880), 7 Fed. Rep. 479; 18 O. G. 463; 18 Blatch. 273; 5 Bann. & A. 544.

⁸ That an injunction will issue where the defendants were owners of the device but had obtained no right to use it, see *Porter Needle Co. v. National Needle Co.* (1883), 17 Fed. Rep. 536.

That the possession and advertising

of infringing devices warrant an injunction, though no actual infringement has been committed, see *American Bell Telephone Co. v. Globe Telephone Co.* (1887), 31 Fed. Rep. 729; 24 Blatch. 522.

That the use of an invention involving a patented process is a continuing infringement, see *Beedle v. Bennett* (1887), 122 U. S. 71; 39 O. G. 1326.

That a territorial grantee cannot be enjoined from advertising and selling within his territory, on the ground that his vendees take the articles elsewhere, see *Hatch v. Hall* (1884), 30 O. G. 1096; 22 Fed. Rep. 438.

That a vendee will not be enjoined from using the article purchased, on the ground that it infringes another patent of the vendor, if it could be used in no other way, see *Roosevelt v. Western Electric Co.* (1884), 28 O. G. 812; 20 Fed. Rep. 724.

That a defendant will not be enjoined from using an invention which he had in use when the patent was granted, see *Dorlan v. Guie* (1885), 25 Fed. Rep. 816; 34 O. G. 702.

sented. Whenever, upon such investigation as the court has opportunity or is disposed to make, it is apparent that the plaintiff has a right which the defendant threatens to invade, an injunction may be issued, — the rules which govern the discretion of the court being intended for the furtherance of justice, not for its denial. But where one or all of these three forms of proof are offered, it is still within the same discretion to withhold relief, for reasons which indicate that its application in the present instance would be inequitable. These reasons relate to the situation and conduct of the plaintiff or defendant, to the substance of the patent, or to the consequences which would follow from the grant of an injunction.

§ 1193. Preliminary Injunction: Grounds of its Refusal: No Irreparable Injury.

Among the reasons relating to the plaintiff which may induce the court to refuse an injunction is the fact that no irreparable injury would result from the infringement.¹ Thus where the patent is about to expire, or an established license fee exists and has been tendered by the defendant, or the damages resulting from the infringement could be easily computed and the defendant is pecuniarily responsible, or where the bill claims damages and profits only to some date already past, or an adequate remedy can be obtained at law, — the court may either deny the application of the plaintiff or grant it in such a modified form as will secure him the exact protection to which he is entitled.²

§ 1193. ¹ In *Pullman Car Co. v. Baltimore & Ohio R. R. Co.* (1881), 19 O. G. 224, Bond & Morris, JJ.: (224) "It is not a matter of course, upon the presentation of a patent which *prima facie* establishes the right of the patentee to the thing patented, accompanied by an allegation that the defendant is violating it, that a preliminary injunction will issue; but it must appear likewise that if the writ of injunction does not now issue the complainants will be irreparably injured, and

that no subsequent decree of the court can sufficiently ascertain and make good their damages." 5 Fed. Rep. 72 (73); 4 Hughes, 236 (237).

See also *Westinghouse Air Brake Co. v. Carpenter* (1887), 32 Fed. Rep. 484; *Keyes v. Pueblo Smelting & Refining Co.* (1887), 31 Fed. Rep. 560; *Zinsser v. Cooledge* (1883), 17 Fed. Rep. 538; *Earth Closet Co. v. Fenner* (1871), 5 Fisher, 15.

² That an injunction will not be issued in the last weeks of the term of

§ 1194. Preliminary Injunction: Grounds of Its Refusal: Plaintiff's Laches or Acquiescence.

Another reason is found in the plaintiff's acquiescence in the infringement, or his laches in the enforcement of his

the patent, when the plaintiff can be compensated in damages, except in peculiar cases, see *Parker v. Sears* (1850), 1 Fisher, 93.

That an injunction will issue after the patent has expired to prevent the use or sale of articles made without authority for that purpose while the patent was in force, see *New York Belting & Packing Co. v. Magowan* (1886), 27 Fed. Rep. 111; 34 O. G. 1278; *American Diamond Rock Boring Co. v. Sheldon* (1880), 1 Fed. Rep. 870; 5 Bann. & A. 292; 18 Blatch. 50.

That if a party knows that the articles being made by him during a patent are infringements, he will be enjoined against selling them after the patent expires, see *New York Belting & Packing Co. v. Magowan* (1886), 27 Fed. Rep. 111; 34 O. G. 1278.

That the sale of an article made under the patent with the consent of the patentee cannot be enjoined after the patent expires, see *Reay v. Rau* (1883), 23 O. G. 1928; 15 Fed. Rep. 749.

That the patent having expired an injunction may be refused, see *Clark v. Wilson* (1886), 36 O. G. 456; 28 Fed. Rep. 95; 24 Blatch. 38.

That where the plaintiff grants licenses the injunction may be refused and a license fee ordered, see *Smith v. Sands* (1885), 24 Fed. Rep. 470; 32 O. G. 1467; *Hodge v. Hudson River R. R. Co.* (1868), 6 Blatch. 165.

That where a license fee exists and is tendered, an injunction will be denied, see *Blake v. Greenwood Cemetery* (1877), 13 O. G. 1046; 14 Blatch. 342; 3 Bann. & A. 112.

That an injunction may be refused

when the defendant will take a license, and this is the plaintiff's usual mode of profit, see *Baldwin v. Bernard* (1872), 5 Fisher, 442; 2 O. G. 320; 9 Blatch. 509, note.

That no injunction will issue where there is adequate remedy at law, as where a licensee refuses to pay his license-fee, see *Blanchard v. Sprague* (1859), 1 Clifford, 288.

That an injunction may be granted though the defendant is a mere user and the plaintiff grants licenses at a fixed price, see *Howe v. Newton* (1865), 2 Fisher, 531.

That where the damages would be measured by a license-fee no injunction will issue, see *Smith v. Sands* (1885), 24 Fed. Rep. 470; 32 O. G. 1467; *Hoe v. Boston Daily Advertiser Co.* (1883), 23 O. G. 1123; 14 Fed. Rep. 914.

That an injunction will be granted though the defendant offers to take a license, if the granting of a license would injure the plaintiff's business, see *Baldwin v. Bernard* (1872), 2 O. G. 320; 5 Fisher, 442; 9 Blatch. 509, note.

That where a bill claims profits and damages only up to a specified past date no injunction should be ordered, see *Spring v. Domestic Sewing Mach. Co.* (1882), 13 Fed. Rep. 446; 22 O. G. 1445.

That on a motion for an injunction it is a material question whether the defendant is responsible for profits and damages if any are recovered, see *Morris v. Lowell Mfg. Co.* (1866), 3 Fisher, 67.

That when the defendants are fully responsible, and the plaintiff can be adequately compensated, irreparable damage must be shown to warrant an in-

rights.¹ The unwilling submission of the plaintiff to injuries which he could not resist does not prejudice him in a court of equity.² But an intelligent and voluntary consent, even though manifested only by inaction, for any considerable period, if unexplained, is a fault that may deprive him of a remedy which otherwise he would have obtained. Thus, where he has abandoned the practice of the invention, and seen it go into general unlicensed use without attempting to restrain or punish the infringers, the court will not assist him, after a long interval, in the endeavor to reclaim his monopoly and interrupt the enjoyment of the public, except upon a full and final hearing of the cause.³ The acquiescence of any

junction, see *New York Grape Sugar Co. v. American Grape Sugar Co.* (1882), 10 Fed. Rep. 835; 20 Blatch. 386; *Pullman Car Co. v. Balt. & Ohio R. R. Co.* (1880), 5 Fed. Rep. 72; 19 O. G. 224; 4 Hughes, 236.

§ 1194. ¹ That acquiescence in an infringement may forfeit the right to relief in equity, see *Kittle v. Hall* (1887), 24 Blatch. 184; 29 Fed. Rep. 508; 39 O. G. 707; *Magic Ruffle Co. v. Elm City Co.* (1877), 11 O. G. 501; 14 Blatch. 109; 2 Bann. & A. 506; *Union Mfg. Co. v. Lounsbury* (1863), 2 Fisher, 389.

That laches in obtaining a re-issue may prevent relief in equity, see *Wolensak v. Reiher* (1885), 115 U. S. 96; 31 O. G. 1301; *Tillinghast v. Hicks* (1882), 23 O. G. 739; 13 Fed. Rep. 388.

That no injunction will issue where the plaintiff has been negligent in asserting his rights, see *Keyes v. Pueblo Smelting & Refining Co.* (1887), 31 Fed. Rep. 560; *McLaughlin v. People's R. R. Co.* (1884), 21 Fed. Rep. 574; 29 O. G. 277; *Union Mfg. Co. v. Lounsbury* (1863), 2 Fisher, 389.

That delay may or may not defeat the right to an injunction, see *American Middlings Purifier Co. v. Christian* (1877), 4 Dillon, 448; 3 Bann. & A. 42.

² That if the defendant infringes when the plaintiff is powerless to prevent it, that does not take away his right to protect his interest when he becomes able, see *McMillin v. Barclay* (1871), 5 Fisher, 189; 4 Brews. (Pa.) 275.

That a patentee is not guilty of laches while ignorant of the infringement, see *Kilbourn v. Sunderland* (1889), 130 U. S. 505; *Adams v. Howard* (1884), 26 O. G. 825; 19 Fed. Rep. 317; *N. Y. Grape Sugar Co. v. Buffalo Grape Sugar Co.* (1883), 25 O. G. 1076; 18 Fed. Rep. 638; 21 Blatch. 519.

That a delay in suing infringers caused by the bankruptcy of the patentee and the vesting of the patent in his assignee, accompanied with fruitless efforts of the patentee to regain it until shortly before suit was brought, is not such laches as forfeits the right to sue, if timely notice were given to infringers, see *Kittle v. Hall* (1887), 29 Fed. Rep. 508; 39 O. G. 707; 24 Blatch. 184.

³ In *Green v. French* (1879), 4 Bann. & A. 169, Nixon, J.: (170) "The general principle of equity jurisprudence which underlies applications of this sort is that the court will not lend its help by way of preliminary injunction in those cases where it appears that the complainant has acquiesced in

owner of the patent has the same effect upon the rights of his assignees and grantees as upon his own.⁴ A similar result follows from the unreasonable delay of the plaintiff in instituting actions, though he has never intentionally submitted to an infringement.⁵ The owner of a patented invention owes a

the infringement and unreasonably delayed suit against the infringers. When patentees sleep over their rights, without an excuse, they must not rely upon the extraordinary aid of the court when they awake from their slumbers, but must be satisfied with such relief as may be afforded by the ordinary course of practice after final hearing." 16 O. G. 215 (215). See also *Jones v. Merrill* (1875), 8 O. G. 401; *Wyeth v. Stone* (1840), 1 Story, 273; 2 Robb, 23.

That an injunction will be refused if the plaintiff has acquiesced for two years in the infringement, see *Spring v. Domestic Sewing Mach. Co.* (1879), 16 O. G. 721; 4 Bann. & A. 427.

That no injunction will be granted where the plaintiff has long acquiesced in the infringement unless his acquiescence be explained, see *Mundy v. Kendall* (1885), 23 Fed. Rep. 591; 32 O. G. 1237.

That no injunction will issue if the plaintiff abandoned the invention, or abandoned his rights under the patent, see *Wyeth v. Stone* (1840), 1 Story, 273; 2 Robb, 23.

That the plaintiff can be prejudiced only by such acquiescence in the infringement as to induce the reasonable belief that he intended to dedicate the invention to public use, see *Williams v. Boston & Albany R. R. Co.* (1878), 16 O. G. 906; 17 Blatch. 21; 4 Bann. & A. 441.

⁴ That the plaintiffs are chargeable with the laches of former owners of the patent, see *Spring v. Domestic Sewing Mach. Co.* (1879), 16 O. G. 721; 4 Bann. & A. 427. See also § 1220, note 6, *post*.

That an assignee of claims for past infringements is bound by the laches of his assignor, see *N. Y. Grape Sugar Co. v. Buffalo Grape Sugar Co.* (1885), 32 O. G. 1356; 24 Fed. Rep. 604.

⁵ In *McLaughlin v. People's R. R. Co.* (1884) 21 Fed. Rep. 574, Brewer, J.: (574) "Under these circumstances, whatever action at law he may have for damages, I think his own laches such as prevents a court of equity from interfering by injunction. That the general principles of equity jurisprudence control in patent cases cannot be doubted. Rev. St. § 629, par. 9; also, section 4921, which last section contains these words: 'The several courts vested with jurisdiction of cases arising under the Patent Laws shall have power to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any rights secured by a patent, upon such terms as the court may deem reasonable.' Now, generally speaking, the laches of complainant is sufficient ground for non-interference on the part of a court of equity. Nearly all the lifetime of this patent the complainant has remained silent, by his silence consenting to, or at least acquiescing in, the acts of the defendant. To interfere now by injunction would seem manifestly inequitable. That this question of laches can be raised by demurrer, and that it is a good defence to a bill in equity, is abundantly sustained by the authorities." 29 O. G. 277 (277).

Further, that an injunction may be denied where suit is unreasonably delayed, see *Ladd v. Cameron* (1885), 25 Fed. Rep. 37; *Green v. French* (1879),

certain duty to known infringers, which obliges him to give them notice of the wrongful character of their use of the invention, unless they are already conscious of their violation of his patent.⁶ Having given this notice without avail, he may postpone his suit during the pendency of other actions, or during any reasonable time upon sufficient cause, provided no intentional encouragement is afforded to the infringers.⁷ But

16 O. G. 215 ; 4 Bann. & A. 169 ; Williams v. Boston & Albany R. R. Co. (1878), 16 O. G. 906 ; 17 Blatch. 21 ; 4 Bann. & A. 441 ; Jones v. Merrill (1875), 8 O. G. 401.

That a bill alleging thirteen years of infringement is demurrable unless it gives satisfactory reasons for the delay in suing, see *McLaughlin v. People's R. R. Co.* (1884), 21 Fed. Rep. 574 ; 29 O. G. 277.

That delay in bringing suit is not abandonment, see *Williams v. Boston & Albany R. R. Co.* (1878), 16 O. G. 906 ; 17 Blatch. 21 ; 4 Bann. & A. 441.

That delay in suing, if satisfactorily accounted for, is not laches, see *Green v. French* (1879), 16 O. G. 215 ; 4 Bann. & A. 169.

That delay in seeking relief is no bar to an injunction unless it works an estoppel, see *N. Y. Grape Sugar Co. v. Buffalo Grape Sugar Co.* (1883), 18 Fed. Rep. 638 ; 25 O. G. 1076 ; 21 Blatch. 519.

⁶ That diligence is required of the plaintiff when the defendant is not conscious of his infringement, see *Merriam v. Smith* (1882), 11 Fed. Rep. 588.

That silence is not laches, unless the defendant was misled, see *Reay v. Raynor* (1884), 26 O. G. 1111 ; 22 Blatch. 13 ; 19 Fed. Rep. 308 ; *N. Y. Grape Sugar Co. v. Buffalo Grape Sugar Co.* (1883), 25 O. G. 1076 ; 18 Fed. Rep. 638 ; 21 Blatch. 519.

That a known infringer should be early notified of the plaintiff's rights and of his intention to enforce them, see

Morris v. Lowell Mfg. Co. (1866), 3 Fisher, 67.

That if the plaintiff gave such notice as he was able it is sufficient, see *Kittle v. Hall* (1887), 39 O. G. 707 ; 29 Fed. Rep. 508 ; 24 Blatch. 184.

That mere delay in suing when the defendant knows he is infringing is no bar to a suit for damages, see *Concord v. Norton* (1883), 16 Fed. Rep. 477.

That all persons are bound to take notice of a patent duly issued, see *National Car Brake Shoe Co. v. Terre Haute Car & Mfg. Co.* (1884), 28 O. G. 1007 ; 19 Fed. Rep. 514.

⁷ That a mere forbearance to sue, after notice given, cannot affect the right to an injunction, unless affirmative encouragement to the infringer was also given, see *Collignon v. Hayes* (1881), 20 O. G. 447 ; 8 Fed. Rep. 912.

That the bringing and pendency of a suit is notice to all other infringers that the rights conferred by the patent are to be maintained, see *Colgate v. Gold & Stock Telegraph Co.* (1879), 16 O. G. 583 ; 16 Blatch. 503 ; 4 Bann. & A. 415.

That a plaintiff may delay suing other infringers, while the validity of his patent is in question in a pending suit, without being guilty of laches, see *Green v. Barney* (1884), 19 Fed. Rep. 420 ; *Green v. French* (1879), 16 O. G. 215 ; 4 Bann. & A. 169 ; *Van Hook v. Pendleton* (1846), 1 Blatch. 187.

That an injunction will be granted, though not prayed for till the patent is about to expire, if the plaintiff has de-

any laches, either in commencing or in prosecuting his suit, which evidences culpable indifference to his rights, is a sufficient reason for the denial of that interference, which, if really needed, would more promptly have been sought.⁸ Where there has been no laches, the lapse of time since the infringement was discovered becomes unimportant, and an injunction may be granted though the patent has almost expired.⁹

§ 1195. Preliminary Injunction : Grounds of Its Refusal : Estoppel.

Where the laches or acquiescence of the plaintiff has misled the defendant into enterprises which would be destroyed by an injunction, the court will recognize the estoppel and refuse the desired relief.¹ An effectual estoppel also exists

laid only in order to establish his patent in the courts and has but just succeeded, see *Rumford Chemical Works v. Vice* (1877), 11 O. G. 600 ; 14 Blatch. 179 ; 2 Bann. & A. 584.

That acquiescence cannot be inferred from the fact that the plaintiff does not sue all infringers at once, for this is at his option, see *McWilliams Mfg. Co. v. Blundell* (1882), 11 Fed. Rep. 419 ; 22 O. G. 177.

⁸ That an injunction will be issued though the plaintiff did not file his bill till three months after the infringement was ascertained, see *Union Paper Bag Mach. Co. v. Binney* (1871), 5 Fisher, 166.

That an injunction will be refused when the plaintiff has delayed his motion for it for eighteen months after receiving notice of the infringement, see *Hockholzer v. Fager* (1873), 2 Sawyer, 361.

That when the plaintiff permits a suit at law against the defendant to remain three years unprosecuted, and the defendant is responsible, no injunction will issue, see *United Nickel Co. v. New Home Sewing Mach. Co.* (1883),

17 Fed. Rep. 528 ; 24 O. G. 1177 ; 21 Blatch. 415.

That an injunction will not be granted after a suit has been pending for many months, and no new facts have been shown since it was brought, and there were as good reasons for an injunction then as now, see *Andrews v. Spear* (1877), 4 Dillon, 472.

That a motion for an injunction will be denied where it has been already refused and the plaintiff waits till the defendant's evidence is closed before renewing it, see *Wooster v. Howe Mach. Co.* (1879), 16 O. G. 314 ; 4 Bann. & A. 319.

⁹ In *Green v. French* (1879), 4 Bann. & A. 169, Nixon, J.: (171) "A delay in bringing actions against infringers, when satisfactorily accounted for, is not to be treated as laches. It would be a great hardship to require patentees, who are generally poor, to institute legal proceedings as soon as an infringement was ascertained, or lose the right to the protection which an interlocutory injunction affords." 16 O. G. 215 (215).

§ 1195. ¹ See § 1194 and notes, *ante*. That a plaintiff is not estopped by

where the plaintiff has violated his equitable obligations to the defendant, whether created by an express or implied contract, and has thereby placed the defendant in a situation where his self-preservation compelled him to infringe.² Thus if the defendant is a licensee and has been secretly under-sold by his licensor — the plaintiff, or if the value of his license has been impaired by the unwarrantable grant of licenses to others or their grant at lower royalties, or if any subsisting relation between the parties renders the interference of the court unjust, the application for an injunction will be denied.³ Where the defendant, with the understanding that the only open question between the plaintiff and himself is one of compensation, enters in good faith into a contract with third par-

silence unless the defendant was misled by it, see *Reay v. Raynor* (1884), 26 O. G. 1111; 19 Fed. Rep. 308; 22 Blatch. 13; *N. Y. Grape Sugar Co. v. Buffalo Grape Sugar Co.* (1883), 25 O. G. 1076; 18 Fed. Rep. 638; 21 Blatch. 519.

That an injunction may issue on one patent although the suit has been abandoned as to another, unless the defendants have been misled, see *Atlantic Giant Powder Co. v. Rand* (1879), 16 O. G. 87; 16 Blatch. 250; 4 Bann. & A. 263.

That the release of an infringer from liability for the past is no bar to an injunction for the future, see *Babcock & Wilcox Co. v. Pioneer Iron Works* (1888), 43 O. G. 756.

That a defendant may be enjoined though he has been misled by the plaintiff into supposing that his present acts do not infringe, see *Sarven v. Hall* (1873), 6 Fisher, 495; 4 O. G. 666; 11 Blatch. 295.

² That an injunction will be refused if the plaintiff has violated his contract with the defendant, although the defendant has also broken the contract, see *Crowell v. Parmenter* (1878), 18 O. G. 360; 3 Bann. & A. 480.

That a breach of the license by the

licensor does not justify an infringement by the licensee, see *Willis v. McCollin* (1886), 38 O. G. 1017; 29 Fed. Rep. 641.

That one who knowingly permits another to take out a patent for a certain invention, and then himself patents a different invention, is estopped to claim that he is the inventor of the former invention, see *Fraim v. Keen* (1885), 34 O. G. 1048; 25 Fed. Rep. 820.

³ That an injunction will be denied to one who has acted fraudulently toward the defendant, as where a licensor has secretly undersold his licensee, see *Washburn & Moen Mfg. Co. v. Scutt* (1884), 22 Fed. Rep. 710; *Hoffheins v. Brandt* (1867), 3 Fisher, 218.

That an injunction will be denied to a licensor who fraudulently licensed others, and thus hurt the defendant's trade, see *Washburn & Moen Mfg. Co. v. Cincinnati Barbed Wire Fence Co.* (1884), 22 Fed. Rep. 712.

That no injunction will be granted where new and difficult questions are to be decided, or where there is anything in the relations of the parties which could cause it to operate unjustly, see *Union Paper Bag Mach. Co. v. Binney* (1871), 5 Fisher, 166.

ties, the injunction, although general in reference to all other uses of the invention, may except this contract from its operation and permit him to fulfil it.⁴ Acts of bad faith toward the public may also furnish reasons for denying an injunction to the plaintiff.⁵

§ 1196. Preliminary Injunction : Grounds for its Refusal : Improper Purpose of Plaintiff in Requesting it.

The improper purposes for which the plaintiff intends to employ the injunction, should it be allowed, are also a sufficient ground for its refusal. An injunction is designed to preserve existing rights, not to punish past injuries nor indirectly prejudice the defendant by placing him within the plaintiff's power.¹ Where the main object to be effected is a proper one the court does not concern itself with the ulterior advantages to be derived from its employment. But if as a protection against infringements it is of small importance to the plaintiff, and is desired by him chiefly to compel the defendant to act or to refrain from acting in other matters, or to enforce a recognition of the plaintiff's rights from third parties, the court will ordinarily decline to interfere.²

⁴ That where the defendant had entered into a contract with third parties in good faith, and with the understanding that the only question between himself and the plaintiff was one of compensation, and did not deny the patent nor the infringement but offered to pay reasonable sums for the privilege of completing his contract, an injunction was refused as to such contract and granted as to all other uses, see *Smith v. Sharp's Rifle Mfg. Co.* (1857), 3 Blatch. 545.

⁵ That no injunction will be granted where novelty is denied, and before taking out his patent the plaintiff sold the goods marked "imported from Paris," see *Booth v. Garelly* (1847), 1 Blatch. 247.

That an injunction will be refused if the patentee has never used the invention, nor permitted others to use it, see

Hoe v. Knap (1886), 27 Fed. Rep. 204 ; 36 O. G. 1244.

§ 1196. ¹ That an injunction issues to protect a clear right from unjust injury, see *Cook v. Ernest* (1872), 2 O. G. 89 ; 5 Fisher, 396.

That an injunction is a remedial writ in the nature of a prohibition, intended to prevent the commission of future injuries, not to punish past ones, see *Poppenhusen v. N. Y. Gutta Percha Comb Co.* (1858), 2 Fisher, 74 ; 4 Blatch. 184.

² That an injunction is for the purpose of preventing multiplicity of suits or repeated infringements, not to stop litigation or force a compromise in the suit in which it is granted, see *Morris v. Lowell Mfg. Co.* (1866), 3 Fisher, 67.

That the object of an injunction is to prevent mischief, not to cause it by

§ 1197. Preliminary Injunction: Grounds of its Refusal: Defendant's Good Faith.

The good faith of the defendant is a matter which, in connection with other circumstances, may exercise a powerful influence upon the decision of the court. Mere innocence in the infringement, or in preparations to infringe, constitutes no reason why it should be permitted or go unredressed. But where a defendant, in the honest belief that his device is essentially different from that of the plaintiff, or in ignorance of the existence of the plaintiff's patent, enters into important contracts, or invests large amounts of capital, entailing heavy losses if his business should be interrupted, and the plaintiff can be otherwise sufficiently protected, an injunction may be properly withheld.¹ Where the defendant, notwithstanding the presumptions of infringement and validity raised by the plaintiff's evidence, insists that on the full hearing he can maintain his defence, and the court cannot yet determine whether such defence would or would not be fatal to the

aiding the plaintiff to coerce the defendant into a compromise, see *Parker v. Sears* (1850), 1 Fisher, 93.

That whether an injunction should ever be issued to compel a party to perform his contract is doubtful, see *Smith v. Cummings* (1852), 1 Fisher, 152.

That a preliminary injunction cannot be resorted to in order to compel the defendant city to give a contract to the plaintiffs rather than to their competitors, if the latter are the lowest bidders, see *American Nicholson Pavement Co. v. City of Elizabeth* (1870), 4 Fisher, 189.

That an injunction sought for the purpose of establishing an apparent title against all users, and thus induce them to pay tribute to the plaintiff, will be denied, see *Western Union Tel. Co. v. Balt. & Ohio Tel. Co.* (1885), 25 Fed. Rep. 30.

§ 1197. ¹ That where the plaintiff can be otherwise protected, a defendant who has acted in good faith, and who would be seriously injured by an injunc-

tion, will not be enjoined, see *Batten v. Silliman* (1855), 3 Wall. Jr. 124.

That where the plaintiff's assignor has neglected to employ his invention in the State where the suit is pending during the extended term, and the defendant bought his machine in ignorance of the plaintiff's rights, and the same questions were never in issue in prior suits, an injunction will be refused unless the defendant is irresponsible, see *Gear v. Holmes* (1873), 6 Fisher, 595.

That an injunction will be refused where there has been no judgment sustaining the patent, unless there has been acquiescence equivalent to an admission of its validity or some other strong reason, if the defendant defends in good faith, see *Crowell v. Harlow* (1878), 18 O. G. 466; 3 Bann. & A. 478.

That all persons are bound to take notice of a patent duly issued, see *National Car Brake Shoe Co. v. Terre Haute Car & Mfg. Co.* (1884), 28 O. G. 1007; 19 Fed. Rep. 514.

action, the good faith of the defendant may also turn the balance in his favor.²

§ 1198. Preliminary Injunction: Grounds of its Refusal: Defendant's Patent.

Where the defendant owns or acts under a patent which on its face authorizes the use of the process or device now claimed to be an infringement, an injunction may be withheld until after a final hearing, although the plaintiff's application is supported by the usual proof.¹ The existence of the defendant's patent may raise a doubt upon the question of identity between the infringing and the patented inventions, or upon the question of priority between him and the plaintiff, and this doubt is increased by any evidence of negligence upon the part of the plaintiff in the enforcement of his

² That an injunction will not be granted if the defendant shows that he believes he has a just defence, and is not a wilful pirate of the invention, unless his defence is an evident mistake of law or fact, see *Goodyear v. Dunbar* (1860), 1 Fisher, 472; 3 Wall. Jr. 310.

That a defendant acting in an honest belief that a re-issue with expanded Claims is void, will not be enjoined, see *Western Union Tel. Co. v. Balt. & Ohio Tel. Co.* (1885), 25 Fed. Rep. 30.

That a defendant will not be enjoined from using an invention which he employed before the patent was granted, see *Dorlan v. Guie* (1885), 25 Fed. Rep. 816; 34 O. G. 702.

§ 1198. ¹ That an injunction will be refused when the defendant has a patent for the same invention, which is *prima facie* valid, the court comparing the two specifications to determine whether they are the same, see *Sargent v. Carter* (1857), 1 Fisher, 277.

That an injunction will not issue if the defendant is acting under letters-patent which cover his machine, see

Goodyear v. Dunbar (1860), 1 Fisher, 472; 3 Wall. Jr. 310.

That an injunction will be granted though the defendant holds a patent for an improvement, since this patent cannot avail him beyond its proper scope, see *Goodyear Dental Vulcanite Co. v. Evans* (1868), 3 Fisher, 390; 6 Blatch. 121.

That an injunction will be granted though the defendant has a subsequent patent, if the infringement be clear, see *Morse Fountain Pen Co. v. Esterbrook Steel Pen Mfg. Co.* (1869), 3 Fisher, 515.

That an injunction will issue though the defendant has patented other improvements on the same subject, see *Cook v. Ernest* (1872), 5 Fisher, 396; 2 O. G. 89; *McComb v. Ernest* (1871), 1 Woods, 195; *Goodyear Dental Vulcanite Co. v. Evans* (1868), 3 Fisher, 390; 6 Blatch. 121.

That an injunction may issue though the defendant is suing to obtain a patent, see *Minneapolis Harvester Works v. McCormick Harvesting Mach. Co.* (1886), 37 O. G. 556; 28 Fed. Rep. 565.

rights.² The good faith of the defendant, the absence of concealment in reference to his operations, the extent of his enterprise, and the injury he would sustain from any prema-

² In *Goodyear Dental Vulcanite Co. v. Gardner* (1870), 4 Fisher, 224, Clifford, J. : (228) "Attempt is made to show that the rule does not apply in this case because letters-patent have also been granted to the respondent, but it is clear that the introduction of the respondent's patent does not change the burden of proof on the question of novelty. He must still prove the allegation of his answer that the original patentee was not the original and first inventor of his improvement. Serious doubts were formerly entertained whether the letters-patent of the respondent were admissible in any view of the case, and it is still the settled rule that the question of infringement cannot be controlled or materially affected by such consideration. (*Blanchard et al. v. Putman*, 8 Wall. 425 ; *Corning et al. v. Burden*, 15 How. 271). Since the decision of the case last named, the letters-patent of the defendant are admitted in evidence on the question of novelty, as entitled to some weight where the evidence is nicely balanced, but it is quite incorrect to suppose that a patent, subsequent in date, can have the effect as evidence to overcome the *prima facie* presumption otherwise afforded by the introduction of one of prior date, that the patentee was the original and first inventor of what is therein described as his improvement. Such a conclusion is without any foundation in principle, and finds no support in any analogy of the law or in any decided cases." 3 Clifford, 408 (413). The defendant's patent is proof that the experts in the Patent Office regarded his invention as substantially different from the one previously patented by the plaintiff (*Westlake v. Cartter*, 6 Fisher, 519),

and hence that the defendant does not infringe. This is its entire effect.

In *Blanchard v. Puttman* (1867), 3 Fisher, 186, Leavitt, J. : (192) "I may remark here that both these parties are patentees, and the presumption equally applies to both in relation to the novelty and utility of their inventions. There is a presumption from the issuance of a patent to Morris, years after the date of the Blanchard patent, that he had invented something different from the invention for which a patent had been previously granted to Blanchard ; for, if the Commissioner had come to a different conclusion, it would have been his duty to have rejected the application." 2 Bond, 84 (93).

In *Corning v. Burden* (1853), 15 How. 252, Grier, J. : (271) "It is evident that a patent, thus issued after an inquisition or examination made by skilful and sworn public officers, appointed for the purpose of protecting the public against false claims or useless inventions, is entitled to much more respect, as evidence of novelty and utility, than those formerly issued without any such investigation. Consequently such a patent may be, and generally is, received as *prima facie* evidence of the truth of the facts asserted in it. And in cases where the evidence is nicely balanced, it may have weight with a jury in making up their decision as to the plaintiff's right ; and if so, it is not easy to perceive why the defendant who uses a patented machine should not have the benefit of a like presumption in his favor, arising from a like investigation of the originality of his invention, and the judgment of the public officers that his machine is new, and not an infringement of the

ture decision against his patent, are all elements to be considered by the court, unless his patent is evidently void, or his acts are unwarranted by its provisions, and it thus constitutes no answer to the plaintiff's claims.³

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

That one patented article is presumed to differ from articles covered by other patents, see *Buerk v. Imhaeuser* (1876), 11 O. G. 112; 2 Bann. & A. 465.

That if the defendant has a patent it is evidence that the experts in the Patent Office did not consider his device identical with the plaintiff's, and this is entitled to consideration by the jury, see *Westlake v. Cartter* (1873), 4 O. G. 636; 6 Fisher, 519.

That where a defendant acts under another patent it is presumed that he does not infringe, and no injunction will issue unless the court can see from inspection that he does infringe, see *Sargent Mfg. Co. v. Woodruff* (1873), 5 Bissell, 444.

That an injunction will issue against the defeated party to an interference in favor of the successful party, if the former relies on his own prior patent, see *Greenwood v. Bracher* (1880), 17 O. G. 1151; 1 Fed. Rep. 856; 5 Bann. & A. 302.

That no injunction will issue where the defendants have manufactured under a patent of a date prior to the plaintiff's, which has expired without ever being tested by the plaintiff in a suit, see *Whitney v. Rollstone Machine Works* (1875), 8 O. G. 908; 2 Bann. & A. 170.

³ That no injunction will be granted where the defendant is openly using a device made under other patents, in full competition with the plaintiff's and in good faith, unless the injury is irreparable or the defendant unable to respond in damages, see *Burleigh Rock Drill Co. v. Lobdell* (1875), 7 O. G. 836; Holmes, 450; 1 Bann. & A. 625.

That where the defendant claims to have acted under a patent and with the acquiescence of the plaintiff, and to have invested a large capital in the enterprise, no injunction will issue unless the case is clear, see *North v. Kershaw* (1857), 4 Blatch. 70.

That where the original patent has expired and a patent for improvements thereon, covering the same principle, has not been adjudicated, and it clearly appears that the latter patent has been infringed under a patent procured for that purpose, and the remedy is important to the plaintiff and there is no good reason to the contrary, an injunction will issue, see *Plimpton v. Winslow* (1880), 3 Fed. Rep. 333; 5 Bann. & A. 563.

That where the litigants claim under adverse titles, still undetermined in the Patent Office, an injunction will be refused, see *National Feather Duster Co. v. Dearborn Luster Co.* (1882), 24 O. G. 497.

That an injunction will be granted though the defendant operates under

§ 1199. Preliminary Injunction : Grounds for its Refusal : Doubts of the Court as to the Existence of Proper Conditions.

Where, notwithstanding the evidence offered by the plaintiff in support of his patent or his title or the allegation of infringement, the court is still in doubt upon either of these questions the injunction may be denied.¹ The keener scru-

a different patent with unlike Claims, if what he really does is an infringement, see *Collignon v. Hayos* (1881), 20 O. G. 447 ; 8 Fed. Rep. 912.

§ 1199. ¹ In *Sickels v. Young* (1855), 3 Blatch. 293, Nelson, J. : (296) "As this is a motion simply for a preliminary injunction, and not a case upon pleadings and proofs for a final hearing, I shall not look further into the mass of papers before me, than to ascertain whether or not a case has been made which, upon established principles of equity, to prevent an irreparable injury requires the court to interfere pending the litigation, and restrain the defendants from the further use of the apparatus or machinery charged with infringement, until the right is finally determined. And, upon these principles, it is well settled that, unless the right is clear upon the papers and proofs presented, and upon which the motion is founded, in favor of the plaintiffs, the injunction will be withheld, and the rights of the parties be left unaffected and unchanged until the case is matured for the final hearing, and definitively disposed of."

In *Isaacs v. Cooper* (1821), 4 Wash. 259, Washington, J. : (260) "The practice of the court of equity, upon motions of this kind, is to grant an injunction upon the filing of the bill, and before a trial at law, if the bill state a clear right, and verify the same by affidavit. If the bill states an exclusive possession of the invention or discovery, for which the plaintiff has obtained a patent, an injunction is granted, although the court may feel doubts as to the

validity of the patent. But if the defects in the patent or specification are so glaring that the court can entertain no doubt as to that point, it would be most unjust to restrain the defendant from using a machine or other thing which he may have constructed, probably at great expense, until a decision at law can be had." 1 Robb, 332 (334).

Further, that unless upon the whole evidence the court is reasonably satisfied that an injunction should issue it should be refused, see *Norton Door Check & Spring Co. v. Hall* (1889), 37 Fed. Rep. 691 ; *Thompson v. Rand Avery Supply Co.* (1889), 38 Fed. Rep. 112 ; *Huber v. Myers Sanitary Depot* (1887), 34 Fed. Rep. 48 ; *Bradley & Hubbard Mfg. Co. v. Charles Parker Co.* (1883), 17 Fed. Rep. 240 ; 24 O. G. 995 ; *N. Y. Grape Sugar Co. v. American Grape Sugar Co.* (1882), 10 Fed. Rep. 835 ; 20 Blatch. 386 ; *Illingworth v. Spaulding* (1881), 9 Fed. Rep. 154 ; *Cross v. Livermore* (1881), 21 O. G. 139 ; 9 Fed. Rep. 607 ; *Wilson Packing Co. v. Clapp* (1878), 13 O. G. 368 ; 8 Bissell, 154 ; 3 Bann. & A. 243 ; *Burleigh Rock Drill Co. v. Lobdell* (1875), Holmes, 450 ; 7 O. G. 836 ; 1 Bann. & A. 625 ; *Wells v. Gill* (1872), 2 O. G. 590 ; 6 Fisher, 89 ; *Fales v. Wentworth* (1872), 5 Fisher, 302 ; Holmes, 96 ; 2 O. G. 58 ; *Jones v. Hodges* (1871), Holmes, 37 ; *American Nicholson Pavement Co. v. City of Elizabeth* (1870), 4 Fisher, 189 ; *Muscan Hair Mfg. Co. v. American Hair Mfg. Co.* (1858), 1 Fisher, 320 ; 4 Blatch. 174 ; *Winans v. Eaton* (1854), 1 Fisher, 181 ; *Goodyear v. Railroad* (1853), 1 Fisher, 626 ; *Parker v.*

tiny of the present judge may detect infirmities in the patent hitherto not noticed or not fully appreciated, or may perceive substantial differences between the defendant's device and the patented invention which have previously escaped attention. In such a case he may decline to interfere, though prior judges have sustained the patent and determined the issue of infringement against the defendant. Where the construction of the patent is not inflexible, or where the monopoly is not invaded unless the interpretation claimed by the plaintiff is correct, and this interpretation can be questioned;² where the defendant offers counter-judgments in his favor, of sufficient number and authority to show that serious differences of opinion may exist on the same facts now submitted to the court;³ where the respective assertions and denials of the parties disclose equities which cannot be examined and decided on a motion for an injunction, or terminate in issues of fact which the proof admissible on such a motion cannot properly elucidate;⁴ where the patent is recent and no ade-

Sears (1850), 1 Fisher, 93; Brooks v. Bicknell (1845), 4 McLean, 70.

That an injunction will be refused where the question is one of fact only, and the affidavits are of equal weight, see Beane v. Orr (1875), 9 O. G. 255; 2 Bann. & A. 176.

That where validity is doubtful an injunction will be denied, see Fraim v. Sharon Valley Malleable & Gray Iron Co. (1886), 27 Fed. Rep. 457.

That where the validity of the patent is doubtful, and especially where it rests on the plaintiff's evidence and none is offered in opposition, an injunction will be refused, see Sullivan v. Redfield (1825), 1 Paine, 441; 1 Robb, 477.

² That no injunction will be granted when the novelty of the plaintiff's invention is doubtful, where his patent is not sustained by a judgment or acquiescence in the plaintiff's construction of his claim, and there is no infringement unless the plaintiff's construction of his claim is correct, see Mowry v. Grand

St. & Newtown R. R. Co. (1872), 5 Fisher, 586; 10 Blatch. 89.

That a construction by acquiescence cannot be established in a single year, and an injunction based on such construction is not warrantable, see Johnston Ruffler Co. v. Avery Mach. Co. (1886), 28 Fed. Rep. 193; 36 O. G. 1043.

³ That where the novelty was denied, and the patent had been sustained in only one case out of three, an injunction was refused and an account and monthly report ordered, see Allen v. Sprague (1850), 1 Blatch. 567.

⁴ In Potter v. Whitney (1866), 3 Fisher, 77, Lowell, J.: (78) "The principles which govern courts in granting or refusing preliminary injunctions in patent cases are well established. As a general rule, if the plaintiff has made out a clear title and the question of infringement presents no difficulty, an injunction will be granted. The hearing is had upon *ex parte* affidavits, and if

quate opportunity has been afforded for such an investigation of the patentability of the invention as renders the judgments sustaining it reliable;⁵ where a re-issue has apparently attempted to extend the scope of the original, or the original has been judicially construed to be exclusive of the invention practised by the defendant,⁶ — any of these conditions war-

the questions to be decided are difficult and complicated, especially if they involve disputed facts which have never been passed upon by a court or jury, then, although the court may be inclined to think the complainant is right, yet it will not interfere at this stage of the cause whether the questions relate to title or to infringement. And even when the title is clear, yet if there are peculiar circumstances which show that the defendant's interests would be very injuriously affected by an injunction, while those of the plaintiff would not be so affected by refusing it, it may be refused." 1 Lowell, 87 (88).

That if the plaintiff claims only an equitable title, and that is being contested in the local courts, no injunction will issue, see *Continental Store Service Co. v. New York Store Service Co.* (1885), 31 O. G. 1561.

That an injunction will be denied if there is a substantial controversy as to the equities of the parties, and the motion does not permit an inquiry into such equities, see *Smith v. Cummings* (1852), 1 Fisher, 152.

That no injunction will be granted after the patent has expired where the defendant has both a legal and an equitable defence, but the end of the suit at law will be awaited, see *Concord v. Norton* (1883), 16 Fed. Rep. 477.

⁵ That an injunction will be refused if the patent is openly defective, see *Isaacs v. Cooper* (1821), 4 Wash. 259; 1 Robb, 332.

That no injunction will issue if the patent is recent and disputed, until

after a trial at law, see *Sullivan v. Redfield* (1825), 1 Paine, 441; 1 Robb, 477.

That when the patent has been issued only two months and no judgment or acquiescence sustains it, no injunction will be granted, see *Brown v. Hinkley* (1873), 3 O. G. 384; 6 Fisher, 370.

That where the patent is doubtful, the plaintiff sells licenses, and the defendant is responsible, no injunction will issue, see *National Hat Pouncing Mach. Co. v. Hedden* (1886), 29 Fed. Rep. 147; 38 O. G. 1129.

That no injunction will be granted where the plaintiff is guilty of laches and the defendant is responsible, or where novelty is denied and judgments against the patent are produced, though new trials have been granted on points not affecting validity, see *Keyes v. Pueblo Smelting & Refining Co.* (1887), 31 Fed. Rep. 560.

That an injunction will not issue where the patent is recent, the specification obscure, and the proof of infringement meagre, see *Muscan Hair Mfg. Co. v. American Hair Mfg. Co.* (1858), 1 Fisher, 320; 4 Blatch. 174.

⁶ That an injunction on a re-issue will be denied where its Claims are evidently broader than those of the original, see *Brewster v. Parry* (1882), 14 Fed. Rep. 694.

That no injunction will be granted on a re-issue where the re-issue was delayed ten years, and its validity is disputed, and there has been no decision in its favor, no royalties or license-fees paid to the patentee, and no general

rants the court in overruling the presumption which the plaintiff's evidence may have created in his favor, and in refusing to allow a temporary injunction.

§ 1200. Preliminary Injunction: Grounds of its Refusal: Disastrous Consequences if Granted.

Reasons for withholding an injunction may also be found in its probable effect, if granted, either upon the interests of the plaintiff, or those of the defendant or the public.¹ Where an injunction would be useless to the plaintiff on account of the existence of another order of the same character or because no injury will result to him from its denial,

acquiescence by the public, and the defendant is not alleged to be irresponsible, see *Tillinghast v. Hicks* (1882), 13 Fed. Rep. 388; 23 O. G. 739.

That an injunction on a re-issue will be refused where it is doubtful whether the re-issue is broader than the original, until that question is settled, see *Steam Gauge & Lantern Co. v. Miller* (1882), 11 Fed. Rep. 718.

That no injunction will be granted on a re-issue to prevent the infringement of inventions previously disclaimed, see *Leggett v. Avery* (1879), 101 U. S. 256; 17 O. G. 445.

That an injunction will be granted when the valid Claims of a re-issue are infringed, see *Starrett v. Athol Mach. Co.* (1883), 14 Fed. Rep. 910; 23 O. G. 1729.

That an injunction will be granted though the Claims of the re-issue are expanded, see *Lorillard v. McDowell* (1877), 13 Phila. 461; 2 Bann. & A. 531; 11 O. G. 640.

That an injunction will issue on Claims reproduced from the original patent, though other Claims of the re-issue are invalid, see *Duff v. Calkins* (1883), 25 O. G. 601; *Starrett v. Athol Mach. Co.* (1883), 14 Fed. Rep. 910; 23 O. G. 1729.

That where the validity of the re-

issue is doubtful, no injunction will be granted, see *Arnheim v. Finster* (1885), 24 Fed. Rep. 276; 32 O. G. 256.

§ 1200. ¹ That an injunction will issue where worse mischief would ensue from denying than from granting it, see *Hat Sweat Mfg. Co. v. Davis Sewing Mach. Co.* (1887), 41 O. G. 1273; 82 Fed. Rep. 401; *Covert v. Curtis* (1885), 25 Fed. Rep. 43; *Irwin v. Dane* (1871), 4 Fisher, 359; 2 Bissell, 442.

That the standing of the plaintiffs in their trade is matter of importance and may be considered as a reason for an injunction, see *Irwin v. Dane* (1871), 4 Fisher, 359; 2 Bissell, 442.

That on a motion for an injunction it is a material question whether the defendant makes and sells or only uses the plaintiff's invention, the former being an increasing wrong, see *Morris v. Lowell Mfg. Co.* (1866), 3 Fisher, 67.

That an injunction will issue more easily against a mere seller than a maker, see *Covert v. Curtis* (1885), 25 Fed. Rep. 43.

That an injunction ought to be refused against the mere user, not being the maker or seller of the invention, if the case is doubtful or the balance of inconvenience is on the side of the defendant, see *Howe v. Newton* (1865), 2 Fisher, 531.

or where it is apparent that, if now allowed, it must on final hearing be dissolved, the court will reject the application.² Where the injury to the defendant would be out of all proportion to the benefit accruing to the plaintiff, or where the invention is a part only of some wider process or device whose use is essential to the business of the defendant and whose abandonment must prove the ruin of his enterprise, the court may, if he is responsible or tenders compensation to the plaintiff, refuse to interrupt his operations until the necessity therefor is made apparent on the final hearing.³ If the cessation of the alleged infringing acts

² That an injunction will not be granted while another to the same effect is already in force in a different suit, see *Gold & Stock Telegraph Co. v. Pearce* (1884), 19 Fed. Rep. 419; 22 Blatch. 62.

That no preliminary injunction will issue to compel an act, when on final hearing the duty to perform it may be doubtful, see *Westinghouse Air Brake Co. v. Carpenter* (1887), 32 Fed. Rep. 484; *International Tooth Crown Co. v. Mills Co.* (1884), 22 Fed. Rep. 659; 30 O. G. 662; *Parkhurst v. Kinsman* (1847), 2 Halst. Ch. (N. J.) 600.

³ That an injunction will be refused where it will do the plaintiff little good and the defendant much harm, see *Hockholzer v. Eager* (1873), 2 Sawyer, 361.

That an injunction will be refused where its allowance would injure the defendant more than it would benefit the plaintiff, see *McCrary v. Pennsylvania Canal Co.* (1880), 5 Fed. Rep. 367; *Potter v. Whitney* (1866), 3 Fisher, 77; 1 Lowell, 87; *Morris v. Lowell Mfg. Co.* (1866), 3 Fisher, 67; *North v. Kershaw* (1857), 4 Blatch. 70; *Day v. Candee* (1853), 3 Fisher, 9.

That an injunction will be refused where it would do great injury to the defendants, see *Furbush v. Bradford* (1858), 1 Fisher, 317; *Barnard v. Gibson* (1849), 7 Howard, 650.

That no injunction will be issued where it would work great hardship and other remedies are equally available, see *Swift v. Jenks* (1884), 19 Fed. Rep. 641; 27 O. G. 615; *Guidet v. Palmer* (1872), 6 Fisher, 82; 10 Blatch. 217.

That no injunction will be granted where the plaintiff and defendant are rival manufacturers, and the patent covers only part of a larger machine which cannot be dispensed with except at great loss, a royalty being tendered, see *Hoe v. Boston Daily Advertiser Co.* (1883), 14 Fed. Rep. 914; 23 O. G. 1124.

That where a defendant has acted in good faith and would be seriously injured, and the plaintiff has an established license-fee, no injunction will issue unless in a very clear case, or where the patent has been sustained by judgments, see *Batten v. Silliman* (1855), 3 Wall. Jr. 124.

That an injunction will be granted though it injures the defendant, especially where he was not ignorant of the plaintiff's invention, see *Hussey v. Whitely* (1860), 2 Fisher, 120; 1 Bond, 407.

That if the defendant erects works to carry on the business after notice that he infringes, he has no claim to consideration in equity, see *Westinghouse Air Brake Co. v. Carpenter* (1887), 32 Fed. Rep. 545.

would prove injurious to the public, whose safety or convenience depend upon the use of the invention by the defendant, this likewise constitutes a sufficient reason for the denial of the application.⁴

§ 1201. Preliminary Injunction : Granted without Reserve if the Plaintiff is Entitled to it.

Where, however, the validity of the patent, the title of the plaintiff and the intention of the defendant to infringe are fully proved, and neither the foregoing nor other circumstances render the grant of an injunction inequitable, the court will issue it without reluctance or evasion.¹ Though it

⁴ That an injunction will not be granted where the device is needed for public use and the plaintiff can be otherwise protected, see *Bliss v. City of Brooklyn* (1871), 4 Fisher, 596; 8 Blatch. 533.

That an injunction will not be granted where it would occasion great public injury, unless in a case of absolute right, see *Blake v. Greenwood Cemetery* (1877), 13 O. G. 1046; 14 Blatch. 342; 3 Bann. & A. 112.

That an injunction will be denied where it would injure the public and not benefit the plaintiff, see *Ballard v. City of Pittsburgh* (1882), 12 Fed. Rep. 783.

That where the injunction would merely prevent the defendant from purchasing and using any fresh infringing articles it will not be withheld on the ground that the public will be inconvenienced, see *Goodyear v. Railroad* (1853), 1 Fisher, 626.

§ 1201. ¹ In *Poppenhusen v. N. Y. Gutta Percha Comb Co.* (1858), 2 Fisher, 74, Ingersoll, J.: (76) "The writ prayed for is to act as a remedy against a threatened wrong, by preventing the commission of such wrong. And it is not necessary, before a writ to prevent a wrong issue, that the wrong should have actually been committed. If it were, the

remedy by injunction would be a very inadequate one. When the rights of a party under a patent have been clearly and distinctly established, and an infringement of such rights is threatened, or when they have been infringed, and the party has good reason to believe they will continue to be infringed, an injunction will issue. It issues for the reason that there is good ground to believe that in future they will be infringed. And when a trial at law has been had, resulting in a verdict in favor of the patentee, in which the right to the improvement patented has been fully established to the satisfaction of the court, and the infringement of right made clear, such trial, resulting in such a verdict, is sufficient, without any other proof, to authorize the court to grant an injunction to prevent any future violation of right. Such trial, with such a result, affords sufficient proof that in future there will be an infringement unless such infringement is restrained by injunction." 4 Blatch. 184 (187).

Further, that where the validity of the patent is established, and the infringement by the defendant is clear, an injunction will be granted, see *Foster v. Crossin* (1885), 23 Fed. Rep. 400; *Odorless Excavating Co. v. Lauman* (1882), 12 Fed. Rep. 788; *McWilliams*

may work hardship to the defendant or to other parties, and though the defendant offers such security against future losses as the plaintiff may require, the infringement will not be permitted to continue to the manifest and injurious violation of the patent.² Nor can the defendant claim immunity

Mfg. Co. v. Blundell (1882), 22 O. G. 177; 11 Fed. Rep. 419; *White v. Heath* (1882), 22 O. G. 500; 10 Fed. Rep. 291; *New York Grape Sugar Co. v. American Grape Sugar Co.* (1882), 10 Fed. Rep. 835; 20 Blatch. 386; *Steam Gauge & Lantern Co. v. Miller* (1881), 8 Fed. Rep. 314; 20 O. G. 889; *Cross v. Livermore* (1881), 21 O. G. 139; 9 Fed. Rep. 607; *Weeks v. Buffalo Scale Co.* (1880), 11 Fed. Rep. 901; *Kirby Bung Mfg. Co. v. White* (1880), 17 O. G. 974; 1 Fed. Rep. 604; 1 *McCrary*, 155; 5 *Bann. & A.* 263; *American Middlings Purifier Co. v. Christian* (1877), 4 *Dillon*, 448; 3 *Bann. & A.* 42; *American Shoe Tip Co. v. National Shoe Toe Protector Co.* (1877), 11 O. G. 740; 2 *Bann. & A.* 551; *Weston v. White* (1876), 13 *Blatch.* 447; 2 *Bann. & A.* 364; *Brown v. Hinkley* (1873), 3 O. G. 384; 6 *Fisher*, 370; *Chase v. Wesson* (1873), 6 *Fisher*, 517; 4 O. G. 476; *Holmes*, 274; *Robertson v. Hill* (1873), 6 *Fisher*, 465; 4 O. G. 132; *Wells v. Gill* (1872), 2 O. G. 590; 6 *Fisher*, 89; *Miller v. Androscoggin Pulp Co.* (1872), 1 O. G. 409; 5 *Fisher*, 340; *Holmes*, 142; *Mowry v. Grand St. & Newtown R. R. Co.* (1872), 5 *Fisher*, 586; 10 *Blatch.* 89; *McComb v. Ernest* (1871), 1 *Woods*, 195; *Thayer v. Wales* (1871), 5 *Fisher*, 130; 9 *Blatch.* 170; *American Nicholson Pavement Co. v. City of Elizabeth* (1870), 4 *Fisher*, 189; *Shelly v. Brannan* (1870), 4 *Fisher*, 198; 2 *Bissell*, 315; *Conover v. Mers* (1868), 3 *Fisher*, 386; *Goodyear v. Rust* (1868), 3 *Fisher*, 456; 6 *Blatch.* 229; *Hodge v. Hudson River R. R. Co.* (1868), 6 *Blatch.* 165; *Potter v. Whitney* (1866), 3 *Fisher*, 77; 1 *Lowell*,

.87; *Goodyear v. Hills* (1866), 3 *Fisher*, 134; *Morris v. Lowell Mfg.* (1866), 3 *Fisher*, 67; *Doughty v. West* (1865), 2 *Fisher*, 553; *Potter v. Muller* (1864), 2 *Fisher*, 465; *Hussey v. Whitely* (1860), 2 *Fisher*, 120; 1 *Bond*, 407; *North v. Kershaw* (1857), 4 *Blatch.* 70; *Sickels v. Mitchell* (1857), 3 *Blatch.* 548; *Day v. N. E. Car Spring Co.* (1854), 3 *Blatch.* 154; *Goodyear v. Day* (1852), 2 *Wall. Jr.* 283; *Tracy v. Torrey* (1851), 2 *Blatch.* 275; *Gibson v. Van Dresar* (1850), 1 *Blatch.* 532; *Motte v. Bennett* (1849), 2 *Fisher*, 642; *Ogle v. Ege* (1826), 4 *Wash.* 584; 1 *Robb*, 516; *Isaacs v. Cooper* (1821), 4 *Wash.* 259; 1 *Robb*, 332.

That whenever the plaintiff is found to be legally entitled to an injunction it is the duty of the court to grant it without evasion, see *Blanchard v. Reeves* (1850), 1 *Fisher*, 103.

That the court has no discretion to refuse an injunction where the patent has been established by a judgment and the infringement is clear, see *Green v. French* (1879), 16 O. G. 215; 4 *Bann. & A.* 169.

² In *Morris v. Lowell Mfg. Co.* (1866), 3 *Fisher*, 67, *Lowell, J.*: (69) "In granting or refusing a preliminary injunction, the court will carefully consider the situation of the parties. Its important office is to preserve the rights of the patentee pending the litigation of his title. If the title has already been fully established, or is otherwise so clear that no reasonable doubt of its validity remains, a court of equity would, in many cases, grant such an injunction as it would a final injunction notwithstanding the injury which

on the ground that the plaintiff infringes other patents, nor that other persons are engaged with him in the infringement of the plaintiff's patent, nor that he is under obligations to others which the injunction will compel him to disregard, nor that he owns the articles whose use or sale is held to be forbidden by the patent.⁸ These circumstances, indeed, like the

might result to the defendant. But where there is no danger of loss to the plaintiff, and great loss will result to the defendant, the case must be substantially free from doubt to require such action."

That an injunction will issue though the injury to the defendant may be great, if the right of the plaintiff and the infringement are clear, see *Hodge v. Hudson River R. R. Co.* (1868), 6 Blatch. 165.

That where the injury to the plaintiff from refusing an injunction would be great, it may be granted, see *Covert v. Curtis* (1885), 25 Fed. Rep. 43.

That an injunction will issue where the plaintiff's right is clear, though it works hardship to the defendant and a conditional injunction would protect the plaintiff, see *Ely v. Monson & Brimfield Mfg. Co.* (1860), 4 Fisher, 64.

That if the plaintiff's right is clear an injunction works no real hardship to the defendant, see *Potter v. Schenck* (1866), 3 Fisher, 82; 1 Bissell, 515.

That an injunction will be granted though it may cause injury to third parties, see *Rumford Chemical Works v. Vice* (1877), 11 O. G. 600; 14 Blatch. 179; 2 Bann. & A. 584.

That when the case is clear and the infringement proved the injunction will be granted without regard to private or public convenience, see *Sickels v. Tilston* (1857), 4 Blatch. 109.

That where the right is clear an injunction must issue whatever injury may result, see *Morris v. Lowell Mfg. Co.* (1866), 3 Fisher, 67; *Potter v. Fuller* (1862), 2 Fisher, 251.

That an injunction will issue where the plaintiff's loss by its refusal would far exceed the injury to the defendant by granting it, if the infringement is not disputed and acquiescence is proved, see *Hat-Sweat Mfg. Co. v. Davis Sewing Mach. Co.* (1887), 41 O. G. 1273; 32 Fed. Rep. 401.

That when the patent is valid and the infringement clear an injunction will be granted though bonds be offered, see *McWilliams Mfg. Co. v. Blundell* (1882), 22 O. G. 177; 11 Fed. Rep. 419; *Tracy v. Torrey* (1851), 2 Blatch. 275.

⁸ That an injunction will not be refused on the ground that the plaintiff is violating some other patent, see *Young v. Lippman* (1872), 5 Fisher, 230; 2 O. G. 249; 9 Blatch. 277.

That an injunction will not be withheld in order to allow the defendant to fulfil a contract, since the contract is, in effect, only the apportioning of a license, which is not allowed, see *Consolidated Fruit Jar Co. v. Whitney* (1874), 10 Phila. 268; 1 Bann. & A. 356.

That when the defendant is a licensee, and is notified that the license was obtained by fraud, and asks the court to allow him to finish a contract, he must show that the contract was made before such notice was given, or an injunction will issue, see *Consolidated Fruit Jar Co. v. Whitney* (1874), 10 Phila. 268; 1 Bann. & A. 356.

That an injunction is not refused on the ground that the defendant owns the infringing articles, see *Porter Needle Co. v. National Needle Co.* (1883), 17 Fed. Rep. 536.

That an injunction will be more

preceding, may avail him where the principal questions are in doubt, or where the court, though disposed to allow the temporary injunction on the plaintiff's evidence, foresees that different conclusions may be reached upon the final hearing; but where the plaintiff's case is clear, and his injury is imminent, the court will never hesitate to grant the desired relief.⁴

§ 1202. Preliminary Injunction : Bond and Account Ordered in Lieu thereof.

Similar circumstances to those which lead the court to deny an injunction may induce it to modify the order, and require a bond and a continuing account from the defendant.¹

readily granted against a merchant who merely sells the invention, than against a manufacturer who makes it, see *Covert v. Curtis* (1885), 25 Fed. Rep. 43.

⁴ That an injunction will not be granted where final relief would on the same proofs be denied, see *International Tooth Crown Co. v. Mills* (1884), 22 Fed. Rep. 659; 30 C. G. 662; *Parkhurst v. Kinsman* (1847), 2 Halst. Ch. (N. J.) 600.

That an injunction will be refused if the patentee has never used the invention or permitted others to use it, see *Hoe v. Knapp* (1886), 27 Fed. Rep. 204; 36 O. G. 1244.

§ 1202. ¹ That a bond may be ordered instead of an injunction, see *Wetherill v. Passaic Zinc Co.* (1872), 6 Fisher, 50; 2 O. G. 471; 9 Phila. 385; *Ely v. Monson & Brimfield Mfg. Co.* (1860), 4 Fisher, 64.

That an injunction will be granted where infringement is probable and the patent has been sustained by the Supreme Court of the United States, unless the defendant gives a bond and keeps an account, see *American Middlings Purifier Co. v. Christian* (1877), 4 Dillon, 448; 3 Bann. & A. 42.

That where the patent is in doubt, though the infringement is clearly

shown, an injunction may be refused and a bond ordered with an account to be taken at frequent periods, see *New York Belting & Packing Co. v. Magowan* (1884), 23 Fed. Rep. 596.

That a bond will be ordered instead of an injunction when the validity of the patent is in dispute, and has never been adjudged, and public acquiescence is denied and not proved, see *Morris v. Shelbourne* (1871), 4 Fisher, 377; 8 Blatch. 266.

That a bond will not be required of a defendant except in cases where an injunction would otherwise issue, see *American Middlings Purifier Co. v. Atlantic Milling Co.* (1877), 4 Dillon, 100; 3 Bann. & A. 168.

That a patentee, using the invention himself, has a right to an injunction, not merely a bond and account, see *Consolidated Fruit Jar Co. v. Whitney* (1874), 10 Phila. 268; 1 Bann. & A. 356.

That a motion to substitute a bond for an injunction in order that the defendant may fulfil his contracts will not be granted unless the plaintiff would be adequately protected thereby, see *Westinghouse Air Brake Co. v. Carpenter* (1887), 32 Fed. Rep. 545.

Thus where the patent is about to expire, or the plaintiff has been negligent in the assertion of his rights, or the legal remedy is adequate and the defendant responsible, or the invention has been so incorporated into the defendant's business that its extrication is impossible without causing him unwarrantable injury, or the defendant is a mere vendee whose manufacturer or vendor has not been attacked by the plaintiff, or facts and relations between the parties give rise to an equitable estoppel, or the practical effect of the injunction would be to destroy the value of other patents not in litigation, or an account and bond will afford temporary protection to the plaintiff, — in these cases, though his right cannot be questioned, the purposes of justice are accomplished when the payment of accruing damages and profits is secured.²

² That an injunction will be denied and a bond ordered where the patent has only six months to run, see *Howe v. Morton* (1860), 1 Fisher, 586.

That if a plaintiff has been negligent in enforcing his rights he is only entitled to compensation and future protection, and this can be secured by bond without an injunction, see *Jones v. Merrill* (1875), 8 O. G. 401; *Goodyear v. Honsinger* (1867), 3 Fisher, 147; 2 *Bissell*, 1.

That where the defendant's device is essential to his business, and is made under a later patent, an injunction will be refused and a bond ordered, though the plaintiff's patent is not disputed, if the defendant has acted in good faith, see *United States Annunciator & Bell Telegraph Mfg. Co. v. Sanderson* (1854), 3 *Blatch*. 184.

That an injunction will be refused and a bond ordered when the defendant has large capital invested and the plaintiff does not manufacture the invention, see *Dorsey Harvester Revolving Rake Co. v. Marsh* (1873), 6 Fisher, 387.

That a bond may be ordered where an injunction would do the defendant irreparable injury, see *Eastern Paper*

Bag Co. v. Nixon (1888), 45 O. G. 1571.

That an account will be ordered instead of an injunction when the injunction would injure the defendant more than it would benefit the plaintiff, see *McCreary v. Penn. Canal Co.* (1880), 14 *Phila.* 441; 5 *Fed. Rep.* 367.

That a patentee should sue the infringing makers rather than their vendees, and when he attacks the latter first, a bond will be ordered rather than an injunction, see *Irwin v. McRoberts* (1879), 16 O. G. 853; 4 *Bann. & A.* 411.

That if the patentee has never used his invention or permitted others to use it, a bond will be ordered instead of an injunction, see *Hoe v. Knapp* (1886), 36 O. G. 1244; 27 *Fed. Rep.* 204.

That a bond may be ordered instead of an injunction where the patentee grants licenses, or does not use the invention, or is guilty of laches misleading the defendant, see *Westinghouse Air Brake Co. v. Carpenter* (1887), 32 *Fed. Rep.* 545.

That no injunction will be ordered where the plaintiff grants licenses, though an infringement is claimed and

A bond, when substituted in this manner for an injunction, should be sufficient in amount to cover all probable losses to the plaintiff, and the account must so describe the articles sold or used by the defendant that any person acquainted with the business can fix their value and compute their profits.³

the patent has been sustained by the courts, but a bond may be required, see *McMillan v. Conrad* (1883), 5 *McCrury*, 140; 16 *Fed. Rep.* 128; *Greenwood v. Bracher* (1880), 1 *Fed. Rep.* 856; 17 *O. G.* 1151; 5 *Bann. & A.* 302.

That a bond may be ordered instead of an injunction where the defendant is responsible and intends to contest the suit, see *American Middlings Purifier Co. v. Christian* (1877), 4 *Dillon*, 448; 3 *Bann. & A.* 42.

That where priority is doubtful, the plaintiff grants licenses, and the defendant is responsible, a bond will be ordered, see *National Hat Pouncing Mach. Co. v. Hedden* (1886), 38 *O. G.* 1128; 29 *Fed. Rep.* 147.

That where novelty is doubtful, a bond and account may be ordered, or an injunction may issue if the plaintiff gives bond, see *Heysinger v. Dennison Mfg. Co.* (1882), 15 *Phila.* 509.

That a bond may be ordered where a late decision of the Supreme Court renders the law of the case questionable, see *Eastern Paper Bag Co. v. Nixon* (1888), 35 *Fed. Rep.* 752.

That an injunction will be refused and a bond ordered when a licensor has sold the device at lower rates in self-defence against his licensee, who refused to pay royalties and also cut the price, though the infringement may be clear, see *Washburn & Moen Mfg. Co. v. Scutt* (1884), 22 *Fed. Rep.* 710.

That an injunction will be refused and a bond ordered when there are two patents, one valid and the other doubtful, and an injunction on the valid patent would operate as an injunction on

the other, see *Goodyear v. Hills* (1866), 3 *Fisher*, 131.

That an injunction will be denied and a bond ordered where the defendant's machine embraces improvements which cannot be used without the original, see *Howe v. Morton* (1860), 1 *Fisher*, 586.

That an injunction will be denied and a bond ordered where the defendant's machine embraces valuable features not covered by the plaintiff's patent, see *Stainthorp v. Humiston* (1862), 2 *Fisher*, 311.

That a bond will be ordered and an injunction denied if the former answers the purpose as well, although the patent has been sustained by repeated judgments and the infringement is clear, see *Blake v. Robertson* (1873), 6 *Fisher*, 509; 11 *Blatch.* 237.

That an injunction will be refused and a bond ordered where there has been no adjudication, and no evidence is offered of the extent of public acquiescence, and no claim was made on the defendant for three years, but the patent is not denied and the infringement is clear, see *Sykes v. Manhattan Elevator & Grain Drying Co.* (1869), 6 *Blatch.* 496.

That a bond will be ordered rather than an injunction pending a writ of error in the Supreme Court, see *Wells v. Gill* (1872), 6 *Fisher*, 89; 2 *O. G.* 590.

³ That the bond on an injunction should always be fixed at an amount sufficient to cover all possible damages, see *Brown v. Shannon* (1857), 20 *Howard*, 55.

That a monthly account ordered to

§ 1203. Preliminary Injunction: Who may be Enjoined: Public Corporations: Private Corporations: Copartners.

Any person, natural or artificial, who in the opinion of the court may be about to perpetrate or participate in an infringing act, or to derive a direct advantage from its performance, may be made defendant in an application for an injunction, and may be prohibited from committing or promoting the proposed infringement. A municipal corporation may be enjoined from practising the invention through its agents, or from permitting infringing contractors to violate the patent for its benefit.¹ Private corporations may be ordered to refrain from authorizing or accepting the results of an infringement; and the same prohibition may be extended to its stockholders or servants if they infringe jointly or aid in the infringement, although they are not liable for damages and profits.² The owner of a patent may enjoin his former partners after the dissolution of the firm, though during its continuance their right to use the invention was, by the partnership agreement, made equal to his own.³

be filed with the clerk need only so describe the articles that persons in the trade can determine their value in the market, and state the profits, see *Wilder v. Gayler* (1849), 1 Blatch. 511.

§ 1203. ¹ That a city may be enjoined, see *Bliss v. City of Brooklyn* (1871), 4 Fisher, 596; 8 Blatch. 533.

That a city may be enjoined from permitting an infringing pavement to be laid by its contractors, see *Elizabeth v. Pavement Co.* (1877), 97 U. S. 126.

² That an injunction may restrain all persons, whether officers of a corporation or not, who are aiding in promoting the infringing sale or use, and whether they are liable for profits or damages or not, see *American Cotton Tie Supply Co. v. McCready* (1879), 17 O. G. 565; 17 Blatch. 291; 4 Bann. & A. 588.

That each stockholder of an infringing association is liable to be enjoined, and made a party to the suit, see *Tyler v. Galloway* (1882), 22 O. G. 1294; 13 Fed. Rep. 477; 21 Blatch. 66.

That officers of an infringing association are not liable to injunction unless they are stockholders, see *Tyler v. Galloway* (1882), 22 O. G. 1294; 13 Fed. Rep. 477; 21 Blatch. 66.

That defendants infringing in concert may be enjoined though they are stockholders and servants of a corporation, see *Poppenhusen v. Falke* (1861), 2 Fisher, 181; 4 Blatch. 493.

³ That a patentee may enjoin his former partners after the firm is dissolved, see *Pentlarge v. Beeston* (1877), 14 Blatch. 352; 3 Bann. & A. 142.

§ 1204. **Preliminary Injunction: Who may be Enjoined: Co-owners: Assignees: Licensees: Agents, etc.**

An injunction may be granted at the instance of one owner of a patent against an infringing co-owner.¹ Where the patentee of an original invention and the inventor of an improvement obtain a joint re-issue, covering both inventions, each can restrain the other from using the improved invention except for their joint benefit.² The assignee of an enjoined infringer, taking his title with notice of the pending injunction, occupies toward the plaintiff the same position as his assignor, and is liable at once to be restrained, whatever injury he may thereby sustain.³ Licensees who exceed the privileges conferred upon them by the license, or who practise the invention after repudiating their contract with the owner of the patent, may be enjoined from further wrongful acts;⁴ though where a licensee transcends his rights through accident or mistake, and upon notice ceases to infringe, the court will ordinarily refuse to issue an injunction.⁵ The licensee

§ 1204. ¹ That an infringing co-owner is liable to the other owners like any other infringer, see *Duke v. Graham* (1884), 19 Fed. Rep. 647; *Herring v. Gas Consumer's Association* (1878), 9 Fed. Rep. 556; 13 O. G. 637; 3 McCrary, 206; 3 Bann. & A. 253; and §§ 797, 913, and notes, *ante*.

² That when the patentee of an original invention and the inventor of an improvement obtain a re-issue, covering the two inventions in their joint names, each can enjoin the other from using the invention except for their joint benefit, see *Duke v. Graham* (1884), 19 Fed. Rep. 647.

³ That a new party, taking under an infringer after injunction with notice, has the same rights in reference to the plaintiff as his vendor, and is not an independent infringer, but is liable at once to be enjoined, however great his loss, and cannot give a bond instead, see *Parkhurst v. Kinsman* (1848), 2 Blatch. 78.

That a grantee cannot be enjoined from selling within his territory, on the ground that his vendees take the articles elsewhere, see *Hatch v. Hall* (1884), 30 O. G. 1096; 22 Fed. Rep. 438.

⁴ That a vendee may use the article purchased though it infringes another patent of the vendor, if it cannot be otherwise used, see *Roosevelt v. Western Electric Co.* (1884), 28 O. G. 812; 20 Fed. Rep. 724.

That an injunction will be granted against a licensee unless his acts are in accordance with his license, see *Brooks v. Stolley* (1845), 3 McLean, 523; 2 Robb, 281.

That a licensee will be enjoined if he uses the patent without paying his license fees, whether the license is voidable or not, and if he will not pay he must not use, see *Day v. Hartshorn* (1855), 3 Fisher, 32.

⁵ That a licensee, who transcends his rights, may be enjoined unless he

of one joint-owner of a patent cannot be interfered with by another, unless his acts are an invasion of the rights of his own licensor.⁶ The partner of a licensee enjoys the immunity bestowed on his copartner by the license, and is not subject to an injunction while the firm fulfils its obligations to the licensor.⁷ Though a defendant proclaims himself to be the agent of another, he will be treated as a principal if the infringing article bears his name, and the other evidence points to him as the party primarily responsible for the infringement, and as such he will be enjoined.⁸ Actual agents who sell infringing articles on behalf of their maker or owner are also liable to an injunction, although they have no interest in the vended articles nor in the proceeds of the sale.⁹ Whether those who contribute to the infringing act by furnishing tools and materials therefor, in the due course of business and without participation in the act or its direct results, can be enjoined, is doubted; on principle, their connection with the infringement appears too remote to warrant the proceeding.¹⁰

acted under a misapprehension, and has ceased to infringe, see *Wilson v. Sherman* (1850), 1 Blatch. 536.

That a licensee to make a certain number of articles will not be enjoined until the whole number are made, see *Aspinwall Mfg. Co. v. Gill* (1887), 32 Fed. Rep. 702.

⁶ That a licensee under one co-owner of the patent will not be enjoined at the suit of the other co-owner, see *Clum v. Brewer* (1855), 2 Curtis, 506.

⁷ That where a firm being licensee assigned to one member, who used the invention in conjunction with a new party, an injunction against the new party will be refused, see *Belding v. Turner* (1871), 4 Fisher, 446; 8 Blatch. 321.

⁸ That when an infringing article bears the name of the defendant, and the evidence points to him as the principal person engaged in its manufacture, he will be enjoined though he holds

himself out as the agent of another, see *McWilliams Mfg. Co. v. Blundell* (1882), 22 O. G. 177; 11 Fed. Rep. 419.

⁹ That a defendant who sells the device for its owner, and has no interest in it or in the sale, may be enjoined, see *Maltby v. Bobo* (1876), 14 Blatch. 53; 2 Bann. & A. 459.

That a salesman making a separate profit may be enjoined, though his employer is sued in another district, see *Steiger v. Heidelberger* (1880), 4 Fed. Rep. 455; 18 O. G. 1463; 18 Blatch. 426.

That defendants who sell as agents of a maker may be enjoined, and do not thereby sustain irreparable injury, see *Potter v. Fuller* (1862), 2 Fisher, 251.

¹⁰ That whether a lessor can be enjoined from leasing his tools, etc., to an infringing lessee is doubted, see *Starrett v. Athol Mach. Co.* (1883), 14 Fed. Rep. 910; 23 O. G. 1729.

§ 1205. Preliminary Injunction: Who may be Enjoined: Defendant Ceasing to Infringe.

No injunction can be granted against a defendant whose interest in the infringing enterprise had expired before the filing of the application.¹ The presumption of an intention to infringe which arises from past infringements ceases when the defendant is no longer capable of violating the plaintiff's rights, and the probability of his regaining his former capacity is too slight to justify the issue of a prohibitory order. Where an infringer dies before or pending suit, there is no presumption that his personal representatives purpose to continue the infringement, and until they manifest that purpose they cannot be enjoined.²

§ 1206. Preliminary Injunction: Form of Application.

An application for a preliminary injunction pending a suit in equity may either be incorporated into the original bill or constitute a separate proceeding.¹ An injunction in aid of a suit at law must be applied for in an independent motion, as if it were the only equitable remedy required. In any case, however, the application must clearly state the plaintiff's right, and its intended violation by the defendant, and pray for the immediate interference of the court. In describing the right of the plaintiff the application must set forth the production of the invention by the patentee or his assignor, the issue of the patent, and the title of the plaintiff, in substantially the

§ 1205. ¹ In *Potter v. Crowell* (1866), 3 Fisher, 112, Withey, J. : (115) "Where the injury is not only past, but cannot from the nature of the case be renewed or continued, no injunction would be granted; for the well-recognized principle should in such case prevail, that past injuries are not in themselves ground for injunction, and because the restraining power of a court of equity can only be evoked, not to remedy injuries already done, but to prevent injury." 1 Abbott 89 (91).

That an injunction will not issue against a defendant who, at the time of

filing the bill, had parted with his interest in the infringing device, see *Brammer v. Jones* (1867), 3 Fisher, 340; 2 Bond, 100.

² That an injunction will not issue against personal representatives of a deceased infringer, unless they manifest an intention to infringe, see *Draper v. Hudson* (1873), Holnes, 208; 6 Fisher, 327; 3 O. G. 354.

§ 1206. ¹ That pending suit an injunction may be obtained by supplemental bill, see *Allis v. Stowell* (1883), 23 O. G. 1033; 15 Fed. Rep. 242.

same manner as in an original bill for the recovery of damages or profits. It must allege that the plaintiff has himself practised the invention, and is at present in the enjoyment of his exclusive privilege except so far as the defendant or other infringers are concerned; and must set forth the judgments, public acquiescence, or equivalent facts, on which the presumption of his right is based.² In describing the threatened infringement of the defendant the particular acts intended must be specified, in order that the court may judge whether they are invasions of the patent, and are of sufficient consequence to warrant summary relief.³ If the patent has expired, it must be averred that the alleged infringing articles were made during the term of the patent and in violation of its provisions.⁴ It must also appear whether the infringement has already commenced or is merely apprehended. The application must be supported by the oath of the plaintiff, who must also swear that he or his assignor is the original inventor of the art or instrument protected by the patent.⁵ The prayer for an injunction may be separately expressed, or may be inferred from the assertion of those facts which show that the plaintiff needs and has a right to such relief.⁶ Where the

² That on a bill or motion for an injunction the averments must show former judgments sustaining the patent, or public acquiescence, or equivalent acts, see *Gutta Percha & Rubber Mfg. Co. v. Goodyear Rubber Co.* (1875), 3 Sawyer, 542; 2 Bann. & A. 212.

That it is sufficient in a bill to allege that the patent has been sustained in another Circuit court, that the defendant has infringed generally, and that the plaintiff has a patent, with a profert, see *American Bell Telephone Co. v. Southern Telephone Co.* (1888), 34 Fed. Rep. 803.

³ That a motion for a preliminary injunction should set out the acts constituting the infringement so that the court may see whether the injunction is needed, general allegations not being sufficient, see *Kirby Bung Mfg. Co. v. White* (1880), 17 O. G. 974; 1 Fed. Rep. 604; 1 McCrary, 155; 5 Bann. & A. 263.

⁴ That a bill to enjoin the use of the device after the patent expires, must aver that the device was made before it expired, see *American Diamond Rock Boring Co. v. Rutland Marble Co.* (1880), 2 Fed. Rep. 355; 18 Blatch. 147; 5 Bann. & A. 346.

⁵ That the plaintiff seeking an injunction must swear that he is the inventor, his oath to his patent not being enough, see *Sullivan v. Redfield* (1825), 1 Paine, 441; 1 Robb, 477; *Rogers v. Abbott* (1825), 4 Wash. 514; 1 Robb, 465.

That false swearing in an affidavit, made before the bill is filed to be used on motion for an injunction, is perjury, see *Baldwin v. Bernard* (1872), 2 O. G. 320; 5 Fisher, 442; 9 Blatch. 509, note.

⁶ That the plaintiff need not specially pray for an injunction if the bill shows a *prima facie* case for one, see *Goodyear v. Mullee* (1868), 3 Fisher, 420.

application is incorporated into the original bill the averments of the bill are regarded as relating to the application also, and therefore should not be repeated.⁷ But where the application is an independent proceeding it must be complete in itself, and disclose all the matters upon which the court must pass in order to grant or to deny the temporary injunction.⁸ New forms of apprehended infringement, discovered after the filing of the application, may be made the subject of a supplemental bill, and may be covered by the same injunction.⁹

§ 1207. Preliminary Injunction : Notice to Defendant of Application : Appearance : Answer.

Until the act of 1874 the Federal courts had no authority to grant injunctions without previous notice to the defendant, and a hearing on the points at issue if he so desired.¹ In cases of great emergency the court had power, under the act of 1872, to issue a restraining order against the defendant, pending the application for a preliminary injunction, which served all the purposes of an *ex parte* injunction, but without prejudice to the defendant on the merits of the application.² The act of 1874, however, has been interpreted as an abrogation of the rule requiring notice, and as therefore conferring on the Federal courts the general authority of courts of equity in reference to *ex parte* injunctions.³ Whether this

⁷ That where a bill was filed one week before the application for an injunction was made, the plaintiff, in his affidavit accompanying such application, need not renew his allegation that he believed the patentee to be the first inventor, see *Young v. Lippman* (1872), 2 O. G. 249 ; 5 *Fisher*, 230 ; 9 *Blatch*, 277.

⁸ That matters not alleged in the bill cannot be urged as grounds for the injunction, see *International Tooth Crown Co. v. Mills Co.* (1884), 30 O. G. 662 ; 22 *Fed. Rep.* 659.

⁹ That where a supplemental bill alleges new transactions of the defendant the injunction may be extended to

them, see *Parkhurst v. Kinsman* (1848), 2 *Blatch*, 78.

§ 1207. ¹ That no injunction will be granted without notice to the defendant and a chance to be heard on an answer, and proof and affidavits will be received on both sides, see *Wilson v. Stolley* (1847), 4 *McLean*, 272.

² Sec. 718, *Rev. Stat.*

³ That since the act of June 22, 1874, no previous notice of a motion for an injunction is required, and the court may now grant an immediate restraining order to be in force till the motion is decided, see *Yuengling v. Johnson* (1877), 1 *Hughes*, 607 ; 3 *Bann. & A.* 99.

departure from principles so long established will be ultimately sustained is doubtful, — the evils resulting from *ex parte* injunctions, especially in cases of infringement, being out of all proportion to the benefits obtained by an abandonment of the ancient practice. If notice is required, it must be reasonable in view of all the circumstances of the parties, but may be waived by the appearance of the defendant.⁴ When he appears, he may in his answer admit the truth of the averments contained in the application, or traverse or avoid them, wholly or in part. The answer to an application for an injunction is subject to the same general rules as an answer to an original bill.⁵ It confesses whatever it does not deny, and where its denial relates to any point involving the validity of the patent it must set forth the particular facts on which the denial rests.⁶ If the defendant does not appear, the hearing will proceed *ex parte* on the application and the evidence presented by the plaintiff.⁷

§ 1208. Preliminary Injunction: Questions Arising on the Application.

Among the material questions arising on the hearing are: the nature of the invention; the standing of the plaintiff in the trade; the character and extent of the infringement; whether the defendant makes and sells or only uses the invention, — the former being an increasing wrong; the responsibility of the defendant for the damages and profits, if recovered; and the inconvenience to the respective parties of denying or allowing the injunction.¹ Whether the plaintiff can enjoy his

⁴ That an injunction will issue where the defendant has actual notice of the motion and appears, though the service of the subpoena on him was irregular, see *Thayer v. Wales* (1871), 5 Fisher, 130; 9 Blatch. 170.

⁵ That on a motion to grant or continue an injunction an answer to the bill for injunction, though filed without a rule, will be treated as an answer, see *Brooks v. Bicknell* (1843), 3 McLean, 250; 2 Robb, 118.

⁶ That the defendant cannot allege,

in reply to a motion for an injunction, a prior use in general on his knowledge and belief, but must set out particulars of the information on which his allegation rests, see *Young v. Lippman* (1872), 2 O. G. 249; 5 Fisher, 230; 9 Blatch. 277.

⁷ That a motion for an injunction is an *ex parte* proceeding, see *Potter v. Whitney* (1866), 3 Fisher, 77; 1 Lowell, 87.

§ 1208. ¹ In *Furbush v. Bradford* (1858), 1 Fisher, 317, Curtis, J. : (318)

own invention without invading other patents, and whether his conduct has misled the defendant where no fraud or estoppel can be claimed, are immaterial.²

§ 1209. Preliminary Injunction: Hearing: Production of Evidence.

The evidence on the hearing is presented by affidavits. Those of the plaintiff usually accompany the application; those of the defendant follow with his answer; and the plaintiff closes in rebuttal, no reply on behalf of the defendant being permitted.¹ Each party is allowed a reasonable

“In acting on applications for temporary injunctions to restrain the infringement of letters-patent, there is much latitude for discretion. The application may be granted or refused unconditionally, or terms may be imposed on either of the parties as conditions for making or refusing the order, and the state of litigation, where the plaintiff's title is denied, the nature of the improvement, the character and extent of the infringement complained of, and the comparative inconvenience which will be occasioned to the respective parties, by allowing or denying the motion, must all be considered in determining whether it should be allowed or refused, and if at all, whether absolutely or upon some and what conditions.”

See also § 1200, note 1, and § 1202 and notes, *ante*.

² That on a motion for an injunction the fact that the plaintiff cannot use his invention without infringing a prior patent is immaterial, the two questions being wholly distinct, see *Young v. Lippman* (1872), 2 O. G. 249; 5 Fisher, 230; 9 Blatch. 277.

That an injunction will be granted though not all the grants of right in a patent are infringed, see *Potter v. Holland* (1858), 1 Fisher, 382; 4 Blatch. 238.

That under Sec. 4921 an injunction issues irrespective of any right to prof-

its or damages, or other relief, see *Colgate v. International Ocean Telegraph Co.* (1879), 17 O. G. 194; 17 Blatch. 308; 4 Bann. & A. 609; *American Cotton Tie Supply Co. v. McCready* (1879), 17 O. G. 565; 17 Blatch. 291; 4 Bann. & A. 588.

That an injunction will be granted though the plaintiff has misled the defendant, unless there were fraud or estoppel, see *Sarven v. Hall* (1873), 6 Fisher, 495; 4 O. G. 666; 11 Blatch. 295.

See also § 1195 and notes, *ante*.

§ 1209. ¹ That on a motion for an injunction affidavits may be read on both sides as to the matters in controversy in the bill, see *Brooks v. Bicknell* (1843), 3 McLean, 250; 2 Robb, 118.

That on a motion for an injunction, if the defendant's facts as set up are insufficient, it is immaterial whether their statement is called and received as an affidavit or an answer, see *Goodyear v. Mullee* (1868), 3 Fisher, 420.

That the practice of treating an answer to a motion for a preliminary injunction, when denying the bill, merely as an affidavit is a departure from the rules of courts of equity, see *Parker v. Sears* (1850), 1 Fisher, 93.

That on a motion for an injunction the plaintiff may rebut the defendant's affidavits by any proper evidence, see

time to inspect the affidavits of the other and to prepare his own, and evidence not thus submitted to inspection cannot be regarded by the court. The proper evidence in support of the patent is the patent itself, with its renewals and extensions, judgments sustaining it at law or equity, the acquiescence of the public in the exclusive possession of the plaintiff, and special injunctions against the defendant or other infringers.² The evidence of the plaintiff's title consists of the written instruments by which his legal interest was created, or the contracts or other circumstances which confer on him his equitable rights.³ The evidence of intended infringement must cover both the acts of the defendant and the identity of his device or process with that protected by the patent, — the former being proved by his past conduct, threats, or preparations; the latter by judgments, expert testimony, or the personal inspection of the court.⁴ The defendant's evidence may be drawn from judgments, records, or any matters of fact which controvert or weaken the presumptions raised by the proof offered by the plaintiff.⁵

Goodyear v. Mullee (1868), 3 Fisher, 420.

That where the defendant on a motion for an injunction sets up new matter, as license, etc., the plaintiff may reply with more proofs, but the defendant cannot put in additional evidence to rebut such proofs, see *Day v. New England Car Spring Co.* (1854), 3 Blatch. 154.

That affidavits filed after the stipulated date cannot be considered on a motion for an injunction, see *American Paper Barrel Co. v. Laraway* (1886), 28 Fed. Rep. 141; 37 O. G. 674.

² That a motion for an injunction may be supported by the following classes of evidence: (1) Letters-Patent; (2) Renewal of Patent; (3) Recovery in Equity; (4) Recovery at Law; (5) Possession and use; (6) Special injunc-

tions against other parties; (7) Special injunctions against the present defendant, see *Woodworth v. Rogers* (1847), 3 W. & M. 135; 2 Robb, 625.

³ That where the right of a plaintiff to an injunction depends on a written instrument the court will construe it, and grant or refuse an injunction accordingly, see *Hodge v. Hudson River R. R. Co.* (1868), 6 Blatch. 165; *Clum v. Brewer* (1855), 2 Curtis, 506.

⁴ See § 1191 and notes, *ante*.

⁵ That where the plaintiff, on a motion for an injunction, offers extracts from certain documents to support his claims, the defendant may offer the whole documents in evidence upon the subsequent trial, see *Western Union Telegraph Co. v. Baltimore & Ohio Telegraph Co.* (1885), 23 Blatch. 419.

§ 1210. Preliminary Injunction: Ex Parte Hearings: Burden of Proof.

When the hearing proceeds *ex parte*, through the failure of the defendant to appear and answer, if the plaintiff's affidavits show the issue of the patent and a judgment in its favor or an acquiescence by the public, and a probable infringement by the defendant, an injunction will issue though the court may have some doubt concerning the validity of the patent;¹ but if the patent is defective on its face, or the title of the plaintiff is uncertain, an injunction will be refused.² When the application is heard upon opposing evidence, and the plaintiff's affidavits make a *prima facie* case for an injunction, the defendant must present testimony sufficient to overcome the presumptions thus created, or prove the existence of other circumstances rendering the allowance of an injunction inexpedient.³ The application will be decided on broad views of the equitable rights of the parties. The court, from the nature of the proceeding, can examine only far enough to ascertain whether the plaintiff has or has not an apparent title to protection, and cannot, therefore, enter into inquiries concerning difficult questions of law or the

§ 1210 ¹ That an injunction will be granted almost of course if the patent has been sustained by a judgment and infringement is shown, see *Wells v. Gill* (1872), 6 Fisher, 89; 2 O. G. 590; *Thayer v. Wales* (1871), 5 Fisher, 130; 9 Blatch. 170.

That where there has been long enjoyment under the patent an injunction will be granted although a trial at law has already been ordered, see *Brooks v. Norcross* (1851), 2 Fisher, 661.

² That an injunction will be denied if the patent is defective on its face, see *Isaacs v. Cooper* (1821), 4 Wash. 259; 1 Robb, 332.

That although on a prior suit the Claims of the patent were held to be too broad and invalid, yet disclaimer being filed, and an infringement now shown, an injunction and account will be ordered, see *Terry Clock Co. v. New Haven Clock*

Co. (1879), 17 O. G. 909; 4 Bann. & A. 121.

That where a patent has never been passed upon by the courts the first question on a motion for an injunction is whether there has been sufficient public acquiescence to raise a presumption in favor of the patent, see *Guidet v. Palmer* (1872), 6 Fisher, 82; 10 Blatch. 217.

That no injunction will issue to restrain a patentee, nor will equity otherwise interfere with him, unless the plaintiff has a patent, see *Hoeltge v. Hoeller* (1870), 2 Bond, 386.

³ That an injunction will be granted where the defence of prior use is not established, see *Welling v. La Bau* (1882), 12 Fed. Rep. 875.

That no injunction will be granted where validity and infringement are denied under oath unless the patent is sustained by a judgment or by long ac-

weight and value of conflicting evidence.⁴ In some cases the absence of any right in the plaintiff is so clear that no further litigation will be permitted; in others, the matter is so doubtful that its determination is postponed until the final hearing; in others, though not entirely satisfied of the justice of the plaintiff's claim, the court allows the injunction, as on the whole more consonant with equity than its denial.⁵

§ 1211. Preliminary Injunction : Form and Scope of Injunction.

A preliminary injunction may contain a general or a limited prohibition, and may issue either alone or in connection with other special orders for relief.¹ When certain Claims of the patent are disputed, the injunction may be confined to those which are unquestionably valid; and when certain infringing articles already used by the defendant cannot be equitably enjoined, he may be forbidden to procure others and employ them.² When an injunction issues after the expiration of

quiescence, see *Hovey v. Stevens* (1846), 1 W. & M. 290; 2 Robb, 479. See also § 1199 and notes, *ante*.

⁴ See § 1173 and notes, *ante*.

⁵ That some cases are so clear that equity will not permit further litigation, while in others the plaintiff's rights so largely preponderate that he is entitled to an injunction whatever may be its consequences, see *Morris v. Lowell Mfg. Co.* (1866), 3 Fisher, 67.

That an injunction will not be denied for the non-joinder of parties, if the defendant is using the infringing device for purposes belonging exclusively to the plaintiff, see *Bassett v. Malone* (1880), 11 Fed. Rep. 801.

That a motion for an injunction is addressed to the discretion of the court, and the court may order an issue to the jury, see *Ayling v. Hull* (1865), 2 Clifford, 494.

That if the evidence on a motion for an injunction is conflicting the issue will be sent to a jury or master, to examine the device of the defendant and take further evidence and report, see

Parker v. Hatfield (1845), 4 McLean, 61; *Brooks v. Bicknell* (1845), 4 McLean, 70.

Upon the entire matter of this paragraph, see §§ 1199, 1201, and notes, *ante*.

1211. ¹ That an injunction is to protect the plaintiff without unnecessary injury to the defendant, and will be fitted to each case accordingly, see *Kirby Bung Mfg. Co. v. White* (1880), 1 Fed. Rep. 604; 17 O. G. 974; 1 McCrary, 155; 5 Bann. & A. 263.

That injunctions in the Federal courts vary with circumstances, and may be simple injunctions, or coupled with an order for a bond and account or for an account only, see *Kirby Bung Mfg. Co. v. White* (1880), 17 O. G. 974; 1 Fed. Rep. 604; 1 McCrary, 155; 5 Bann. & A. 263.

² That the defendant may be enjoined from infringing two Claims of the patent though other Claims are in dispute, see *Colt v. Young* (1852), 2 Blatch. 471.

That an injunction may issue on

the patent, it must be directed only against devices constructed while the patent was in force.³ An injunction may be granted unconditionally, or upon such terms as the court may see fit to impose.⁴ Where there is doubt in reference to its propriety, the plaintiff may be compelled to secure the defendant against the injury caused by the injunction by a bond of indemnity payable if the injunction should appear upon the final hearing to have been unwarranted.⁵ In allow-

valid Claims though other Claims are not disclaimed, see *Duff v. Calkins* (1883), 25 O. G. 601.

That an injunction may be granted forbidding the employment of any other devices than those already in use, see *Colgate v. Gold & Stock Telegraph Co.* (1879), 16 O. G. 583 ; 16 Blatch. 503 ; 4 Bann. & A. 415.

³ In *American Diamond Rock Boring Co. v. Rutland Marble Co.* (1880), 2 Fed. Rep. 356, Wheeler, J. : (356) "It is argued for the defendants that to continue the restraint upon such machines after the expiration of the term of the patent is in effect to extend the term of the patent. The grant to the patentee was of the exclusive right to make, use, and vend to others to be used, the invention during the term. The right to exclude others from making, using, and selling was the essential thing, and really all that was granted. He had the right to do all these himself, to any extent, without the grant. The exclusive right was his property. Any making for use during the term was taking from him what belonged to him. To permit any others to make or produce such machines during the term, and hold them till the expiration and then use them freely, as if made after, would be to permit them to make off with so much of his property that the law had guaranteed to him. To restrain the use after the term, without his consent, gives nothing to him that he was not entitled to, and takes nothing from them that they had any right to. It

gives him no right acquired beyond his term, and merely secures to him the full right he was entitled to during the term. The law would be open to reproach if it would not allow a court of equity, by its usual methods, in a case properly before it to accomplish a result so just." 18 Blatch. 146 (146) ; 5 Bann. & A. 345 (345).

That an injunction prohibiting the use of a combination of old elements does not prevent the making and use of such combination after the patent expires, see *Johnson v. Brooklyn & C. R. Co.* (1888), 37 Fed. Rep. 147.

⁴ That the court has a wide latitude in granting preliminary injunctions, and may order or refuse them either unconditionally or on terms, see *Furbush v. Bradford* (1858), 1 Fisher, 317.

⁵ That an injunction will not be ordered without a bond from the plaintiff when his right is vague and the defendant might be injured, see *Blake v. Boisselier* (1880), 16 O. G. 854 ; 5 Bann. & A. 352.

That if the defendant is also an inventor he may claim bonds from the plaintiff to secure him against loss in case the plaintiff's suit fails or the injunction proves to be improper, see *Consolidated Fruit Jar Co. v. Whitney* (1874), 10 Phila. 268 ; 1 Bann. & A. 356.

That where an injunction issues upon the filing of a bond by the plaintiff and the defendant prevails he can sue on the bond, see *Tobey Furniture Co. v. Colby* (1888), 35 Fed. Rep. 592.

ing an injunction by consent, after the withdrawal of the defendant's opposition, the court will not pass on any question connected with the merits of the controversy, for the purpose of influencing future litigation.⁶

§ 1212. Preliminary Injunction: Effect of Injunction.

An injunction takes effect according to its terms, and operates only upon the persons and the actions named therein.¹ It remains in force as long as the patent is capable of infringement, unless previously recalled by the court or superseded by some other judgment in the suit.² It has no authority over acts or individuals beyond the local jurisdiction

See this case also for a rule of damages on such a bond.

That pending a suit against an infringing seller the plaintiff may be enjoined from suing the defendant's vendees, see *Ide v. Ball Engine Co.* (1887), 31 Fed. Rep. 901 ; 41 O. G. 1271.

That when there is a pending suit against the maker of a device the defendant may enjoin the plaintiff from suing the defendant's vendees though the plaintiff is not in the district where the injunction issues, as the court has jurisdiction over him through the pending suit, but the defendant must give bonds to secure the plaintiff, see *Birdsell v. Hagerstown Agricultural Implement Mfg. Co.* (1877), 1 Hughes, 64 ; 11 O. G. 641.

That until damages are paid by the maker no injunction will issue to restrain the patentee from pursuing the vendee and user, see *Tuttle v. Matthews* (1886), 28 Fed. Rep. 98 ; 36 O. G. 694 ; *Fisher v. Consolidated Amador Mine Co.* (1885), 11 Sawyer, 190 ; 25 Fed. Rep. 201.

That a patentee will not be enjoined from suing at law if the bill for an injunction shows a good defence at law, see *Hapgood v. Hewitt* (1886), 119 U. S. 226 ; 37 O. G. 1247.

⁶ That no decision will be rendered for the mere purpose of affecting other

cases, see *American Middlings Purifier Co. v. Vail* (1878), 15 Blatch. 315 ; 4 Bann. & A. 1.

§ 1212. ¹ That an injunction must be restricted to the things named therein, see *Walling v. Rubber Coated Harness Trimming Co.* (1875), 7 O. G. 608 ; 2 Bann. & A. 1.

² That an injunction will remain in force as long as it may be needed, see *Singer Sewing Mach. Mfg. Co. v. Union Button-Hole & Embroidery Co.* (1873), 4 O. G. 553 ; 6 Fisher, 480 ; *Holmes*, 253.

That an injunction can run only during the life of the patent and should be so limited, see *Nathan v. New York Elevated R. R. Co.* (1880), 2 Fed. Rep. 225 ; 5 Bann. & A. 280.

That where the date of the expiration of the patent is in dispute the court will not limit the injunction, but the defendant can move for a dissolution when the date at which he claims the patent must expire has arrived, see *Westinghouse Air Brake Co. v. Carpenter* (1887), 32 Fed. Rep. 545.

That an injunction forbidding the use of an infringing machine does not expire with the patent, see *American Diamond Rock Boring Co. v. Rutland Marble Co.* (1880), 2 Fed. Rep. 356 ; 18 Blatch. 146 ; 5 Bann. & A. 345.

of the court, except when the defendant resides within the district and hence can there be held accountable for his infringements wherever they may be committed.³ It may be modified from time to time, on application to the court, as the interests of the parties may require; and if it lapses through the surrender of the patent for re-issue, it may be continued under the re-issue by an order granted on a supplemental bill.⁴ It may also be suspended temporarily in public emergencies, or when extraordinary necessity arises outside the private interests of the defendant.⁵

³ That a defendant residing and infringing in one district cannot be enjoined by the court of another, such injunction being ineffective, see *Goodyear v. Chaffee* (1855), 3 Blatch. 268.

That process runs against the person, and the court will award it though it may give the plaintiff no effectual relief, and though the defendant may evade its operation, see *Thompson v. Mendelsohn* (1871), 5 Fisher, 187.

That a defendant who is within the jurisdiction may be enjoined though his acts are performed without it, see *Boyd v. McAlpine* (1844), 3 McLean, 427; 2 Robb, 277.

That a court can restrain the use of the invention in another district if it once obtains jurisdiction over the defendant's person; but if it is necessary to proceed against the infringing device the court can only act in the district where the device is located, see *Wilson v. Sherman* (1850), 1 Blatch. 536.

That where use in one district is shown the plaintiff is entitled to an account for all infringements by making, using, or selling in that district, and to an injunction against further infringements there, see *Locomotive Engine Safety Truck Co. v. Erie R. R. Co.* (1872), 3 O. G. 98; 10 Blatch. 292; 6 Fisher, 187.

That the citizenship of the infringer within the district where the suit is brought gives the right to proceed in

such district against him personally to prevent infringement elsewhere, see *Hatch v. Hall* (1884), 22 Fed. Rep. 438; 30 O. G. 1096.

That if a motion for an injunction is heard outside the district where the suit is pending the order will not issue until the court is sitting within the district, see *Putnam v. Weatherbee* (1875), 8 O. G. 320.

⁴ That an injunction can be modified where the court deems it proper, see *De Florez v. Reynolds* (1880), 17 O. G. 503; 8 Fed. Rep. 434; 17 Blatch. 436; 5 Bann. & A. 140; *Goodyear v. Honsinger* (1867), 3 Fisher, 147; 2 Bissell, 1.

That an injunction may be continued under a re-issue by a supplemental bill, see § 1122, notes 8-10, *ante*.

⁵ That a motion to suspend the issue of an injunction will be denied where it does not appear from the affidavits that the infringement will cease, see *Macaulay v. White Sewing Mach. Co.* (1881), 21 O. G. 204.

That neither the fact that the patent has but a year to run, nor the fact that the defendants have made contracts while aware of their liability to the plaintiff, is sufficient reason for suspending an injunction and allowing the infringement to continue, see *Brown v. Deere* (1881), 19 O. G. 1217; 6 Fed. Rep. 487; 2 McCrary, 425. See also § 1221 and note 2, *post*.

§ 1213. Preliminary Injunction: Dissolution of Injunction.

A preliminary injunction may be dissolved by the court whenever it appears that its continuance would no longer serve the purposes for which it was originally granted. Where the evidence taken on the merits before the jury or the master shows that the patent is invalid, or the plaintiff without title, or the acts of the defendant justifiable, and, therefore, that upon the final hearing defeat awaits the plaintiff, the court will recall the order and deliver the defendant from its prohibitions.¹ Upon the application for a dissolution the defendant has the burden of proof, and if the injunction were granted on the oath of the plaintiff that he was the first inventor, fortified by the patent, judgments, acquiescence, and the issue of former injunctions, only the most conclusive evidence can prevail upon the court to reverse its former decree.²

§ 1213. ¹ That a temporary injunction will not be dissolved after the evidence is in unless the defendant has made out a defence, see *Union Paper Bag Mach. Co. v. Newell* (1874), 5 O. G. 459; 11 Blatch. 549; 1 Bann. & A. 113.

That an injunction will be dissolved on evidence showing that the device was known in the United States before the patent, and on the production of the device itself, see *Young v. Lippman* (1872), 5 Fisher, 230; 2 O. G. 249; 9 Blatch. 277.

That where it appears that the defendant acts under a license from the plaintiff the injunction will be dissolved, see *Goodyear v. Bourn* (1855), 3 Blatch. 266.

That if the evidence shows that on the final hearing the plaintiff's patent will not be defeated, a motion to dissolve an injunction will be denied, see *Richardson v. Croft* (1880), 11 Fed. Rep. 800.

That evidence which would prevent the issue of an injunction should be sufficient to dissolve it, see *Cary v. Domestic Spring Bed Co.* (1886), 26 Fed. Rep. 38; 34 O. G. 1158.

That an injunction will be dissolved on new evidence raising grave doubts as to the validity of the patent, see *Cary v. Domestic Spring Bed Co.* (1886), 26 Fed. Rep. 38; 34 O. G. 1158.

² That on a motion to dissolve the injunction the defendant must overcome the equity of the bill and the evidence in its support, see *Hussey v. Whitely* (1860), 2 Fisher, 120; 1 Bond, 407; *Sparkman v. Higgins* (1846), 1 Blatch. 205.

That on a motion to dissolve the court must weigh the evidence, and if the balance is in favor of the plaintiff continue the injunction and allow an action at law to be brought, see *Woodworth v. Rogers* (1847), 3 W. & M. 135; 2 Robb, 625.

That where the defendants in equity dispute the validity of the patent, a suit at law must be brought at the next term, or the pending injunction will be dissolved, and on such suit the trial will be confined to the objections set up in the answer and affidavit, see *Woodworth v. Edwards* (1847), 3 W. & M. 120; 2 Robb, 610.

That an injunction ordered upon the

An injunction will not be dissolved on the ground of hardship to the defendant when he knowingly infringed, nor on account of a conditional license granted to him by the plaintiff, nor for informality in the notice if the defendant actually appeared, nor on doubts as to the powers of officials in the Patent Office when legislation is pending to remove them, nor on the same evidence which induced the court to grant it, nor on new evidence improperly omitted in the former hearing or which would have been rejected for want of proper allegations in the answer.³ A dissolution may be ordered on the filing

oath of the patentee that he was the original inventor, the grant of the patent, an undisturbed enjoyment of exclusive rights, judgments sustaining the patent, and the issue of former injunctions, will not be dissolved unless the patent is impeached by most conclusive evidence, see *Hussey v. Whitely* (1860), 2 Fisher, 120 ; 1 Bond, 407.

That if the defendant's motion leaves no doubt that the patent is invalid, an injunction will be dissolved, see *Hussey v. Whitely* (1860), 2 Fisher, 120 ; 1 Bond, 407.

³ That an injunction will not be dissolved on the ground that it is a hardship to the defendant, when he was not ignorant of the plaintiff's invention, see *Hussey v. Whitely* (1860), 2 Fisher, 120 ; 1 Bond, 407.

That an injunction by consent is not invalidated by granting a conditional license, see *Pentlarge v. Beeston* (1880), 1 Fed. Rep. 862 ; 18 Blatch. 38 ; 5 Bann. & A. 323.

That on a motion to dissolve an injunction, for informality in serving notice of the motion for injunction, the informality is considered as cured by the appearance of the defendant, see *Brammer v. Jones* (1867), 3 Fisher, 340 ; 2 Bond, 100.

That an injunction will not be dissolved on doubts as to the powers of officers in the Patent Office when legislation is pending to remove them, see

Woodworth v. Hall (1846), 1 W. & M. 389 ; 2 Robb, 517.

That an injunction will not be dissolved on the same facts which induced another judge to grant it, see *Hussey v. Whitely* (1860), 2 Fisher, 120 ; 1 Bond, 407 ; *Woodworth v. Rogers* (1847), 3 W. & M. 135 ; 2 Robb, 625.

That the defendant cannot offer, on a motion to dissolve, the facts which he neglected to present on the motion for an injunction, unless his excuses are very satisfactory, see *National School Furniture Co. v. Paton* (1879), 16 Blatch. 563 ; 4 Bann. & A. 432 ; *Woodworth v. Rogers* (1847), 3 W. & M. 135 ; 2 Robb, 625.

That an injunction will not be dissolved after long delay on the ground that the patented invention is described in a prior patent to the plaintiff, see *Holmes Electric Protective Co. v. Metropolitan Burglar Alarm Co.* (1887), 31 Fed. Rep. 562 ; 40 O. G. 1242.

That where an answer alleges no names or residences of persons having prior knowledge, and no abandonment, but mere prior use generally, and the plaintiff having taken proofs and the defendant having taken none a preliminary injunction is granted, and the defendant without asking leave to amend his answer and after the time for taking proof has expired moves to dissolve the injunction on affidavits of prior use and abandonment, the motion will be denied

of the answer if its denial of validity or infringement is supported by sufficient *prima facie* evidence and no rebutting testimony is offered by the plaintiff.⁴

§ 1214. Preliminary Injunction: Obligation of Defendant to Obey.

An injunction, whether granted on an *ex parte* or a contested hearing, or by consent, is binding on the defendant, and must be obeyed until rescinded by the court.¹ The defendant has no right to construe it for himself, ceasing to use what he imagines is forbidden and continuing to employ the residue, but must desist wholly from the practice of the invention, and if he needs further instructions must make application for them to the court.² He cannot be permitted to experiment with other arts or instruments to see how nearly he can imitate the plaintiff's yet still escape infringement; and though he acts under the advice of counsel his liability to punishment for disobedience to the injunction will not be

because the defendant cannot avail himself of these facts at the final hearing, see *Union Paper Bag Mach. Co. v. Newell* (1874), 11 Blatch. 549; 1 Bann. & A. 113; 5 O. G. 459.

⁴ That if the answer denies the validity of the patent and is supported by evidence, the injunction will be dissolved unless counter evidence is filed, see *Woodworth v. Rogers* (1847), 3 W. & M. 135; 2 Robb, 625.

That an injunction will not be dissolved upon a mere answer denying validity, if it were granted on proof of long possession and former judgments, but will be continued and a suit at law ordered, see *Orr v. Merrill* (1846), 1 W. & M. 376; 2 Robb, 331; *Orr v. Littlefield* (1845), 1 W. & M. 13; 2 Robb, 323.

That an injunction vacated on the ground that the patent being limited by a foreign patent had expired therewith, and then restored upon such foreign patent being declared void, may be again vacated if the judgment repealing

the patent is reversed, see *Bate Refrigerating Co. v. Gillett* (1887), 31 Fed. Rep. 809; 40 O. G. 1029.

§ 1214. ¹ That a preliminary injunction is not to be violated though the patent is invalid or the injunction was improperly granted, but must be obeyed until dissolved, see *Phillips v. City of Detroit* (1877), 16 O. G. 627; 2 Flip-pin, 92; 3 Bann. & A. 150.

² That after an injunction issues the defendant has no right to stop using what he considers an infringement and use the rest, but must obey the order as it is granted and ask the court for further instructions if he needs them, see *Hamilton v. Simons* (1869), 5 Bissell, 77.

That where an injunction was broader than was intended the defendant, on being served with notice thereof, should take immediate measures to have it set aside, and not wait to object until a motion for attachment, see *Sickels v. Borden* (1857), 4 Blatch. 14.

diminished.³ His own good faith affords him no protection, and while the court may consider it in affixing the penalty for his contempt, his violation of the injunction is complete if he intends to do and actually does the act which it prohibits, however fully he may have believed his conduct to have been consistent with submission to its terms.⁴

§ 1215. Preliminary Injunction : How Violated.

An injunction is violated by the participation of the defendant in any manufacture, use, or sale of the invention, contrary to the language or the spirit of the prohibition. No cover or subterfuge affords immunity, if the effect resulting from his acts is that which the injunction is intended to prevent. An injunction forbidding the defendant to make the invention is disobeyed whether he manufactures it as principal or agent or mere workman, and whether he completes it or, having par-

³ That an injunction is to be obeyed whether the court is right or not, and the defendant cannot experiment to see how near he can come to an infringement and still escape, see *Craig v. Fisher* (1873), 2 Sawyer, 345.

That the advice of counsel is no excuse for contempt, for counsel have no right to advise, it being the duty of the court alone to construe the injunction, see *Bate Refrigerating Co. v. Gillett* (1887), 30 Fed. Rep. 683; *Burr v. Kimbark* (1887), 29 Fed. Rep. 428; 40 O. G. 246; *Matthews v. Spangenberg* (1883), 23 O. G. 1624; 15 Fed. Rep. 813; *Hamilton v. Simons* (1869), 5 Bissell, 77; *Goodyear v. Mullee* (1867), 3 Fisher, 209; 5 Blatch. 429.

That mistake in construing his license will not excuse the violation of an injunction by the licensee, see *Iowa Barb Steel Wire Co. v. Southern Barbed Wire Co.* (1887), 40 O. G. 578; 30 Fed. Rep. 615.

⁴ In *Atlantic Giant Powder Co. v. Dittmar Powder Mfg. Co.* (1881), 20 O. G. 1380, Blatchford, J.: (1380) "The injunction in this case forbade the mak-

ing, using, or selling certain powders described in it, and any powder substantially like any of said designated powders, and any infringement of said patent. What the defendants did, they did not do accidentally or unintentionally, but knowing fully what they did. They were therefore guilty of contempt. What they did is not the less legally a contempt because they did not think they were infringing or were advised that they were not. Any question of *animus* can bear only on the extent of punishment." 9 Fed. Rep. 316 (317).

That good faith, ignorance of law, and advice of counsel may affect the penalty, though they cannot excuse the violation of the injunction, see *Morss v. Domestic Sewing Mach. Co.* (1889), 38 Fed. Rep. 482; *Bate Refrigerating Co. v. Gillett* (1887), 30 Fed. Rep. 683; *Matthews v. Spangenberg* (1883), 23 O. G. 1624; 15 Fed. Rep. 813.

That a mistake as to the legal effect of a contract may affect the penalty, see *Iowa Barb Steel Wire Co. v. Southern Barbed Wire Co.* (1887), 30 Fed. Rep. 615; 40 O. G. 578.

tially constructed it, sends it to other persons to be finished.¹ An injunction not to use is violated by the practice of an evasive process, by employing colorable variations though the defendant believed the difference to be essential, or by operating under another patent whose owner had, within the knowledge of the defendant, already been enjoined.² The use of articles covered by different patents and not obviously identical with the enjoined invention, if in good faith, is not a contempt of the injunction, nor is the employment of devices made after the plaintiff's patent had expired.³ An injunction

§ 1215. ¹ That an injunction is violated if the defendant works as an employee in a factory where the infringing articles are made, see *Goodyear v. Mullee* (1867), 3 Fisher, 209; 5 Blatch. 429.

That parties enjoined are guilty of contempt, if they combine with others to encourage and defend infringers in their infringing acts, and in their denial of the validity of the patent, see *Bate Refrigerating Co. v. Gillett* (1887), 30 Fed. Rep. 683.

That a defendant, parting with his interest in the infringing business during suit, but without change of parties on the record, is bound by the decree, see *Gloucester Isinglass & Glue Co. v. Le Page* (1887), 30 Fed. Rep. 370.

That an injunction against making an invention is violated by partially making it and sending it to others to be completed, see *Knowles v. Peck* (1875), 42 Conn. 386.

² That a defendant violates an injunction by practising an evasive process, see *Wetherell v. New Jersey Zinc Co.* (1874), 5 O. G. 460; 1 Bann. & A. 105.

That an injunction is violated by the use of colorable variations though the defendant supposes the variations are substantial, see *Atlantic Giant Powder Co. v. Dittmar Powder Mfg. Co.* (1881), 20 O. G. 1380; 9 Fed. Rep. 316.

That a party under injunction is guilty of contempt if he uses another patent similar in principle, whose author had also been enjoined, and he can purge himself only by showing that he did not know of the injunction against its author, see *Woodworth v. Rogers* (1847), 3 W. & M. 135; 2 Robb, 625.

That it is a violation of the injunction to make articles embodying the same principle though varying in form, see *Burr v. Kimbark* (1887), 40 O. G. 246; 29 Fed. Rep. 428.

³ That an injunction is not violated by the use of articles covered by different patents unless the articles are obviously the same, see *Buerk v. Imhaeuser* (1876), 11 O. G. 112; 2 Bann. & A. 465.

That to use a separately claimed part of the invention is a contempt, see *Matthews v. Spangenberg* (1883), 23 O. G. 1624; 15 Fed. Rep. 813.

That an injunction forbidding the use of devices made during the patent is not violated by the use of those made after the patent has expired, see *American Diamond Rock Boring Co. v. Sutherland Falls Marble Co.* (1880), 2 Fed. Rep. 353; 5 Bann. & A. 347; 18 Blatch. 148.

That the injunction is not violated unless the thing used is the patented invention, see *Fetter v. Newhall* (1884), 28 O. G. 285; 20 Fed. Rep. 113.

not to sell is disobeyed by any act which has the legal import of a sale. An agreement to sell, without delivery or an intention to deliver, is not contempt.⁴ But any transaction which passes the ownership of the forbidden articles from the defendant to another person, whether alone or incorporated into other articles, whether under the form of a sale, a barter, a mortgage, or a judgment, whether the defendant acts as principal or agent, and whether the articles were made or procured before or after the grant of the injunction, if voluntarily entered into and performed by the defendant, is a defiance of the prohibition.⁵ It is also a contempt of the injunction for the defendant to permit others to make or use or sell, contrary to its terms, on his behalf, or to confirm or recognize an agreement made before the allowance of the order, but whose execution the injunction now forbids.⁶

§ 1216. Preliminary Injunction : By Whom Violated.

An injunction may be violated, not only by the acts of the defendant himself, but by those of other persons who are rep-

⁴ That a preliminary injunction is not violated by an agreement to sell without delivery or intent to deliver, see *McKay v. Scott Sole Sewing Mach. Co.* (1881), 20 O. G. 372.

⁵ That where after the injunction the defendant took old devices, which were sold under the patent, and put them into his machines and sold the whole together, it was a contempt, see *Craig v. Fisher* (1873), 2 Sawyer, 345.

That where infringing devices were sold before the injunction, and were afterward returned to the defendant and again sold by him, there was probably a technical violation of the injunction unless the devices were included in the accounting, or had been paid for, see *Allis v. Stowell* (1881), 19 O. G. 727.

That a defendant, appearing and being enjoined against making and selling, violates the injunction by selling outside the jurisdiction of the court, whether the articles sold were ever in its jurisdiction or not, see *Macaulay v.*

White Sewing Mach. Co. (1881), 9 Fed. Rep. 698 ; 21 O. G. 496.

That where a defendant who has been enjoined continues to sell either in his own name or as agent he is guilty of contempt, see *Potter v. Muller* (1865), 2 Fisher, 631 ; 1 Bond, 601.

That an injunction is violated by an agreement to furnish and the actual furnishing of an infringing device, though it was made before the injunction was issued, see *Colgate v. Gold & Stock Telegraph Co.* (1879), 17 O. G. 193 ; 4 Bann. & A. 559.

⁶ That an injunction may be violated by confirming or recognizing an agreement existing before the injunction, see *Colgate v. Western Union Telegraph Co.* (1879), 17 O. G. 194 ; 4 Bann. & A. 562.

That an enjoined defendant, carelessly omitting to notify his agents of the injunction, becomes guilty of a technical contempt if they still infringe, see *Mundy v. Lidgerwood Mfg. Co.* (1888), 34 Fed. Rep. 541.

resenting him or are under his control.¹ An injunction against a city binds its public boards if they have notice, though no service has been made on them as parties; and their conduct in contempt of the injunction renders both the corporation and themselves amenable to punishment.² If the officers of a private corporation continue the infringement after the grant of an injunction, or a son or servant practises the invention while the father or the master is enjoined, all are alike guilty of contempt, though the subordinates acted in obedience to orders.³

§ 1217. Preliminary Injunction : Application for Attachment for Contempt.

The remedy of the plaintiff for the violation of an injunction is by an application to the court for an order of attach-

§ 1216. ¹ That an injunction is violated by allowing persons, over whom the defendants have official authority, to infringe, see *Phillips v. City of Detroit* (1877), 16 O. G. 627; 2 *Flippin*, 92; 3 *Bann. & A.* 150.

² That an injunction against a city binds its boards of public works, if they have notice, though no service is made on them as parties, see *Phillips v. City of Detroit* (1877), 16 O. G. 627; 2 *Flippin*, 92; 3 *Bann. & A.* 150.

³ That officers of an infringing corporation, if personally enjoined, are liable for contempt, see *Iowa Barb Steel Wire Co. v. Southern Barbed Wire Co.* (1887), 30 *Fed. Rep.* 123; 40 O. G. 577.

That officers of a corporation, having been individually enjoined, are guilty of contempt if they afterwards infringe as managers of a different corporation, see *Iowa Barb Steel Wire Co. v. Southern Barbed Wire Co.* (1887), 30 *Fed. Rep.* 123; 40 O. G. 577.

That where the defendant was a corporation, and the managing president was the contriver of the infringing process, he was held liable for the contempt, see *Wetherell v. New Jersey*

Zinc Co. (1874), 5 O. G. 460; 1 *Bann. & A.* 105.

That it is no defence to a motion for an attachment that the defendant was the servant of a corporation and obeyed orders, see *Sickels v. Borden* (1857), 4 *Blatch.* 14.

That where a father was enjoined, and his son, living with him and under his control, violated the injunction, the father was held for contempt though the son received and spent his own wages, but the son filing an agreement not to violate further, the father was not punished but compelled to pay the master's fee, see *Dunks v. Grey* (1880), 3 *Fed. Rep.* 862; 5 *Bann. & A.* 634.

That a servant or agent, separately sued, is not bound by a judgment against his principal, see *Hayes v. Bickelhaupt* (1885), 32 O. G. 136; 24 *Fed. Rep.* 806.

That the vendee of the defendant's infringing business, pending suit, is not bound by an injunction afterwards obtained, unless he were made a party to the suit, see *Bate Refrigerating Co. v. Gillett* (1887), 30 *Fed. Rep.* 685; 39 O. G. 833.

ment against the defendant, upon which, if found guilty, he may be subjected to fine or imprisonment. This application is collateral to the proceeding in which the preliminary injunction was granted, and may be made at any time when the misconduct of the defendant renders it necessary.¹ The affidavits accompanying the application must state the specific acts or omissions which constitute the alleged contempt, and any interrogatories addressed to the defendant must be confined to these particular offences.² The defendant is not obliged to answer to matters charged on information and belief, but may demur to improper interrogatories and recover costs. Upon the hearing on the application no new evidence can be received to vary the construction already given to the patent, nor can the defendant attack the validity of the injunction, nor the correctness of its interpretation by the court.³ The only point at issue is the performance by the defendant of the forbidden acts, and these may be examined either by the court in person or through the aid of experts or other proper witnesses.⁴ When the alleged violation of the

§ 1217. ¹ That a motion for attachment for contempt will be granted without a new suit if an injunction is violated, see *Wetherell v. New Jersey Zinc Co.* (1874), 5 O. G. 460; 1 Bann. & A. 105.

That where a patent is fully discussed and understood on the trial, and the case is not closed, but an account is being taken, a motion for attachment for contempt may be made, see *Higby v. Columbia Rubber Co.* (1883), 18 Fed. Rep. 601.

² That the affidavits accompanying a motion for attachment must state the specific acts or omissions which constitute the contempt, and the interrogatories addressed to the defendant must be confined to these specific offences, but the defendant need not answer to matters charged on information and belief, and if he demurs to improper interrogatories he can recover his costs, see *Parkhurst v. Kinsman* (1848), 2 Blatch. 76.

³ That on a motion for attachment for contempt no evidence can be admitted to vary the construction already given to the patent by the court, see *Burdett v. Estey* (1879), 16 Blatch. 105; 4 Bann. & A. 141.

That a party in contempt will not be heard on the injunction till he has purged himself of the contempt, see *Ready Roofing Co. v. Taylor* (1878), 15 Blatch. 94; 3 Bann. & A. 368.

That a defendant consenting to a decree and an injunction must obey the injunction until it is dissolved, and cannot attack it on proceedings for contempt, see *Roemer v. Neumann* (1883), 19 Fed. Rep. 98.

⁴ That on a motion for an attachment the court may, at its discretion, examine the fact of infringement by itself or may have experts, but its decision on this question does not prejudice the parties on the accounting, see *Burdett v. Estey* (1879), 16 Blatch. 105; 4 Bann. & A. 141.

injunction consists in acts in some respects dissimilar to those described in the injunction, and a new question of identity between the defendant's art or instrument and the patented invention is thus presented, the matter cannot be investigated on the application for attachment, but requires new pleadings and new evidence in a supplemental bill or in a separate action.⁵ A like necessity exists where the defendant acts under a new patent, or under a contract whose validity is contested in another court, or where the defendant's justification demands a re-examination of the scope and meaning of the plaintiff's patent.⁶ An attachment is intended only for summary relief in cases where the single issue raised relates to the commission by the defendant of the prohibited acts of manufacture, use, and sale, and is not a proceeding in which collateral or fundamental questions can be considered and

⁵ That where the infringement is in dispute that question cannot be tried on a motion for attachment for contempt, but only on pleadings and evidence in a new suit, see *Temple Pump Co. v. Goss Pump & Rubber Bucket Mfg. Co.* (1887), 31 Fed. Rep. 292; *Putnam v. Hollender* (1882), 11 Fed. Rep. 75; *Bate Refrigerating Co. v. Eastman* (1881), 11 Fed. Rep. 902; *Liddle v. Cory* (1865), 7 Blatch. 1.

That after a decree has been rendered in a pending suit the court will not determine on contempt proceedings whether an infringement actually exists, and if the infringement is in dispute a supplemental bill or a new one must be filed, see *Allis v. Stowell* (1883), 15 Fed. Rep. 242; 23 O. G. 1033.

That no attachment will issue where the defendant denies that he is using the plaintiff's process and the court below is divided on that point, see *California Artificial Stone Paving Co. v. Molitor* (1885), 113 U. S. 609; 31 O. G. 1044.

That equity will never proceed for contempt unless the violation of the injunction is clear and proven, and

the question whether the device used actually infringes is always open for evidence, see *Birdsell v. Hagerstown Agricultural Implement Mfg. Co.* (1877) 11 O. G. 420; 1 Hughes, 59; 2 Bann. & A. 519.

That a motion for attachment for contempt will not be granted if the claim that the injunction has been violated raises a new question as to the construction of the patent, for on that question the defendant has a right to be heard, see *Poppenhusen v. New York Gutta Percha Comb Co.* (1859), 2 Fisher, 80; 4 Blatch. 253.

⁶ That where the defendant is acting under a new patent granted since the injunction issued there can be no attachment for contempt but a new hearing must be had, see *Wirt v. Brown* (1887), 30 Fed. Rep. 187; *Onderdonk v. Fanning* (1880), 2 Fed. Rep. 568; 5 Bann. & A. 431.

That no attachment will be ordered while the validity of an agreement under which the injunction was obtained is disputed in a State court, see *Pentlarge v. Beeston* (1880), 1 Fed. Rep. 862; 18 Blatch. 38; 5 Bann. & A. 326.

decided. When these arise the court is forced to deny the application, and leave the plaintiff to pursue his remedy against the defendant by a supplemental or an independent action.

§ 1218. Preliminary Injunction: Order of Attachment: when Issued.

An order for attachment will not issue unless the violation of the injunction is clear, nor even then if the injunction was procured by strategy, and its violation was induced by the fraud of the plaintiff for the purpose of entrapping and punishing the defendant.¹ Where the plaintiff believes that the

§ 1218. ¹ That no attachment will be granted for contempt when there is reasonable ground to doubt the wrongfulness of the defendant's conduct, see *Bate Refrigerating Co. v. Gillett* (1887), 30 Fed. Rep. 685; 39 O. G. 833; *California Artificial Stone Paving Co. v. Molitor* (1885), 113 U. S. 609; 31 O. G. 1044.

That a clear case must be made out in proceedings for contempt or the court will not punish, and the court must have no substantial doubt that the defendant intended to violate the injunction, see *Allis v. Stowell* (1881), 19 O. G. 727.

That no attachment will be granted for contempt unless it is proved indisputably that the infringement still continues, see *Celluloid Mfg. Co. v. Chrolithian Collar & Cuff Co.* (1885), 24 Fed. Rep. 585; *Smith v. Halkyard* (1884), 19 Fed. Rep. 602; 26 O. G. 1020.

That a bond given by the defendant to the plaintiff four months before the injunction, acknowledging the validity of the patent and the plaintiff's right to all that was covered by it, is not evidence of a breach of the injunction except so far as it admitted that the defendant had infringed and it might thence be presumed that he still did so, a presumption that could be removed

by proof, see *Byam v. Eddy* (1853), 2 Blatch. 521; 24 Vt. 666.

That no attachment will be ordered against one who was not a party to the suit with notice of the injunction, see *Sickels v. Borden* (1857), 4 Blatch. 14.

That an attachment for contempt will not be granted unless notice of the motion has been served on the defendant, and the infringement complained of is committed either by him or by persons under his control, see *Bate Refrigerating Co. v. Gillett* (1885), 24 Fed. Rep. 696; 32 O. G. 1466.

That after an injunction is ordered upon condition that the plaintiff file a bond, the defendant, if present in court when such order was made, must take notice at his peril that the condition has been fulfilled, see *Burr v. Kimbark* (1887), 29 Fed. Rep. 428; 40 O. G. 246.

That knowledge that an injunction is ordered is equivalent to service as a ground for an attachment for contempt, see *United Telephone Co. v. Dale* (1884), L. R. 25 Ch. D. 778.

That where the plaintiff, having obtained an injunction, by strategy procures its violation by the defendant, and the defendant was innocent, no attachment will be ordered, see *Sparkman v. Higgins* (1846), 2 Blatch. 29.

That after an injunction has been

defendant is defying the prohibition of the court, he may obtain evidence against him by employing others to deal with him in the infringing enterprise, provided he resorts to no artifice or falsehood to secure the commission of the infringing acts; but where his conduct leads to the infringement he is estopped from urging it against the defendant as a contempt of court.

§ 1219. Preliminary Injunction: Penalty for Contempt.

A defendant, having been found guilty of contempt in violating an injunction, may be punished by fine or imprisonment, in the discretion of the court.¹ The amount of the fine is measured in ordinary cases by the damage which the plaintiff has sustained through the defendant's disobedience,² to which the costs and legal expenses incurred by the plaintiff on the application for attachment may be added.³ The amount

granted, the patentee may send persons to buy of the defendant in order to see if he is violating the injunction, and such sending is not an implied license to the defendant to sell, see *Knowles v. Peck* (1875), 42 Conn. 386.

That the plaintiff may show that he believed the defendant was violating the injunction, and took this method to find out, see *Knowles v. Peck* (1875), 42 Conn. 386.

That the report of a person sent by the plaintiff for this purpose is privileged and is no ground for an action of slander, see *Knowles v. Peck* (1875), 42 Conn. 386.

§ 1219. ¹ That the order adjudging the contempt need not aver that the injunction was lawful, nor recite the offence where the affidavits and reports filed do so and the order refers thereto, see *Fischer v. Hayes* (1881), 20 O. G. 601; 6 Fed. Rep. 63; 19 Blatch. 13.

² That where a preliminary injunction is violated the defendants are not obliged to pay a royalty, if they were acting in good faith and in an official capacity and were deriving no personal

benefit from the violation, see *Phillips v. City of Detroit* (1877), 16 O. G. 627; 2 Flippin, 92; 3 Bann. & A. 150.

³ In *Doubleday v. Sherman* (1870), 4 Fisher, 253, Blatchford, J.: (254) "The question in these cases is as to the extent of punishment to be awarded against the defendant, Boas, for his contempt of court in violating the injunction issued by the court. It is not contended that he ought not to pay the taxed costs, which are nine hundred and seventy-nine dollars and eleven cents, but opposition is made to the item of two thousand seven hundred and twenty-three dollars and seventy cents for solicitors and counsel fees, and disbursements, as ascertained and adjusted by the clerk under the order of the court. The incurring of such fees and disbursements was made necessary by the resistance which the defendant, Boas, made to the application for the attachment, and in the course of the proceedings before the master on the reference to take testimony as to the violation of the injunctions. The fact of the violation is established and that it

of these may be determined by the court, or by agreement, or by reference to a master for evidence and computation.⁴ Where the defendant has acted in bad faith or contumaciously, the penalty may be increased according to his ill deserts.⁵ In mitigation, on the other hand, the court may consider his pecuniary situation, or domestic difficulties, or the motive of the plaintiff in praying for the order.⁶ A committal for non-payment is incidental to the judgment for a fine, and is entirely distinct from imprisonment as a specific

was wilful, although the master reports that the extent of the violation was not shown by the proofs offered before him. The fact that the extent of the violation is not shown, — that is, the extent to which the plaintiffs were injured by the violation, is not a good reason for withholding the allowance of counsel fees and disbursements, which were made necessary to establish the violation itself, although it is a good reason for not imposing on the defendant a further pecuniary fine by way of indemnity to the plaintiff." 8 Blatch. 45 (46).

⁴ That in proceedings in equity for contempt, the fine may be imposed by an order made in the original suit, see *Fischer v. Hayes* (1881), 20 O. G. 601 ; 6 Fed. Rep. 63 ; 19 Blatch. 13.

That an order adjudging the contempt, and directing the amount of the penalty to be ascertained, does not exhaust the power of the court and may be followed by an order fixing the fine, see *Fischer v. Hayes* (1881), 20 O. G. 601 ; 6 Fed. Rep. 63 ; 19 Blatch. 13.

That a defendant being in custody under attachment for contempt, the case may be referred to the master as to the intention of the defendant, in order to aid the court in fixing the penalty, see *Goodyear v. Mullee* (1867), 3 Fisher, 259 ; 5 Blatch. 463.

⁵ That where the defendant acts in bad faith the penalty for contempt will

be severe, see *Craig v. Fisher* (1873), 2 Sawyer, 345.

That the penalty is measured in part by the perseverance of the defendant in his wrongful conduct, see *Potter v. Muller* (1865), 2 Fisher, 631 ; 1 Bond, 601.

⁶ That in fixing the penalty for contempt the situation of the defendant pecuniarily and domestically may be considered, see *Goodyear v. Mullee* (1867), 3 Fisher, 259 ; 5 Blatch. 463.

That the defendant, to mitigate the penalty for contempt, may show his inability to pay, but it must be clearly proved, see *Doubleday v. Sherman* (1870), 4 Fisher, 253 ; 8 Blatch. 45.

That where the violation of an injunction is not wilful and the object of the motion for attachment is to find out whether the defendant really infringes, he is liable only for the profits or damages and the costs of the motion, see *Ready Roofing Co. v. Taylor* (1878), 15 Blatch. 94 ; 3 Bann. & A. 368 ; *Schillinger v. Gunther* (1877), 14 Blatch. 152 ; 11 O. G. 831 ; 2 Bann. & A. 544.

That where the defendant has acted in good faith the penalty should be confined to the injury sustained by the plaintiff and costs, or to costs only, see *Iowa Barb Steel Wire Co. v. Southern Barbed Wire Co.* (1887), 30 Fed. Rep. 615 ; 40 O. G. 578 ; *Matthews v. Spangenberg* (1883), 23 O. G. 1624 ; 15 Fed. Rep. 813.

penalty.⁷ When the fine is paid there can be no commitment, or if paid after commitment the defendant is entitled to be released. Over the penalty itself the court has no authority after the term at which the judgment was rendered has expired, but it may at any time discharge a defendant whose confinement is contingent on his payment or ability to pay a fine.⁸ The order for commitment may be suspended for appeal on giving bonds with surety to pay the fine whenever the court may vacate the suspension, and reasonable time to file the bond will be allowed.⁹

⁷ In *Fischer v. Hayes* (1881), 20 O. G. 601, Blatchford, J. : (603) "It is suggested that section 725 provides for the punishment of a contempt by fine or imprisonment, and that therefore a commitment for non-payment of the fine is unlawful, because such commitment is imprisonment. There is, however, no commitment or imprisonment if the fine be paid. There is not commitment and fine. The punishment by a fine is fully inflicted under the terms of the order, if the fine be paid as the order directs, and in such case there can be no commitment. So, if there be a commitment for non-payment of the fine there must be a discharge as soon as the fine is paid. The payment of the fine is the punishment. The awarding or infliction of the fine is no punishment. The commitment is an incident of the fine. It is not in any manner the "imprisonment" allowed by the statute. The payment of the fine and a commitment for not paying it cannot co-exist. The commitment is not a separate punishment of imprisonment added to the payment of a fine. It is in this view that it has always been held that where a statute authorizes or prescribes the infliction of a fine as a punishment either for a contempt of court or for a defined offence it is lawful for the court inflicting the fine to direct that the party stand committed until the fine be paid, although there be no specific affirmative

grant of power in the statute to make such direction." 19 Blatch. 13 (21); 6 Fed. Rep. 63 (71).

⁸ That a contempt of court is a specific criminal offence and a fine is a judgment, see *Fischer v. Hayes* (1881), 20 O. G. 601; 6 Fed. Rep. 63; 19 Blatch. 13.

That the court has no power to vary the judgment for contempt after the term has expired, see *Fischer v. Hayes* (1881), 20 O. G. 601; 6 Fed. Rep. 63; 19 Blatch. 13.

That an order for commitment for contempt by failing to pay money is a civil order, not a criminal sentence, and may be revoked by the court if the defendant is unable to comply, see *Hendryx v. Fitzpatrick* (1884), 19 Fed. Rep. 810.

⁹ That an order of commitment for non-payment of a fine on contempt may be suspended for appeal, on giving bond with surety to pay the fine whenever the court may vacate the suspension, and reasonable time to file such bond may be allowed, see *Fischer v. Hayes* (1881), 7 Fed. Rep. 96; 20 O. G. 672; 19 Blatch. 184. For a form for carrying the above order into effect, see the case cited.

That no appeal lies to the Supreme court on a contempt proceeding, see *Hayes v. Fischer* (1881), 102 U. S. 121.

That when a judgment in contempt

§ 1220. Perpetual Injunction : when Granted.

A perpetual injunction issues, as a matter of course, at the conclusion of a suit in equity, whenever the plaintiff has sustained the allegations of his bill, provided the patent has not then expired.¹ It is granted irrespective of his right to profits or damages or any other form of relief, and though the infringement ceased at the allowance of the preliminary injunction and has not been since renewed, unless the court is satisfied that no further violation of the patent can be committed by the defendant.² When one of several patents which are joined in the same action, or one Claim of the patent, is found valid and the others void, an injunction on the valid Claim or patent will be ordered.³ Even although the patent has expired, if the infringing acts consist in the employment of articles made in defiance of the patent during its existence, an injunction against the use of these specific articles will be decreed.⁴ If the patent terminates between the interlocutory and the final decree, the subsequent extension of the patent entitles its owner to the exercise of these preventive powers.⁵ An assignee of the patent and of the damages for past infringements can also be protected by this equitable

involves a decision on the validity of the patent, the proceeding is reviewable in the Supreme court, and if reversed the interlocutory order in contempt may be reversed also, without prejudice to future proceedings, see *Worden v. Searls* (1887), 121 U. S. 14 ; 39 O. G. 359.

§ 1220. ¹ That if a decree finds an infringement a perpetual injunction will be ordered, see *Potter v. Mack* (1868), 3 Fisher, 428 ; *Goodyear v. Berry* (1868), 3 Fisher, 439 ; 2 Bond, 189.

² That the right to an injunction is independent of the right to profits or damages, see *Colgate v. International Ocean Tel. Co.* (1879), 17 O. G. 194 ; 17 Blatch, 308 ; 4 Bann. & A. 609 ; *American Cotton Tie Supply Co. v. McCready* (1879), 17 O. G. 565 ; 17 Blatch. 291 ; 4 Bann. & A. 588.

That although the infringement

stopped when the injunction issued the court will decree a perpetual injunction and account, there being no disclaimer of the right to use the invention by the defendant, and it not appearing that there were no damages or profits, see *Bullock Printing Press Co. v. Jones* (1878), 13 O. G. 124 ; 3 Bann. & A. 195. See also §§ 1191, 1205, and notes, *ante*.

³ See § 1211, note 2, *ante*.

⁴ See § 1211, note 3, *ante*.

⁵ That where a patent expires after the interlocutory decree, and hence no injunction is ordered on the final decree, the extension of the patent afterwards is a good ground for an injunction to be ordered, see *Bliss v. City of Brooklyn* (1871), 8 Blatch. 533 ; *Tilghman v. Mitchell* (1871), 4 Fisher, 615 ; 9 Blatch. 18.

means, however adequate may be the compensation which a court of law is able to afford.⁶ Thus in all cases the remedy is measured by and fitted to the threatened wrong, and whatever the defendant is adjudged to have done or attempted in the past, contrary to the plaintiff's demonstrated rights, he will be prohibited from undertaking or performing in the future, during the continuance of the monopoly.

§ 1221. Perpetual Injunction : Duration : Suspension.

A perpetual injunction is operative only during the life of the patent, and should be expressly limited thereto, except in reference to infringing articles constructed while the patent was in force and capable of use after it has expired.¹ Where it would cause no special harm to the defendant it may be granted after the hearing on the merits, but may be suspended till the acceptance of the master's report in order to allow time for an appeal.² It will not be suspended on the ground

⁶ That the rule as to injunctions applies to a bill by an assignee as well as to one by an inventor, see *Motte v. Bennett* (1849), 2 Fisher, 642.

That an injunction may be granted in favor of an assignee of the patent and of past damages, though for the latter he may be compelled to seek redress at law, see *Merriam v. Smith* (1882), 11 Fed. Rep. 588.

That an injunction will be granted in one State though the plaintiff's title in another State was derived from an assignor who had lost his rights by neglect, see *Gear v. Holmes* (1873), 6 Fisher, 595.

§ 1221. ¹ In *Nathan v. Elevated R. R. Co.* (1880), 2 Fed. Rep. 225, Wheeler, J.: (229) "An injunction issued in pursuance of a final decree should, by its terms, be limited to the time it may properly remain in force; and an injunction to restrain infringement of a patent can, of course, properly continue only during the term of the patent." 5 Bann. & A. 280 (284). See also *De Florez v.*

Raynolds (1880), 17 O. G. 503; 8 Fed. Rep. 484; 17 Blatch. 436; 5 Bann. & A. 140.

² In *Potter v. Mack* (1868), 3 Fisher, 428, Swayne, J.: (429) "The court decreed a perpetual injunction, and also a decree that the account should be taken. The case was referred to a master for that purpose, with a view to ascertain the amount of damages which were finally to be allowed to the plaintiff. An application is made that this final decree shall be suspended, as it regards the injunction, until the account shall be determined upon and the decree shall be finally made upon that account, and when the defendant, for the first time, will have the right to appeal. He cannot appeal from the decree as it at present stands, because, although the decision is final as to the merits of the case, it is in form an interlocutory decree only, and the rule established by the Supreme court is that an appeal can be taken only from a final decree. It has been held in this class of cases

that the patent is about to expire, nor that the defendant is bound by contracts with third parties if his obligations were assumed with knowledge of the plaintiff's claims, nor where the defendant has denied the usefulness of the invention and thus prevented the recovery of substantial damages.³ A suspension after final decree rests in the discretion of the court which granted the injunction, and on allowing it the court must protect the interests of all parties and secure the immediate cessation of the infringement.⁴ After a perpetual injunction has been ordered an appeal to the Supreme Court does not, of itself, suspend or supersede it.⁵

§ 1222. Perpetual Injunction by Consent.

The court may issue a perpetual injunction by consent of the defendant, as well as upon final hearing, unless the action or decree are evidently collusive; but in such cases it will not pass upon the patentability of the invention nor the validity of the patent in order to influence the course of future

that a decree is not to be considered final for the purposes of appeal until after the coming in of the master's report."

That an injunction is not to be suspended till final decree unless it would work some special hardship to the defendant, see *Potter v. Mack* (1868), 3 *Fisher*, 428.

³ That an injunction will not be suspended on the ground that the patent is about to expire, see *Brown v. Deere* (1881), 6 *Fed. Rep.* 487; 19 *O. G.* 1217; 2 *McCrary*, 425.

That an injunction will not be suspended to enable the defendant to perform contracts entered into with knowledge of the patent, see *Brown v. Deere* (1881), 6 *Fed. Rep.* 487; 19 *O. G.* 1217; 2 *McCrary*, 425.

That a final injunction will not be suspended while the decree is unreversed, except in case of some public necessity or other extraordinary interest outside the parties, and the defendant

cannot urge such reasons if he has denied utility and prevented the recovery of substantial damages, see *Munson v. Mayor of New York* (1884), 19 *Fed. Rep.* 313; 22 *Blatch.* 45.

⁴ That the suspension of an injunction after final decree rests with the court which granted it, and in so doing the court must protect all interests and pay due regard to the difference between royalties, licenses, and monopolies, see *Brown v. Deere* (1881), 6 *Fed. Rep.* 487; 19 *O. G.* 1287; 2 *McCrary*, 425. See also § 1212 and note 5, *ante*.

That a decree and injunction will be issued before a reference for an account unless the defendant shows that equity requires otherwise, see *Rumford Chemical Works v. Hecker* (1877), 11 *O. G.* 330; 2 *Bann. & A.* 386.

⁵ That a bond on an appeal after the final decree does not act as a *supersedes* on the injunction but only on the money judgment and costs, see *Whitney v. Mowry* (1867), 3 *Fisher*, 157; 2 *Bond*, 45.

litigation.¹ Where the terms of the consent are afterward disputed the injunction will be recalled, and the entire action be re-opened for a final hearing.² An injunction by consent is not dissolved by the granting and acceptance of a conditional license.³ When it appears, at any stage of the proceedings, that the action is collusive the case will be summarily dismissed.⁴

§ 1223. Perpetual Injunction: Violation: Dissolution.

A perpetual injunction may be violated by any of the acts which, under a preliminary injunction to the same effect, would be regarded as a contempt of court. The mode in which the plaintiff then obtains redress, and the measure of the penalty inflicted on the defendant, follow the rules already stated in reference to this offence. The dissolution of a perpetual injunction rests also on the principles before described, and may be ordered upon suitable application at any time within two years after the entering of the decree.¹

§ 1222. ¹ That a final injunction may issue upon a decree by consent, see *Tomkinson v. Willetts Mfg. Co.* (1884), 31 O. G. 918; 32 O. G. 382; 23 Fed. Rep. 895; *McWilliams Mfg. Co. v. Blundell* (1882), 22 O. G. 177; 11 Fed. Rep. 419.

That in granting a decree by consent no question upon the merits will be decided, see *American Middlings Purifier Co. v. Vail* (1878), 15 Blatch. 315; 4 Bann. & A. 1.

² That if on a motion for attachment for contempt of a decree by consent the terms of the consent are in dispute, the whole case will be opened and a final hearing had, see *Roemer v. Neumann* (1883), 19 Fed. Rep. 98.

That a decree by consent is not such a general decree as allows an attachment for contempt upon mere motion, but a bill must be filed and issues raised, see *Higby v. Columbia Rubber Co.* (1883), 18 Fed. Rep. 601.

³ That a conditional license is not ground for dissolving an injunction by consent, see *Pentlarge v. Beeston* (1880), 1 Fed. Rep. 862; 18 Blatch. 38; 5 Bann. & A. 326.

⁴ That a decree by collusion will be annulled and the case dismissed on the petition of strangers to it, see *Barker v. Todd* (1882), 15 Fed. Rep. 265; 23 O. G. 438.

That collusive suits are not entertained and proceedings thereon will be set aside, see *Gardner v. Goodyear Dental Vulcanite Co.* (1873), 3 O. G. 295; 6 Fisher, 329.

That suits are not to be prosecuted by agreement of both parties to carry out a compromise, one party paying all the expenses, see *Gardner v. Goodyear Dental Vulcanite Co.* (1873), 3 O. G. 295; 6 Fisher, 329.

§ 1223. ¹ See §§ 1213-1219, and notes, *ante*.

CHAPTER IV.

OF WRONGS BETWEEN CONTRACTING PARTIES: AND THEIR
REMEDIES.

§ 1224. Rights of Parties to Contracts concerning Patented Inventions Rest on the General Law of Contracts.

The reciprocal rights of Assignors and Assignees, of Grantors and Grantees, and of Licensors and Licensees, rest upon express or implied contracts between the parties. The law no otherwise creates them than as it permits the parties to enter into the agreements out of which they spring, and it protects them on the same grounds that it enforces other obligations. The subject-matter of these contracts being the patent privilege, or some immunity derived therefrom, the principles of patent jurisprudence form an important element in that body of law by which the contracts are interpreted and the relations and duties of the parties are determined. Apart from this element, however, the general law of contracts furnishes the measure by which their rights are ascertained, and the methods by which their wrongs may be redressed.¹

§ 1224. ¹ The collation and discussion of cases concerning these contract relations is rendered somewhat difficult by the failure of the courts to recognize and point out the similarities and differences which exist between the agreements of assignors and assignees, or grantors and grantees, on the one hand, and those of licensors and licensees on the other. As mere contracts relating to an interest in a patented invention all stand on the same footing, and the rules regarding their enforcement, or rescission, are practically the same. But in the nature of the rights which they

confer they are essentially distinct, and hence the obligations they impose and the estoppels to which they give rise are very different. An assignment or grant conveys the whole or a part of the monopoly, creates or purports to create a property in the transferee in consideration of which he pays or promises to pay the purchase money, and is governed by the same rules as to warranty, fraud, failure of consideration, &c., as any other sale of personal or real estate. A license, on the contrary, conveys and creates nothing, but is in itself a simple agreement not to enforce

§ 1225. Wrongs against the Rights of the Parties to a Contract concerning Patented Inventions are Breaches of Contract, even where they Infringe the Patent.

Wrongs committed by these parties against each other, whatever else they may involve, therefore embrace a breach of contract. The infringement of a patent, contrary to the terms of an agreement with its owner, is not less the violation of a covenant because it is the invasion of a patented monopoly. While the same person may occupy a two-fold relation toward the owner of a patent, one as his assignee or licensee within the scope of the conveyance, the other as a stranger outside the conveyance, and in the latter capacity may commit wrongful acts for which no contract suit would lie, yet when as a contracting party he has bound himself to respect the reserved rights of his grantor, and then infringes, his liability rests on a double basis and he may be pursued either upon his broken contract or for his tortious interference with the property of his grantor.¹ So far as any wrong committed by the parties interested in a patented invention constitutes or includes an infringement of the patent, the nature of that wrong and of its remedy has been sufficiently discussed in the preceding chapter. It remains, in the present, to consider those injuries which simply violate the agreements of the parties, and the redress which courts of equity or law afford.

the prohibitions of the monopoly against the licensee. Every user of the invention has the option to practise it in defiance of the patent, at the risk of a suit for infringement, or to exempt himself from liability to suit by submitting to the patent and paying the license fee, and having exercised this option and having enjoyed the exemption, in consideration of the royalty paid or to be paid, occupies toward his licensor, on all questions of estoppel, payment, &c., an attitude entirely different from that of a mere vendee of property. In the discussion of the subject in the text, these distinctions are preserved and the cases

are arranged in the notes, as far as was possible, to support and illustrate the doctrines thus formulated. But the real value of any case for either purpose cannot be estimated unless the classifications and principles given in the text are kept in mind, and these should, therefore, be examined in advance of any study of the notes.

§ 1225. ¹ That a licensee exceeding the privileges conferred by his license both violates the contract and infringes the patent, see *Pope Mfg. Co. v. Owsley* (1886), 87 O. G. 781; 27 Fed. Rep. 100.

§ 1226. As Contracting Parties, Assignors and Assignees and Grantors and Grantees Enjoy the same Rights and are Subject to the same Wrongs.

In reference to the nature and obligations of their contracts, grantors and grantees occupy the same relations toward each other as assignors and assignees. The grant is an assignment of the patent within an area less than the entire territory of the United States, and in the district granted the rights and duties of the grantee are identical with those of assignees. Being subject to the same wrongs and entitled to the same remedies as those whose contracts cover the whole area within which the monopoly prevails, they require no separate attention, and the rules hereafter stated in reference to assignors and assignees may be regarded as equally applied to them.

SECTION I.

OF THE WRONGS COMMITTED BY ASSIGNORS AGAINST ASSIGNEES : AND THEIR REMEDIES.

§ 1227. **Contract Rights of the Assignee against the Assignor.**

Under his contract with the assignor, an assignee is entitled to the conveyance of a perfect legal title to a valid patent, without fraud or imposition and with an exact fulfilment of the express and implied warranties which the contract contains. The violation of his rights by the assignor, therefore, consists either: (1) In a neglect or refusal to convey the patent; or (2) In the conveyance of a defective title; or (3) In the conveyance of an invalid patent; or (4) In deceit or artifice inducing the assignee to enter into the transaction; or (5) In breach of warranty. For each of these wrongs an adequate remedy exists, either in law or equity.

§ 1228. **Remedy of the Assignee when the Assignor Refuses to Convey the Patent.**

The neglect or refusal of the assignor to convey the patent to the assignee may be voluntary or involuntary. If involuntary, the only remedy of the assignee is by an action at law

upon the breach of contract. If voluntary, the assignee may sue at law for damages or obtain specific performance in a court of equity. A contract for the assignment of a patent, or an undivided interest therein, belongs to that peculiar class of contracts which equity will compel the parties to perform according to its terms, on the ground that otherwise irreparable injury may be inflicted.¹ An oral contract to convey a future patent, collateral to a contract for a partnership between the inventor and the assignee, will thus be enforced after the patent has been granted, although the inventor has repudiated the partnership agreement.² But the performance of an agreement whose fulfilment would be inequitable, or contrary to public policy, or ineffective on account of the previous conveyance or expiration of the patent, will not be decreed.³ Where the established principles of equity do not

§ 1228. ¹ That an agreement concerning a patent can be specifically enforced, see *Adams v. Messinger* (1883), 147 Mass. 185; *Fuller Co. v. Bartlett* (1887), 68 Wis. 73; *Hapgood v. Rosenstock* (1885), 23 Blatch. 95; 23 Fed. Rep. 86.

That equity will decree specific performance of a contract to assign a patent or an interest therein, see *Somerby v. Buntin* (1875), 118 Mass. 279; *Satterthwaite v. Marshall* (1872), 4 Del. Ch. 337.

That an oral agreement to convey a patent will be enforced, see *Searle v. Hill* (1887), 73 Iowa, 367.

That an agreement to assign all future inventions relating to a certain art may be defined and enforced in equity, see *Reese's Appeal* (1888), 122 Pa. St. 392.

² That an oral agreement of one person to give his interest in a future patent, and of the other to put in funds, and of both to render their services, is a partnership agreement, and the patent will be partnership property, and specific performance by the inventor will be decreed, see *Somerby v. Buntin* (1875), 118 Mass. 279.

³ That specific performance will not be decreed in favor of a party who has repeatedly broken the contract, though the other party was the first to break it, see *Ohio Steel Barb Fence Co. v. Washburn & Moen Mfg. Co.* (1886), 26 Fed. Rep. 702; 35 O. G. 1337; *Foster v. Goldschmidt* (1884), 28 O. G. 915; 22 Blatch. 287; 21 Fed. Rep. 70.

That if a party who has broken the contract has any remedy against the other, it is at law not in equity, see *Ohio Steel Barb Fence Co. v. Washburn & Moen Mfg. Co.* (1886), 26 Fed. Rep. 702; 35 O. G. 1337; *Werden v. Graham* (1883), 24 O. G. 101; 107 Ill. 169.

That equity will not decree specific performance where the order would be futile or afford imperfect relief, see *Wollensak v. Briggs* (1886), 37 O. G. 339; 20 Brad. (Ill.) 50; *Werden v. Graham* (1883), 24 O. G. 101; 107 Ill. 169.

That equity will not decree performance where the patent does not exist or defendant has no title, see *Kennedy v. Hazelton* (1888), 128 U. S. 667; *Kennedy v. Hazelton* (1888), 33 Fed. Rep. 293; 46 O. G. 973.

That specific performance of a contract to assign a patent may be decreed

permit the court to order a performance of the contract an indirect coercion may be exercised upon the assignor by an injunction, forbidding any transfer or enjoyment of the patent contrary to his agreement with the assignee.⁴ A voluntary refusal of the assignor to convey the legal title after the equitable interest has been transferred, or to remove a cloud upon the legal title already vested in the assignee, also demands the interference of a court of equity, which may compel the

when the rights of *bona fide* purchasers have not intervened, see *Whitney v. Burr* (1885), 115 Ill. 289.

That equity will not decree specific performance of a contract on one part to assign a patent, and on the other to manufacture the invention, after long delay and where the plaintiff has not kept his own agreements, see *Werden v. Graham* (1888), 24 O. G. 101; 107 Ill. 169.

That specific performance of a contract to assign will not be decreed if the plaintiff has been guilty of laches unless the defendant has acquiesced in the delay, and where a subsequent assignment has occurred the plaintiff must show tender or performance on his part and notice to the assignee, see *N. Y. Paper Bag Mach. Co. v. Union Paper Bag Mach. Co.* (1887), 32 Fed. Rep. 783.

That equity will not decree specific performance of a contract to render personal services requiring skill and judgment, nor where the exact thing to be done cannot be described, nor where it would involve the disclosure of an inventor's secret, see *Wollensak v. Briggs* (1886), 37 O. G. 339; 20 Brad. (Ill.) 50.

That a contract which is unconscionable and in a measure against public policy will not be enforced, see *Pope Mfg. Co. v. Gormully* (1888), 34 Fed. Rep. 877.

That an assignee before patent, having notice of a prior unrecorded assignment, and with such notice procuring the patent to himself, holds it in trust for the former assignee and may be com-

pelled to convey it to him, see *Pontiac Knit Boot Co. v. Merino Shoe Co.* (1887), 31 Fed. Rep. 286.

That a contract binds the persons who participate in it, though signed only by one representing the rest, see *Bean v. Clark* (1887), 40 O. G. 1454.

⁴ In *Singer Mfg. Co. v. Union Button Hole & Embroidery Co.* (1873), 4 O. G. 553, Lowell, J. : (555) "I think the fair result of the later cases may be thus expressed: If the case is one in which the negative remedy of injunction will do substantial justice between the parties by obliging the defendant either to carry out his contract or lose all benefit of the breach, and the remedy at law is inadequate, and there is no reason of policy against it, the court will interfere to restrain conduct which is contrary to the contract, although it may be unable to enforce a specific performance of it. It seems to me that this case comes easily within this rule. The court cannot, perhaps, superintend the performance of a contract to manufacture machines, but it can restrain the defendants from selling in violation of their agreement." Holmes, 253 (258); 6 Fisher, 480 (485).

That the owner of a patent, who has contracted to sell it to the plaintiff, may be enjoined from selling it to any one else, though no specific performance may be decreed, see *Adams v. Messenger* (1888), 147 Mass. 185; *Goddard v. Wilde* (1888), 17 Fed. Rep. 845.

That courts of equity will not inter-

assignor to execute the necessary instruments unless the assignee prefers the remedy of damages at law.⁵

§ 1229. **Remedy of Assignee when the Title Derived by him from the Assignor Proves Defective.**

Where the title proves defective after the contract is completed, and the assignee has fulfilled his part of the agreement, equity may compel the assignor to make it perfect, if it is in his power to do so; if not, the contract may either be rescinded and the parties placed in their original position, or the assignee may seek redress at law.¹ Equity will set aside the contract when the consideration of the assignment consisted of specific articles of property which ought to be returned to the assignee, or of the assumption of personal obligations from which he ought to be released. It will also rescind the contract when the failure of title is partial, and adequate compensation for the injury thereby inflicted on the assignee cannot be obtained at law. In ordering a rescission, the court protects the rights of all parties; and where the title is not totally defective the assignee must reconvey the patent to the assignor and must account for the benefits received from its enjoyment during his period of ownership,

pret contracts for ordinary parties, no trust relation existing, see *Florence Sewing Mach. Co. v. Singer Mfg. Co.* (1870), 4 Fisher, 329; 8 Blatch. 113.

⁵ That equity will compel one having the record title to convey to the true owner, see *Annie v. Wren* (1887), 51 Hun (N. Y.), 352; *Berolzheimer v. Strauss* (1884), 51 Sup. Ct. N. Y. 96.

That where a licensee conspired to acquire a prior patent and have it re-issued to cover the licensor's invention it is a fraud on the licensor, and equity may compel the licensee to assign to him the re-issued patent, see *Hale & Kilburn Mfg. Co.'s Appeal* (1883), 3 Pennypacker (Pa.), 378; *Everitt v. Hale* (1882), 15 Phila. 305.

That a cloud on the title to a patent may be removed in equity, see *Goodyear v. Day* (1856), 6 Duer, 154.

That a covenant to convey an extension is valid and enforceable in equity, see *Goodyear v. Day* (1856), 6 Duer, 154.

That equity will protect one to whom the patentee promises to assign the extended term, if after the extension he refuses or is unable to do so, see *Day v. Candee* (1853), 3 Fisher, 9.

§ 1229. ¹ That equity may compel the perfecting of an incomplete title, see *Goodyear v. Day* (1856), 6 Duer, 154. See also § 1228 and notes, *ante*.

That if the defective title can be made perfect by the assignor, the assignee cannot rescind, see *Marsh v. Scott* (1888), 125 Ill. 114.

That the assignee cannot claim both an enforcement and a rescission but must elect between them, see *Creighton v. Haggerty* (1884), 50 Hun (N. Y.), 9.

unless the loss exceeded the advantage or the assignor originally acted in bad faith.² Where the consideration for the assignment was a specific sum of money which has been already paid, and the title to the patent wholly fails, the assignee may sue at law for the recovery of the price, after a tender of the patent to the assignor.³ In all cases, whatever the consideration may have been, and whether the title is partially or entirely void, or the defect is curable or incurable by further conveyances from the assignor, an action for damages may be sustained upon the broken contract, their measure being determined by the loss which the defect of title has occasioned.

§ 1230. **Remedy of the Assignee when the Patent Proves to be Invalid.**

The conveyance of an invalid patent forms no consideration for a contract, and when an assignee has, in good faith and with due caution, parted with any property or assumed any obligation relying upon its validity, he is entitled on discovering the failure of consideration to a return of the property or a release from the obligation.¹ The ground of invalidity is immaterial. A patent void for want of novelty or practical utility in the invention affords as little consideration for a contract as one void for want of priority in the inventor, provided the assignee has exercised reasonable care in the exami-

² That the conveyance cannot be repudiated so as to free the vendee from the duty of paying the purchase money unless the invention be restored to the assignor, see *Sherman v. Champlain Transportation Co.* (1858), 31 Vt. 162.

³ That if the vendor had no title there is no consideration for the sale, see *Hardesty v. Smith* (1851), 3 Ind. 39; *Edwards v. Richards* (1834), Wright, (Ohio), 596.

That if the assignor creates a legal title which defeats the equitable title of his prior assignee he must refund the purchase money, see *Bellis v. Henwood* (1838), 6 Pa. Co. (Pa.) 78.

That if the title to the patent fails,

the vendee may recover the purchase money, see *Holden v. Curtis* (1819), 2 N. H. 61.

That the consideration expressed in the conveyance of a patent is not conclusive, and the true consideration may be shown, see *Wheeler v. Billings* (1868), 7 Transcript Ap. (N. Y.) 121.

§ 1230. ¹ That the assignment of a worthless patent-right is no consideration for a contract, see *Bierce v. Stocking* (1858), 11 Gray, 174.

That an assignee cannot rescind the contract on the ground that a defect exists in the patent if the defect can be remedied by the assignor, see *Marsh v. Scott* (1838), 125 Ill. 114.

nation of the invention before the purchase.² But the absence of pecuniary value in the invention does not avoid the patent, nor can the assignee complain of any defect which must have been apparent to him at the time of purchase, since the law does not undertake to prohibit the transfer of invalid patents, nor to assist an intelligent and voluntary purchaser in his repudiation of the sale.³ The remedy of the assignee of a void patent may be sought either in equity or at law. If the price paid was in money, the amount may be recovered in a suit at law, upon an offer to reconvey the patent to the assignor.⁴ When specific property is to be returned, or an obli-

² That where the patent is void on account of a defective specification, there will be no consideration for a note given for the purchase money, see *Keith v. Hobbs* (1878), 69 Mo. 84.

That if the patent is void because the invention is useless, the note given for it is without consideration, see *Rowe v. Blanchard* (1864), 18 Wis. 441; *Jolliffe v. Collins* (1855), 21 Mo. 388; *Fallis v. Griffith* (1833), Wright (Ohio), 308.

That if the invention will not answer its purpose without alterations, the patent will be void, and the vendee may repudiate the sale for failure of consideration, see *Cowan v. Dodd* (1866), 3 Cold. (Tenn.) 278.

That a useless invention is no consideration for a note, though both parties believed it to be useful, see *Lester v. Palmer* (1862), 4 Allen, 145.

That if the invention can be improved and made operative without introducing a new principle, the contract will not be avoided, see *Cowan v. Dodd* (1866), 3 Cold. (Tenn.) 278.

That if the invention is useful when sold, there is no failure of consideration, though subsequent ones supersede it, see *Harmon v. Bird* (1839), 22 Wend. 113.

That uselessness is no defence where the vendee bought on his own judg-

ment and without fraud, see *Hardesty v. Smith* (1851), 3 Ind. 39.

³ That "want of value" and "want of utility" are not the same thing, see *Burns v. Barnes* (1877), 58 Ind. 436.

That an interest in or license under a valid patent is a good consideration for a note or other contract, whether the interest has any pecuniary value or not, see *Nash v. Lull* (1869), 102 Mass. 60; *Howe v. Richards* (1869), 102 Mass. 64, note.

⁴ That money paid for a void patent can be recovered back, see *Darst v. Brockway* (1842), 11 Ohio, 462.

That when the vendee pays the purchase money, with full knowledge of all the facts, he cannot recover it, see *Stevens v. Head* (1837), 9 Vt. 174.

That if the vendee has derived benefit from the sale he cannot recover back the price paid, though the patent is void, see *Holden v. Curtis* (1819), 2 N. H. 61.

That in an action to recover back the price on the ground that the patent is invalid the patent must be re-assigned or tendered to the seller, see *Dillman v. Nadelhoffer* (1885), 19 Brad. (Ill.) 375.

That if the patent is void because the invention is not new and useful the note given therefor is void, and the vendee need not offer to re-assign, see

gation released, the contract must be set aside in equity, and the parties restored to their former condition. Where general damages will compensate the assignee, an action at law for these may be maintained. The conveyance of a patent for a different invention from that which forms the subject-matter of the contract is equivalent, in its effect, to the conveyance of an invalid patent. The assignee is not bound to accept it, but may rescind the contract and recover back the price, or have such other relief as the case requires. If he accepts the conveyance, however, and avails himself of the advantages of the invention therein described, he is estopped from setting up the departure from the contract, either as a cause of action or a defence against the assignor.⁵

§ 1231. Remedy of the Assignee when the Assignor Procured the Assignment through Deceit.

Where the assignor has by deceit or artifice induced the assignee to enter into the contract it may be set aside in equity, or the assignee may have his remedy for damages at law.¹ The distinction, which elsewhere prevails between the

National Bank v. Peck (1871), 8 Kan. 660.

That where benefits have been received the contract cannot be rescinded, but only an action for damages will lie, see Moore v. Bare (1860), 11 Iowa, 198.

⁵ That the vendee of a patent-right may recover back his money if the patent-right was not what he agreed to buy, unless he has accepted a deed describing it, and if he has he cannot recover unless there was fraud or a warranty, see Foss v. Richardson (1860), 15 Gray, 303.

That if the right agreed to be assigned differs from that covered by the patent, the sale is void, and the purchase money, if paid, is recoverable, see Burrell v. Jewett (1830), 2 Paige, 133.

That if the patent is referred to by its date in the assignment it will be presumed that the vendor examined it,

and the doctrine of *caveat emptor* will apply, see Myers v. Turner (1855), 17 Ill. 179.

That an assignment by the vendee to other persons does not estop him from claiming invalidity, see Hawks v. Swett (1875), 4 Hun (N. Y.), 146; 6 Thomp. & C. 529.

§ 1231. ¹ That the assignee of a patent may have the assignment rescinded for fraud in the representations of the assignor as to the patented invention, see Hall v. Orvis (1872), 35 Iowa, 366; and cases cited in other notes under this paragraph.

That a corporation purchasing the right to sell an invention may rely on the statements of the vendors and is not bound by the rule *caveat emptor*, and may sue for fraudulent representations though they were made to the persons forming such corporation before it was

expression of an unfounded opinion and the averment of a falsehood, is equally applicable to the vendor of a patent. Extravagant recommendations are to be expected from the owner of any commodity which he desires to sell, and buyers must be on their guard in order not to be misled. Thus representations of the assignor concerning the probable value of the invention to the assignee, though false, are not such fraud as warrants a rescission of the contract unless the vendor knew that the vendee was ignorant and was relying upon his opinion.² But statements affirming the validity of the patent, or the novelty or utility or salability or cost of the invention, if made with an intention to deceive the assignee and acted on by him, constitute a sufficient ground for the avoidance of the assignment in equity, or the recovery of damages at law.³ These fraudulent assertions furnish the same occa-

organized, see *Iowa Economic Heater Co. v. American Economic Heater Co.* (1887), 32 Fed. Rep. 735.

That the assignee may rescind the assignment for fraud and recover the price paid or the property conveyed as the consideration, see *Marsh v. Scott* (1888), 125 Ill. 114.

That the assignee may sue the assignor for fraudulent statements which induced him to purchase the patent, see *Bull v. Pratt* (1815), 1 Conn. 342; and other cases cited in the notes to this paragraph.

² That false representations as to the amount already offered for the right are not such warranties of value as will avoid the contract of sale, or sustain an action for deceit, see *Dillman v. Nadelhoffer* (1885), 19 Brad. (Ill.) 375.

That a statement by the vendor that the invention would be useful to the vendee is a mere expression of opinion, not a fraud, see *Louden v. Birt* (1853), 4 Ind. 566.

That representations as to value are mere opinions, and cannot avoid the sale, since only falsehoods as to matters of fact can do that, see *Neidefer v. Chastain* (1880), 71 Ind. 363.

That a contract of sale will be rescinded for false representations of the vendor as to the value of the patent, the vendee being ignorant and relying on the vendor, see *Page v. Dickerson* (1871), 28 Wis. 694.

³ That in an action for fraud the plaintiff may show that the patent is invalid on account of a prior patent, see *Bull v. Pratt* (1815), 1 Conn. 342.

That a sale may be avoided on account of false representations of the vendor that the invention was never before patented, and was never used except under the patent sold, see *Morrow v. Brown* (1869), 31 Ind. 378.

That a sale procured by false representations of the vendor as to the novelty and usefulness of the invention is void, see *Johnson v. McCabe* (1871), 37 Ind. 535.

That a vendee has a right to rely on the vendor's representations as to the salability of the invention, see *Hull v. Fields* (1882), 76 Va. 594.

That wilful falsehoods of the vendor as to the cost of making the invention are fraud, see *Peffley v. Noland* (1881), 80 Ind. 164.

That a vendor is not bound by his

sion for relief whether made in words or by the exhibition of false devices purporting to be the patented invention, and whether proceeding from the assignor himself or from his agents.⁴ The consequences of the fraud are not averted by the ability of the assignee to have discovered the deceit by resorting to the records of the Patent Office, or by an inquiry of persons skilled in the art.⁵ If the assertions of the assignor relate to matters of existing fact, and are intended to influence the action of the assignee, his reliance upon them without further investigation is not, as between the parties, evidence of undue credulity, unless the assertions were manifestly untrue or absurd, or the assignee has neglected such precautions as every prudent man would have observed.⁶ A rescission of the contract on the ground of fraud must be made promptly after its discovery. The subsequent exercise of ownership over the patent, and the enjoyment of its benefits, will affirm the sale and deprive the assignee of his equitable remedy.⁷ Nor can the advantages derived from the invention

representations as to the validity of the patent, or the novelty or priority of the invention, unless he was guilty of fraud, see *Rawson v. Harger* (1878), 48 Iowa, 269.

⁴ That the vendee of a patent-right may rely on the representations of the vendor as to what the patent covers, and if the part shown to the vendee is not covered it is a fraud, see *Rose v. Hurley* (1872), 39 Ind. 77.

That a sale will be set aside for fraud of the vendor by falsehoods concerning the value and utility of the invention, and the employment of false devices in exhibiting it, see *Gardner v. Trenary* (1885), 65 Iowa, 646.

That statements as to utility, made in the presence of the vendor by one who travelled with him in selling the patent-right, are binding on the vendor, see *Foster v. Trenary* (1885), 65 Iowa, 620.

⁵ That a vendee may sue the vendor for false representations as to what was

covered by the patent, or not covered by an earlier patent, though by searching the records in the Patent Office he could have discovered the error, see *David v. Park* (1870), 103 Mass. 501.

That if the patent is void on account of a prior patent for the same invention, and the vendee was induced to purchase by the fraudulent statements of the vendor that it was valid, he may re-assign the patent and rescind the sale, though by searching the records of the Patent Office he might have discovered the fraud, see *McKee v. Eaton* (1881), 26 Kan. 226.

⁶ That where both vendor and vendee have equal knowledge, or means of knowledge, equity will not relieve, if both parties were in good faith, see *Rawson v. Harger* (1878), 48 Iowa, 269.

⁷ That if the vendee exercises ownership over the patent after he discovers the fraud, it will affirm the sale, see *Dunks v. Fuller* (1875), 32 Mich. 242.

That where a vendee, after he dis-

before the fraud was discovered be retained by the rescinding assignee. The contract becomes void from its beginning, and the mutual restoration of all its results, on either side, must follow.⁸ A bill in equity to set aside the assignment, therefore, must allege that no benefits have been received since the discovery of the fraud, and must offer to return those which had previously accrued.⁹ When the patented invention is entirely worthless, and the assignee has been induced to purchase it by the fraudulent representations of the assignor as to its value, the price may be recovered in a suit at law without a prior rescission of the contract or an offer to return the patent to the assignor.¹⁰ But where the parties were of equal knowledge or in equal fault, or where the purchase money has been paid after a full acquaintance with the facts, no action to recover it will lie. A suit for damages, leaving the contract still in force so far as the ownership of the patent is concerned, can always be sustained when actual fraud has been committed by the assignor.¹¹ In proof of his guilty

covers the fraud, acquiesces in it and takes the benefit of the sale, other parties not interested in the sale cannot avoid it, that power being confined to him and those who share his rights, see *Edmunds v. Hildreth* (1854), 16 Ill. 214.

⁸ That where the vendee has benefited by the assignment he cannot have it rescinded, and recover back the purchase money on the ground of fraud, unless he accounts for the benefits received, see *Edmunds v. Myers* (1854), 16 Ill. 207; *Edmunds v. Hildreth* (1854), 16 Ill. 214.

⁹ That a bill to rescind an assignment on the ground of fraud must aver that the benefits were received before the fraud was discovered, and must offer to return the profits received, see *Edmunds v. Myers* (1854), 16 Ill. 207; *Edmunds v. Hildreth* (1854), 16 Ill. 214.

¹⁰ That the purchase money may be recovered on the ground of the vendor's fraudulent representations as to the

value of the patent, and if the patent is entirely worthless no tender to return it is necessary, see *Hess v. Young* (1877), 59 Ind. 379.

That where the vendor agrees to return the purchase money if the vendee fails to realize a certain sum within a given time, the vendee is bound to make reasonable efforts to sell, considering his ability and means, though if he has no means and does not speak English, he is not bound to embark in the manufacture of the invention, see *Berger v. Peterson* (1875), 78 Ill. 633.

That if the vendee, with a right to rescind if the enterprise is unsuccessful, makes reasonable efforts, and the vendor prevents sales from being made, the vendor must pay back the price with interest, though before the time was up the vendee had refused to reconvey, see *Berger v. Peterson* (1875), 78 Ill. 633.

¹¹ That a vendee of territory, some of which the vendor did not own, may sue for damages without offering to re-

knowledge, similar false assertions in other transactions relating to the same invention may be shown.¹²

§ 1232. Remedy of Assignee for Breach of Warranty.

An assignment of a patent raises an implied warranty of title, but not of the validity of the patent nor of the practical value of the patented invention.¹ An action for breach of warranty will, therefore, lie only where the title proves defective, unless the instrument of conveyance contains express covenants which have been broken by the assignor. Such covenants may relate directly to the patent or by necessary implication warrant its validity. In either case they create rights which can be vindicated by an action at law for damages. Where the assignor of the patent is himself an assignee, and both parties are in equal ignorance concerning the patentability of the invention, no question as to an implied warranty of validity can arise.²

assign, and will be allowed damages in proportion to the value of such unsold territory to the whole area, as shown by the price paid, see *Moorehead v. Davis* (1883), 92 Ind. 303.

¹² That fraud in effecting sales to others may be proved to show guilty knowledge in the same acts toward the vendee, see *Foster v. Trenary* (1885), 65 Iowa, 620.

§ 1232. ¹ That the assignment of a patent carries an implied warranty of title, see § 783 and notes, *ante*.

That a vendee in an action against the vendor on an implied warranty must show that he has been disturbed in the enjoyment of the right, or that the vendor had no right which he could convey, see *Stevens v. Head* (1837), 9 Vt. 174.

That a warranty of the exclusive right within a given territory extends only to the specific inventions conveyed to the vendee, see *Kingman v. Martin* (1887), 24 Ill. Ap. 435.

That a covenant not to make, use or sell any device for the same purpose is

too broad and against public policy, see *Berlin Mach. Works v. Perry* (1888), 71 Wis. 495.

That there is no implied warranty of validity in the sale of a patent right, see *Hiatt v. Twomey* (1836), 1 Dev. & Bat. Eq. (N. C.) 315.

That if the title to the patent passes to the vendee the consideration paid cannot be recovered back unless the contract has been rescinded, or was tainted with fraud, or there was an express warranty which has been broken, see *Case v. Morey* (1818), 1 N. H. 347.

² In *Johnson v. Willimantic Linen Co.* (1866), 33 Conn. 436, Butler, J. : (442) "It is not material to enquire whether or not generally, on the sale of a patent-right, there is an implied warranty of its validity. There is undoubtedly a strong current of authority in that direction. And the cases in this country where in actions for the price of a patent-right or patented machine the defendant has prevailed on the ground of a failure of consideration, are quite numerous. Where there was an ex-

SECTION II.

OF WRONGS COMMITTED BY ASSIGNEES AGAINST ASSIGNORS: AND THEIR REMEDIES.

§ 1233. Rights of Assignor against Assignee.

An assignor, under his contract with the assignee, acquires a right to an acceptance of the conveyance of the patent, to the performance of the conditions embraced in the assignment, and to the payment of the stipulated price. He also has the right, implied in every contract, to honesty and fair dealing on the part of the assignee. His rights are, therefore, violated when the assignee refuses to execute the contract, or to fulfil his obligations under it, or to pay the purchase money according to the terms of the agreement, or when he takes undue advantage of the ignorance or credulity of the assignor.

§ 1234. Remedy of Assignor when the Assignee Refuses to Accept the Assignment.

The wrong committed by the refusal of the assignee to accept the conveyance of the patent, when duly tendered by the assignor, can generally be redressed only in a suit at law for

press warranty, or the vendor by representation expressly professed to sell the patent as a valid one, and the purchaser relied on that profession, or where the vendor knew that there was a defect in the patent and that it was invalid and concealed the fact (although he made no express representation whatever), and in such concealment was guilty of fraud, the correctness of the decisions cannot be questioned. And one or another of these elements existed in a majority of the cases collected by Mr. Law in his Digest, many of which have been cited on this trial. But it is questionable whether as between two assignees of a patent-right, neither of whom has any opportunity to know whether it is invalid for want of novelty or not, especially since the re-organization of

the Patent Office and a provision for a determination of that question by examiners before the patent is granted, and a series of Federal decisions holding such a patent *prima facie* evidence of novelty, the vendor who acts in good faith, in the absence of fraud, express warranty, or any representation or fact other than the mere fact of sale indicating that he sold the patent as valid, the vendor should be holden to an implied warranty and failure of consideration on that ground, if in fact invalid, or the vendor be permitted to defend upon the ground of a mutual misconception of a fact. The English courts would not now so hold on either ground; and I am inclined to think that, upon principle, a discrimination should be made here."

damages. The injury inflicted on the assignor by such refusal is not irreparable to a degree which calls for equitable interference, when it merely leaves the patent in his hands and withholds the service or the money which was to form the consideration for its transfer. There are, however, cases in which the obligations imposed by the contract on the assignee are of such a character that justice cannot be done to the assignor except by a specific performance of the agreement, and in these cases equity will compel its execution, not because the transaction related to a patent privilege, but on account of the peculiar circumstances of the parties and the necessity for this extreme relief.¹ Thus where the consideration to be given for the patent was the conveyance of real property, or the surrender of some right essential to the assignor, the terms of the agreement may be explicitly enforced, and the assignee may be obliged to transfer or release the stipulated property or claim.²

§ 1235. Remedy of Assignor for Breach of the Conditions in the Assignment.

For the injury inflicted on the assignor by the non-fulfilment of conditions imposed by the assignment on the assignee, a remedy in damages may be obtained at law. Where the conditions are made essential to the title of the assignee, or are in their nature necessary to the enjoyment of the reserved rights of the assignor, the failure to perform them forfeits the interest of the assignee in the patent, and on a proper application equity will decree a reconveyance.¹ Conditions embraced in the assignment, but which the assignee does not expressly or impliedly promise to perform, though working a forfeiture of his interest in the patent, can neither be enforced in equity nor made the basis of a suit at law.²

§ 1234. ¹ See § 788 and notes, *ante*.

² See § 1229, *ante*.

§ 1235. ¹ See § 788 and notes, *ante*.

That if the assignor rescinds for breach of contract he must return the purchase money or other consideration already paid, see *Bellis v. Henwood* (1888), 6 Pa. Co. (Pa.) 78.

² That an assignment on conditions, not containing any express agreement to perform the conditions, may be forfeited by not performing, but cannot be enforced, nor is the party liable in damages for non-performance, see *Newell v. Wheeler* (1866), 4 Rob. (N. Y.) 247; *Newell v. Wheeler* (1866), 2 Abb. Pr. 134.

§ 1236. **Remedy of the Assignor when the Assignee has Procured the Assignment by Fraud.**

The wrong committed by the fraud or unfair dealing of the assignee, in obtaining the conveyance of the patent, may be redressed either at law or equity. If the assignor prefers to treat the conveyance as effective and permit the assignee to retain the patent, he may have his remedy in damages commensurate with the value of the patent of which he has been deprived. But when he desires to rescind the sale equity will afford him this relief on his return of the consideration, and in addition will compel the assignee to account for the benefits which he has received. Where the assignee has not been guilty of actual fraud, but has obtained the patent for an inadequate price through the ignorance of the assignor as to its true value, the contract will be set aside upon the restoration of the purchase money and the payment of a reasonable compensation for the services and expenses of the assignee.¹

§ 1237. **Remedy of Assignor when the Assignee Refuses to Pay the Purchase Money.**

Upon the neglect or refusal of the assignee to pay the purchase money for the patent, the assignor may recover the amount in assumpsit, debt, or covenant, according to the form of the contract.¹ To such an action several defences may be urged in addition to a general denial of the obligation, among which are the failure of the title conferred upon the assignee, the invalidity of the patent, and fraud or breach of warranty on the part of the assignor. Concerning each of these defences certain questions have arisen, and been decided, which demand especial mention.

§ 1236. ¹ That where a vendor is ignorant of the value of the patent, and a vendee knowing its value purchases it at an inadequate price, and under suspicious circumstances, the sale will be set aside on payment to the vendee of his expenses and a reasonable compensation for his services, see *Leonard v. Barnum* (1874), 34 Wis. 105.

§ 1237. ¹ That equity will not set aside the assignment of a patent on the

ground that the purchase money has not been paid, see *Perkins v. United States Electric Light Co.* (1883), 24 O. G. 204; 21 Blatch. 308; 16 Fed. Rep. 513.

That the vendee, being bound to pay \$1000 within a year or to re-assign the patent, may re-assign on a demand of the money a few days after the year expires, and must then either re-assign or pay, see *Manvel v. Holdredge* (1871), 45 N. Y. 151.

§ 1238. Defences of the Assignee against the Assignor's Action for the Purchase Money : Defective Title.

An assignor whose title, at the time of his conveyance, was defective, or who has failed for any other cause to confer upon the assignee a complete right to the patent, has not performed his own part of the contract and therefore cannot claim the stipulated price.¹ Thus where he is himself an assignee and his assignment is imperfect or remains unrecorded at the risk that a superior title may be gained by others, or where the instrument delivered to the assignee is insufficient to transfer the legal title to the patent, or where a cloud rests on the title affecting its validity or rendering its extent uncertain, the assignee may properly withhold the purchase money till these difficulties are removed, and meanwhile may employ them as a defence against an action brought for its recovery.² In this defence the burden of proof lies on the assignee, unless he has been actually disturbed in the enjoyment of the patent by the assertion of a superior title.³

§ 1238. ¹ That want of title in the assignor is a good defence against his action for the purchase money, see *Nye v. Raymond* (1854), 16 Ill. 153.

That the vendee may show in his defence that there is no such patent as the one assigned to him, see *Brown v. Wright* (1856), 17 Ark. 9; *Nye v. Raymond* (1854), 16 Ill. 153.

That an agreement to procure and assign a patent never executed, and incapable of being executed because the invention is not patentable, is no consideration for a promise to pay money, and no price can be recovered, see *Westervelt v. Fuller Mfg. Co.* (1885), 13 Daly, 352.

² That an unrecorded assignment gives a vendor no such title as enables him to maintain an action against his vendee for the price, see *Higgins v. Strong* (1836), 4 Blackf. (Ind.) 182. This case assumes, however, that a record is essential to validity of title, which is untrue.

That where an assignee re-assigned to the inventor in order that the inventor might take out a patent in his own name, and the inventor gave the assignee his note therefor, and afterward the assignee obtained a patent for part of the former invention as his own, and the inventor was refused a patent on the ground of the assignee's prior patent, the note of the inventor to the assignee is still collectible, it being presumed that the assignee had a right to the patent he obtained and that the inventor had no right to the patent for which he applied, see *Clark v. Smith* (1875), 21 Minn. 539.

³ That a vendee when sued for the price has the burden on him to show that the vendor had no title, unless he has been disturbed in his use of the invention, see *Stevens v. Head* (1837), 9 Vt. 174.

§ 1239. Defences of the Assignee against the Assignor's Action for the Purchase Money: Patent Invalid.

An assignee may defend against an action for the purchase money by showing that no patent answering the description of the assignment ever issued, or that the one described is void, either for want of novelty or utility in the invention or on account of its abandonment before the application, or by reason of a defective specification or excessive Claims, or for substantial variations in a re-issue, or any other cause which would defeat the patent in an action for infringement.¹ Under but one of these objections does any serious question of law arise. It has been urged in many cases that the art or instrument protected by the patent must possess pecuniary value in order to entitle the assignor to recover the price of the patent

§ 1239. ¹ That the vendee may defend on the ground that there is no such patent as the one sold, see *Brown v. Wright* (1856), 17 Ark. 9; *Nye v. Raymond* (1854), 16 Ill. 153.

That the defence against an action for the price and a suit to recover back the purchase money stand on different grounds, see *Stevens v. Head* (1837), 9 Vt. 174.

That the invalidity of the patent is a defence on the ground of a failure of consideration, see *Marston v. Swett* (1876), 66 N. Y. 206; *Nye v. Raymond* (1854), 16 Ill. 153. See also § 1230 and notes, *ante*.

That notes given for a void patent are not collectible by the vendor, and their collection may be enjoined, see *Darst v. Brockway* (1842), 11 Ohio, 462.

That if a patent is found void on the ground of prior public use and abandonment, a note given for an interest therein is also void, see *Earl v. Page* (1834), 6 N. H. 477.

That no recovery of purchase money can be had where the patent is void for a defective specification, see *Keith v. Hobbs* (1878), 69 Mo. 84.

That if a patent for an improvement

does not so describe the original that the improvement can be known, the patent is defective and the vendee is not liable for the price, see *Cross v. Huntley* (1835), 13 Wend. 385.

That the vendee of a patent void for excessive Claims is bound by the sale unless he repudiates it before the defect is cured by disclaimer, see *Hotchkiss v. Oliver* (1848), 5 Denio, 314.

That no rights of estoppel arise on a *nudum pactum*, and if the patent is void a note based thereon is *nudum pactum*, see *Saxton v. Dodge* (1870), 57 Barb. 84.

That in defending against an action on a note, on the ground that the patent is void, the patent is attacked only collaterally, by way of evidence, see *Saxton v. Dodge* (1870), 57 Barb. 84.

That where the vendor of the patent is himself an assignee, and both he and his vendee are on equal ground as to knowledge of the validity of the patent, and he is guilty of no fraud or concealment, he may recover the purchase money though the patent be invalid, see *Johnson v. Willimantic Linen Co.* (1866), 33 Conn., 436.

from the assignee. But the courts have drawn a broad and clear line of distinction between that uselessness of the invention which avoids the patent and that worthlessness in the market which makes its ownership unprofitable to the assignee. A want of pecuniary value in the invention is no defence to an action for the purchase money, in the absence of fraud or warranty on the part of the assignor.² That the patented article has been superseded in the market, or cannot be employed in certain territory, or is universally unsalable, does not prove nor tend to prove that the patent is invalid or that the assignee has not received the property for which the price was to be paid.³ A want of utility in the invention itself, on the other hand, is a good defence to an action for the purchase money, since the patent being invalid there is no consideration for its payment.⁴ Thus where the invention has not been or cannot be reduced to practice, or will not answer its intended purpose without such alterations as require inventive skill, the contract is not binding, although both parties acted in good faith, believing that the invention was available in its appropriate art.⁵ But even here the as-

² That pecuniary worthlessness is no defence, see *Miller v. Finley* (1872), 26 Mich. 240.

That a note for the price is good, if the patent is valid, though the invention is of no great utility, see *Green v. Stuart* (1874), 7 Baxter (Tenn.), 418.

That if any value exists, however small, the notes given for the patent will be valid, see *Myers v. Turner* (1855), 17 Ill. 179.

³ That the invention has been superseded is no defence, if it were useful when sold, see *Harmon v. Bird* (1839), 22 Wend. 118.

That the vendee cannot defend on the ground that there is no use for the invention in the territory sold to him, if it is *per se* useful, see *Pottle v. Thomas* (1838), 12 Conn. 565.

That when the specification calls for "water" simply, any water must answer the purpose, and if the water found

in the territory sold will not answer the patent is void, see *Keith v. Hobbs* (1878), 69 Mo. 84.

That unsalability is no evidence of inutility, see *Jolliffe v. Collins* (1855), 21 Mo. 338.

⁴ That the vendee in an action for the price can defend on the ground that the invention was neither new nor useful, though both parties were in good faith, see *Jones v. Burnham* (1877), 67 Me. 93; *Midkiff v. Boggess* (1860), 15 Ind. 210; *McClure v. Jeffrey* (1856), 8 Ind. 79; *Geiger v. Cook* (1842), 3 Watts & Serg. 266. See also § 1230 and notes, *ante*.

That "useful" means "lawfully useful," at least as far as the consideration for a note is concerned, see *Pacific Iron Works v. Newhall* (1867), 34 Conn. 67.

⁵ That if the invention cannot be made practically operative without a

signee who buys on his own judgment, and who without fraud or misconduct by the assignor assumes the entire risk of the utility of the invention, must abide by his agreement and complete the purchase.⁶ The utility necessary to sustain the patent is presumed from the existence of the patent, though it may be disproved by the assignee.⁷ When this defence is set up by the assignee he should offer to return the patent and account for the profits made in its enjoyment, but when the patent is found void no actual return is necessary.⁸ This

further exercise of inventive skill, the patent is void, and the price cannot be recovered, see *Cowan v. Dodd* (1866), 3 Cold. (Tenn.) 278.

That in an action to recover an amount agreed to be paid for future inventions of the plaintiff, the defendant may show that they are worthless, have not been reduced to practice, and were known as worthless before the plaintiff invented them, see *McDougall v. Fogg* (1858), 2 Bosw. (N. Y.) 387.

That uselessness is a defence only when the patent would be void for want of utility, see *Wilson v. Hentges* (1879), 26 Minn. 288.

That the entire uselessness of the invention is a full defence to an action for the price though the patent may be authentic, see *Smith v. Hightower* (1886), 76 Ga. 629; *Clough v. Patrick* (1865), 37 Vt. 421.

That a note given for a patent-right, if negotiable, can be collected by a *bona fide* holder, though the patent is worthless, see *Woolen v. Ulrich* (1878), 64 Ind. 120.

⁶ That a vendee who buys on his own judgment cannot defend on the ground of inutility, see *Hardesty v. Smith* (1851), 3 Ind. 39.

⁷ That the jury are to judge of utility, see *Rowe v. Blanchard* (1864), 18 Wis. 441.

That on an issue as to the validity of a patent, in a suit between the vendor and vendee, the court must instruct the

jury though not all the points are argued before the court, see *Bollas v. Hays* (1819), 5 S. & R. 427.

That it is presumed that an invention is valuable until the contrary is shown, see *Gerrish v. Bragg* (1883), 55 Vt. 329.

That in an action on a note given for a patent-right the patent is not conclusive evidence of the utility of the invention, see *Bierce v. Stocking* (1858), 11 Gray, 174.

⁸ That in an action against the vendee for the price, the record of a report of an examiner in the Patent Office, on an application for an extension, is not competent evidence against the patentee to show that the patent was originally invalid, see *McMahon v. Tyng* (1867), 14 Allen, 167.

That evidence of the invalidity of the patent is not admissible in an action for the price unless the Federal courts have declared the patent invalid, see *Elmer v. Pennel* (1855), 40 Me. 430; *contra*, *Nash v. Lull* (1869), 102 Mass. 60.

⁸ That unless the vendee offers to return the patent, and account for the profits made by it, or avers that it had no value, he cannot defend an action for the purchase money on the ground of failure of consideration, see *Burns v. Barnes* (1877), 58 Ind. 436.

That where an assignment is made before the invention is tested, and there is no warranty of utility and no fraud, the vendees must pay the purchase money if they use it either in part or as a

defence is complete even when the assignor, besides conveying the patent, has also furnished materials to the assignee for the invention and given him instructions how to use them.⁹ The assignee must, however, spread the facts which prove the invalidity upon the record, though the judgment of the court upon them is only collateral and introductory to that on the main question as to the existence of the debt.¹⁰ Where the patent is found void as to a portion of its Claims and valid as to others, if the price can be apportioned the assignor can recover the amount which may be due for the conveyance of the valid Claims.¹¹ An assignee, who has transferred his interest in the patent to third parties, cannot avail himself of this defence unless his assignees rescind their contract with him, or refuse to pay, or have subjected him to other loss on this account; and if he does defend, he must return the patent to the assignor except perhaps in cases where its irremediable invalidity is fully proved.¹² The right

whole, though they cannot use it if it be useless, see *Palmer's Appeal* (1880), 96 Pa. St. 106.

That if the vendee has derived any benefit from the patent the plaintiff can recover the price unless there was a warranty or fraud, and evidence that the patent was of little value is not admissible, see *Vaughan v. Porter* (1844), 16 Vt. 266.

That a vendee cannot take the benefit of the transaction and refuse to pay the price, see *Union Mfg. Co. v. Lounsbury* (1864), 42 Barb. 125.

That it is doubted whether when a void patent is sold, and the purchaser has enjoyed the monopoly and there has been no fraud in the vendor and no liability exists toward others, the vendee can defend against an action for the price, see *Marston v. Swett* (1876), 66 N. Y. 206.

That an assignment or license grants only the right not to be sued or to sue others, which is a right resting wholly on the patent, and hence if the patent fails the right is gone, the sale has no

consideration, and though the vendee has used or made the invention, it was only what all had a right to do, and the vendor cannot recover, see *Hawks v. Swett* (1875), 4 Hun (N. Y.), 146; 6 *Thomp. & C.* 529; *Marston v. Swett* (1875), 4 Hun (N. Y.), 153; 6 *Thomp. & C.* 534; overruled in *Marston v. Swett* (1876), 66 N. Y. 206.

⁹ That the receipt of materials or instructions with the void patent does not impair this defence, see *Bliss v. Negus* (1811), 8 Mass. 46.

¹⁰ That a vendee is not bound by the sale where the patent is void, but if he would defend against an action for the price on that ground, he must spread his equity on the record, see *Bellas v. Hays* (1819), 5 S. & R. 427.

¹¹ That the vendee must pay *pro tanto* if the patent is partly void, and the subject-matter is divisible, see *Nye v. Raymond* (1854), 16 Ill. 153.

¹² That a vendee who has sold his interest to another cannot defend against his vendor's action for the price on the ground of invalidity or uselessness, un-

to defend against an action for the purchase money, on the ground that the patent is void, may be waived by the parties in their contract, and where they have expressly provided in another manner for its possible invalidity, the assignee cannot allege it as an answer to the suit.¹³ That the invention covered by the patent is an infringement upon earlier patents has been declared to be a defence, if the assignee was ignorant of this fact at the time of purchase, but the existence of a later patent for the same invention offers no bar to a recovery by the assignor.¹⁴

§ 1240. Defences of the Assignee against the Assignor's Action for the Purchase Money: Fraud in the Sale.

That the assignee was led to purchase the monopoly by the fraudulent representations of the assignor is another defence which may be urged successfully against an action for the price.¹ Such representations must have been averments of existing facts, as distinguished from mere expressions of opinion or exaggerated recommendations of the invention, but may relate either to the title of the assignor, the validity of the patent, or the utility and value of the patented process or device. An assignee, defending upon this ground, must offer

less there was a warranty or a fraud, nor can he restore the patent and rescind the sale, and he is also estopped by his own assignment based on that of the vendor, see *Thomas v. Quintard* (1855), 5 Duer, 80.

¹³ That if both parties provide in the conveyance for the possible invalidity of the patent, the vendee cannot defend, in an action for the price, on the ground of want of consideration, see *Johnson v. Willimantic Linen Co.* (1866), 33 Conn. 436.

¹⁴ That in a suit on a note given for a patent-right, evidence that the patent was void as being an infringement of a prior patent is not admissible unless that fact has been found by a competent Federal court, see *Elmer v. Pennel*

(1855), 40 Me. 430. *Contra*, *Nash v. Lull* (1869), 102 Mass. 60.

That another patent has been granted to a later patentee for the same invention is no defence to a note for a prior patent, see *Crow v. Eichinger* (1870), 34 Ind. 65.

§ 1240. ¹ That fraudulent representations by the vendor that the invention was never before patented, and never used except under the patent sold, will be a good defence to a note given therefor, see *Morrow v. Brown* (1869), 31 Ind. 378.

That a note for a patent, fraudulently obtained and void, is invalid though some materials were furnished and instructions given to the vendee, see *Bliss v. Negus* (1811), 8 Mass. 46.

to return the patent, and show that he derived no benefits therefrom, or render an account of those which he received.²

§ 1241. Defences of the Assignee against the Assignor's Action for the Purchase Money: Breach of Warranty.

A breach of warranty may constitute an entire or partial defence to an action for the purchase money, according to the nature of the broken covenant.¹ The implied warranty of title, and the express warranty of validity, are of the essence of the contract, and a breach of these relieves the assignee from all his obligations. Other covenants may have the same or a more limited effect, to be determined by the extent to which their non-fulfilment impairs the value of the patent to the assignee. If their infraction is equivalent to a total failure of the consideration for the promise of the assignee to pay the price, or if the price cannot be apportioned between the advantage he receives from the conveyance and that of which he is deprived by the breach of warranty, the action of the assignor must fail. But when he has derived and still retains a partial and separable benefit from the assignment, he may be compelled to pay a corresponding portion of the purchase money.

§ 1242. Defences of the Assignee against the Assignor's Action for the Purchase Money: Special Statutory Defences.

To guard against the perpetration of fraud upon assignees by the sale of invalid patents several of the States have

² That where a vendee defends an action for the price on the ground of fraud in the sale, he should aver that he made no profits and offer to reconvey, see *Rose v. Hurley* (1872), 39 Ind. 77.

That a vendee when sued for the price of a patent may show fraudulent representations of the plaintiff as to the usefulness of the invention, although he did not offer to return it after discovering its want of utility, see *Groff v. Hansasel* (1878), 33 Md. 161.

§ 1241. ¹ That a breach of warranty

by the vendor is a defence against the notes given by the vendee, see *Hawes v. Twogood* (1861), 12 Iowa, 582.

That a vendee, who purchases an invention with an agreement from the vendor to pay any license fee which the vendee may be compelled to pay for the use of the invention, may defend against an action for the price *pro tanto*, on the ground that he has paid such license fee on demand of the agent of the patentee, see *Orr v. Burwell* (1849), 15 Ala. 378. See also § 783 and notes, *ante*.

enacted special laws, imposing certain restrictions on the sale, or prescribing certain forms for the expression of the contract. Statutes limiting the right to sell the patent privilege itself have been uniformly held unconstitutional, because impairing franchises conferred by Congress under the Constitution of the United States.¹ But the power of individual States to regulate the use or sale of patented articles, and to compel compliance with specific forms of contract, is unquestionable.² Those to which reference is here particularly made relate to negotiable paper given in payment by the assignee. Under the law-merchant such paper in the hands of a *bona fide* holder, who took it in the usual course of business before maturity, is good against the maker irrespective of any equities or possible defences between him and the assignor. The vendor of an invalid patent, or defective title, was thus enabled to deprive the assignee of all defence against an action for the price, by obtaining a negotiable note for the purchase money and negotiating it before the fraud or want of consideration was discovered.³ To prevent this evil, statutes were enacted in a number of the States, requiring every note given for a patent to recite that fact upon its face and thus put every subsequent holder upon inquiry as to the existence of an adequate consideration. These statutes have been sustained by the courts of last resort, and under them an assignee whose note contains this information can set up any defence

§ 1242. ¹ That a State has no power to enact laws impairing the value or affecting the mode of transfer of letters-patent, see *People v. Russell* (1883), 49 Mich. 617; 25 O. G. 504; *Wilch v. Phelps* (1883), 14 Brown (Neb.), 134; *Crittenden v. White* (1876), 23 Minn. 24; *Patterson v. Com.* (1875), 11 Bush (Ky.), 311; *Hollida v. Hunt* (1873), 70 Ill. 109; and other cases cited in § 46, note 4, *ante*.

That a State may require the vendor of patent-rights to file with the county clerk copies of the letters-patent, and an affidavit that the letters are genuine and unrevoked and that he has authority to sell, see *Hankey v. Downey* (1888), 116

Ind. 118; *Pape v. Wright* (1888), 116 Ind. 502; *New v. Walker* (1886), 108 Ind. 365.

² That the use or sale of patented articles may be regulated by State laws, see *Hackett v. State* (1885), 105 Ind. 250; *Patterson v. Com.* (1875), 11 Bush (Ky.), 311; and § 46, note 4, *ante*.

³ That a note given for a patent is good in the hands of a *bona fide* holder though the patent were invalid, see *Woolen v. Ulrich* (1878), 64 Ind. 120.

That the note was procured by fraud is no defence against a *bona fide* holder, see *Hereth v. Merchants National Bank* (1870), 34 Ind. 380.

against the holder which could have been advanced against the assignor.⁴ But a note given for a patent, in the usual form and making no disclosure as to its consideration, is not changed in legal character by these statutes. In some States it has, indeed, been decided that, by virtue of these statutes, negotiable paper which omits this notice is open to all defences, in the hands of a holder having knowledge of its consideration, that might have been made if the notice had been properly inserted.⁵ But at the same time it is asserted that an innocent holder may rely upon the note when in the ordinary form, whatever may have been the actual consideration.⁶

⁴ That a State has power to prescribe the terms of a note given for a patent, see *Herdie v. Roessler* (1888), 109 N. Y. 127; *Haukey v. Downoy* (1888), 116 Ind. 118; *Pape v. Wright* (1888), 116 Ind. 502; *Herdie v. Roessler* (1886), 39 Hun (N. Y.), 195; *New v. Walker* (1886), 108 Ind. 365; *Tod v. Wick Bros.* (1881), 36 Ohio St. 370; *Haskell v. Jones* (1878), 86 Pa. St. 173; *Domestic Sewing Mach. Co. v. Hatfield* (1877), 58 Ind. 187; and § 46, note 4, *ante. Contra*: *Castle v. Hutchinson* (1885), 25 Fed. Rep. 394; *Wilch v. Phelps* (1883), 14 Brown (Neb.), 134.

That a State may fix a maximum charge for the use of an invention, see *Central Union Tel. Co. v. Bradbury* (1885), 106 Ind. 1.

That the buyer of a note with notice that it was given for a patent is not, as matter of law, chargeable with knowledge that it was obtained by fraud or without consideration, but if he bought it with notice of the fraud he cannot estop the maker from setting up such defences against him, see *Sackett v. Kellar* (1872), 22 Ohio St. 554.

That where it is a penal offence under State laws to take a negotiable note for a patent not containing a statement that it was given for a patent, it is not such offence to take a non-negotiable note, see *State v. Brower* (1876), 30 Ohio St. 101.

That in a suit on a non-negotiable note by the assignee against the maker, the want of consideration is a good defence, see *Johnson v. McCabe* (1871), 37 Ind. 535.

That notes given for the product of an invention, or for the patented article, need not state that fact, though the law requires such statement when the note is given for the patent-right itself, see *State v. Peck* (1874), 25 Ohio St. 26.

⁵ That where a State law requires that a note given for a patent shall state that fact on the note itself, a note without it is open, in the hands of one having notice of its consideration, to all defences which could be made if it contained it, see *De Long v. Barnes* (1887), 45 Ohio St. 237; *New v. Walker* (1886), 108 Ind. 365; *Weaver v. Frantz* (1881), 1 Pennypacker (Pa.) 153; *Tod v. Wick Bros.* (1881), 36 Ohio St. 370.

That where a statute requires the note to give notice of its consideration, and it fails to do so, a holder of a note with notice that it was given for a patent is affected by the fraud if there were any, see *Hunter v. Henninger* (1880), 93 Pa. St. 373.

⁶ That where a note is given for a patent without the notice required by statute, an innocent *bona fide* holder before maturity is not bound by the equities, see *Tescher v. Merea* (1888),

Where there are no such statutes, the knowledge of a holder that the note was given for a patent does not charge him with any notice of fraud or secret equities, nor does the statement of its consideration alter its effect as negotiable paper under the general law.⁷

SECTION III.

OF THE WRONGS COMMITTED BY LICENSORS AGAINST LICENSEES: AND THEIR REMEDIES.

§ 1243. Rights of the Licensee against the Licensor.

The only universal right of licensees against their licensors consists in the enjoyment of the privileges conferred by the license, without the assertion against them of the prohibitory powers of the monopoly. Their other rights grow out of the peculiar contracts into which they enter, and are incapable of complete classification. The most common among them have, however, from time to time been submitted to adjudication, and the appropriate remedies for their violation have thus been determined. As these remedies are few in number and distinct in character, the subject can be treated more conveniently and clearly by making them the principal topics of discussion and grouping under each the wrongs which can be thereby redressed. These remedies are four: (1) A specific performance of the contract; (2) A rescission of the contract; (3) An action for damages; and (4) An action to recover back money improperly paid to the licensor.

118 Ind. 586; *Hunter v. Henninger* (1880), 93 Pa. St. 373; *Haskell v. Jones* (1878), 86 Pa. St. 173.

⁷ That it is presumed that a note given for a patent-right is on good consideration, and a purchaser before maturity is not put on inquiry, see *Gerrish v. Bragg* (1883), 55 Vt. 329.

That the knowledge that a note was given for a patent-right raises no suspicion as to its validity, see *Borden v. Clark* (1873), 26 Mich. 410; *Miller v. Finley* (1872), 26 Mich. 249.

That the words "given for a patent-

right," in a note, do not import that there was fraud or give notice to the holder of any equities, see *Hereth v. Merchants National Bank* (1870), 34 Ind. 380.

That writing on a note "given for a patent-right" does not affect the character of the note under the law-merchant, and the maker cannot set up his equities against a *bona fide* holder, see *Hereth v. Meyer* (1870), 33 Ind. 511. *Contra*: *Herdic v. Roessler* (1888), 109 N. Y. 127; *Herdic v. Roessler* (1886), 39 Hun (N. Y.), 195.

§ 1244. Remedies of the Licensee against the Licensor: Specific Performance.

In certain cases equity will decree a specific performance of the contracts embraced in or collateral to the license; in others, it will afford an equivalent remedy by enjoining against conduct contrary to the rights thereby conferred. Where the licensor refuses to execute essential instruments, or where his contract binds him to reduce the license fees if subsequent licenses are granted at a lower rate, these obligations can be specifically enforced.¹ When he endeavors to invade the rights created by the license, as by improperly declaring it forfeited and warning the public against dealing with the licensee, or by licensing others contrary to the terms of an exclusive license; or where having agreed to supply the licensee with the patented articles for sale, he threatens to retire from business and assign the patent, to the destruction of the value of the license, — an injunction may be granted to restrain him from his contemplated wrong.² In all cases,

§ 1244. ¹ That a parol contract for a license can be specifically enforced, see *Nichols v. Marsh* (1886), 61 Mich. 509.

That an implied contract can be specifically enforced, see *Fuller Co. v. Bartlett* (1887), 68 Wis. 73.

That a contract to reduce royalties if others are licensed at a less sum is enforceable in equity, see *Washburn & Moen Mfg. Co. v. Chicago Galvanized Wire Fence Co.* (1884), 109 Ill. 71.

That in a suit by a licensee against one of three joint licensors, to obtain a change of terms in the license, all must be made parties or there can be no decree, see *Florence Sewing Mach. Co. v. Singer Mfg. Co.* (1870), 4 Fisher, 329; 8 Blatch. 113.

That where the licensor agreed with the licensee not to license others at a less royalty without reducing his, and does so license, this *ipso facto* reduces his, see *Florence Sewing Mach. Co. v. Grover & Baker Sewing Mach. Co.* (1872), 110 Mass. 70.

² In *Baker Mfg. Co. v. Washburn & Moen Mfg. Co.* (1883), 5 McCrary, 504, McCrary, J. : (507) "We think that so much of the injunction as restrains the defendant from declaring a forfeiture of the complainant's license for non-payment of royalty at the rate originally fixed therein should remain in force. A public declaration of such a revocation might greatly injure the business of the complainant, and the damages could not readily be ascertained and compensated in money. It would destroy, in a great measure, confidence in the right and title of complainant, and thus disable it from making sales. Persons dealing in patented articles must be able to assure the public that they have a clear right to do so, in order to secure patronage, since both seller and buyer may be liable in damages if the article is sold in violation of the rights of the owner of the patent-right." 18 Fed. Rep. 172 (174).

That the licensor of an exclusive

however, the circumstances of the parties and the consequences of the wrongful act must govern. The license contract is eminently a personal one, and therefore if no ground for equitable interference exists, either in the subject-matter of the agreement or the irreparable injury which its violation will entail, the licensee must seek his remedy at law.⁸

§ 1245. Remedies of the Licensee against the Licensor: Rescission of the License.

The license, with its dependent contracts, may be rescinded by a court of equity on account of fraudulent representations of the licensor inducing the acceptance of the license by the licensee, or on account of flagrant breaches of the contract.¹ Where the licensor forbids the licensee to practise the invention, and especially where in an action for infringement he prevents him by an injunction from enjoying the privileges bestowed upon him by the license, the licensee is absolved from its obligations, and may obtain from equity its formal and final cancellation.² Whether a licensee can, under any

licensee to sell, having agreed to supply the licensee with articles for sale, may be enjoined from giving up his business and assigning his patents and so destroying the value of the license, see *Singer Sewing Mach. Co. v. Union Button Hole and Embroidery Co.* (1873), Holmes, 253; 6 Fisher, 480; 4 O. G. 553.

⁸ That equity will not define the conditions in a license, nor save the licensee from the consequences of his mistakes of fact or construction, see *Florence Sewing Mach. Co. v. Singer Mfg. Co.* (1870), 4 Fisher, 329; 8 Blatch. 113.

That equity will not interfere to prevent the licensor from denying the licensee's right, or the licensor from revoking the license, see *Florence Sewing Mach. Co. v. Singer Mfg. Co.* (1870), 4 Fisher, 329; 8 Blatch. 113.

That on a deposit of a license fee, pending a motion to enjoin the licensor from interfering with the licensee, and the dismissal of the bill, the fee will be

ordered paid to the licensor or be retained by the court till the whole case is decided, see *Florence Sewing Mach. Co. v. Singer Mfg. Co.* (1871), 4 Fisher, 348; 8 Blatch. 177.

That a party receiving a benefit from a contract may be restrained from violating it, though the other party be not bound, see *Singer Mfg. Co. v. Union Button Hole & Embroidery Co.* (1873), 4 O. G. 553; 6 Fisher, 480; Holmes, 253.

§ 1245. ¹ That a license may be annulled on the ground of fraudulent misrepresentations of the licensor as to the salableness of the invention, see *Hull v. Fields* (1882), 76 Va. 594.

² That a licensor does not *ipso facto* dissolve the contract by prohibiting the licensee from using the patented article, see *Union Mfg. Co. v. Lounsbury* (1864), 42 Barb. 125.

That suing out and serving an injunction is a breach of the contract of license, see *Sullings v. Goodyear Dental Vulcanite Co.* (1877), 36 Mich. 313.

circumstances, so repudiate the license as to escape all liability for breach of its conditions may be doubted; but its rescission in a court of equity determines the relation between him and the licensor, and makes him thenceforward a stranger to the patent.³

§ 1246. Remedies of the Licensee against the Licensor: Action for Breach of Contract.

An action for damages may be maintained at law by the licensee for any breach of the license contract on the part of the licensor. Where an exclusive license has been granted, or a license containing stipulations not to license others in the future, a violation of these stipulations renders the licensor liable for all resulting injuries.¹ Such an exclusive right is invaded by every concession, by suit or otherwise, which operates as a recognition of the privilege in others, whether they are later patentees or not, and whether the invention which they practise is identical with or different in name and formal attributes from that covered by the license.² An agreement of the licensor to sue infringers, and to use due diligence in the protection of the licensee, subjects him to an action if he neglects this duty, though such agreements do not oblige him to attack those whose claims are based on adverse patents, or estop him from averring that his efforts would be fruitless on account of the invalidity of his own patent.³

³ See §§ 819, 820, 822, and notes, *ante*.

§ 1246. ¹ That a new license granted to others, in violation of the rights of an existing licensee, makes the licensor liable for all resulting damage, see *Pitts v. Jameson* (1853), 15 Barb. 310.

That where a royalty is based on the number of articles sold, if the licensee ceases to make and sell he abandons his license; and the licensor may then license to other parties, see *Pitts v. Jameson* (1853), 15 Barb. 310.

² That an agreement by the licensor not to license any other person is broken by every concession, by suit or otherwise, which operates as a recognition of

the rights of others to make and use, whether they are later patentees or not, see *Jackson v. Allen* (1876), 120 Mass. 64.

That a licensor granting an exclusive territorial license excludes himself and all others from using any device, though different in name, which is substantially the same, see *Ferree v. Smith* (1877), 29 La. An. 811.

³ That if a licensor who has agreed to prosecute infringers stops the infringement in any way, it complies with the agreement, see *Foster v. Goldschmidt* (1884), 21 Fed. Rep. 70; 28 O. G. 915; 22 Blatch. 287.

That a license with a covenant to sue

Acts of infringement by the licensor, within the territory of his licensee, may be treated as breaches of contract and the basis of an action for damages, or as infringements calling for an equitable remedy, at the option of the licensee.

§ 1247. Remedies of the Licensee against the Licensor: Action to Recover Back the Moneys already Paid.

An action will lie to recover license fees paid by mistake or on a contract procured by the fraud of the licensor. Where several patents are covered by one license, and the amount due to each can be apportioned, if the gross sum is paid in good faith after some of the patents have expired, the part received for the expired patents must be refunded.¹ Mistakes in computation, followed by erroneous payments, may be rectified in the same manner. Where license fees have been obtained by fraud, and no benefit whatever has resulted to the licensee, an action to enforce repayment may be maintained. But when the licensee has derived from the license advantages equivalent to the sum expended, although he may recover nominal damages in an action for the fraud, a restoration of the license fee cannot be claimed.² That the patent is adjudged invalid after license fees have been paid affords no ground for their recovery from the licensor.³

infringers, and not to license others, and to use diligence in securing the licensee's rights, does not bind the licensor to protect the licensee against persons claiming under adverse patents, or warrant against them, or estop the licensor from denying the validity of the patent in a suit for damages for not suing or for licensing others, see *Jackson v. Allen* (1876), 120 Mass. 64.

§ 1247. ¹ That where licensees under several patents continue to pay royalties on all after some have expired, without knowledge on their part or notice from the licensor, they can recover back what they should not have paid in assumpsit, if they are without fault and acting under a mistake of fact, believing that all the patents are still in force, see

Stanley Rule & Level Co. v. Bailey (1878), 45 Conn. 464.

That where a receiver by agreement for three owners of a patent recovers the royalties for them and pays them over, and the licensee sues to recover them back as paid by mistake, the owners must be the defendants though no demand was made on the receiver, before distribution, by the licensees, see *Florence Sewing Mach. Co. v. Grover & Baker Sewing Mach. Co.* (1872), 110 Mass. 70.

² That a settlement made under threat of a suit is not void for fraud or intimidation, see *Pope Mfg. Co. v. Owsley* (1886), 27 Fed. Rep. 100; 37 O. G. 781.

³ That money paid for license fees cannot be recovered back after the pat-

SECTION IV.

OF THE WRONGS COMMITTED BY LICENSEES AGAINST LICENSORS:
AND THEIR REMEDIES.

§ 1248. Rights of Licensor against Licensee.

The rights of a licensor against his licensee are wholly governed by their private contracts, and can therefore assume any form the parties may desire. In few, if any, cases are these rights enforceable in equity, except by a rescission of the contract for their violation, — actions for damages and for unpaid license fees affording usually an ample remedy.

§ 1249. Remedies of Licensor against Licensee: Rescission of License.

A license may be rescinded in equity, on the application of the licensor, whenever the misconduct of the licensee renders its continuance prejudicial to the contract rights of the licensor. Thus where the licensee refuses to comply with the terms of the license, and thereby causes injury to the licensor, a bill in equity will lie to revoke it and to recover damages.¹ The same remedy exists when the licensee assigns to others a mere personal license, or when, having agreed to pay a license fee based on the number of patented devices which he makes and sells, he neglects to manufacture them in reasonable quantities and put them on the market.² A breach of covenant

ent is declared invalid, see *Schwargenbach v. Odorless Excavating Apparatus Co.* (1885), 35 O. G. 1339.

That a settlement under fear of suit cannot be rescinded on the ground that the patent has subsequently been held invalid in a suit by other parties, see *Pope Mfg. Co. v. Owsley* (1886), 27 Fed. Rep. 100; 37 O. G. 781.

It would seem that the doctrine of these cases should be so modified as to conform to that governing the right of the licensor to recover license fees, as set forth in § 1251 and notes, *post*.

§ 1249. ¹ That where a licensee re-

fuses to comply with the terms of his license a bill will lie to revoke his license and for damages, see *Adams v. Meyrose* (1882), 10 Fed. Rep. 671.

² That the assignment of a personal license is invalid, see § 823 and notes, *ante*.

That the failure of the licensee to manufacture and sell the articles on which royalties are payable is an abandonment of the license, see *Pitts v. Jameson* (1853), 15 Barb. 310.

That an agreement to pay the inventor a royalty until \$5,000 has been paid, and then a lower one, is an agree-

does not, however, *ipso facto* annul the license, nor can this be accomplished by notice to the licensee to cease his use of the invention, though such notice must be given by the licensor if the terms of the agreement so require.³ The licensee has a right to be heard by a competent tribunal before his privileges can be withdrawn, and if the licensor attempts to declare the license void, and in this manner interfere with the business of the licensee, he may be enjoined, on proper conditions, until the right to forfeiture can be determined.⁴ Equity will not aid a licensor in enforcing his rights unless he has substantially fulfilled his own obligations, and the licensee in his defence may set up the same matters which would avail him if the suit were one at law for an infringement.⁵

§ 1250. Remedies of Licensor against Licensee: Action for Breach of Contract.

A licensee who violates the provisions of his license may be sued on the contract for damages. When his wrongful acts constitute also an infringement of the patent the licensor

ment to continue the business as long as it is reasonably profitable, see *Wilson v. Marlow* (1872), 66 Ill. 385.

³ That a license is not forfeited by non-payment of royalties, unless the license so provides, and the licensor can sue only in the local courts for royalties, not in the Federal courts for infringement, see *Consolidated Midclings Purifier Co. v. Wolf* (1886), 37 O. G. 567 ; 28 Fed. Rep. 814.

That a license cannot be annulled by a mere notice to the licensee, see *Union Mfg. Co. v. Lounsbury* (1864), 42 Barb. 125.

⁴ That a license can be rescinded only by mutual agreement of the parties or by a court of equity, see § 822 and notes, *ante*.

That an agreement that on failure of the licensee to perform his covenants the licensor may rescind the license by a written notice is valid, and if the license is so rescinded future uses will

be infringements, see *Hammacher v. Wilson* (1886), 36 O. G. 233 ; 26 Fed. Rep. 239.

That where a licensor attempts to revoke the license and notifies the public of such revocation he may be enjoined, see *Baker Mfg. Co. v. Washburn & Moen Mfg. Co.* (1883), 5 McCrary, 504 ; 18 Fed. Rep. 172.

⁵ That equity will not aid a licensor who has not kept his own covenants with the licensee, see *Foster v. Goldschmidt* (1884), 22 Blatch. 287 ; 21 Fed. Rep. 70 ; 28 O. G. 915.

That a licensee cannot justify his infringements by the licensor's breach of contract, see *Willis v. McCollin* (1886), 38 O. G. 1017 ; 29 Fed. Rep. 641.

That a licensor who has misrepresented his rights to his licensees and fails to protect them is not entitled to a specific performance of their contract, see *Brewster v. Tutthill Spring Co.* (1888), 34 Fed. Rep. 769.

may have his remedy either for the breach of contract or for the invasion of the monopoly; and if he adopts the former the measure of his damages will be the injury caused by the infringement.¹ When his violation of the agreement consists

§ 1250. ¹ In *Magic Rufl. Co. v. Elm City Co.* (1875), 8 O. G. 773, Shipman, J. : (774) "If the licensee 'uses the patented invention beyond the limits of the license or grant, or in any way not authorized by the license or grant, then there has been a violation of a right secured to the patentee under a law of the United States, giving to him the exclusive right to use the thing patented, although such licensee performs, according to their terms, all the covenants entered into by him.' (Goodyear *v.* Union India Rubber Co., 4 Blatchf. C. C. R. 65; Wood *v.* Wells, Crittenden & Co., 6 Fisher's Patent Cases, 382.) And if the licensees have also expressly covenanted in their agreement of license that they will do, or will not do, a particular act, or will not use the invention for a particular purpose, a violation of such covenant is also a breach of contract, not arising under the laws of the United States but for which remedy may be sought in the Circuit court of the United States, provided the citizenship of the parties gives jurisdiction to such courts. (Goodyear *v.* Union India Rubber Co., cited, *supra*; Goodyear *v.* Congress Rubber Co., 3 Blatchf. C. C. R. 455; Wilson *v.* Sanford, 10 Howard, 99.) In this case it was competent for the complainants to take either one of the two remedies for the alleged injury which have been mentioned. They could bring a bill alleging an injury to their exclusive rights under the laws of the United States, or, as the residence of the party gave this court jurisdiction, could bring a proper suit setting up the breach of the contract as the gravamen of their action. The averments of their bill are

sufficient to justify a court in holding it necessary that it is a bill for an injury to their patent-rights, but it is manifest from an examination of the stating part of the bill that the pleader intended to make the alleged breach of agreement the foundation of the action, and that he is seeking to recover damages for an injury to the complainants arising out of the violation of the contract. But the defendants insist that a bill in equity, based upon the contract, cannot be sustained, because for a breach of the contract there is complete and adequate remedy at law. There is undoubtedly a remedy at law for the alleged injury. The only question is whether it is complete and adequate. If the complainants were seeking to recover royalties which the defendants had agreed to pay, inasmuch as the account is particularly within the knowledge of the defendants, or if the patent was still in existence and the prevention remedy by injunction against future injuries could be administered, there would be no question that a bill in equity would be a proper remedy. (*Eureka Co. v. Bailey*, 11 Wall. 488; *Goodyear v. Congress Rubber Co.*, 3 Blatchf. C. C. R. 449; *Rich et al. v. Atwater*, 16 Conn. 409.) In this case the defendants had not agreed to pay royalties, and an injunction cannot be granted inasmuch as the patent has expired. It is alleged that the defendants have violated the contract of license by manufacturing and selling a ruffle which they were not authorized to make, and which they had agreed not to make. By this violation the complainants say that they have been injured, and the redress which they ultimately seek is the payment of dam-

in mere omissions, — as where he fails to practise the invention and thus realize the stipulated royalties for the licensor, — the suit must be for damages alone.² The licensee, when sued for the breach of a covenant concerning his mode of using the invention, is not estopped by the covenant from averring that the patent of the licensor is void.³

ages. Although the suit is upon the contract the damage to the complainants, if any, is the damage which they have sustained from the injury to their patent-rights. The ascertainment of the facts from which such damages can be estimated is, in cases of injury to property in letters-patent, peculiarly within the province of a court of equity, because the facts from which damages are to be computed can only be ascertained by an account and a discovery of the number and amount of articles which have been sold by the defendants, facts which are exclusively within their knowledge. They alone have the evidence which can enable the complainants to recover either at law or in equity." 13 Blatch. 151 (156); 2 Bann. & A. 152 (157).

That a licensee, exceeding his license, may be sued either under the contract or as an infringer, see *Pope Mfg. Co. v. Owsley* (1886), 37 O. G. 781; 27 Fed. Rep. 100.

That in such cases the damages for the breach of contract are measured by the loss caused by the infringement, see *Magic Ruffle Co. v. Elm City Co.* (1875), 13 Blatch. 151; 2 Bann. & A. 152; 8 O. G. 773.

That after recovery in assumpsit or account no further damages for the infringement can be claimed, see *Steam Stone Cutter Co. v. Sheldons* (1883), 24 O. G. 703; 15 Fed. Rep. 608; 21 Blatch. 260.

² That mere non-payment of royalties does not make the licensee an infringer, see *Consolidated Middlings Pur-*

ifier Co. v. Wolf (1886), 37 O. G. 567; 28 Fed. Rep. 814.

That a contract to pay royalties *per* thing done obliges the licensee only to pay for what is actually done not on what might have been done, see *Newell v. Wheeler* (1867), 2 Trans. Ap. (N. Y.) 160.

That an agreement to pay a certain sum for each of the first four hundred machines made is not a contract to make that number, see *Babcock v. Northern Pacific R. R. Co.* (1886), 26 Fed. Rep. 756; 36 O. G. 942.

³ That a covenant by the licensee as to the mode of use of the invention does not estop him from showing that the patent is void when he is sued thereon, see *Bliss v. Negus* (1811), 8 Mass. 46; *Hayne v. Maltby* (1789), 3 D. & E. 438.

That a covenant to aid in suppressing infringements is binding on the licensee personally, see *Washburn & Moen Mfg. Co. v. Southern Wire Co.* (1889), 37 Fed. Rep. 428.

That the covenants in a license cannot deprive the licensee of the right to show that his acts do not infringe the patent, see *White v. Lee* (1882), 23 O. G. 1621; 14 Fed. Rep. 789.

That a breach of the license by the licensor does not justify the licensee in infringing, see *Willis v. McCollin* (1886), 38 O. G. 1017; 29 Fed. Rep. 641.

That the revocation of a license before the alleged infringement leaves the former licensee to urge any defence open to ordinary infringers, see *Wooster*

§ 1251. Remedies of the Licensor against the Licensee: Action for License Fees for the Use of the Invention.

The refusal or neglect of a licensee to pay the stipulated license fees subjects him to an action at law for their recovery.¹ The obligation to recompense the licensor for the use of the invention is somewhat different in its nature and its consequences from the obligation to pay royalties on actual sales, and these two obligations must be, therefore, separately considered. The obligation to pay the license fee for the use of the invention arises on the acceptance of the license by the licensee.² It is immaterial whether he actually practises the invention or not, the consideration for his contract being his immunity against the prohibitions of the patent. It is also of no importance whether the invention has pecuniary value in the market, or eventually proves beneficial to the

v. Singer Mfg. Co. (1883), 23 O. G. 2513.

That equity may compel a discovery of the number of articles made under a license, if the licensee has covenanted to make such disclosures and fails to do so, see *Pope Mfg. Co. v. Owsley* (1886), 37 O. G. 781; 27 Fed. Rep. 100.

That a contract to arbitrate before suit is binding, and the plaintiff must show that he has made all reasonable efforts in that direction, see *Perkins v. United States Electric Light Co.* (1883), 24 O. G. 204; 21 Blatch. 308.

§ 1251. ¹ That the remedy for a breach of contract to pay license fees is an action at law unless discovery or other equitable relief is needed, see *Ball Glove Fastening Co. v. Ball & Socket Fastener Co.* (1888), 36 Fed. Rep. 309; *McKay v. Mace* (1884), 23 Fed. Rep. 76; 17 Phila. 573; *McMillan v. St. Louis & Miss. Valley Trans. Co.* (1883), 18 Fed. Rep. 260; 5 McCrary, 561; *Blanchard v. Sprague* (1859), 1 Clifford, 288.

That equity has no jurisdiction of a suit to recover a license fee, see *McMillin v. St. Louis & Miss. Valley Transportation Co.* (1883), 18 Fed. Rep. 260; 5

McCrary, 561; *Blanchard v. Sprague* (1859), 1 Clifford, 288.

That equity has jurisdiction over a bill for discovery and account under a license for royalties, if the parties are of different citizenship, see *McKay v. Mace* (1884), 23 Fed. Rep. 76; 17 Phila. 573.

That equity has jurisdiction over a bill for an injunction, discovery, and account against licensees who fail to comply with continuing obligations, see *McKay v. Smith* (1886), 29 Fed. Rep. 295; 39 O. G. 959.

That a license may run after an extension and the royalty will be collectible, see *Union Mfg. Co. v. Lounsbury* (1869), 41 N. Y. 363; *Union Mfg. Co. v. Lounsbury* (1864), 42 Barb. 125.

That a use by the vendees of a licensee is a use by him and he is liable to pay license fees for such use, see *Sherman v. Champlain Transportation Co.* (1858), 31 Vt. 162.

² That the obligation to pay the license fee is implied from the acceptance of the license, see *Paper Stock Disinfecting Co. v. Boston Disinfecting Co.* (1888), 147 Mass. 318.

licensee. Until the license is repudiated, or the contract is rescinded, his liability continues and the payments must be made. When sued for license fees, however, he may defend on any ground which is equivalent to a failure of the consideration for his contract.³ Thus he may set up a want of title in his licensor, and show that other parties own the same or a superior patent to whom he may be held responsible for its enjoyment, unless he knew of the defect of title when he accepted the license.⁴ But where he is the owner of the rival patent, and took the license to quiet the dispute between himself and the licensor, and has received the benefit desired, he cannot in an action for the license fee attack the title which his conduct has admitted.⁵ Nor can a title under a subsequent patent be urged by him in his defence, unless his recognition of the title of the licensor was fraudulently obtained.⁶ It has sometimes been said that if the patent of the licensor is void there can be no consideration for the contract since a void patent creates no monopoly, and where there is no monopoly there can be no actual immunity.⁷ This position

³ That where the consideration for the license fees has wholly failed they cannot be collected, see *Jenkins v. Abbotts* (1874), 54 N. H. 447.

That a licensee cannot defend a suit for royalties on the ground that the licensor grants licenses to others at a less rate unless there was an express covenant that he would not do so, see *McKay v. Smith* (1889), 39 Fed. Rep. 556.

⁴ That a licensee cannot show want of title in his licensor as a defence to an action for license fees, if he had due notice of the facts when the license was given, see *Jones v. Burnham* (1877), 67 Me. 93.

That a licensee taking his license with a full knowledge of the adverse claims against the patent, and enjoying the benefit of his license, cannot then attack the licensor's patent, see *Parkhurst v. Kinsman* (1849), 1 Blatch. 488.

⁵ That a rival patentee, taking a license to quiet a dispute and receiving its

benefits, cannot defend a suit for license fees by denying the right of the licensor, see *Hall Mfg. Co. v. American Railway Supply Co.* (1882), 48 Mich. 331.

⁶ That a licensee when sued on the license cannot defend by setting up rights under a subsequent patent to justify his non-performance of duty, or question the validity of the plaintiff's patent, unless he alleges fraud in the plaintiff, see *Fornecrook Mfg. Co. v. Barnum Wire & Iron Works* (1884), 54 Mich. 552.

⁷ That the price for a license to use the invention is not recoverable if the patent is void or the licensor has no title, see *Pacific Iron Works v. Newhall* (1867), 34 Conn. 67.

That on a license to practise the invention, the royalty is not collectible if the patent is worthless, see *Jenkins v. Abbotts* (1874), 54 N. H. 447.

That in a suit by payees or endorsees with notice on a note for license fees,

is, however, incorrect, for while the patent remains unimpugned by a decree of invalidity the ability of the patentee to enforce it, and consequently the immunity from its prohibitions enjoyed by the licensee, are presumed to be legitimate and real. Hence it has been held, in other and better considered cases, that if the patent is apparently valid the licensee, under its assumed protection, has enjoyed advantages of which, without the license, he would have been deprived, and that his obligations under the license continue until he is disturbed in his enjoyment by a superior patent, or until the patent under which he acts has been declared invalid or annulled.⁸ Upon

the defendant has the same rights as if the suit were for license fees direct, and if the patent is void the note is without consideration, see *Saxton v. Dodge* (1870), 57 Barb. 84.

That an exclusive license to make, with an agreement to assign after the license expires, is without consideration if the patent is invalid, and the license fee cannot be recovered, the licensee enjoying no rights which he did not already have, see *Harlow v. Putnam* (1878), 124 Mass. 553.

⁸ That an assignment and a license stand on different ground as to the defence of want of consideration, since if the patent is invalid the assignee gets nothing, while the licensee may still have received benefits, see *Jones v. Burnham* (1877), 67 Me. 93.

That a licensee, receiving benefits under a license covenanting not to deny validity, is estopped from making such denial in a suit for license fees, see *Magic Ruffle Co. v. Elm City Co.* (1875), 8 O. G., 773; 13 Blatch. 151; 2 Bann. & A. 152.

That a licensee, after long delay and having enjoyed all possible benefits of the patent, cannot deny the consideration of the license, see *Davis v. Gray* (1867), 17 Ohio St. 330.

That a licensee who has had the benefit of exclusive rights under a patent

cannot deny its validity, see *Rogers v. Reissner* (1887), 41 O. G. 351; 30 Fed. Rep. 525.

That where a licensee derives any benefit from the license, though it be not an exclusive one, there is no failure of consideration, see *Laver v. Dennett* (1883), 109 U. S. 90; 25 O. G. 882.

That a licensee may dispute a patent when he has repudiated it with full knowledge of the licensor, see *Brown v. Lapham* (1886), 37 O. G. 676; 23 Blatch. 475; 27 Fed. Rep. 77.

That a licensee covenanting not to dispute the patent, or the licensor's title, is estopped while the license remains in force, see *Pope Mfg. Co. v. Owsley* (1886), 37 O. G. 781; 27 Fed. Rep. 100.

That the vendor of a machine, sold with a right to use a patented article therewith, can recover the price of the machine without proving his right under the patent, unless it appears that the vendee has been interfered with by one whose rights are *prima facie* violated by its use, see *Buss v. Putney* (1859), 38 N. H. 44.

That until the patent is annulled, or adjudged invalid, a licensee receiving its benefit must pay the license fees, see *White v. Lee* (1882), 23 O. G. 1621; 14 Fed. Rep. 789; *Marston v. Swett*

his eviction or the overthrow of the patent his liability to pay for the further use of the invention ceases, and whether his license fees were payable at intervals, or in a gross sum which is yet unpaid, the licensor can collect only an amount sufficient to cover the period of liability. And when the license fees have been paid for the whole term of the patent by a gross sum in advance it would seem that the licensee should recover from the licensor such a proportion of the amount as the remainder of the term bears to the period of liability, since as to that part of the license fee the consideration must have wholly failed. The obligations of licensees, under licenses to use implied from the relations of the parties, are in most respects identical with those created by express licenses, though they are not bound by the same estoppels.⁹ A licensee, under an implied license arising from the lawful purchase of a patented device, acquires a right to use it as long as its identity can be preserved. Into the price of the device, in such cases, the license fee also enters, and when sued for the price the vendee may defend by showing that the article is an infringement of a prior patent and is therefore practically useless, or may set off against the price a license fee which he

(1880), 82 N. Y. 526; *Hilsen v. Libby*, (1878), 44 Sup. Ct. N. Y. 12.

That where the licensee is estopped by his agreement the license is not affected by the fact that in a suit between other parties the patent has been held invalid, see *Pope Mfg. Co. v. Owsley* (1886), 37 O. G. 781; 27 Fed. Rep. 100.

That the vendee of a right to use cannot enjoin the vendor from suing for the price on the ground of a prior patent, unless there has been warranty or fraud, see *Cansler v. Eaton* (1856), 2 Jones Eq. (N. C.), 499.

⁹ That assumpsit will lie to recover for use under an implied license, see *Deane v. Hodge* (1886), 35 Minn. 146.

That where an inventor was an officer of a corporation which used his invention with his consent, he can recover in assumpsit a reasonable compensation for

such use unless it was implied to be without compensation, see *Deane v. Hodge* (1886), 35 Minn. 146.

That where two patents cover improvements on the same invention, and an action in assumpsit is brought on both, recovery may be had on the second as to so much of the invention as is not covered by the first, see *Deane v. Hodge* (1886), 35 Minn. 146.

That one who uses under an implied license cannot deny utility when sued for compensation, see *Palmer v. U. S.* (1885), 20 Ct. of Claims, 432.

That in an action to recover a royalty on an implied contract where the question of priority is raised, the patentee may show his efforts and achievements in the art in order to prove that he was the first inventor, see *Hubbell v. U. S.* (1885), 20 Ct. of Claims, 354.

has been compelled to pay in order to enjoy it.¹⁰ A vendee, who has purchased with an option to return the article or pay the price inclusive of the license fee, must exercise his option within the stipulated or a reasonable time, or the sale will become absolute and the price can be recovered.¹¹

§ 1252. Remedies of the Licensor against the Licensee: Action for Royalties on Sales.

The obligation to pay royalties on sales arises only when the sale is completed and the price received. Every voluntary act of the licensee which places the article beyond his own control has the legal effect of a sale, and is sufficient to create a liability for royalties.¹ Thus where he recovers dam-

¹⁰ That a note for a device which the vendor represented to be covered by his patent, but which is in fact an infringement of the patent of another inventor, and has been enjoined as such, is void, see *Pacific Iron Works v. Newhall* (1867), 34 Conn. 67.

That the price of a patented machine cannot be recovered when the machine is an infringement on a prior patent and worthless, though its separate parts may be valuable, see *Peck v. Farrington* (1832), 9 Wend. 44.

That a vendee of a patented article cannot defend an action for the purchase money on the ground that he has been sued as an infringer and incurred expense thereby, though the vendor agreed to give him an indemnity bond and has failed to do so, but the failure to give the bond might be a complete defence by itself, see *Horne v. Hoyle* (1886), 27 Fed. Rep. 216; 36 O. G. 1248.

That a vendee may defend an action for the price on the ground that the invention infringes other patents, see *Croninger v. Paige* (1879), 48 Wis. 229.

¹¹ That if the vendee was to pay or return the device, he must return or tender a return within reasonable time

or he will be liable to the payment, see *Pottle v. Thomas* (1838), 12 Conn. 565.

That the agreement by the licensee to deliver up the licensed article at the end of a year is not fulfilled by his leaving it on the licensor's desk in his office, but in his absence and in the absence of any one acting for him, and without waiting a reasonable time to see him, although a delivery may be made at his place of business as well as at his residence, see *Wooster v. Sandman* (1879), 8 Daly (N. Y.), 218.

That the attempt to exercise an option, in cases where it does not exist, does not affect the general remedies for breach of contract, see *Weed v. Draper* (1870), 104 Mass. 28.

§ 1252. ¹ That any act which has the effect of a sale is a sale for the purpose of estimating royalties, see *Wilder v. Adams* (1860), 16 Gray, 478.

That where an article passes beyond the control of the licensee by his own act it is equivalent to a sale for the purposes of a royalty, see *Wilder v. Stearns* (1871), 48 N. Y. 656.

That where one licensee, who is bound to pay a royalty on each article sold by him, buys articles of another licensee whose liability is the same, and

ages against infringers and in this mode legitimates their sales, these become practically sales of his, and royalties on them are payable to the licensor.² This liability he cannot avoid by varying the form or name of the article while its substantial attributes remain, nor by disposing of it in an incomplete condition to another licensee, nor is it terminated by a revocation of the license.³ Upon an action for the recovery of royalties, sales may be proved by evidence of the manufacture and shipment of the articles, and if the licensee refuses to disclose their number and amount it will be presumed that these have not decreased since the last account was rendered.⁴

then sells them, he is not bound to pay a royalty on them though the other licensee fails to pay his royalty on them, see *Howe v. Wooldredge* (1866), 12 Allen, 18.

That where a certain sum is to be paid for every article sold or caused to be sold by the promisor he must account for every transfer of the right to use the article, and for all settlements made with those who use it without right, these being, in effect, sales also, see *Rodgers v. Torrant* (1880), 43 Mich. 113.

² That where a licensee, in pursuance of an agreement to sue infringers, recovers damages against them and thus legitimates their sales, he must pay a royalty on these articles also, it being in effect a sale, see *Wilder v. Adams* (1860), 16 Gray, 478.

³ That a royalty must be paid on devices which employ equivalent elements, as well as on those which conform to the letter of the specification, see *Wilder v. Adams* (1860), 16 Gray, 478.

That a royalty on each article made and sold or disposed of covers unfinished articles sold to a new company succeeding the licensee, see *Marsh v. Dodge* (1875), 4 Hun (N. Y.), 278; 6 *Thomp. & C.* 568.

That although a licensee has been 300.

notified by the licensor that the license is terminated for breach of condition, the licensor can recover his royalty for the articles made and sold as well after as before the service of such notice, see *Union Mfg. Co. v. Lounsbury* (1869), 41 N. Y. 363.

That where a licensor, having been notified of the licensee's intention to terminate his license to use certain machines after three months, permits the licensee to sell the machines to a third party, and knowingly acquiesces in such sale for two years, he cannot then demand royalties from the licensee, see *Wilde v. Smith* (1879), 8 Daly, 196.

⁴ That in a suit for royalties on sales, manufacture and shipment are *prima facie* evidence of sale, see *Marsh v. Dodge* (1872), 5 Lans. (N. Y.) 541.

That where the defendant in an action for royalties on sales refuses to account and show his books, it may be presumed that he sold as many as the last account showed, see *Smith v. Standard Laundry Co.* (1882), 11 Daly (N. Y.), 154.

That where a yearly royalty is payable, and the licensee has exercised his option to terminate the license in the middle of a year, he is obliged to pay a *pro rata* portion of the annual royalty, see *Gale v. Nourse* (1860), 15 Gray,

The licensee, in his defence, cannot attack the patent or the title of his licensor. In the price which he has charged and received for the articles sold the royalty has been computed and collected from the purchaser, and having derived this advantage from the license, he cannot be permitted to deny its obligations.⁵ If the patent be in fact invalid his benefit is none the less on that account, and the apparent monopoly which it creates has at least served him in securing a market for his products and the profit on his sales.⁶ But when the

⁵ That a licensee in defence to an action for accrued royalties on sales cannot deny the validity of the patent, see *Hyatt v. Ingalls* (1883), 49 Sup. Ct. N. Y. 375; *Jones v. Burnham* (1877), 67 Me. 93; *Marston v. Swett* (1876), 66 N. Y. 206; *Marsh v. Dodge* (1875), 4 Hun (N. Y.), 278; 6 Thomp. & C. 568.

That an exclusive licensee to sell, having received the full benefit of his license, cannot in an action thereon deny the power of the licensor to license, nor question the validity of his patent, though he himself owns a rival patent and took a license to quiet disputes, see *Hall Mfg. Co. v. American Railway Supply Co.* (1882), 48 Mich. 331.

That on a suit for license fees for machines actually sold by the defendant, it is not a defence that the plaintiff is not the true inventor or that he has broken the contract, since if damages could be recouped against him, this would be no plea in bar, see *Birdsell v. Perego* (1865), 5 Blatch. 251.

That a licensee while receiving benefits under an apparently valid patent is obliged to pay his royalties, and the invalidity of the patent is no defence, see *McKay v. Smith* (1889), 39 Fed. Rep. 556; *Covell v. Bostwick* (1889), 39 Fed. Rep. 421; *Marsh v. Harris Mfg. Co.* (1885), 62 Wis. 276; *Hyatt v. Ingalls* (1883), 49 Sup. Ct. N. Y. 375; *Patterson's Appeal* (1882), 99 Pa. St. 521; *Angier v. Eaton, Cole, & Burnham Co.* (1881), 98 Pa. St. 594.

That the licensee is estopped to deny the validity of the patent only as to acts done while the license was in force, see *Tibbo Mfg. Co. v. Heincker* (1889), 37 Fed. Rep. 686.

That a licensee, knowing the patent to be of doubtful validity, is obliged to pay the royalties as long as he receives the benefit, and cannot deny the validity of the patent, nor the title of the patentee, while he is not interfered with, see *Jones v. Burnham* (1877), 67 Me. 93.

That it is doubtful whether a licensee under a re-issue, when sued for royalties, can show that the re-issue is void, see *Washburn & Moen Mfg. Co. v. Wilson* (1882), 48 Sup. Ct. N. Y. 159.

That where no fraud is practised, one who agrees with full knowledge to pay a royalty under a patent cannot afterwards deny its validity, see *Eureka Co. v. Bailey Co.* (1870), 11 Wall. 488.

That an agreement in a license that the licensee is estopped to deny the validity of the patent will bind him in a suit for royalties, see *Marsh v. Harris Mfg. Co.* (1885), 63 Wis. 276; *Evory v. Candee* (1879), 17 Blatch. 200; 4 Bann. & A. 545.

That the liability of the licensee for royalties continues until he rescinds the license and gives notice thereof to the licensor, see *Marston v. Swett* (1880), 82 N. Y. 526.

⁶ That royalties on sales are due and collectible although the patent is actually invalid, since benefit therefrom has

patent is repealed, or priority is awarded to other parties, or a superior title is asserted resulting either in the interruption of his business or in the creation of new liabilities to the paramount owner, he can repudiate the license, and refuse to pay the stipulated royalties.⁷ Thenceforward if he practises the

accrued to the licensee, see *Smith v. Standard Laundry Co.* (1882), 11 Daly (N. Y.), 154; *Marston v. Swett* (1880), 82 N. Y. 526. *Contra*: *Hawks v. Swett* (1875), 4 Hun (N. Y.), 146; 6 *Thomp. & C.* 529. But see *Marston v. Swett* (1876), 66 N. Y. 206; and *Wilson v. Hentges* (1879), 26 Minn. 290, — a case which evidently misapprehends the nature of the benefits received by the licensee under a license to sell.

That although a patent may not be good for all it claims, a licensee having the benefit of it cannot take advantage of its invalidity in a suit for royalties, see *Milligan v. Lalance & Grosjean Mfg. Co.* (1884), 21 Fed. Rep. 570; 29 O. G. 367.

That a note given for the right to sell in certain places a machine which is practically valueless is without consideration, the availability of the machine for use being always warranted, see *Smith v. Hightower* (1886), 76 Ga. 629.

⁷ In *White v. Lee* (1882), 14 Fed. Rep. 789, Lowell, J.: (790) "The question has been argued whether the defendant can resist an action for license fees, under a contract, by proving that the patent is void. In his very thorough brief the defendant cites all the important cases; and they in a cursory examination seem to present a difference of opinion, which on a more careful study will be found to disappear. Many of the decisions treat a licensor as a landlord, and a licensee as his tenant, who cannot dispute the title so long as he has the occupancy of the premises. Many of the cases, such as *Bowman v. Taylor*, 2 Adol. & E. 278; *Smith v. Scott*, 6 C. B. (N. S.) 771; *Wilder v.*

Adams, 2 Wood. & M. 320, are actions at law, and turn upon the effect of a recital or covenant in a sealed instrument. The agreement in this case is not under seal, and this is not an action at law. Other cases state the general doctrine in a somewhat absolute and general way, hardly admitting exceptions. (See *Crossley v. Dixon*, 10 H. L. Cas. 293; *Clark v. Adie*, 2 App. Cas. 423.) On the other hand there are cases in the United States which seem to hold that the invalidity of the patent may always be proved, such as *Harlow v. Putnam*, 124 Mass. 553. But these were cases on either side which required no nice distinctions. The law is, I think, that a plea or answer that the patent is void is not of itself a sufficient defence, but that evidence of what may be called an eviction is such defence. The difficulty is to ascertain what amounts to an eviction in a patent case. It is easily discovered whether a tenant of a certain parcel of land has or has not been evicted; but if a patent is void, still the licensee may have had all the benefit of a valid patent, because his exclusive title may never have been disputed. In *Lawes v. Purser*, 6 El. & Bl. 930, 932, the counsel for the plaintiff admitted that if every one had publicly used the patented invention, that might be equivalent to an eviction; but contended that a simple plea that the patent was void might mean merely that the pleader, when he began to draw his plea, had discovered a technical flaw which no one else had thought of; and the judgment pursued this exact line of reasoning. In a case in Massachusetts, the defendants, who were licensees and

invention, the remedy of the licensor is by a suit for damages for breach of contract, or by an action for infringement. An assignment of the license does not relieve the licensee from his obligation to pay the proper royalties, the assignee being regarded as his agent and the sales made on his account.⁸ A

had used the patent to keep off competition, were said by Thomas, J., to have had all the benefit of a valid patent. (*Bartlett v. Holbrook*, 1 Gray, 114.) In New York in a case which was twice brought before the Court of Appeals, it was held, — first, that mere invalidity of the patent was not a defence; and second, that a repeal of the patent was a defence. (*Marston v. Swett*, 66 N. Y. 206; s. c. 82 N. Y. 526.) These cases point to the true distinction, however difficult its application may sometimes be, that something corresponding to eviction must be proved if a licensee would defend against an action for royalties." 23 O. G. 1621 (1621).

In *Marston v. Swett* (1880), 82 N. Y. 526, Finch, J.: (533) "We think the true rule to be deduced from the authorities is this: Where the patent is apparently valid and in force the party using it, receiving the benefit of its supposed validity, is liable for royalties agreed to be paid and cannot set up as a defence the actual invalidity of the patent. The reasons for the rule are that the party has got what he bargained for; that he cannot be allowed at the same time to affirm and disaffirm the patent; and that he cannot in this way force the patentee into a defence of his right and compel him to try it in a collateral action. While the manufacture goes on under such an apparently valid patent it is presumed to be under and in accordance with the agreement to pay royalties. If the manufacturer does not so intend, and chooses to make the patented article, not under the patent, but in hostility to it, he must give notice of that intention, in order that the

presumption may not attach or the patentee be misled. But if the patent is annulled or destroyed by due and effective legal proceedings, and priority of invention and a patent is awarded to another, no notice is necessary, for there is no presumption or inference of manufacture under a patent judicially avoided and annulled. It ceases to exist. The manufacture is either absolutely free, or an infringement upon the rights of the prior inventor, or in submission to his claims."

That a licensee must repudiate his license before he can defend against a claim for royalties by denying the validity of the patent, see *Hyatt v. Ingalls* (1883), 49 Sup. Ct. N. Y. 375.

That where a licensor sues the licensee for fees, the licensee cannot attack the patent unless he can prove eviction, see *Rogers v. Reissner* (1887), 30 Fed. Rep. 525; 41 O. G. 351.

That an exclusive licensee, in defence to an action for royalties on sales, may show that a prior patentee is in the market asserting his superior rights and supplying the market, and that the licensee is thus deprived of his exclusive use, and may be accountable for his use to the prior patentee, see *Angier v. Eaton, Cole, & Burnham Co.* (1881), 98 Pa. St. 594.

That the mere claim by third parties that the licensee infringes is no defence to an action for royalties on sales, see *Davis v. Gray* (1867), 17 Ohio St. 330.

⁸ That an assignment of his license does not relieve the licensee from his obligation to pay royalties, see *Wilde v. Smith* (1879), 8 Daly (N. Y.), 196.

licensor will not be enjoined from suing to recover royalties although his claims exceed the fees named in the contract, since this as well as other elements of the controversy are capable of determination in a court of law; nor, on the other hand, can he prevent the licensee by an injunction from exercising his rights under the license, on the ground that license fees remain unpaid.⁹

SECTION V.

OF THE WRONGS COMMITTED BY JOINT-OWNERS AND OTHER CONTRACTING PARTIES AGAINST EACH OTHER: AND THEIR REMEDIES.

§ 1253. Rights of Co-owners against Each Other.

No relation is created between joint-owners of a patent by the mere fact of their common interest in the invention. Each is entitled, under the present condition of our law, to practise the invention and to license others, without accountability to his co-owner. If he exceeds the privilege conferred upon him by the patent, and employs an infringing art or instrument, he is to his co-owners like a stranger to the patent, and may be sued for the infringement in the usual mode.¹ To establish between joint-owners such relations as involve mutual responsibility within the limits of the patent special contracts are necessary, and these are construed and enforced in the same manner as between parties who are not co-owners.² In certain cases contracts are implied from the circumstances under which their joint interest has arisen.

⁹ That a licensor will not be enjoined from suing for his license fees on the ground that he charges the plaintiff more than he agreed to, his true defence being at law, but he may be enjoined from declaring the license void and thus putting the licensee to great loss, see *Baker Mfg. Co. v. Washburn & Moen Mfg. Co.* (1883), 18 Fed. Rep. 172; 5 McCrary, 504.

That a failure to pay royalties does not make the licensee an infringer, see *Consolidated Middlings Purifier Co. v. Wolf* (1886), 37 O. G. 567; 28 Fed. Rep. 814.

§ 1253. ¹ See §§ 797, 913, and notes, *ante*.

² See § 798 and notes, *ante*.

Thus where the patentee of an original invention and the inventor of an improvement united in a re-issue of the patent, covering the improved invention, and were therein named as joint patentees, their rights were held to have become inseparable, and either could restrain the other from employing the invention except for their joint benefit.³

§ 1254. Reciprocal Rights of Co-owners who are also Partners.

The principal relation formed by express contract between joint-owners of a patent is that of partnership in the business in which the patented invention is to be employed. While this relation subsists their rights as patentees are subordinated to their rights as partners. Neither is at liberty to use the invention, nor to license others to use it, contrary to the welfare of the common enterprise, and any attempt to do so may be met by an injunction.¹ At the same time their power under the Patent Laws to grant such licenses is not impaired, and parties purchasing from either, in good faith and without a knowledge of the partnership agreement, can exercise their privileges, leaving the other owner to his remedy for damages against their licensor for his breach of the contract. Where the articles of partnership require one of the owners to give his time to the joint enterprise, he is entitled to a rea-

³ That where two patentees obtain separate patents for the same invention, and afterward a joint patent for it, they are estopped under the latter from asserting their title under the former, see *Barrett v. Hall* (1818), 1 Mason, 447 ; 1 Robb, 207.

That where the patentee of an original invention and the inventor of an improvement unite in a re-issue covering both, each can restrain the other from using it except for their joint benefit, see *Duke v. Graham* (1884), 19 Fed. Rep. 647.

§ 1254. ¹ That a patent may be contributed to the capital stock of a partnership, see *Rehuss v. Moore* (1889), 6 Pa. Co. (Pa.) 245 ; *Farr v. Morrill* (1889) 53 Hun (N. Y.), 30.

That the representative of a deceased partner may maintain a bill in equity to compel the surviving partner to sell letters-patent belonging to the firm, and to account for the use of the patent since the death of the deceased partner, see *Freeman v. Freeman* (1883), 136 Mass. 260.

That co-owners, being partners, are liable for acts in violation of the partnership agreement, see § 798 and notes, *ante*.

That a co-owner, not named as licensor, is entitled to his share of the royalties if the co-owners were partners when the license was granted, see *Rogers v. Reissner* (1887), 41 O. G. 351 ; 30 Fed. Rep. 525.

sonable compensation for his services, and if by their agreement his wages are to be deducted from the profits of the business and no profits are realized, he may assert them as a debt against the partnership.² Such partnership agreements are, however, void if the patent is invalid, and either, in a suit against him by the other on the contract, may set up invalidity in his defence.³ Their violation of the partnership agreement subjects them to the same actions, whether at law or equity, which are available to other partners.

§ 1255. **Reciprocal Rights of Joint Licensees: Third Parties.**

Joint licensees also sustain relations to each other, through their express or implied contracts, from which arise peculiar rights whose violation demands a legal remedy. The most common form of these relations is that of partnership, in which the members of a licensed firm become jointly and severally liable to the licensor for the performance of the contract and the payment of the stipulated fees. Their relation as copartners is governed by the ordinary rules of partnerships, and their remedies against each other follow the usual course of partnership litigation. But as joint licensees each is a surety for the collective body to which all belong, and may be held responsible for the fulfilment of the obligations which it has assumed.¹ Each likewise has his remedy against the firm for payments made or conditions performed on its account, and in an action to enforce these rights the liability of the surety or the firm to the licensor is not open to inquiry, the fact that the surety has been damnified entitling him to a recovery.² Other relations between licensees,

² That under an agreement between the inventor and his co-owner of the patent that the time given to the invention by the inventor shall be paid for by a deduction from the royalties received on account of the other, wages may be claimed if no royalties are due, see *Rice v. Garnhart* (1874), 34 Wis. 453.

³ That an agreement providing that the co-owner shall pay the inventor for devoting his time and skill to practising

the invention is invalid if the patent is void, see *Rice v. Garnhart* (1874), 34 Wis. 453.

§ 1255. ¹ That each member of a licensed firm is liable for the license fees and is surety for any assignee of the firm, see *Sizer v. Ray* (1881), 87 N. Y. 220.

² That a former member of a licensed firm, suing as surety for license fees paid by him on its account, cannot be defeated

of various character and obligation, may subsist, for wrongs against which actions lie in equity or at law. The rights and duties of third parties in reference to the different owners of the privileges created by letters-patent, with the single exception of the duty to respect the monopoly, rest upon the same principles and are enforced by the same methods as those arising out of ordinary contracts, express or implied.³

SECTION VI.

OF THE COURTS HAVING JURISDICTION OVER WRONGS BETWEEN CONTRACTING PARTIES.

§ 1256. Jurisdiction of Federal Courts over Contract Actions.

In actions upon contracts the jurisdiction of the Federal courts depends upon the citizenship of the parties, although the subject-matter of the contract is a right arising under the Patent Laws. When, therefore, the plaintiff and defendant reside in different States, any of the foregoing actions may be instituted in the Federal courts, and there pursued to a complete recovery. But when the parties are citizens of the same State the local tribunals alone have jurisdiction of the controversy. A State court, however, cannot decree an assignment of a patent on the ground that the petitioner is the true inventor, for this is indirectly an adjudication on the priority

by proof that the firm was not liable to the licensor, see *Sizer v. Ray* (1881), 87 N. Y. 220.

³ That any person may make a contract to supply a patented article, taking his own risk of obtaining a license, see *Hobart v. Detroit* (1868), 17 Mich. 246.

That it is doubtful whether a city can reject the lowest bid on a contract, on the ground that the bidder has no rights under the patent, if he is willing to give proper bonds to carry out his contract, see *Atty. Gen. v. Detroit* (1872), 26 Mich. 263.

That where a patentee is the only bidder on a city contract, to be awarded,

by law, to the lowest bidder, he will be the lowest bidder since others could have bid, see *Hobart v. Detroit* (1868), 17 Mich. 246.

That an injunction to refrain from trespassing on an exclusive license to sell a device may issue against parties who are not bound by and who do not have any notice of the contract, see *Singer Mfg. Co. v. Union Button-Hole & Embroidery Co.* (1873), 4 O. G. 553; 6 Fisher, 480; Holmes, 253.

That a contract not to make certain articles during the life of a patent is not in restraint of trade, see *Billings v. Ames* (1862), 32 Mo. 265.

of invention and the validity of an existing patent; nor can it entertain any suit by which the patentability of the invention or the fact of an infringement is to be determined.¹

§ 1257. Jurisdiction of State Courts over Contract Actions.

Over all questions of pure contract a State court has undoubted jurisdiction.¹ It can compel specific performance, or set aside agreements.² It can protect the various parties by injunction against the invasion of their contract rights.³ It can award damages for breach of warranty, for non-fulfilment of conditions, and for fraud.⁴ It can enforce the payment of

§ 1256. ¹ That a State court cannot enjoin infringements, see *Kayser v. Arnold* (1886), 41 Hun (N. Y.), 275; *Continental Store Service Co. v. Clark* (1885), 100 N. Y. 365; 7 N. Y. Code Pr. 183.

That a State court cannot decree the assignment of a patent on the ground that the petitioner is the real inventor, see *Slemmer's Appeal* (1868), 58 Pa. St. 155. See also as to this entire Section §§ 854-866, *ante*.

§ 1257. ¹ That a State court has jurisdiction over actions on contracts though the validity of a patent, or fraud, may be in question, see *Page v. Dickerson* (1871), 28 Wis. 694.

That a State court can enforce a contract though the patent is contested by the same parties in the Federal courts, see *Nichols v. Marsh* (1886), 61 Mich. 509.

² That a State court has jurisdiction over the subject-matter of the patent, though not over its validity, see *Maurice v. Devol* (1883), 23 W. Va. 247.

That a State court can enforce a contract for a patent, and may collaterally pass on its validity, see *Continental Store Service Co. v. Clark* (1885), 100 N. Y. 365; 7 N. Y. Code Pr. 183; *Slemmer's Appeal* (1868), 58 Pa. St. 155.

That a State court has jurisdiction over an action to compel an inventor to

assign the patent in pursuance of a former agreement, see *Wrinn v. Annin* (1888), 84 Fed. Rep. 435; *Fuller Co. v. Bartlett* (1887), 68 Wis. 73; *Binney v. Annan* (1871), 107 Mass. 94.

That a State court has jurisdiction to set aside a sale of the title and interest in a patent and extension on the ground of fraud on the part of the vendee, see *Leonard v. Barnum* (1874), 34 Wis. 105.

That a State court cannot rescind a contract to purchase a patent on the ground that the patent is invalid, that being a question for the Federal authority alone, see *Cowan v. Mitchell* (1872), 11 Heisk. (Tenn.) 87.

³ That a State court has complete jurisdiction over an action on an express contract in regard to the use of the patent, though its validity is in question, see *Williams v. Star Sand Co.* (1888), 35 Fed. Rep. 369; *Creighton v. Haggarty* (1884), 50 Sup. Ct. N. Y. 9.

That in an action in a State court, for breach of a covenant that the patent is for a new invention and on a new principle, the plaintiff may attack the patent and show the contrary, see *Wright v. Wilson* (1857), 11 Rich. Law (S. C.), 144.

⁴ That a State court has jurisdiction over an action for breach of warranty and of a covenant that the invention is

purchase money, license fees, or royalties.⁵ It can enjoin against such torts and violations of agreement as would not find an adequate remedy at law.⁶ These powers are ample for all actions, except those which involve the existence of the patent as a franchise granted by the general government, or seek direct redress for an infringement of the patented invention.⁷

§ 1258. Jurisdiction of the Court of Claims.

The Court of Claims occupies toward the United States, in some respects, the position of a State court toward its citizens. On this court Congress has conferred jurisdiction over all contract claims of individuals against the United States, and here the owner of a patent must seek his remedy when the govern-

new and on a new principle, see *Wright v. Wilson* (1857), 11 Rich. Law (S. C.), 144.

That a State court may inquire into the validity of a patent in a suit on a contract, when its invalidity will show a failure of consideration, see *Rice v. Garnhart* (1874), 34 Wis. 453.

That a State court has jurisdiction over an action for fraud in selling a patent-right, see *Hunt v. Hoover* (1868), 24 Iowa, 231; *Lindsay v. Roraback* (1858), 4 Jones. Eq. (N. C.) 124.

That a State court has jurisdiction over an action for fraud in the sale of a patent-right though the validity and construction of the patent are collaterally involved, see *David v. Park* (1870), 103 Mass. 501.

⁵ That a State court has jurisdiction of a suit to recover the price agreed to be paid for an assignment, with a request for the issue of the patent to the assignee, see *Lockwood v. Lockwood* (1871), 33 Iowa, 509.

That State courts have exclusive jurisdiction over actions for royalties, see *Hubbard v. Allen* (1888), 123 Pa. St. 198; *Dale Tile Mfg. Co. v. Hiatt* (1888), 125 U. S. 46.

That a State court has jurisdiction over actions for royalties though the validity of the patent may be disputed by the defendant, see *Hyatt v. Ingalls* (1883), 49 Sup. Ct. N. Y. 375.

⁶ That a State court may enjoin against the publication of a libel on a patent-right, see *Emack v. Kane* (1888), 36 Fed. Rep. 46; *Bell v. Singer Mfg. Co.* (1880), 65 Ga. 452.

⁷ That where judgment on the issue will affect the right conferred by the patent, a State court has no jurisdiction, see *Saxton v. Dodge* (1870), 57 Barb. 84.

That a question as to the effect of an assignment of one third of an invention upon three divisional patents issued for such invention, is solely for the Federal courts, see *Puetz v. Bransford* (1887), 32 Fed. Rep. 318.

That a State court cannot enjoin a patentee from circulating notices warning people not to buy the patented article except from him, if the questions of validity and infringement are in issue, see *Hovey v. Rubber Tip Pencil Co.* (1871), 33 Sup. Ct. N. Y. 522.

ment has made use of his invention.¹ A wrongful invasion of his rights on the part of the sovereign who created and protects them cannot be contemplated by the law as possible, and therefore it is presumed that every appropriation of a patented invention for the use and by the authority of the United States is under a contract, express or implied, to pay

§ 1258. ¹ In *James v. Campbell* (1832), 104 U. S. 356, Bradley, J: (358) "But the mode of obtaining compensation from the United States for the use of an invention where such use has not been by the consent of the patentee has never been specifically provided for by any statute. The most proper forum for such a claim is the Court of Claims, if that court has the requisite jurisdiction. As its jurisdiction does not extend to torts, there might be some difficulty, as the law now stands, in prosecuting in that court a claim for the unauthorized use of a patented invention, although, where the tort is waived and the claim is placed upon the footing of an implied contract, we understand that the court has in several instances entertained the jurisdiction. It is true it overruled such a claim on the original patent in this case, presented in 1867; but, according to more recent holdings, it would properly now take cognizance of the case. The question of its jurisdiction has never been presented for the consideration of this court, and it would be premature for us to determine it now. If the jurisdiction of the Court of Claims should not be finally sustained, the only remedy against the United States, until Congress enlarges the jurisdiction of that court, would be to apply to Congress itself. The course adopted in the present case of instituting an action against a public officer, who acts only for and in behalf of the Government, is open to serious objections. We doubt very much whether such an action can be sustained. It is substantially a suit

against the United States itself, which cannot be maintained under the guise of a suit against its officers and agents except in the manner provided by law." 21 O. G. 337 (338).

That the Court of Claims has jurisdiction of a suit against the United States on a special contract with a patentee for the use of his invention at an agreed price, see *Burns v. U. S.* (1868), 4 Ct. of Claims, 113.

That the United States may be sued in the Court of Claims to recover for the use of an invention by its employees even when the right of the patentee is denied, the recovery being under the right of eminent domain for compensation, see *Hollister v. Benedict & Burnham Mfg. Co.* (1885), 113 U. S. 59.

That the use of an invention by the United States is not a "caption of property" and is not within the jurisdiction of the Court of Claims, see *Pitcher v. U. S.* (1863), 1 Ct. of Claims, 7.

That an official of the government, known to the patentee to have no authority to purchase the patent on behalf of the United States, cannot bind it by his contract to pay for the use of the invention, see *Shavor v. U. S.* (1868), 4 Ct. of Claims, 440.

That a contract between a patentee and the government for the use of his invention can be determined by the government only when it ceases to use the invention and it must pay while it uses, see *Burns v. U. S.* (1868), 4 Ct. of Claims, 113.

That whether a patentee can waive an infringement by the government and sue on the implied contract, *quere*, see

the established or a reasonable compensation.² This compensation may be recovered by a proceeding instituted in the Court of Claims, in form and nature similar to a suit in equity.

United States *v.* Palmer (1888), 128 U. S. 262.

That the United States has a right to use, without compensation, an invention made by its agent under its direction and at its expense, see *Solomons v. United States* (1886), 21 Ct. of Claims, 479; *s. c.* (1887), 22 Ct. of Claims, 335.

That an officer of the United States cannot claim a royalty for his use of his own invention in the public service, see *Davis v. United States* (1888), 23 Ct. of Claims, 329.

² That the Court of Claims has no jurisdiction of infringement suits, see *Forehand v. United States* (1888), 23 Ct. of Claims, 477; *Fletcher v. United States* (1875), 11 Ct. of Claims, 748.

That the Court of Claims has jurisdiction over actions against the United States for royalties, see *United States v. Palmer* (1888), 128 U. S. 262; *McKeever v. United States* (1878), 14 Ct. of Claims, 396; 23 O. G. 1525; 18 Ct. of Claims, 757.

That if the United States practises the invention without license it is liable to make compensation, and no provision of the Constitution exempts it from such liability, see *Palmer v. United States* (1885), 20 Ct. of Claims, 432; *McKeever v. United States* (1878), 14 Ct. of Claims, 396; 23 O. G. 1525.

That no contract can be implied from the mere use of the invention, see *Forehand v. United States* (1888), 23 Ct. of Claims, 477.

That when the government advertises for inventions for a certain purpose, and two similar but distinct inventions are submitted by different inventors, one of which is adopted, there is no implied contract in favor of

the other inventor, see *Fletcher v. United States* (1875), 11 Ct. of Claims, 748.

That Congress may by special act direct the Court of Claims to ascertain what compensation should be paid to a patentee for the use of his invention by the government, see *Dahlgren v. U. S.* (1880), 16 Ct. of Claims, 30.

That the liability of the United States for the use of the invention is the same when the court inquires in pursuance of a reference by Congress, though the damages are limited by an amount named in the act of reference, see *Hubbell v. United States* (1869), 5 Ct. of Claims, 1.

That the validity of the patent may be denied in a suit against the United States for compensation on an implied contract, see *Hubbell v. United States* (1885), 20 Ct. of Claims, 354; *Morse Arms Mfg. Co. v. United States* (1880), 16 Ct. of Claims, 296.

That the claim of the inventor against the United States may be barred by the Statute of Limitations, see *Butler v. United States* (1888), 23 Ct. of Claims, 335.

That where the government has made and used an invention, but has not dealt in it nor made a commercial profit from it, damages are to be measured by the value of the invention to the government over other devices which it had a right to employ, see *Dahlgren v. United States* (1880), 16 Ct. of Claims, 30.

That the United States is not liable in damages for the unlawful issue of a patent to a rival inventor, see *Thistle v. United States* (1856), Devereux, Ct. of Claims, 130.

A P P E N D I X.

THIS appendix contains a digest of those cases decided and published since the body of the work went to press, which either state or illustrate propositions of law. Cases turning wholly upon questions of fact are not cited. A number of these cases have been added to the notes in the correction of the proof-sheets, but do not appear in all the paragraphs to which they are pertinent, and are therefore here repeated. Taken together with the notes, this appendix is intended to present a complete digest of all the cases, involving questions of Patent Law, in the Federal or State reports down to and including the following volumes, viz.: 133 U. S.; 40 Fed. Rep.; 49 O. G.; 24 Ct. of Claims; 24 Blatch.; 13 Sawyer; 11 Bissell; 5 McCrary; 6 Mackey; 87 Ala.; 51 Ark.; 81 Cal.; 12 Col.; 59 Conn.; 5 Dak.; 5 Del.; 5 Del. Ch.; 24 Fla.; 82 Ga.; 1 Idaho; 128 Ill.; 29 Ill. App.; 120 Ind.; 77 Iowa; 42 Kan.; 87 Ky.; 40 La.; 81 Me.; 70 Md.; 149 Mass.; 75 Mich.; 40 Minn.; 66 Miss.; 98 Mo.; 36 Mo. App.; 8 Mont.; 28 Neb.; 19 Nev.; 66 N. H.; 118 N. Y.; 56 N. Y. Sup. Ct.; 17 N. Y. Civ. Proc.; 14 Daly (N. Y.); 62 Hun (N. Y.); 67 How. Pr. (N. Y.); 23 Abb. (N. Y.); 5 Denio (N. Y.); 51 N. J.; 45 N. J. Eq.; 2 New Mex.; 104 N. C.; 46 Ohio St.; 17 Oregon; 129 Pa. St.; 3 Grant (Pa.); 2 Woodw. (Pa.); 6 Pa. Co. (Pa.); 4 Pennypacker (Pa.); 17 Phila. (Pa.); 15 R. I.; 30 S. C.; 87 Tenn.; 74 Tex.; 27 Tex. App.; 3 Utah; 61 Vt.; 84 Va.; 3 Wash.; 32 W. Va.; 74 Wis.; 2 Wy.; 5 Bann. & A.; 6 Fisher; 2 Robb. The English cases are also brought down to 14 L. R. App.; 42 L. R. Ch. D.; 23 L. R. Q. B.

ABANDONMENT OF APPLICATION.

See APPLICATION.

ABANDONMENT TO THE PUBLIC.

Invention must be Complete.

That a mere mental conception can be abandoned as to rival inventors, but only a completed invention can be

abandoned to the public, see *Webster v. Sanford* (1888), 44 O. G. 567.

By Delay before Application.

That delay in applying for a patent is not *ipso facto* abandonment, see *United States Electric Lighting Co. v. Consolidated Electric Light Co.* (1888), 33 Fed. Rep. 869.

That laches in applying for a patent will defeat the first inventor in favor of a diligent later inventor, see *Hubel v. Dick* (1886), 24 Blatch. 59; 28 Fed. Rep. 132; 36 O. G. 939.

By Public Use or Sale.

That experimental sale and use is not public use, see *Campbell v. City of New York* (1888), 35 Fed. Rep. 504; 44 O. G. 1185.

That an experimental use by an inventor is not public use, though a profit is derived from such use, but if the use is mainly for profit and the experiment is only incidental, and the use is public and for more than two years before the application for a patent, it is an abandonment, see *Smith & Griggs Mfg. Co. v. Sprague*, (1887), 123 U. S. 249; 41 O. G. 1037.

That where an invention is put into public use without reserving rights in it or exercising control over it, or examining it to test its efficiency, the use is not experimental, see *Root v. Third Ave. R. R. Co.* (1889), 37 Fed. Rep. 673; 46 O. G. 1393.

That the burden rests on the patentee to show that a public use more than two years before the application was experimental, see *Root v. Third Ave. R. R. Co.* (1889), 37 Fed. Rep. 673; 46 O. G. 1393.

That a use in public being proved more than two years before application, the plaintiff has the burden to show that it was experimental, see *Smith & Griggs Mfg. Co. v. Sprague* (1887), 123 U. S. 249; 41 O. G. 1037.

That "two years before the application" means before the application is filed in the Patent Office, see *Campbell v. City of New York* (1888), 35 Fed. Rep. 504; 44 O. G. 1185.

That the assignment of a patent covering an invention is not a sale of

the invention, nor can it be regarded as public use or sale upon the question of abandonment, see *United States Electric Lighting Co. v. Consolidated Electric Light Co.* (1888), 33 Fed. Rep. 869.

That to an abandonment by public use the knowledge and consent of the inventor is not necessary under the Acts of 1836 and 1839, see *Andrews v. Hovey* (1888) 124 U. S. 694; 42 O. G. 1285; *Blessing v. Trageser Steam Copper Works* (1888) 34 Fed. Rep. 753; *Andrews v. Hovey* (1887), 123 U. S. 267; 41 O. G. 1162.

That public use or sale need not be with the "knowledge, acquiescence, or consent of the inventor," and an allegation to that effect is surplusage, see *Campbell v. City of New York* (1888), 35 Fed. Rep. 504; 44 O. G. 1185.

For a discussion and interpretation of Sec. 7, Act of 1839, see *Andrews v. Hovey* (1888) 124 U. S. 694; 42 O. G. 1285; *Andrews v. Hovey* (1887), 123 U. S. 267; 41 O. G. 1162.

That public use under a joint patent is a bar to a sole patent to one of the former joint patentees, see *Ex parte MacLay* (1889), 49 O. G. 1043.

By Application.

That when a patentee has full knowledge of all the facts, a failure to claim may be an abandonment to the public, see *Huber v. N. O. Nelson Mfg. Co.* (1889), 38 Fed. Rep. 830; 47 O. G. 1732.

That a failure to claim described matter is abandonment unless steps are taken to protect it by timely application, see *Brush Electric Co. v. Fort Wayne Electric Light Co.* (1889), 40 Fed. Rep. 826.

That to fully describe and not claim

is abandonment unless the right to a future patent is reserved, see *Holmes Electric Protective Co. v. Metropolitan Burglar Alarm Co.* (1887), 33 Fed. Rep. 254.

That the reservation in an application of matter to be covered by future patents is improper, the inventor's right to his invention and a patent for it being independent of any such precaution, see *Ex parte Blair* (1888), 43 O. G. 113.

That a described invention essentially distinct from the one claimed in the application, and which ought not to have been mentioned therein, is not dedicated to the public, see *Ex parte Johnston* (1889), 46 O. G. 1641.

That the description of an art in a patent for the apparatus does not dedicate the art to the public if a patent therefor is applied for within two years from the date of the other patent, see *Eastern Paper Bag Co. v. Nixon* (1888), 35 Fed. Rep. 752; 45 O. G. 1571.

After Application.

That an invention is not abandoned by abandoning the application, and does not become the property of the public until after two years' public use or sale, and hence abandoned applications are not open to the public, see *Ex parte Fowler* (1889), 49 O. G. 562.

ACTION IN EQUITY.

Parties.

That a person having an interest in the proceeds of the suit but not in the patent need not be a party to a bill in equity for infringement, see *Tilghman v. Proctor* (1888), 125 U. S. 136; 43 O. G. 628.

That the grantee of the exclusive right to make, use, and sell, throughout the United States on payment of

royalties, must be joined as plaintiff with his grantor in a suit to enjoin an infringement, see *Clement Mfg. Co. v. Upson & Hall Co.* (1889), 40 Fed. Rep. 471.

That the sole owner of one patent may join with the licensor and exclusive licensee of another patent in a suit for an act which infringes both patents, see *Huber v. Myers Sanitary Depot* (1888), 34 Fed. Rep. 752.

Bill.

That the court must determine, in its discretion, whether a bill is multifarious, see *Singer Mfg. Co. v. Springfield Foundry Co.* (1888), 34 Fed. Rep. 393.

That an averment in the bill that the plaintiff became interested in the patent before bringing the suit, by means of certain assignments of which profert is made, is sufficient, see *Clement Mfg. Co. v. Upson and Hall Co.* (1889), 40 Fed. Rep. 471.

That a bill describing the invention without sufficient certainty is demurrable, see *Wise v. Grand Avenue R. R. Co.* (1888), 33 Fed. Rep. 277.

That after decree for defendants the bill may be amended to count on an additional patent and further hearing and evidence be had thereon, see *Underwood v. Gerber* (1889), 37 Fed. Rep. 796; 48 O. G. 675.

That a bill counting on an original may be amended to count on the re-issue, see *Reay v. Berlin & Jones Envelope Co.* (1887), 24 Blatch. 278.

Plea.

That matter of substantive defence cannot be urged on a plea, and if so set up the plea will be ordered to stand as part of the answer, see *Edison Electric Light Co. v. Westinghouse* (1889), 40 Fed. Rep. 666.

That a plea in equity cannot raise the issue of infringement, see *Korn v. Wiebusch* (1887), 33 Fed. Rep. 50.

That the question whether the term of the patent has expired may be raised by plea in equity, see *Edison Electric Light Co. v. U. S. Electric Lighting Co.* (1888), 35 Fed. Rep. 134; 43 O. G. 1456.

Answer.

That the defence of non-patentability for want of inventive skill need not be set up in the answer, see *Hendy v. Golden State & Miners' Iron Works* (1888), 127 U. S. 370; 43 O. G. 1117.

That an amendment of the answer will be allowed to cover evidence of prior patents which have been treated as regularly in the case for that purpose on the arguments, see *Babcock & Wilcox Co. v. Pioneer Iron Works* (1888), 34 Fed. Rep. 338; 43 O. G. 756.

Laches of Plaintiff.

That laches of the plaintiff in equity may be fatal to his claims, see *Kittle v. Hall* (1887), 24 Blatch. 184; 29 Fed. Rep. 508; 39 O. G. 707.

That a plaintiff is not guilty of laches while enforcing his claims against infringers in general in the courts, see *American Bell Telephone Co. v. Southern Telephone Co.* (1888), 34 Fed. Rep. 795.

Cross-Bill.

That the defendant cannot file a cross-bill to enjoin the plaintiff from infringing the defendant's patent, see *McCormick Harvesting Mach. Co. v. Deering* (1889), 47 O. G. 1222.

Evidence.

That an extension of time for taking new testimony will not be granted on a motion which does not set out the

character of the testimony, see *Streat v. Steinam* (1889), 38 Fed. Rep. 548.

Rehearing.

That counsel are bound to anticipate and be prepared for every point that can be made on the evidence, see *Timken v. Olin* (1888), 37 Fed. Rep. 205.

That a rehearing will not be allowed on evidence already before the court and passed on adversely by another judge unless there is manifest error, see *Rogers v. Reissner* (1888), 34 Fed. Rep. 270.

That a rehearing will not be granted to enable defendants to take more evidence against the plaintiff's right to file a disclaimer, if notice had been given that one might be filed, or to offer cumulative and controverted proof as to the comparative utility of the patented invention and other devices, see *Electrical Accumulator Co. v. Julien Electric Co.* (1889), 39 Fed. Rep. 490.

That a hearing may be opened and new evidence taken on the ground of a recent decision of the Supreme Court, giving new views of the law, see *Campbell v. Mayor of New York* (1888), 36 Fed. Rep. 260; 45 O. G. 344.

That a rehearing in equity is at the discretion of the court and no appeal lies from its decision, see *Roemer v. Bernheim* (1889), 132 U. S. 103; 49 O. G. 1535.

That a court will not reverse its decision, after a full hearing on pleadings and proof, unless it is perfectly clear that an error has been committed, see *Coupe v. Weatherhead* (1889), 37 Fed. Rep. 16.

That the interlocutory decree and other proceedings are subject to revision until the final decree is passed,

see *Celluloid Mfg. Co. v. Cellonite Mfg. Co.* (1889), 40 Fed. Rep. 476.

Accounting.

That an accounting of profits can be had only when the infringement took place before the suit was commenced, see *Marsh v. Nichols* (1888), 128 U. S. 605; 46 O. G. 239.

That the accounting must be limited to the time fixed by the plaintiff as the period of infringement, see *Creamer v. Bowers* (1888), 35 Fed. Rep. 206.

That the validity of the Claims of the patent cannot be considered on the accounting, see *Skinner v. Vulcan Iron Works* (1889), 39 Fed. Rep. 870.

That where the master errs by rejecting evidence a motion should be made to the court at once to compel him to receive it, see *Celluloid Mfg. Co. v. Cellonite Mfg. Co.* (1889), 40 Fed. Rep. 476.

That an accounting will not be opened to receive evidence that might previously have been offered where all important testimony was actually presented, see *Morss v. Union Form Co.* (1889), 39 Fed. Rep. 468.

That evidence taken on an accounting at great expense may be saved for future use if the decree is opened on rehearing, see *Campbell v. City of New York* (1888), 35 Fed. Rep. 504; 44 O. G. 1185.

Draft Report.

That no objections to the final report will be considered unless they were urged against the draft report, see *Celluloid Mfg. Co. v. Cellonite Mfg. Co.* (1889), 40 Fed. Rep. 476.

That where objections to the draft report have been accidentally overlooked they may be sometimes made to the final report, see *Celluloid Mfg.*

Co. v. Cellonite Mfg. Co. (1889), 40 Fed. Rep. 476.

Final Report.

That a master's report is to be set aside with almost as much reluctance as the verdict of a jury, see *Welling v. La Bau* (1888), 34 Fed. Rep. 40; 43 O. G. 117.

That objections to the master's report on matters of law may be made at any time, see *Celluloid Mfg. Co. v. Cellonite Mfg. Co.* (1889), 40 Fed. Rep. 476.

That the conclusions of the master on matters of fact are not departed from unless error or mistake is clearly shown, see *Tilghman v. Proctor* (1888), 125 U. S. 136; 43 O. G. 628.

That the findings of fact by the master will not be reviewed when there was a fair conflict of testimony, see *Celluloid Mfg. Co. v. Cellonite Mfg. Co.* (1889), 40 Fed. Rep. 476.

That the master's report, made out as best he could from the evidence of the plaintiff, will not be disturbed where the defendant was a wanton infringer and could have shown the exact extent of his profits, see *Creamer v. Bowers* (1888), 35 Fed. Rep. 206.

That when the master's report is objected to because the infringement was not wilful and the reduction in plaintiff's prices was not due wholly to the infringement, the court can consider the entire subject of the computation of damages, see *Boesch v. Gräff* (1890), 133 U. S. 697.

Profits and Damages, See **DAMAGES,** **PROFITS,** *post.*

Bill of Review.

That a bill of review for errors on the face of the decree must be filed within two years from the date of the decree, see *McDonald v. Whitney* (1889), 39 Fed. Rep. 466.

Costs.

That a complainant who sues in equity on two patents and recovers on only one is entitled to costs, see *Schmid v. Scovill Mfg. Co.* (1889), 37 Fed. Rep. 345.

That the defendant will not be compelled to deliver up the infringing articles to be destroyed when he was in good faith and no further infringement is probable, see *American Bell Telephone Co. v. Kitsell* (1888) 35 Fed. Rep. 521. See also brief of counsel citing authorities *pro* and *con*, in above case.

ACTION AT LAW.**When forbidden.**

That a suit at law cannot be brought without leave of the court, pending an accounting, for infringements since the decree, as the accounting may cover them, see *Morss v. Knapp* (1888), 35 Fed. Rep. 218.

Parties.

That an exclusive license to make and sell throughout the United States on payment of royalties on sales leaves the legal title in the licensor, and he may sue third parties for infringement, see *Freese v. Swartchild* (1888), 35 Fed. Rep. 141.

Declaration.

That the declaration must allege that the invention has not been in public use for more than two years before the application, and it is not sufficient to deny a public use "with consent of the inventor," see *Blessing v. Trageser Steam Copper Works* (1888), 34 Fed. Rep. 753.

Demurrer.

That a demurrer for non-patentability will be sustained if the court can see that the patent is void, see *West v. Rae* (1887), 33 Fed. Rep. 45.

That a demurrer for non-patentability will be sustained only when the matter is so clear that no question of fact can arise upon it, see *Blessing v. Trageser Steam Copper Works* (1888), 34 Fed. Rep. 753.

That a demurrer for want of novelty will be sustained only when the court, from its own knowledge, has no doubt that the device is well-known and in common use, see *Eclipse Mfg. Co. v. Adkins* (1888), 36 Fed. Rep. 554.

Pleadings.

That pleadings in patent cases follow the forms employed in the local courts, see *Celluloid Mfg. Co. v. American Zylonite Co.* (1888), 34 Fed. Rep. 744.

That the notice of special defences is not a pleading and cannot be demurred to, see *Henry v. United States* (1887), 22 Ct. of Claims, 75.

Evidence.

That the court may take judicial notice of want of novelty in clear cases, see *Ligowski Clay Pigeon Co. v. American Clay Bird Co.* (1888), 34 Fed. Rep. 328.

That lack of invention must fairly appear or the patent will prevail, see *Marvin v. Gotschall* (1888), 36 Fed. Rep. 314.

That the defendant's patent is *prima facie* evidence of the novelty and utility of his invention, see *Worswick Mfg. Co. v. City of Kansas* (1889), 38 Fed. Rep. 239; *Deane v. Hodge* (1886), 35 Minn. 146.

That the patent throws upon the defendant the burden of proof on the question of novelty, and if the evidence leaves it doubtful the patent will be sustained, see *Frankfort Whiskey Process Co. v. Mill Creek Distilling Co.* (1889), 37 Fed. Rep. 533.

That the patent is *prima facie* evidence of utility, and must be overcome by sufficient proof, see *Kirk v. Du-Bois* (1887), 33 Fed. Rep. 252; 42 O. G. 297.

That the original application and its amendments are admissible to show the character of the actual invention, see *Consolidated Electric Light Co. v. McKeesport Light Co.* (1889), 40 Fed. Rep. 21; 49 O. G. 1536.

That where two opposing experts conflict, one stating facts within his knowledge, and the other asserting a theory, the former will be followed, see *Bèné v. Jeantet* (1889), 129 U. S. 683; 47 O. G. 402.

That positive testimony will not be disregarded on account of the improbability that the same idea, even as to minute details, should have occurred to two persons on different continents at about the same time, see *Bliss v. Merrill* (1887), 33 Fed. Rep. 39; 42 O. G. 97.

That an infringement carried on secretly must be proved by the plaintiff, and he cannot rely on making out a case by examining the defendant or his workmen, or inspecting their devices, see *Dobson v. Graham* (1889), 48 O. G. 976.

That other devices adjudged to be infringements of the patent may be offered in evidence to show that defendant's device is an infringement, see *Reed v. Smith* (1890), 40 Fed. Rep. 882.

ALIEN.

That alien and citizen patentees are now on the same footing under our law, except as to fees and caveats, see *Edison Electric Light Co. v. U. S. Electric Lighting Co.* (1888), 35 Fed. Rep. 134; 43 O. G. 1456.

APPLICATION FOR PATENT.

Petition.

That the petition of the applicant must identify the specification, the oath concerning foreign patents must be specific, and the rules generally carefully observed, see *Ex parte Mason* (1888), 43 O. G. 627.

Oath.

That the application-oath is evidence against the patentee and may limit the construction of his patent, see *Worswick Mfg. Co. v. City of Kansas* (1889), 38 Fed. Rep. 239.

That an innocent false oath as to citizenship does not avoid the patent, see *Tondeur v. Chambers* (1889), 37 Fed. Rep. 333; 46 O. G. 1110.

Signatures.

That the full Christian name must be signed to the specification, see *Ex parte Gentry* (1888), 44 O. G. 822.

Subject-Matter.

That after one patent has issued, a second patent to the same person, either alone or with others, for the same invention though with broader Claims is unlawful, see *Consolidated Roller-Mill Co. v. Coombs* (1889), 39 Fed. Rep. 25; 48 O. G. 255.

That the grant of a subsequent patent to the same inventor raises a presumption that the later patent covers at least a patentable improvement on the former, see *Putnam v. Keystone Bottle Stopper Co.* (1889) 38 Fed. Rep. 234; 48 O. G. 113.

That a foreign patent with narrow Claims does not prevent the applicant from obtaining a domestic patent for a broader invention, see *Faure v. Bradley* (1888), 44 O. G. 945.

That an article which is the necessary product of a machine already patented is not the subject-matter of

a patent, see *Dubois' Appeal* (1887), 6 Mackey, 140. This position is correct if the article can be made in no other way, — being thus fully protected by the patent for the machine. But if it could be produced by other methods, known or yet to be discovered, how can it lose its patentable character by being described in the machine patent, without some act of abandonment on the part of its inventor?

That a patent cannot be obtained for the process of making an article after a patent has been granted for the article as made by that process, see *Mosler Safe and Lock Co. v. Mosler* (1888) 127 U. S. 254; 43 O. G. 1115.

That a patent may be granted on an earlier application, though since it was filed other patents have been granted on subsequent applications for improvements on the subject-matter of the earlier application, see *Ex parte Edison* (1889), 49 O. G. 1591.

That several applications for the same indivisible subject-matter cannot be entertained, but each application must be clearly distinguishable from the others, see *Ex parte Smith* (1888), 44 O. G. 1183.

Joinder.

That division of an application should not be required unless there is such a total want of interdependence as would render the inventions absolutely independent and distinct, see *Ex parte McMahan* (1889), 48 O. G. 255.

That a combination and its elements, a combination and improvements on its parts affecting its result as a whole, and a machine and such parts as are not recognized in the arts as distinct devices, may be joined in

one application unless opposed to the Office classification, see *Ex parte Willcox* (1888), 45 O. G. 455.

That a separable element already in general use cannot be joined with the combination, see *Ex parte La Bordo* (1888), 44 O. G. 700.

That mere improvements on the old elements of a combination, not affecting the essence of the element, cannot be joined with the combination, see *Ex parte Willcox* (1888), 45 O. G. 455.

That two or more elements of a machine may be joined where one depends on and acts with the other to produce a single result, see *Ex parte Coe* (1889), 48 O. G. 1119.

That where the apparatus cannot operate without performing the process, and the process requires apparatus substantially identical with that in question, no division should be required, see *Ex parte McMahan* (1889), 48 O. G. 255.

That where a process and its product or apparatus can separately exist they require separate applications, see *Ex parte Simonds* (1888), 44 O. G. 445.

That a design patent can cover but one invention, see *Ex parte Gerard* (1888), 43 O. G. 1235, 1240.

Specification, see CLAIM, DESCRIPTION, *post*.

Drawings.

That drawings cannot make the patent cover a different invention from that described in the specification, either on an application for a re-issue or by a disclaimer, see *Hailes v. Albany Stove Co.* (1887), 123 U. S. 582; 42 O. G. 95.

That new figures cannot be added to the drawings after filing, without express permission from the Office,

see *Ex parte* Burt (1889), 49 O. G. 1986.

That the lettering of the drawings and specification must correspond, see *Ex parte* Borgfeldt (1889), 49 O. G. 132.

That where none of the elements of a combination are new or claimed separately, and other similar combinations are in use, the patentee is limited to the form of the elements shown by his drawings, see *Heine Safety Boiler Co. v. Smith F. W. H. & P. Co.* (1889), 47 O. G. 1634.

Examination of Application.

That the applicant must satisfy the Patent Office that his invention is operative and useful as well as new, see *Ex parte* De Baussett (1888), 43 O. G. 1583.

That it is the duty of the Patent Office to see that the applicant obtains a patent for whatever patentable subject-matter his application covers, and in all stages of the application to act as his friend and not his opponent, see *Ex parte* Donovan (1888), 44 O. G. 698.

That an examiner must advise the applicant how to so meet objections as to secure his real invention, see *Ex parte* Donovan (1888), 44 O. G. 698.

That an examiner should give to an applicant any information as to objections which will enable him to amend or appeal, see *Ex parte* Burt (1889), 49 O. G. 1986.

That the examiner can require the applicant to make the Claims definite and intelligible, but cannot in any manner hinder him from obtaining his full rights on appeal, see *Ex parte* Rogers (1889), 49 O. G. 1361.

Amendment.

That an amendment cannot introduce matter not substantially disclosed

in the application as filed, see *Steward v. Ellis* (1889), 49 O. G. 1983.

That an amendment covering a distinct invention cannot be received, see *Ex parte* Zabel (1888), 43 O. G. 627.

That an amendment proposing a Claim not identical with the invention already disclosed or with a part thereof, should be admitted and rejected that an appeal may be taken; but if it covers an essentially distinct invention, so that if admitted a division must be ordered, it should not be received, see *Ex parte* Regan (1888), 45 O. G. 589.

That the oath of the applicant that the matter claimed by an amendment was part of the original invention is not conclusive, but the Office may determine the question by inspecting the whole application, see *Ex parte* Regan (1888), 45 O. G. 589.

That a Claim once erased should not be restored by amendment, see *Ex parte* Gillette (1888), 44 O. G. 819.

That a figure added in good faith to a drawing on file, without the permission of the Office will be erased, see *Ex parte* Cordrey (1889), 48 O. G. 397.

That after a second rejection the applicant cannot amend as a matter of right, see *Ex parte* Donovan (1888), 44 O. G. 698.

That an amendment presented nearly two years after rejection will not be received unless the delay is explained, see *Ex parte* Cordrey (1889), 48 O. G. 397.

That an application cannot be withdrawn from issue for purposes of amendment unless irreparable injury would otherwise result, see *Ex parte* Page (1888), 43 O. G. 1455.

That an allowed application may be withdrawn from issue for purposes of

amendment if irreparable injury would otherwise result, as where the matter of the amendment could not be inserted in a subsequent patent, see *Ex parte Myers* (1889), 49 O. G. 131.

That when an applicant, refusing to adopt an amendment suggested by the examiner, is defeated, and years afterward applies for leave to make such amendment, he is bound by the refusal, see *Ex parte Gray* (1889), 46 O. G. 1277.

Appeal in Uncontested Cases.

That a rejection, to be the subject of an appeal, must be a full and positive rejection, not a mere objection, see *Ex parte Baker* (1889), 49 O. G. 1363.

That all questions relating to patentability should be acted on before appeal, see *Ex parte Burt* (1889), 49 O. G. 1986.

That the appeal from a rejection for want of a proper oath lies to the examiners-in-chief, see *Ex parte Boyer* (1889), 49 O. G. 1985.

That an objection to a Claim as functional is not a rejection, nor does appeal lie to the examiners-in-chief, see *Ex parte Barrett* (1888), 45 O. G. 125.

That a functional Claim is necessarily indefinite, and is therefore objectionable in point of form, see *Ex parte Barrett* (1888), 45 O. G. 125.

That a rejection on the merits must be followed by an appeal to the examiners-in-chief, not by a petition to the Commissioner for a review, see *Ex parte Edison* (1889), 49 O. G. 1691.

That whether a device is a combination or an aggregation is a question of substance, and an appeal lies to the examiners-in-chief, see *Ex parte Baker* (1889), 49 O. G. 1363; *Ex parte Gillette* (1888), 48 O. G. 819.

That a Claim for an aggregation

should be rejected and an appeal allowed instead of ordering a division, see *Ex parte Willcox* (1888), 45 O. G. 455; *Ex parte Bullard* (1888), 45 O. G. 1567; *Ex parte Gillette* (1888), 44 O. G. 819.

That the question of division does not fall within the cognizance of the examiners-in-chief, and their recommendation as to it is unwarranted, they having no concern with questions not before them on appeal or within their jurisdiction, see *Ex parte Gillette* (1888), 44 O. G. 819.

That where an application claims an aggregation and its distinct elements, a question of merits as well as form is raised, and appeal lies to the examiners-in-chief, see *Ex parte Carter* (1889), 46 O. G. 1391.

Division of Application.

That in ordering a division between process and product the examiner must give the applicant all the information on which he bases his judgment, see *Ex parte Pastor* (1887), 42 O. G. 95.

That an examiner may waive his requirement for cross-references between pending applications, see *Ex parte Donovan* (1888), 44 O. G. 698.

That divisional applications are treated as the same proceeding with reference to prior use, see *Frankfort Whiskey Process Co. v. Mill Creek Distilling Co.* (1889), 37 Fed. Rep. 533.

Abandonment of Application.

That unavoidable delay in prosecuting an application does not abandon it, see *Ligowski Clay Pigeon Co. v. American Clay Bird Co.* (1888), 34 Fed. Rep. 328.

That an application cannot be suspended at the request of the applicant for more than two years without aban-

doing it, see *Ex parte* Norton (1888), 42 O. G. 296.

That the "last action" of the Patent Office must be some regular and legal action for the preservation or obtaining of the right, not an irregular and illegal step taken by the applicant and a refusal of the Office to recognize it, see *Kirk v. Commissioner* (1886), 5 Mackey, 229; 37 O. G. 451.

That amendments filed in good faith but not important in character are such prosecution of the application as saves it from abandonment, see *Ex parte* Todd (1889), 49 O. G. 731.

That an informal amendment may be received by the Office to save the application from abandonment, upon condition that the amendment be subsequently made to comply with the rules, see *Ex parte* Sullivan (1888), 45 O. G. 709.

That amendments not removing objections nor changing the status of the application in the Office are not such prosecution as prevents its abandonment, see *Ex parte* Edison (1888), 45 O. G. 461.

That a second original application for the same invention can be filed after the first is abandoned by two years' neglect to renew after forfeiture, see *Ex parte* Barnitz (1888), 42 O. G. 1061.

That an abandoned application is no bar to a subsequent patent, see *Beach v. Fowler* (1889), 48 O. G. 821.

That an abandoned or rejected application cannot be cited as a reference, see *Webster v. Sanford* (1888), 44 O. G. 567.

That copies of abandoned cases in the Patent Office must be furnished on application if needed for purposes of evidence, but a motion to inspect

such cases generally will be denied, see *Ex parte* Fowler (1889), 49 O. G. 562; *United States v. Hall* (1889), 48 O. G. 1263.

That an attorney at law may obtain a mandamus against the Commissioner in his own name to procure copies of abandoned applications from the Office, see *United States v. Hall* (1889), 48 O. G. 1263.

Continuous Applications.

That applications are not continuous unless they cover the same invention, see *Green v. Hall* (1889), 46 O. G. 1515.

That a new application filed at the suggestion of the Patent Office is a continuation of the old, see *International Tooth Crown Co. v. Richmond* (1887), 24 Blatch. 223; 30 Fed. Rep. 775; 39 O. G. 1550.

That a new application filed by the executor of a deceased applicant is a continuation of the former application and has the same status in the Patent Office, see *Ex parte* Smith (1888), 43 O. G. 504.

Forfeited Applications.

That an applicant has no right to forfeit an application and file a renewal at his option, see *Ex parte* Manny (1888), 44 O. G. 700.

Allowed Applications.

That an allowed application cannot be withheld when neither reference, publication, public use, nor interference can be urged against it, see *Ex parte* Atwood (1888), 44 O. G. 341.

Bill in Equity for Patent.

That in an *ex parte* case in the Patent Office the remedies by appeal must be exhausted before a bill in equity to obtain the patent can be filed, see *Kirk v. Commissioner* (1886), 5 Mackey, 229; 37 O. G. 451.

That the Secretary should not be made a party to a bill to obtain a patent, see *Kirk v. Commissioner* (1886), 5 Mackey, 229; 37 O. G. 451.

That on an appeal from a decree in equity granting a patent to one of two rival inventors on the sole ground of his priority, the defeated party may raise the question of the patentability of the invention and the Supreme Court may decide it, see *Hill v. Wooster* (1890), 132 U. S. 693.

ART.

That an art is as truly the subject of a patent as a machine or composition of matter, see *The Telephone Cases* (1888), 126 U. S. 1; 43 O. G. 377.

That a process consisting in the production and use of a change in the condition of an electrical current is patentable, see *The Telephone Cases* (1888), 126 U. S. 1; 43 O. G. 377.

That an art is new if the final step is new, though the other steps and the apparatus are old, see *Frankfort Whiskey Process Co. v. Mill Creek Distilling Co.* (1889), 37 Fed. Rep. 533.

That a new art may be produced by omitting one of the steps regarded as necessary in an old one, see *Lawther v. Hamilton* (1888), 124 U. S. 1; 42 O. G. 487.

That a process which is the mere function of a machine is not separately patentable, see *Ex parte Simonds* (1888), 44 O. G. 445.

That a mechanical process capable of being performed by other apparatus than the machine devised by its inventor for the purpose is separately patentable, unless dedicated to the public by the use of the machine, see *Ex parte Young* (1888), 46 O. G.

1635. See this case for a discussion of the relation of processes to machines.

ASSIGNMENT.

That the title to the patent, to whomsoever granted, vests on its issue in the ultimate assignee of record, see *Consolidated Electric Light Co. v. McKeesport Light Co.* (1888), 34 Fed. Rep. 335; 44 O. G. 110.

That a single Claim of a patent may be assigned, see *Pope Mfg. Co. v. Gormully & Jeffrey Mfg. Co.* (1888), 34 Fed. Rep. 893.

That an assignment of all the patentee's interest in the patent for the whole term, with all re-issues, renewals, and extensions, for one fourth of the future proceeds, transfers the entire title to the assignee, see *Rude v. Westcott* (1889), 130 U. S. 152; 48 O. G. 399.

That the transfer of an exclusive right to make, use, and sell, upon the payment of certain royalties, leaves an interest in the transferor and is not an absolute assignment, see *Clement Mfg. Co. v. Upson & Hall Co.* (1889), 40 Fed. Rep. 471.

That the transferee of an undivided interest in the invention for a certain part of the United States is not an assignee, and cannot join in prosecuting an application for a patent, see *Ex parte Funston* (1889), 49 O. G. 1044.

That an assignment made by attorney must be executed in the name of the principal, and sealed with his seal, see *Machesney v. Brown* (1886), 24 Blatch. 168; 38 O. G. 1130; 29 Fed. Rep. 145.

That an assignment of rights of action must be clearly expressed, and if procured pending suit by an assignee of the patent cannot be set up by sup-

plemental bill, see *Emerson v. Hubbard* (1888), 34 Fed. Rep. 327; 46 O. G. 976.

ATTORNEYS.

That patent attorneys and solicitors are not expected to be learned lawyers, and indulgence should be shown to applicants on that account, see *Osgood v. Badger* (1888), 44 O. G. 1065.

That the attorney of the inventor will be recognized by the Patent Office until the assignee asserts his rights, see *Ex parte Baker* (1889), 49 O. G. 1363.

CAVEAT.

That as a design cannot be incomplete no caveat for it is allowable, see *Ex parte Carty* (1888), 44 O. G. 570.

That when an application apparently conflicts with a pending caveat, notice should be sent at once to the caveator without waiting to determine the patentability of the invention, see *Ex parte Ward* (1889), 46 O. G. 1513.

That a caveator after notice is not bound to file any application, nor can he excuse himself for lack of diligence in filing it, nor will an applicant be delayed to wait for an application from a caveator, see *Ex parte Ward* (1889), 46 O. G. 1513; *Elges v. Miller* (1889), 46 O. G. 1514.

CLAIM.

That matter not claimed is not covered by the patent, see *Dickinson v. Parker* (1889) 38 Fed. Rep. 411; *Van Camp v. Maryland Pavement Co.* (1888), 34 Fed. Rep. 740; 43 O. G. 884.

That the patentee is bound by his Claim, see *Electrical Accumulator Co. v. Julien Electric Co.* (1889), 38 Fed. Rep. 117.

That the Claim should leave it to

the Description to enumerate details of construction not essential to the invention, and the Claim cannot be limited to these details, see *Ex parte Laskey* (1889), 48 O. G. 539.

That a feature not alluded to in the Description cannot be covered by the Claim, though it appears in the drawings, see *Gunn v. Savage* (1887), 24 Blatch. 247; 30 Fed. Rep. 366.

That any perfectly clear expression of what the inventor intends to secure to himself in immediate connection with the Claim is virtually part of the Claim, see *La Rue v. Western Electric Co.* (1886), 24 Blatch. 18; 28 Fed. Rep. 85; 36 O. G. 453.

That the file-wrapper and contents may interpret the Claim, see *Royer v. Coupe* (1889), 38 Fed. Rep. 113.

That the inventor of an improvement only cannot claim the entire means, see *Ex parte Miller* (1888), 43 O. G. 1346.

That a patentee who has accepted a patent with Claims restricted by the Patent Office is not limited to the letter of his Claims, nor deprived of the right to equivalents, see *Consolidated Roller-Mill Co. v. Coombs* (1889), 39 Fed. Rep. 25; 48 O. G. 255.

That "as shown and described" will be implied by the courts in all Claims, but is usually required by the Patent Office, especially in design patents, see *Ex parte Gerard* (1888), 43 O. G. 1235.

That the words "means," "mechanism," "connections," are sometimes proper, see *Ex parte Stoughton* (1888), 43 O. G. 1345; *Ex parte Stanbridge* (1888), 43 O. G. 1345.

COMBINATION.

That the effecting a new result as distinguished from an aggregation of

old results is one test of a combination, see *Shipman Engine Co. v. Rochester Tool Works* (1888), 44 O. G. 1067.

That where no result is attained by grouping elements beyond their separate or collective result, the grouping is an aggregation, not a combination, see *Richards v. Michigan Cent. R. R. Co.* (1889), 40 Fed. Rep. 165.

That where the elements do not co-act to produce a new result, there is no patentable combination, see *Brinkerhoff v. Aloe* (1888), 37 Fed. Rep. 92; 46 O. G. 338.

That a combination must perform a function beyond that which is the sum of the functions of its separated elements, see *Ide v. Ball Engine Co.* (1889) 39 Fed. Rep. 548; 49 O. G. 283; *Jones v. Clow* (1889), 39 Fed. Rep. 785.

That a series of identical devices is not a combination, but each device is a complete thing by itself, see *Morrison v. Canton Surgical and Dental Chair Co.* (1889), 49 O. G. 733.

That the omission from a patented combination of one element, leaving the other elements to co-act just as they did before, is not a new invention, see *McClain v. Ortmayer* (1887), 33 Fed. Rep. 284; 42 O. G. 724.

That all claimed elements of a combination are thereby made essential, see *Thompson v. Gildersleeve* (1888), 34 Fed. Rep. 43; 43 O. G. 886.

COMMISSIONER OF PATENTS.

That the duties of the Commissioner are partly ministerial, partly judicial, see *Daniel v. Morgan* (1889), 47 O. G. 811.

That the Commissioner has no jurisdiction over conflicts as to title, nor can he recognize equitable or contract

rights, see *McDonough v. Gray* (1889), 46 O. G. 1245.

CONCEPTION.

That conception is proved by description only when the description shows that the conceiver had not merely perceived the desirability of a result, but the way and means of effecting it, so that a listener to the description, if skilled in the art, could produce it, see *Wherry v. Heck* (1889), 49 O. G. 559.

That drawings and models are much higher evidence of conception than oral descriptions, see *Wherry v. Heck* (1889), 49 O. G. 559.

That an abandoned application may show conception, see *Beach v. Fowler* (1889), 48 O. G. 821.

CONSTRUCTION OF PATENTS.

That patents are to be construed in the light of common knowledge as to what was in use before, see *Fornbrook Mfg. Co. v. Iron Works* (1886), 63 Mich. 195.

That a patent is to be construed in view of the state of the art and so as to protect the actual invention, if its language will permit, see *Consolidated Roller Mill Co. v. Coombs* (1889), 39 Fed. Rep. 25; 48 O. G. 255.

That a patent cannot be construed to cover parts not described or claimed, see *Ball & Socket Fastener Co. v. Kraetzer* (1889), 39 Fed. Rep. 700.

That a narrow Claim must be enlarged by re-issue, if at all, not by construction, see *Becker v. Hastings* (1884), 17 Phila. 580.

That a construction not contemplated when the Claim was drawn cannot be afterwards given to it, see *Ladd v. Mooney* (1884), 17 Phila. 571.

That the Claim of a patent defines what the Patent Office has determined to be the scope of the invention, and it cannot be enlarged by construction, see *Day v. Fair Haven & Westville R. R. Co.* (1889), 132 U. S. 98; 49 O. G. 1364.

That after the Claim has been modified in obedience to the Patent Office it cannot be enlarged by construction to cover the relinquished matter, see *Phoenix Caster Co. v. Spiegel* (1890), 133 U. S. 360; *Roemer v. Peddie* (1889), 132 U. S. 313; 49 O. G. 2151.

That the court in construing the Claims may examine the file-wrapper and contents, see *Consolidated Roller-Mill Co. v. Coombs* (1889), 39 Fed. Rep. 25; 48 O. G. 255.

That the construction put upon a Claim by the Patent Office in allowing it, as shown by the correspondence, will be followed, see *Royer v. Schultz Belting Co.* (1889), 40 Fed. Rep. 158; *Geis v. Kimber* (1888), 36 Fed. Rep. 105; 44 O. G. 108.

That where the Claim is clear the drawings need not be considered in construing it, see *Kidd v. Horry* (1888), 33 Fed. Rep. 712.

CONTRACTS.

Express or Implied.

That the right to use a patented invention may be the subject of a contract express or implied, and assumpsit will lie to recover reasonable compensation for its use, see *Deane v. Hodge* (1886), 35 Minn. 146.

That under an implied contract for the use of an invention the measure of recovery is a reasonable royalty, as custom or expert evidence as to utility and value may indicate, see *Deane v. Hodge* (1886), 35 Minn. 146.

Partnership.

That patents may be contributed to the capital of a partnership, see *Relfus v. Moore* (1889), 6 Pa. Co. (Pa.) 245.

That where a patentee assigns a half-interest in the patent to a capitalist, and they unite in making and selling the invention, they are partners, and at the death of one the business should be settled up, the assets sold and proceeds divided, and a bill in equity may be brought by the executor of the deceased partner against the survivor for that purpose, see *Farr v. Morrill* (1889), 53 Hun (N. Y.), 31.

Warranty.

That a warranty guaranteeing the exclusive sale of one machine within certain territory is not broken by the sale of a different machine in the same territory under the same patent, see *Pratt v. Marean* (1888), 25 Ill. App. 516.

For Royalties.

That the acceptance of a license on condition of royalties is an agreement to pay the royalties, see *Paper Stock Disinfecting Co. v. Boston Disinfecting Co.* (1888), 147 Mass. 318.

That a licensee under a patent covering several inventions is liable for the stipulated royalty, whether he uses one or all of them, see *Hubbard v. Allen* (1889), 123 Pa. St. 198.

In Restraint of Trade.

That a contract regulating the mutual enjoyment of patent-rights is not "in restraint of trade," see *Bowling v. Taylor* (1889), 40 Fed. Rep. 404.

That a restriction in a transfer of rights under a patent being greater than is reasonably necessary to protect the purchaser is void as against public policy, see *Berlin Mach. Works v. Perry* (1888), 71 Wis. 495.

Failure of Consideration.

That an agreement to procure and assign a patent fails if the patent is not procured or procurable, and the purchase money may be recovered by the promisee, see *Westervelt v. Fuller Mfg. Co.* (1885), 13 Daly (N. Y.) 352.

Specific Performance.

That equity may compel the assignment of a patent by the legal owner to those equitably entitled to it, see *Berolzheimer v. Strauss* (1884), 51 Sup. Ct. (N. Y.) 96.

That State courts of equity will compel specific performance of contracts for assignment or license, see *Fuller & Johnson Mfg. Co. v. Bartlett* (1887), 68 Wis. 73.

That a parol agreement to assign a patent may be enforced in equity, and the court may direct the execution of the necessary papers, see *Scarle v. Hill* (1887), 73 Iowa, 367.

That an oral contract for a license to use an invention may be enforced in equity, see *Nichols v. Marsh* (1886), 61 Mich. 509.

That an agreement to apply for and assign foreign patents will be enforced, see *Adams v. Messinger* (1888), 147 Mass. 185.

That an agreement by the owner of a patent to make and deliver the patented article will be enforced in equity, where no special skill is required to make it, see *Adams v. Messinger* (1888), 147 Mass. 185.

That specific performance of an agreement to convey a patent will not be decreed where the defendant has no title or the patent is void, see *Kennedy v. Hazelton* (1888), 128 U. S. 667; 46 O. G. 973.

That the specific performance of a

void patent will not be decreed, see *Kennedy v. Hazelton* (1888), 33 Fed. Rep. 293.

That an unconscionable contract will not be enforced in equity, see *Pope Mfg. Co. v. Gormully* (1888), 34 Fed. Rep. 877.

That the owner of a patent may be enjoined against alienating or encumbering his title thereto, see *Adams v. Messinger* (1888), 147 Mass. 185.

Rescission.

That a contract to purchase a patent right obtained by the fraud of the vendor will be rescinded in equity, and the parties placed *in statu quo*, see *Marsh v. Scott* (1888), 125 Ill. 114.

That a party having the right to a rescission and an affirmance of a contract must make his election and abide by it, see *Creighton v. Haggerty* (1884), 50 Sup. Ct. (N. Y.) 9.

DAMAGES.**Must be proved.**

That damages must be proved, not conjectured, see *Rude v. Westcott* (1889), 130 U. S. 152; 48 O. G. 399.

License Fee as Measure of Damages.

That license fees fixed by plaintiff and voluntarily paid by licensees, are evidence of an established fee, see *United Nickel Co. v. Central Pac. R. Co.* (1888), 36 Fed. Rep. 186.

That a license fee is established only where the payment of such fees is of frequent occurrence and shows the value of the license in similar cases, see *Rude v. Westcott* (1889), 130 U. S. 152; 48 O. G. 399.

That two instances are admissible to show an established license fee, see *Cary v. Lovell Mfg. Co.* (1889), 37 Fed. Rep. 654; 47 O. G. 525.

That irregular and uncertain rates

for licenses do not show a license fee, see *United Nickel Co. v. Central Pac. R. Co.* (1888), 36 Fed. Rep. 186.

That when a regular license fee exists it is not varied by occasional departures in cases of necessity, see *Asmus v. Freeman* (1888), 34 Fed. Rep. 902.

That an allowance of a sum *per* article by a court as damages does not fix a royalty or give a right to interest thereon, see *Graham v. Plano Mfg. Co.* (1888), 35 Fed. Rep. 597.

That payment of a sum in settlement of an infringement does not measure the value of the invention or the damages sustained in other cases, see *Rude v. Westcott* (1889), 130 U. S. 152; 48 O. G. 399; *Cornely v. Marckwald* (1889), 131 U. S. 159; 47 O. G. 1353; *United Nickel Co. v. Central Pac. R. Co.* (1888), 36 Fed. Rep. 186.

That a royalty paid for one right under a patent, or for all the rights, is not evidence of damages for infringing a single different right, see *Colgate v. Western Electric Mfg. Co.* (1886), 24 Blatch. 75.

That a royalty paid for several patents jointly does not show the license fee for either, see *Vulcanite Paving Co. v. American Artificial Pavement Co.* (1888), 36 Fed. Rep. 378; 45 O. G. 948.

Loss of Profits as Measure of Damages.

That where there is no license fee the measure of damages is the profits lost by the patentee by reason of the infringement, and he must show to what extent sales have been diverted from him, see *Covert v. Sargent* (1889), 38 Fed. Rep. 237.

That where the plaintiff does not grant licenses, the measure of dam-

ages for an infringing sale is the amount of profit he would have made if he had sold what the defendant sold, deducting a fair percentage in respect of sales due to the particular exertions of the defendant, but not taking into consideration that the defendant might have sold the same quantity without infringing the patent, or that the price of other goods sold by the plaintiff was reduced by the unlawful competition, see *United Horse Shoe & Nail Co. v. Stewart* (1888), L. R. 13 App. 401.

That the plaintiff may show by circumstantial as well as direct evidence that he would have sold the articles sold by the defendant, see *Covert v. Sargent* (1889), 38 Fed. Rep. 237.

That where defendants, before infringing, bought of the plaintiff, as also during the infringement to some extent, it is a fair presumption that they would have bought of him all they made and used, see *Creamer v. Bowers* (1888), 35 Fed. Rep. 206.

That a plaintiff who claims a loss by reduction of prices must show by sufficient data to what extent such reduction was due to the infringement, see *Boesch v. Gräff* (1890), 133 U. S. 697; *Cornely v. Marckwald* (1889), 131 U. S. 159; 47 O. G. 1353.

That when the plaintiff charged no more when he used his invention than when he did not use it, evidence that he lost valuable contracts through the defendant's competition is inadmissible, see *Vulcanite Paving Co. v. American Artificial Stone Pavement Co.* (1888), 36 Fed. Rep. 378; 45 O. G. 948.

Increase of Damages.

That for a flagrant injury damages will be trebled, see *Lyon v. Donaldson* (1888), 34 Fed. Rep. 789.

That a strenuous contest, if fair and *bona fide*, is no reason for increasing the damages, see *Welling v. La Bau* (1888), 35 Fed. Rep. 302.

That a court will not increase the damages merely because the defendant urged his goods on the plaintiff's customers, see *Morss v. Union Form Co.* (1889), 39 Fed. Rep. 468.

That the court may award damages in equity in excess of the profits and then treble them, see *Tilghman v. Proctor* (1888), 125 U. S. 136; 43 O. G. 628.

That while after final decree the defendant may not be allowed to offer evidence, before carelessly omitted, to show that the patent is void, yet in view thereof the court may refuse to increase damages, see *Welling v. La Bau* (1888), 35 Fed. Rep. 302.

Nominal Damages.

That a plaintiff, not having any compromise in view, is bound by an offer to accept nominal damages, see *Creamer v. Bowers* (1888), 35 Fed. Rep. 206.

Interest.

That interest is allowed on royalties, but not on unliquidated damages, see *Creamer v. Bowers* (1888), 35 Fed. Rep. 206.

DATE.

Of Invention.

That a foreign patentee cannot claim an earlier date for his invention than that of his foreign patent, see *Electrical Accumulator Co. v. Julien Electric Co.* (1889), 38 Fed. Rep. 117.

That a statement in the domestic specification that the applicant has obtained a foreign patent does not prove that fact nor carry back the *prima facie* date of his invention, see *Electrical*

Accumulator Co. v. Julien Electric Co. (1889), 38 Fed. Rep. 117.
Of Patent.

That the date of the American patent need not correspond with that of the foreign one by which its term is limited, see *The Telephone Cases* (1888), 126 U. S. 1; 43 O. G. 377.

DESCRIPTION.

Completeness.

That one pending application cannot refer to another for a fuller description, but each must be complete in itself, see *Ex parte Borgfeldt* (1889), 49 O. G. 132; *Ex parte Everitt* (1889), 49 O. G. 564.

Correctness.

That inaccurate statements concerning the good results of a patented process do not render the Description defective, see *Michaelis v. Roessler* (1888), 34 Fed. Rep. 325.

Fraudulent Concealment.

That the defence of fraudulent concealment is not supported unless an intent to deceive is shown, see *Celluloid Mfg. Co. v. Russell* (1889), 37 Fed. Rep. 676.

Addressed to those Skilled in the Art.

That the Description is addressed to those skilled in the art, see *Celluloid Mfg. Co. v. Russell* (1889), 37 Fed. Rep. 676.

That the Description of a scientific invention is addressed to those learned in the science, see *Electrical Accumulator Co. v. Julien Electric Co.* (1889), 38 Fed. Rep. 117.

That the Description of a process must describe it in a manner intelligible to those skilled in the art, and point out a way to make it practical, but it is not required that it be brought to the highest degree of perfection,

see *The Telephone Cases* (1888), 126 U. S. 1; 43 O. G. 377.

That the Description is sufficient if a skilled mechanic could from it construct the invention, see *Pullman Palace Car Co. v. Wagner Palace Car Co.* (1889), 38 Fed. Rep. 416.

That the specification of a chemical patent is addressed to those skilled in chemistry and is sufficient if intelligible to them, see *Am Ende v. Seabury* (1888) 36 Fed. Rep. 593; 47 O. G. 1354; *Anilin v. Levinstein* (1887), L. R. 12 App. 710.

DESIGN.

When Patentable.

That a design presenting a new appearance to the eye, and creating a demand for the goods on which it is impressed, is patentable though simple and resembling other designs, see *Untermeyer v. Freund* (1889), 37 Fed. Rep. 342; 47 O. G. 527.

That a design is not new unless it would appear to ordinary observers to be different from the old, but the difference may be small, see *Redway v. Ohio Stove Co.* (1889), 38 Fed. Rep. 582.

Combination.

That a patent for a combination of old designs is proper, see *Whitman Saddle Co. v. Smith* (1889), 38 Fed. Rep. 411; *Redway v. Ohio Stove Co.* (1889), 38 Fed. Rep. 582.

That every design is a finished and distinct entity, not a combination, nor a genus, nor a species, see *Ex parte Gerard* (1888), 43 O. G. 1235, 1240.

Design and Manufacture.

That a design may be also a manufacture, see *Ex parte Gerard* (1888), 43 O. G. 1235.

Identity of Designs.

That the identity of designs is measured by their appearance to ordinary

observers, not to experts, see *Redway v. Ohio Stove Co.* (1889), 38 Fed. Rep. 582; *Ex parte Gerard* (1888), 43 O. G. 1235; *Kraus v. Fitzpatrick* (1888), 34 Fed. Rep. 39; 42 O. G. 1202.

DISCLAIMER.

Nature.

That secs. 4917 and 4922 Rev. Stat. concerning disclaimers are parts of one law and require the same conditions for amendment, see *Hailes v. Albany Stove Co.* (1887), 123 U. S. 582; 42 O. G. 95.

Cannot Change Invention.

That a disclaimer cannot change the character of the patented invention nor render further description necessary, but can only eliminate separable matter from the Claims, see *Hailes v. Albany Stove Co.* (1887), 123 U. S. 582; 42 O. G. 95.

That a patent for the apparatus cannot be changed into one for the process by disclaiming the apparatus except when used in the process, see *Grant v. Walter* (1889), 38 Fed. Rep. 594; 47 O. G. 1220.

Affects Claim, not Description.

That a disclaimer is not needed when the Description is excessive but not the Claim, — the Claim controlling the Description and limiting the patent, — see *Brush Electric Co. v. Fort Wayne Electric Light Co.* (1889), 40 Fed. Rep. 826.

Effect on Claim.

That a disclaimer of the separable excess may save the valid portion of the Claim, see *Electrical Accumulator Co. v. Julien Electric Co.* (1889), 38 Fed. Rep. 117.

That the patentee is bound by a Claim which has been narrowed to meet an unfounded objection in the

Patent Office, see *Lapham Dodge Co. v. Soverin* (1889), 40 Fed. Rep. 762.

After Unreasonable Delay.

That a disclaimer to save an otherwise lost suit is not permissible after unreasonable delay, see *Hake v. Brown* (1889), 37 Fed. Rep. 783; 47 O. G. 1071.

As Evidence.

That a disclaimer cannot be put in evidence after decision on the merits in equity, except upon a rehearing and on such terms as the court may impose, see *Roemer v. Bernheim* (1889), 132 U. S. 103; 49 O. G. 1535.

EMPLOYER AND EMPLOYEE.

Assignment.

That the inventions of a person hired to invent, and to patent his inventions in the name of the employer, equitably belong to the employer, and if patented to the inventor he may be compelled in equity to assign his patent to the employer, see *Annin v. Wren* (1887), 44 Hun (N. Y.), 352.

That an employer may patent the inventions of his employees for his own benefit if they consent, see *Dueber Watch-Case Mfg. Co. v. Dalzell* (1889), 38 Fed. Rep. 597.

License.

That an employee disclosing his invention to the employer, and putting it to practical use in the employment, does not thereby transfer a right to the invention itself and the future patent therefor, but licenses the employer to use it, see *Fuller & Johnson Mfg. Co. v. Bartlett* (1887), 68 Wis. 73.

EQUIVALENTS.

Though not identical.

That devices may be equivalents though one answers the purpose better

than the other, see *Roosevelt v. Law Tol. Co.* (1887), 33 Fed. Rep. 505.

"Known" Equivalents.

That a "known equivalent" is such a substitute as is known to be able to accomplish the same result, see *Morley Mach. Co. v. Lancaster* (1889), 129 U. S. 263; 47 O. G. 267.

That equivalents are such though it could not have been known that they would be equivalents until after the device in which they are employed was invented, see *Morley Mach. Co. v. Lancaster* (1889), 129 U. S. 263; 47 O. G. 267.

Covered by Patent.

That a patentee is entitled to equivalents though he may have reformed his Claims under requirements of the Patent Office, see *Rodebaugh v. Jackson* (1889), 37 Fed. Rep. 882; 47 O. G. 658.

ESTOPPEL.

That an attorney in fact, conveying the patent under a power, is not estopped to deny validity, see *H. Tibbe & Son Mfg. Co. v. Heineker* (1889), 37 Fed. Rep. 686; 47 O. G. 1221.

GENUS AND SPECIES.

That the relation of an improvement to its original is not always that of species to a genus, — a species being created only when an original generic element is supplanted by a new or modified element, see *Ex parte Smith* (1888), 44 O. G. 1183.

That a process and its apparatus are not genus and species but distinct inventions, see *Ex parte Atwood* (1888), 44 O. G. 341.

IDENTITY.

That greater perfection in the result effected does not show want of identity, see *Mac Donald v. McLean* (1889), 38 Fed. Rep. 328.

INFRINGEMENT.**By Use.**

That use of the invention for a different purpose is infringement, see *Thompson v. Gildersleeve* (1888), 34 Fed. Rep. 43; 43 O. G. 886.

By Sale.

That the sale of part of an invention to those who have a right to use it is not an infringement, see *Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co.* (1889), 40 Fed. Rep. 577.

That the sale of an element capable of an innocent use, and without collusion, does not infringe the patent for the combination, see *Winne v. Bedell* (1889), 40 Fed. Rep. 463; 49 O. G. 2152.

By Joint or Collusive Acts.

That a joint infringement is one tort, and recovery of satisfaction against one tort-feasor is a bar to further proceedings, see *Babcock & Wilcox Co. v. Pioneer Iron Works* (1888), 34 Fed. Rep. 338; 43 O. G. 756.

That a patent may be infringed by the separate acts of different parties having a common purpose, though no one act is by itself an infringement, see *Celluloid Mfg. Co. v. American Zylonite Co.* (1887), 24 Blatch. 321.

Of several Patents.

That when the titles to two conflicting patents are united in one owner, one invention may be treated as an improvement on the other as against an infringer, see *Putnam v. Keystone Bottle Stopper Co.* (1889), 38 Fed. Rep. 234; 48 O. G. 113.

That where two patents cover in part the same field, a party who has used under both may be held liable for that in each which was not covered by the other, and cannot claim that the

later was void because anticipated by the other, see *Deano v. Hodge* (1886), 35 Minn. 146.

Of Combination-patent.

That a combination-patent is infringed if the substance of the combination is taken, whatever equivalents, alterations, or omissions may be resorted to, see *Proctor v. Bennis* (1887), L. R. 36 Ch. D. 740.

That a combination is not infringed unless all its elements or their equivalents are used, see *Perkins v. Eaton* (1889), 40 Fed. Rep. 672.

That taking some of the elements with equivalents for the others infringes the combination, see *Leary v. Hohenstein* (1889), 37 Fed. Rep. 680; 46 O. G. 1518.

That the reconstruction of a combination after its patent has expired is not an infringement, see *Johnson v. Brooklyn & C. R. Co.* (1888), 37 Fed. Rep. 147.

Of Patent for an Art.

That a patent for an art is not infringed if some of its steps are omitted, see *Royer v. Coupe* (1889), 38 Fed. Rep. 113.

That a process is infringed by employing the essence of the invention, whatever apparatus may be used, see *Morley Mach. Co. v. Lancaster* (1889), 129 U. S. 263; 47 O. G. 267.

Of Machine-patent.

That a machine performing new functions is infringed by any mechanism which employs the same means to accomplish the same results, though its parts are individually improved, see *Morley Mach. Co. v. Lancaster* (1889), 129 U. S. 263; 47 O. G. 267.

Of Design-patent.

That a design may infringe though the infringer's name be coupled with

it, see *Railway v. Ohio Stove Co.* (1889), 38 Fed. Rep. 582.

By the Government or its Officers.

That in the absence of any special agreement the acts of the government in using an invention measure its liability under an implied contract, see *Butler v. United States* (1888), 23 Ct. of Claims, 335.

That the unauthorized use of an invention by a public officer does not raise an implied contract on the part of the government to pay for such use, see *Forehand v. United States* (1888), 23 Ct. of Claims, 477.

That when the government denies that the invention used is the property of the claimant, the use is not under a contract, see *Schillinger v. United States* (1889), 24 Ct. of Claims, 278.

By City.

That a city may be liable for an infringement committed by a contractor acting under its orders, see *Asbestine Tiling & Mfg. Co. v. Hepp* (1889), 39 Fed. Rep. 324; 49 O. G. 413.

By private Corporations, their Officers, etc.

That an officer of a solvent corporation is not liable for its infringements unless he personally participates therein, though he may be bound by an injunction, see *Boston Woven Hose Co. v. Star Rubber Co.* (1889), 40 Fed. Rep. 167.

That the officers of a corporation though made parties will not be individually enjoined or ordered to account when the corporation is solvent, unless they as individuals have violated or threaten to violate the patentee's rights, see *Howard v. St. Paul Plow Works* (1888), 35 Fed. Rep. 743; 45 O. G. 1067.

By Licensor.

That a licensor is liable in equity for infringing acts committed by his licensees when following his directions and working drawings, see *Toppan v. Tiffany Refrigerator Car Co.* (1889), 39 Fed. Rep. 420.

By Licensee.

That a licensee exceeding his license becomes an infringer, see *Covell v. Bostwick* (1889), 39 Fed. Rep. 421.

That a licensee under one Claim of a patent may be treated as an infringer of another Claim, though the infringement is accomplished by the use of the licensed Claim, see *United Nickel Co. v. California Electrical Works* (1885), 11 Sawyer 250.

By Workman.

That a mere workman having no pecuniary interest in the product of his labor is not an infringer, see *Young v. Foerster* (1889), 37 Fed. Rep. 203; 47 O. G. 1353.

Liability of Executor.

That an action in equity for infringement survives against the executor of the infringer, although no injunction can be granted, see *Hohorst v. Howard* (1888), 37 Fed. Rep. 97.

Must be Proved.

That infringement must be proved, not conjectured, see *Winne v. Bedell* (1889), 40 Fed. Rep. 463; 49 O. G. 2152; *Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co.* (1889), 40 Fed. Rep. 577.

INJUNCTION.

Preliminary, when denied.

That an injunction will be refused in the absence of judgments, acquiescence, or success in an interference proceeding, see *Edward Barr Co. v.*

N. Y. & N. H. Automatic Sprinkler Co. (1887), 24 Blatch. 566; 43 O. G. 392.

That an injunction will be refused when there are no judgments or acquiescence, and infringement is doubtful, see *Raymond v. Boston Woven Hose Co.* (1889), 39 Fed. Rep. 365; 48 O. G. 1776.

That an injunction will be refused when there are no judgments or acquiescence, and defendant is solvent and would sustain great injury, and the plaintiff has been guilty of laches, see *Hurlburt v. Carter* (1889), 39 Fed. Rep. 802.

That an injunction will be refused where no judgments have been rendered, acquiescence is doubtful, the infringement is denied, and defendants are pecuniarily responsible, and have a long time carried on an extensive business, while plaintiff has owned the patent but a few months, see *Johnson v. Aldrich* (1889), 40 Fed. Rep. 675.

Judgments.

That a restraining order, pending suit, will be granted on one final judgment and several interlocutory orders for injunctions and a public acquiescence of several years, see *Schneider v. Missouri Glass Co.* (1888), 36 Fed. Rep. 582; 45 O. G. 1069.

That an injunction may issue without a prior judgment at law, but the court, if validity is doubtful, may order an issue at law before allowing an injunction, see *Wise v. Grand Avenue R. R. Co.* (1888), 33 Fed. Rep. 277.

That an injunction will be refused where the evidence of validity consists of a judgment from which an appeal is pending, and where the defendant is acting in good faith and in ignorance

of the infringement and would sustain irreparable injury, while the plaintiff has an adequate remedy at law, see *Consolidated Roller Mill Co. v. Richmond City Mill Works* (1889), 40 Fed. Rep. 474.

That where there has been no judgment or its equivalent, and the defendants deny the validity of the patent if so construed as to prohibit their acts, an injunction will be refused, see *Dickerson v. De La Vergne Refrigerating Mach. Co.* (1888), 35 Fed. Rep. 143.

Acquiescence.

That acquiescence implies an interest adverse to the patent and a submission to the patent, see *Raymond v. Boston Woven Hose Co.* (1889), 39 Fed. Rep. 365; 48 O. G. 1776.

That acquiescence in the right of the inventor to an invention covered by several patents is not acquiescence in any one patent, see *Upton v. Wayland* (1888), 36 Fed. Rep. 593.

Validity Doubtful.

That an injunction will be denied where it is evident that the patent will be very narrowly sustained if at all, see *Glaenger v. Wiederer* (1887), 33 Fed. Rep. 583.

That an injunction will not issue where patentability is doubtful, see *Osborn v. Judd* (1886), 24 Blatch. 167.

That an injunction will be denied where the novelty of the invention is fairly contested, see *Upton v. Wayland* (1888), 36 Fed. Rep. 593.

Infringement Doubtful, Threatened, Evidence of.

That where infringement is doubtful, and other courts have decided that there is none, an injunction will be refused, see *Thompson v. Rand-Avery Supply Co.* (1889), 38 Fed. Rep. 112; 46 O. G. 1112.

That if infringement is doubtful an injunction will be refused, see *Norton Door Check & Spring Co. v. Hall* (1889), 37 Fed. Rep. 691; *Morss v. Knapp* (1889), 39 Fed. Rep. 608; *Russell v. Hyde* (1889), 39 Fed. Rep. 614.

That infringement in the past is not conclusive proof that the infringer will repeat the wrongful act, see *Proctor v. Bayley* (1889), L. R. 42 Ch. D. 390.

That an injunction will issue though infringement has ceased, if it can be repeated, see *Celluloid Mfg. Co. v. Arlington Mfg. Co.* (1888), 34 Fed. Rep. 324; 42 O. G. 828; *Facer v. Midvale Steel Works Co.* (1888), 38 Fed. Rep. 231.

That an injunction may issue though no infringement has yet occurred, see *Sherman v. Nutt* (1888), 35 Fed. Rep. 149.

That an injunction will issue when the patented device has been made for sale and advertised though none have yet been used or sold, see *Butz Thermo-Electric Regulator Co. v. Jacobs Electric Co.* (1888), 36 Fed. Rep. 191; 45 O. G. 833.

That where the defendant has imported parts of the patented combination, and fails to disclose the purpose for which they are to be used, an injunction will issue, see *Schneider v. Missouri Glass Co.* (1888), 36 Fed. Rep. 582; 45 O. G. 1069.

Final Injunction Doubtful.

That an injunction ought not to be granted unless a final decree would be made for the plaintiff on the same evidence, see *Challender v. Royle* (1887), L. R. 36 Ch. D. 425.

Estoppel of Plaintiff.

That where the plaintiff has acquiesced in and countenanced the acts of the defendant an injunction will be

refused, see *Amazon Machine Co. v. Knight* (1889), 39 Fed. Rep. 612.

That an injunction may be refused where the plaintiff has been guilty of laches pending suit and a final decree will soon be rendered, see *Pope Mfg. Co. v. Johnson* (1889) 40 Fed. Rep. 584.

That an injunction will be refused to a licensor who has dealt unfairly to the prejudice of the defendant licensee, see *Seibert Cylinder Oil Cup Co. v. Detroit Lubricator Co.* (1888), 34 Fed. Rep. 216.

That non-user because of State interference with the amount of royalties collectible is no ground for refusing an injunction, see *American Bell Telephone Co. v. Cushman Tel. & Service Co.* (1888), 36 Fed. Rep. 488; 45 O. G. 1193.

Injury to Defendant or Public.

That an injunction will be refused when the defendant is solvent and has used the invention a long time without notice of infringement, and would suffer irreparable injury, and the public are benefited by his use, see *Root v. Mt. Adams & Eden Park Inclined R. R. Co.* (1889), 40 Fed. Rep. 760.

Patent Expired.

That an injunction to prevent the use or sale of articles after the expiration of the patent will not be allowed when the articles were wrongfully made before the patent expired, and a suit for damages therefor is pending, see *Westinghouse v. Carpenter* (1888), 46 O. G. 244.

Defendant's Vendor already Enjoined.

That the vendee and user may be enjoined in one court after the maker has been enjoined in another, especially when the maker was not sued for the profits on this sale, see *Thompson*

v. American Bank Note Co. (1888), 35 Fed. Rep. 203; 45 O. G. 347.

Bond and Account.

That a bond in lieu of an injunction will be ordered when former judgments sustaining the patent have been rendered doubtful by subsequent decisions of the Supreme Court, and the defendant would sustain irreparable injury, see *Eastern Paper Bag Co. v. Nixon* (1888), 35 Fed. Rep. 752; 45 O. G. 1571.

That a bond and account may be ordered in lieu of an injunction when infringement is disputed, and defendant avers that he was ignorant of the patent until the suit was brought and derived no real aid from the invention, see *Eagle Mfg. Co. v. Chamberlain Plow Co.* (1888), 36 Fed. Rep. 905.

Bill for Injunction.

That it is proper to aver in a bill for an injunction that the patent has been established by judgments, to describe the patent generally, and make profert of it, and to allege infringement without specifying details, see *American Bell Telephone Co. v. Southern Telephone Co.* (1888), 34 Fed. Rep. 803.

Bond of Plaintiff and Liability thereon.

That if the plaintiff gives bond on obtaining an injunction and fails in his suit he is liable on the bond for damages arising from loss of sales, depreciation of goods on hand, etc., see *Tobey Furniture Co. v. Colby* (1888), 35 Fed. Rep. 592.

Suspension of Injunction.

That an injunction will not be suspended after judgment on the merits, unless public interests are involved or large numbers of innocent persons would be injured, see *Consolidated Roller-Mill Co. v. Coombs* (1889), 39 Fed. Rep. 803; 48 O. G. 973.

For a review of the cases in which injunctions will be suspended, see *Consolidated Roller-Mill Co. v. Coombs* (1889), 39 Fed. Rep. 803; 48 O. G. 973.

Contempt.

That an enjoined defendant, neglecting to notify his agents of the injunction is liable in contempt for their violations, see *Mundy v. Lidgerwood Mfg. Co.* (1888), 34 Fed. Rep. 541.

That where an enjoined infringer acts under a patent granted since the decree and there is a fair question whether he infringes, he will not be adjudged in contempt on a motion, but the plaintiff must sue on the alleged infringement, see *Penna. Diamond Drill Co. v. Simpson* (1889), 39 Fed. Rep. 284; 48 O. G. 676.

That where the contempt is not wilful a nominal fine and costs only will be imposed, see *Morss v. Domestic Sewing Mach. Co.* (1889), 38 Fed. Rep. 482.

INTERFERENCE.

Jurisdiction of Examiner of Interferences.

That the Examiner of Interferences has exclusive jurisdiction over the issues when declared, but none over the matter of patentability, see *Faure v. Bradley* (1888), 44 O. G. 945.

That the question whether a foreign patent covers the same invention as a domestic application in interference rests exclusively with the Examiner of Interferences, see *Faure v. Bradley* (1888), 44 O. G. 945.

That the decision of the Examiner of Interferences on interlocutory motions will not be reviewed unless he abuses his discretion or disregards some rule of law, see *Reynolds v. Haberman* (1889), 49 O. G. 130.

When Declared.

That an interference will be declared with an unexpired patent only when the applicant has been rejected on that specific patent, see *Ex parte Boyer* (1889), 49 O. G. 1985.

Patent Granted pending Interference.

That a patent issued pending a rival application is treated as an application also, see *Ex parte Boyer* (1889), 49 O. G. 1986; *Bechman v. Johnson* (1889), 48 O. G. 673.

Patentee, how far a Party.

That a patentee has no interest in an interference proceeding after the question whether the applicant shall have a patent is determined, see *Beardslee v. Moeslein* (1889), 46 O. G. 1640.

Priority of Application.

That an earlier application cannot benefit the junior party to an interference unless it appear on its face or is proved by evidence to have been filed by the same applicant, see *Oliver v. Everitt* (1889), 49 O. G. 731.

Dissolution.

That a motion to dissolve an interference cannot be based on any thing except the application, see *Faure v. Bradley* (1888), 44 O. G. 945.

That an interference will not be dissolved for irregularity unless it would defeat the purpose of the interference, see *Steward v. Ellis* (1889), 49 O. G. 1983.

That if a decision on a motion to dissolve an interference rests on the merits, and not on the question whether an interference exists or whether the proceedings are so begun that this question can be decided, no appeal lies to the Commissioner, see *Manny v. Easley* (1889), 48 O. G. 538.

That an interference may be dis-

solved on the ground of non-patentability and the case remanded after the time fixed by the rules where circumstances demand it, even though the same questions had been fully canvassed by the examiner before the interference was declared, see *Reynolds v. Haberman* (1889), 49 O. G. 130.

Evidence; Witnesses; Burden of Proof.

That the matter of taking testimony for use in the Patent Office in interference cases is controlled by the Federal Court of the district where the evidence is taken, not by the Commissioner, see *Wright v. Daggett* (1888), 44 O. G. 913; *Osgood v. Badger* (1888), 44 O. G. 1065.

That depositions taken for the interference hearing between parties substantially the same may be used in court on a suit to annul if the same evidence cannot be retaken, see *Clow v. Baker* (1888), 36 Fed. Rep. 692.

That evidence of foreign invention is not admissible in an interference unless it be a publication or a patent, see *Green v. Hall* (1889), 46 O. G. 1515.

That husband and wife are not competent witnesses for or against each other in the Patent Office, which follows the law of the District of Columbia, see *Marsh v. Rein* (1888), 43 O. G. 1453.

That when a later applicant in interference claims that the earlier copied the invention from his, and that he is the true inventor and was using reasonable diligence in reducing, he has the burden of proof and must establish his claim by a fair preponderance of legal evidence, see *Wherry v. Heck* (1889), 49 O. G. 559.

That on an interference between an application and a patent, the evidence

must be sufficient to overthrow the patent in the courts or obtain its repeal, see *Boach v Fowler* (1889), 48 O. G. 821.

Rehearing.

That a Commissioner may rehear an interference case already decided by his predecessor in office, see *Daniels v. Morgan* (1889), 47 O. G. 811.

That manifest error in law is ground for a rehearing in the Patent Office, see *Green v. Hall* (1889), 47 O. G. 1631.

That after judgment in interference a party who neglected to prepare and try his case cannot have a rehearing, see *Beardslee v. Moeslein* (1889), 46 O. G. 1640.

That motions for a rehearing by different parties to an interference should all be made and heard together, see *Green v. Hall* (1889), 47 O. G. 813.

Effect of Judgment.

That a judgment in interference concludes the issues according to the construction put upon them by the court, and parties who acquiesce in such judgment cannot be allowed afterward to claim for it a different effect, see *Ex parte Gray* (1889), 46 O. G. 1277.

That the examiner is concluded by a judgment in interference, see *Ex parte Booth* (1889), 49 O. G. 1841.

That a party to an interference may subsequently deny patentability in the courts, see *Holliday v. Pickhardt* (1887), 24 Blatch. 201; 29 Fed. Rep. 853.

Appeal.

That from a decision of an examiner that no interference exists, and that those declared must be dissolved, an appeal lies to the Commissioner, see *Von Welsbach v. Lungren* (1889), 48 O. G. 537.

That no appeal lies to the Commissioner from a decision of the examiner on a motion to dissolve an interference involving the right of one of the parties to make the Claim in issue, the Commissioner having no direct jurisdiction over that question, see *Steward v. Ellis* (1889), 49 O. G. 1983.

That an appeal may be signed by the attorney *nunc pro tunc*, see *Pitney v. Smith* (1889), 49 O. G. 129.

That the statement of the reasons for appeal on an interference is no part of the appeal itself and if omitted or defective the appeal may still be valid, and the statement afterward supplied or amended, see *Pitney v. Smith* (1889), 49 O. G. 129.

That where an appeal is seasonably taken the Commissioner cannot decide that it is taken for purposes of delay, see *Pitney v. Smith* (1889), 49 O. G. 129.

Bill for Patent by Defeated Party.

That the issue of a patent to the party prevailing in an interference cannot be delayed by the filing of a bill in equity by the defeated party, see *Wells v. Boyle* (1888), 43 O. G. 752.

That the unreasonable delay of one applicant in pursuing his rights cannot operate to delay action on contesting applicants, see *Ex parte Lombard* (1888), 43 O. G. 1347.

INVENTION.

That the application of a natural force may be a patentable invention, see *Celluloid Mfg. Co. v. Frederick Crane Chemical Co.* (1888), 36 Fed. Rep. 110.

That an invention reached by taking the one step in advance toward which the art was tending is new and patent-

able, see *Anilin v. Lovinstein* (1887), L. R. 12 App. 710.

That the idea of a method of soliciting custom is not an invention, see *Bristol v. Equitable Life Assurance Soc.* (1880), 52 Hun (N. Y.), 161.

INVENTIVE ACT.

Discovery, Inventive Skill.

That discovery is essential to patentability as well as novelty and utility, see *Ex parte Devin* (1888), 45 O. G. 709; *Ex parte Gifford* (1888), 45 O. G. 1457.

That an invention must be the product of an original conception, not merely the carrying forward of an original idea in degree, nor combining old devices without a new mode of operation, see *Burt v. Ivory* (1890), 133 U. S. 349.

That inventive skill implies more than change of form, proportion, degree, use, or arrangement, see *Worswick Mfg. Co. v. City of Kansas* (1889), 38 Fed. Rep. 239.

That inventive skill requires thought, mechanical skill does not, see *Butler v. Bainbridge* (1886), 24 Blatch. 163.

That an inventor must perceive and be able to reproduce his invention and to communicate it to others, see *McDonough v. Gray* (1889), 46 O. G. 1245.

Evidence of Inventive Skill.

That coincidence in the conclusions of two or more alleged inventors indicates mechanical rather than inventive skill, see *Falls Rivet Co. v. Wolfe* (1889), 40 Fed. Rep. 465.

That failure to produce a long-needed and instantly accepted means shows that when produced it resulted from inventive skill, see *Celluloid Mfg. Co. v. American Zylonite Co.* (1888), 35 Fed. Rep. 301.

That a different and beneficial result, improving and cheapening the product, indicates that the change in the mode of production, which others were interested to discover but the patentee alone did discover, involved inventive skill, see *Zinsser v. Kremer*, (1889), 39 Fed. Rep. 111; 48 O. G. 114.

That the immediate adoption of a means which supplies a long felt want indicates novelty, see *United Nickel Co. v. California Electrical Works* (1885), 11 Sawyer, 250; 25 Fed. Rep. 475.

That acceptance by the public is evidence of patentability, see *Tondeur v. Chambers* (1889), 37 Fed. Rep. 333; 46 O. G. 1110.

That public acceptance indicates inventive skill, see *Shipman Engine Co. v. Rochester Tool Works* (1888), 44 O. G. 1067.

That a device is so useful as to obtain immediate public recognition indicates that if inventive skill were not needed to produce it, it would have before been in use, see *Guarantee Trust and Safe Deposit Co. v. New Haven Gas Light Co.* (1889), 39 Fed. Rep. 268; 48 O. G. 1661.

That acceptance by the public and its late production when long needed shows inventive skill, see *Stegner v. Blake* (1888), 36 Fed. Rep. 183; 45 O. G. 126.

That immediate acceptance by the public is better evidence of invention than the opinions of experts and judges, see *Palmer v. Johnston* (1888), 34 Fed. Rep. 336; 43 O. G. 758.

Inventor.

That "one who seeks to enforce the rights secured by a patent is an Ishmaelite, — his hand against every one, and every one's hand against him,"

see *Underwood v. Gerber* (1889), 37 Fed. Rep. 682; 48 O. G. 116.

That the earliest reducer is favored by the law, see *Green v. Hall* (1889), 46 O. G. 1515.

Joint Inventors.

That the burden of proof is on an employer claiming joint invention against the sole patent of the employee, see *Locke v. Lane & Bodley Co.* (1888), 35 Fed. Rep. 289.

That one of two joint patentees may afterward file a sole application and have an interference declared with the joint patent, and is not estopped by his former joint oath nor barred by a previous assignment, since the assignees would become the owners of the sole patent when granted, see *Kohler v. Kohler* (1888), 43 O. G. 247.

That a sole applicant is not estopped by his sworn preliminary statement, when previously one of two joint applicants, nor by his testimony then offered as to the date of public use, that question not being in issue, see *Mead v. Brown* (1889), 48 O. G. 397.

That the testimony of one of two joint patentees and alleged joint inventors that he was in fact a sole inventor is neutralized by his former oath taken to obtain the patent, see *Schlicht & Field Co. v. Chicago Sewing-Machine Co.* (1888), 36 Fed. Rep. 585; 46 O. G. 1394.

JUDGMENTS.

Supreme Court

That decisions of the Supreme and Circuit Courts will be followed where there is no new evidence, see *American Bell Telephone Co. v. Wallace Electric Tel. Co.* (1889), 37 Fed. Rep. 672.

That a judgment of the Supreme Court may be departed from when the facts are different, see *American Bell Telephone Co. v. Southern Telephone Co.* (1888), 34 Fed. Rep. 795.

That prior judgments, even of the Supreme Court, between other parties and on other facts may be departed from, see *Worswick Mfg. Co. v. City of Kansas* (1889), 38 Fed. Rep. 239.

Circuit Courts.

That a judgment in the same circuit by another judge, with the same parties and the same issues, will be followed, see *Heysinger v. Rouss* (1889), 40 Fed. Rep. 584.

That comity requires a judgment in a co-ordinate court in favor of validity to be followed where issues and evidence are the same, see *Hancock Inspirator Co. v. Register* (1888), 35 Fed. Rep. 61; *Hammerschlag Mfg. Co. v. Spalding* (1888), 35 Fed. Rep. 67.

That one Circuit court will not reverse its own decisions out of deference to comity toward another, though it might have followed such other had its judgment been previously known, see *Consolidated Roller Mill Co. v. George T. Smith Middlings Purifier Co.* (1889), 46 Fed. Rep. 305.

That the comity of courts does not require a decision to be followed after the Supreme Court has defined more strictly the points by which the court was guided, see *Rubber & Celluloid Harness Trimming Co. v. India Rubber Comb Co.* (1888), 44 O. G. 343.

That the decision of co-ordinate courts that the re-issue does not depart from the original will be followed on a motion for an injunction, see *Putnam v. Keystone Bottle Stopper Co.* (1889), 38 Fed. Rep. 234; 48 O. G. 113.

Supreme Court of D. C.

That the judgments of the Supreme Court of the District of Columbia in patent cases are entitled to great respect, see *Shannon v. Brunner* (1887), 33 Fed. Rep. 289; 41 O. G. 697.

Patent Office.

That an interference decision concludes the parties as to priority even in the courts, but does not prevent the defeated party from denying validity on other grounds, see *Lyon v. Donaldson* (1888), 34 Fed. Rep. 789.

That a judgment in interference is no proof of validity and does not warrant an injunction, see *Dickerson v. De La Vergue Refrigerating Mach. Co.* (1888), 35 Fed. Rep. 143. See the above case as to the value of interference decisions generally.

Between Other Parties.

That a decree finding a patent invalid is not a judgment *in rem* and does not prevent the plaintiff from suing another defendant and establishing his patent on the same or further evidence, see *Consolidated Roller-Mill Co. v. George T. Smith Middlings Purifier Co.* (1889), 40 Fed. Rep. 305.

On Other Issues.

That a judgment sustaining a patent for a certain form or degree of an invention raises a presumption of validity only as to that form or degree, see *Cary v. Miller* (1888), 34 Fed. Rep. 392.

On the Same Evidence.

That where a patent has been twice sustained against a defence of public use the judgments will be followed unless new facts are shown, see *Simonds Counter Mach. Co. v. Knox* (1889), 39 Fed. Rep. 702.

JUDICIAL SALE.

That a patent cannot be taken on execution in a suit at law, though special proceedings under State statutes may subject them to the claims of creditors, see *Wilson v. Martin-Wilson Fire Alarm Co.* (1889), 149 Mass. 24.

That a license under a patent may be taken on execution by the licensor and sold to satisfy a judgment against the licensee, see *Matthews v. Green* (1884), 17 Phila. 540.

That where the owner of a patent conceals or withholds it from his creditors it is a fraud for which he may be sued and his body taken on execution, see *Keene, petitioner* (1886), 15 R. I. 294.

That a judgment debtor may be compelled by equity to assign his patent to the creditor, see *Clan Ranald v. Wyckoff* (1877), 41 Sup. Ct. (N. Y.), 527.

That a State has power to enact that the patents of the insolvent shall vest in his assignee, and the assignee may invoke the aid of equity to compel the execution of the necessary conveyance by the insolvent, see *Barton v. White* (1887), 144 Mass. 281.

JURISDICTION.**Law and Equity.**

That a patentee may sue either in equity or at law according to the nature of the relief demanded, see *Wise v. Grand Avenue R. R. Co.* (1888), 33 Fed. Rep. 277.

That a patentee having a right to an injunction may sue in equity for it and an accounting, or at law for damages measured by license fee, see *Bragg v. City of Stockton* (1886), 11 Sawyer, 597; 27 Fed. Rep. 509.

That a bill for an injunction and

account may be entertained in equity though the patent has but a few weeks to run, see *Kittle v. Rogers* (1887), 33 Fed. Rep. 49.

That equity will take cognizance of a suit brought long enough before the patent expires to enable equity relief to be granted, see *Singer Mfg. Co. v. Wilson Sewing Mach. Co.* (1889), 38 Fed. Rep. 586.

That where equity will order a final injunction it may also direct an account of damages and profits, see *Asbestine Tiling & Mfg. Co. v. Hepp* (1889), 39 Fed. Rep. 324; 49 O. G. 413.

That equity has jurisdiction of a bill filed to ascertain and administer the rights of the parties under a contract concerning the use of patented inventions, see *Reese's Appeal* (1888), 122 Pa. St. 392.

That equity has jurisdiction of an action by a licensor to obtain an account of royalties from his licensee and an injunction against unlicensed uses of the invention, see *Ball Glove Fastening Co. v. Ball & Socket Fastener Co.* (1888), 36 Fed. Rep. 309.

That equity has jurisdiction to enjoin a licensee who repudiates the license, conspires against the licensor, and still uses the patented invention, see *Hat Sweat Mfg. Co. v. Porter* (1888), 34 Fed. Rep. 745; 44 O. G. 1070

That equity has no jurisdiction over a suit by a licensee in the name of the patentee for damages for past infringements, see *Ulman v. Chickering* (1888), 33 Fed. Rep. 582.

That an objection to equity jurisdiction on the ground that the remedy at law is adequate must be taken by demurrer, plea, or answer, and not at the final hearing, see *Consolidated*

Roller-Mill Co. v. Coombs (1889), 39 Fed. Rep. 25; 48 O. G. 255.

Federal Courts.

That the act of March 3, 1887, does not repeal the provisions of the Revised Statutes conferring jurisdiction of patent cases on the Federal courts irrespective of the amount in dispute, see *Miller-Magee Co. v. Carpenter* (1888), 34 Fed. Rep. 433; 43 O. G. 1118.

That a suit to prevent the making and selling of patented articles, whatever its apparent form or purpose, is within the exclusive jurisdiction of the Federal courts, see *Kayser v. Arnold* (1886), 41 Hun (N. Y.), 275.

That questions involving the legal validity of a patent cannot be considered by a State court, see *Nichols v. Marsh* (1886), 61 Mich. 509.

That an action on a license in which the validity and infringement of a patent are put in issue by the pleadings is a patent case of which the Federal courts have jurisdiction, see *St. Paul Plow Works v. Starling* (1888), 127 U. S. 376; 43 O. G. 1350.

That a controversy between parties claiming under different patents and involving the scope of either patent is within the exclusive jurisdiction of the Federal courts, see *Garver v. Bement* (1888), 69 Mich. 149.

State Courts.

That an action on contract is not within Federal jurisdiction, see *Dale Tile Mfg. Co. v. Hyatt* (1888), 125 U. S. 46; 43 O. G. 249; *Felix v. Scharnweber* (1888), 125 U. S. 54; 43 O. G. 251.

That a case based entirely on contract is not a patent case within the jurisdiction of the Federal courts, see

Brooklyn Watch Case Co. v. Leach (1888), 35 Fed. Rep. 2; *Williams v. Star Sand Co.* (1888), 35 Fed. Rep. 369.

That State courts have jurisdiction of actions arising out of express contracts though patent rights may come in question, see *Creighton v. Haggerty* (1884), 50 Sup. Ct. (N. Y.) 9.

That a State court may decide questions as to the title to letters-patent but cannot enjoin a party from suing for infringement in the Federal courts, see *Childs v. Tuttle* (1889), 54 Hun (N. Y.), 57.

That the State courts may take cognizance of an action to enforce a contract relating to a patent, pending an infringement suit between the same parties in the Federal court, see *Nichols v. Marsh* (1886), 61 Mich. 509.

That an action demanding the assignment of a patent and damages is not a patent case within the jurisdiction of the Federal courts, see *Wren v. Annin* (1888), 34 Fed. Rep. 435.

That State courts have jurisdiction of actions by licensors to recover royalties, see *Hubbard v. Allen* (1889), 123 Pa. St. 198.

That the Federal courts have no jurisdiction where the sole question at issue is the forfeiture of a license, though the suit is brought for infringement and the State courts have refused to entertain it, see *McCarty & Hall Trading Co. v. Glaenzer* (1887), 24 Blatch. 269.

That the Federal courts have no jurisdiction of an action to construe a license, and determine whether the licensee has complied with it, and if not whether the non-compliance works a forfeiture, see *Densmore v. Three Rivers Mfg. Co.* (1889), 38 Fed. Rep. 747.

That State courts have jurisdiction

of a bill in equity to enjoin the defendant from slander of the plaintiff's invention, see *Flint v. Hutchinson Smoke Burner Co.* (1889), 38 Fed. Rep. 546.

Court of Claims.

That the Court of Claims has jurisdiction over claims of patentees for the use of their inventions by the United States with their consent, see *United States v. Palmer* (1888), 128 U. S. 262.

That the Court of Claims has no jurisdiction of a suit for the use of an invention by the government unless the facts imply a contract, see *Schilling v. United States* (1889), 24 Ct. of Claims 278; *Forehand v. United States* (1888), 23 Ct. of Claims 477.

Local Jurisdiction.

That a defendant cannot be sued outside his own district under the Act of 1887 unless he consents, and if he appears specially and demurs the bill must be dismissed, see *Halstead v. Manning* (1888), 44 O. G. 344.

That a corporation cannot be sued for infringement outside the State of its creation merely because its factories are located and its business conducted by agents in the district of suit, see *Preston v. Fire Extinguisher Mfg. Co.* (1888), 46 O. G. 124.

That an objection to local jurisdiction may be made by demurrer or by motion to dismiss, see *Miller-Magee Co. v. Carpenter* (1888), 34 Fed. Rep. 433; 43 O. G. 1118.

That want of local jurisdiction under the Acts of 1887-88, can be waived by appearance, see *McBride v. Grand de Tour Plow Co.* (1889), 40 Fed. Rep. 162; *Morrison v. Canton Surgical & Dental Chair Co.* (1889), 49 O. G. 733.

LIBEL.

That equity will enjoin against malicious public threats to sue a patentee's vendees, but in such suit will not pass on the validity of the patent, see *Emack v. Kane* (1888), 34 Fed. Rep. 46.

That a patentee will not be enjoined from notifying an infringer's customers that he will sue them for the use of the invention, see *Tuttle v. Matthews* (1886), 24 Blatch. 16.

LICENSE EXPRESS.**What is.**

That however exclusive the right conveyed and however unlimited the territory, if it leaves any interest in the monopoly in the patentee within the territory defined, it is a mere license, see *Tuttle v. La Dow* (1889), 54 Hun (N. Y.), 149.

That an agreement not to sue for future infringements on payment of certain royalties is in effect a license, and the licensor cannot treat the licensee as an infringer merely because the royalties are not paid, see *Siebert Cylinder Oil Cup Co. v. Detroit Lubricator Co.* (1888), 34 Fed. Rep. 216.

Exclusive License.

That an exclusive license is a leave to do a thing and a contract not to allow any one else to do it, but confers no interest in the thing and gives the licensee no right to sue in his own name, see *Heap v. Hartley* (1889), L. R. 42 Ch. D. 461.

License to Use.

That where an express license accompanies the sale of a patented article, the vendee is bound by the scope of the license, see *Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co.* (1889), 40 Fed. Rep. 577.

That the right of a licensed user before patent to use the devices after patent extends to improvements on the devices, see *Campbell v. City of New York* (1888), 35 Fed. Rep. 504; 44 O. G. 1185.

That the licensee of a machine can repair it or replace parts, if its identity is not destroyed, see *Young v. Foerster* (1889), 37 Fed. Rep. 203; 47 O. G. 1353.

That each member of a machine may be covered by a different patent, and the replacing of one member may then be an infringement, see *Singer Mfg. Co. v. Springfield Foundry Co.* (1888) 34 Fed. Rep. 393.

License to Sell.

That the exclusive licensee of a grantee cannot sell the invention outside the granted territory, see *Hatch v. Hall* (1887), 24 Blatch. 355.

Covenant to Suppress Infringements.

That the contract of a licensor to prevent infringements binds him to act with reasonable promptness, see *Fornecrook Mfg. Co. v. Iron Works* (1886), 63 Mich. 195.

That a licensor fulfils his stipulation to defend his licensee if he protects him in any manner, see *Covell v. Bostwick* (1889), 39 Fed. Rep. 421.

That a covenant of the licensee to aid the licensor in suppressing infringements is binding upon him though he ceases to enjoy the license, and his sale of his business to a known intended infringer is a breach of the covenant, see *Washburn & Moen Mfg. Co. v. Southern Wire Co.* (1889), 37 Fed. Rep. 428.

Assignability.

That a mere license is not assignable unless it contains express words

to that effect, see *Tuttle v. La Dow* (1889), 54 Hun (N. Y.), 149.

That the receiver of a firm may sell its assets though they consist of inventions made under patents owned by a member of the firm, see *Montross v. Mabie* (1887), 24 Blatch. 282; 41 O. G. 931.

That a license to a partnership does not enure to a corporation formed by the copartners, nor is it assignable to them in their corporate capacity, see *Locke v. Lane & Bodley Co.* (1888), 35 Fed. Rep. 289.

License to Common Carrier.

That where the owner of a patent grants a license for the public use of the invention to a common carrier he cannot restrict its benefits to any fraction of the public, see *Commercial Union Telegraph Co. v. New England Telephone Co.* (1888), 61 Vt. 241.

Estoppel of Licensee.

That a licensee cannot defend by attacking the patent while receiving its benefits, see *Hyatt v. Ingalls* (1883), 49 Sup. Ct. (N. Y.) 375.

That a licensee enjoying the benefit of his license must pay his license fee until eviction, and a liability to damages which the licensor assumes is not such eviction, see *Covell v. Bostwick* (1889), 39 Fed. Rep. 421.

That a licensee cannot defend a suit for royalties on the ground that the licensor has granted licenses at lower rates to other persons unless there was some agreement to the contrary in the license, or on the ground that the patent is invalid unless there has been an eviction, see *McKay v. Smith* (1889), 39 Fed. Rep. 556.

That a licensee to sell is not estopped to deny validity after his license expires, see *H. Tibbe & Son Mfg. Co. v.*

Heineken (1889), 37 Fed. Rep. 686; 47 O. G. 1221.

That where a licensee, in defence to an action for royalties, claims that the patent is invalid on the ground of prior use, he must in his notice or answer state where and by whom the use was made, see *Hat Sweat Mfg. Co. v. Reinoehl* (1886), 40 Hun (N. Y.), 47.

LICENSE IMPLIED.

Vendees of Patentee.

That the sale of the patented article by the patentee without restrictions frees it from the monopoly, see *Pratt v. Marcan* (1888), 25 Ill. App. 516.

That after a grant of territory by the patentee his vendees of the patented articles, with notice of the grant, cannot use the articles within that territory, see *Sheldon Axle Co. v. Standard Axle Works* (1889), 37 Fed. Rep. 789; 48 O. G. 117.

That a vendee of the patentee without notice of a prior licensee's exclusive rights in a certain district may use the vended articles in such district, see *Heap v. Hartley* (1889), L. R. 42 Ch. D. 461.

That purchasers of the interest remaining in the patentee after a grant of territory, knowing of the grant, and afterward renouncing their interest, cannot use in the granted territory articles bought of the patentee, see *Sheldon Axle Co. v. Standard Axle Works* (1889), 37 Fed. Rep. 789; 48 O. G. 117.

That the vendee of a patented article acquires all the rights of the vendor, and if the vendor is licensee of the owner of the whole monopoly, the article is entirely freed from the monopoly and may be repaired or used by the vendee or his servants or sold by

him to others, see *Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co.* (1889), 40 Fed. Rep. 577.

Vendees of Grantee.

That the vendee of a grantee has no right to sell the article in the way of trade in the territory of another grantee, see *Standard Folding Bed Co. v. Keeler* (1889), 37 Fed. Rep. 693.

That the vendee of a grantee cannot sell the articles in course of trade outside the grantee's territory, see *Hatch v. Adams* (1884), 17 Phila. 566.

That the sale of a patented article by a grantee of the patent within his own territory carries the right to use it within territory owned by another, though both parties know that such a use is intended, see *Hobbie v. Jennison* (1889), 40 Fed. Rep. 887. In deciding this case the learned judge follows *Adams v. Burke*, 17 Wall. 453, but dissents therefrom and states the converse and true doctrine in the opinion, q. v. 40 Fed. Rep. 890.

That an agreement between two joint owners to divide the territory between them and respect the exclusive rights of each other is not binding on the subsequent purchaser of the patented article from either without notice, and if he bought without restrictions he may use it anywhere, see *Pratt v. Marean* (1888), 25 Ill. App. 516.

Vendees of Foreign Patentee.

That the vendee of a lawful vendor abroad under a foreign patent cannot use in the United States without permission of the domestic patentee, see *Boesch v. Gräff* (1890), 133 U. S. 697; *Gräff v. Boesche* (1887), 33 Fed. Rep. 279; 13 Sawyer, 17.

Vendees in General.

For a discussion of the scope of an implied license in favor of the vendee of a patented article, see *Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co.* (1889), 40 Fed. Rep. 577.

That the vendee of a patented device may use it till it is worn out, see *Martha Washington Co. v. Martien* (1889), 47 O. G. 1488.

Vendee under Wrongful Sale.

That judgment against the maker and vendor without satisfaction is no defence for the user, his vendee, see *Fisher v. Consolidated Amador Mine Co.* (1885), 11 Sawyer, 190; 25 Fed. Rep. 201.

Vendee before Patent.

That a patentable machine constructed with the consent of the inventor before patent is free from the monopoly, see *Wade v. Metcalf* (1889), 129 U. S. 202.

Use in Employer's business.

That an exclusive licensee under a license from an employee, whom he knew to be making and using the invention in the employer's factory, is chargeable with constructive notice of the employer's rights, see *Dueber Watch-Case Mfg. Co. v. Dalzell* (1889), 38 Fed. Rep. 597.

That an employee of the government, inventing a device at its expense and engrafting it upon the business in which he is occupied, licenses the government to use it without compensation, and his assignee also takes subject to such license, see *Davis v. United States* (1888), 23 Ct. of Claims, 329; *Solomons v. United States* (1886), 21 Ct. of Claims, 479; *Solomons v. United States* (1887), 22 Ct. of Claims, 335.

Use by Corporation of Member's Invention.

That where a corporation uses an invention belonging to one of its officers with his acquiescence there may be an implied contract to pay him a reasonable compensation or not as the other facts may indicate, see *Deane v. Hodge* (1886), 35 Minn. 146.

LOCATION, CHANGE OF.

That to change the location of a part without substantial change in the mode of operation or result is not invention, see *Holmes Electric Protective Co. v. Metropolitan Burglar Alarm Co.* (1887), 33 Fed. Rep. 254.

MANUFACTURE.

That a manufacture is not new because produced in a new way, see *Hake v. Brown* (1889), 37 Fed. Rep. 783; 47 O. G. 1071.

That a product of nature is not patentable because obtained or prepared by a new process, unless it is substantially changed in character thereby, see *Ex parte Latimer* (1889), 46 O. G. 1638.

MATERIALS, CHANGE OF.

That a change in material is not patentable unless involving inventive skill, see *Ex parte Odenheimer* (1889), 49 O. G. 1693.

That change of materials, unless of the essence of the invention, is a mere change of form, see *Brinkerhoff v. Aloe* (1888), 37 Fed. Rep. 92; 46 O. G. 338.

That a mere change of materials, though improving the result, is not invention, see *Ex parte Krell* (1887), 44 O. G. 1504.

That the substitution of a more durable material performing no new

function is not invention, see *J. L. Mott Iron Works v. Cassidy* (1887), 24 Blatch. 289.

That the substitution of one material for another may involve invention, see *Celluloid Mfg. Co. v. Frederick Crane Chemical Co.* (1883), 36 Fed. Rep. 110.

That a new material, made by combining other materials, may be a patentable invention, see *Celluloid Mfg. Co. v. American Zylonite Co.* (1888), 35 Fed. Rep. 417.

NOTES.

That a State statute may require a note given for a patent right to state that fact on its face and then make the note open to all equitable defences, see *Herdic v. Roessler* (1888), 109 N. Y. 127; *Herdic v. Roessler* (1886), 39 Hun (N. Y.), 198.

That a negotiable promissory note, fair on its face, is valid in the hands of an innocent holder for value though taken by the payee in violation of the statutes, see *Tescher v. Merea* (1889), 118 Ind. 586.

That a note given for an English patent is not void though the patent be invalid for want of novelty, see *Chemical Electric Light Co. v. Howard* (1889), 148 Mass. 352.

PATENT.

That a patent issued without the signature of the Secretary has no validity, but the omission may be corrected and the patent be thenceforth valid, see *Marsh v. Nichols* (1888), 128 U. S. 605; 46 O. G. 239.

That a patent issued without the signature of the Secretary is a nullity, but the right to a patent still exists and is assignable, and if the patent

has been sold and the defect subsequently cured, the sale will not be set aside, see *Marsh v. Scott* (1888), 125 Ill. 114.

That a patent is not multifarious because it asserts that a number of different substances may be used as equivalents, see *Celluloid Mfg. Co. v. Frederick Crane Chemical Co.* (1888), 86 Fed. Rep. 110.

PATENT OFFICE.

That the classification in the Patent Office rests on actual divisions in the arts, not on names or titles, see *Ex parte Willcox* (1888), 45 O. G. 455.

That an examiner is both an executive and judicial officer, and in his executive capacity is controlled by the orders of the Commissioner issued on the petition of an applicant, and in his judicial capacity is subject to the Commissioner through the right of appeal, see *Ex parte Rogers* (1889), 49 O. G. 1361.

PRIOR PATENT.

That if the description in a prior patent would enable any good mechanic to make the present device from the one there described, the defence is sustained, see *United States Bung Mfg. Co. v. Independent Bung & Bushing Co.* (1887), 24 Blatch. 406.

That an English patent is given to the public at the date of sealing, see *Bliss v. Merrill* (1887), 33 Fed. Rep. 39; 42 O. G. 97.

PRIOR PUBLICATION.

That an English provisional specification is not a publication until the completed specification is enrolled, see *Ireson v. Pierce* (1889), 39 Fed. Rep. 795.

That a publication in a foreign language placed in the free public library of the Patent Office is presumed to have become known to the public until the contrary is shown, and is a good defence to a subsequent patent for the same invention, see *Harris v. Rothwell* (1887), L. R. 35 Ch. D. 416.

PRIOR USE.

What is.

That prior use requires a practical working apparatus, see *Peency v. City of Lakeview* (1888), 35 Fed. Rep. 586.

That successful experiments may show prior use, see *Electrical Accumulator Co. v. Julien Electric Co.* (1889), 38 Fed. Rep. 117.

That secret use is not prior use, see *Zinsser v. Kremer* (1889), 39 Fed. Rep. 111; 48 O. G. 114.

That the abandonment of a thing greatly wanted indicates that it was an unsuccessful experiment, see *Brush v. Condit* (1889), 132 U. S. 39; 49 O. G. 1211.

Notice.

That prior use and public use are distinct defences requiring separate notices, and the notice of prior use must give names and residences of parties using or having knowledge of the use, see *Meyers v. Busby* (1887), 13 Sawyer, 33.

That evidence of prior use taken without due notice will be rejected by the court, see *Bragg v. City of Stockton* (1886), 11 Sawyer, 597.

EVIDENCE.

That prior use must be proved beyond reasonable doubt, see *Stegner v. Blake* (1888), 36 Fed. Rep. 183; 45 O. G. 126; *Smith v. Davis* (1888), 34 Fed. Rep. 783.

That prior use must be clearly proved, and indefinite testimony inconsistent with the ordinary current of human conduct and events is not sufficient for that purpose, see *Electrical Accumulator Co. v. Julien Electric Co.* (1889), 38 Fed. Rep. 117. See the above rule applied in this case.

PROFITS IN EQUITY.

Infringer liable for.

That an infringer is not a trustee *de son tort*, but is treated in an accounting in equity in the same manner, see *Tilghman v. Proctor* (1888), 125 U. S. 136; 43 O. G. 628.

That though the plaintiff has an established license fee which would measure his recovery of damages at law he may still recover profits in equity without reference to the amount of the license fee, see *Tilghman v. Proctor* (1888), 125 U. S. 136; 43 O. G. 628.

That an erroneous decision made in favor of a different infringer pending the present infringement does not affect the liability of the present defendant to pay full profits, see *Tilghman v. Proctor* (1888), 125 U. S. 136; 43 O. G. 628.

Include Savings.

That the saving from a greater loss is a profit, see *Celluloid Mfg. Co. v. Cellonite Mfg. Co.* (1889), 40 Fed. Rep. 476; *Tilghman v. Proctor* (1888), 125 U. S. 136; 43 O. G. 628.

Include Actual Profits only.

That the actual profit as the defendant has used the invention, not the possible profit from a different use, is to be accounted for, see *Tilghman v. Proctor* (1888), 125 U. S. 136; 43 O. G. 628.

Must be due to the Plaintiff's Invention.

That a plaintiff cannot recover the entire profits unless the whole market value were due to his invention, see *Fay v. Allen* (1887), 24 Blatch. 275.

That where the entire profit of the defendant is derived from the plaintiff's invention, the plaintiff is entitled to recover it, see *Hurlburt v. Schilling* (1889), 130 U. S. 456; 47 O. G. 1067.

That where the entire efficiency and salability of an invention depend on the patented feature the patentee is entitled to recover all the profits, see *McDonald v. Whitney* (1889), 39 Fed. Rep. 466.

That the burden is on the defendant to show what part of his profits was due to his own improvements, when the plaintiff's invention apparently gave the device its market value, see *Morss v. Union Form Co.* (1889), 39 Fed. Rep. 468.

Measured by Advantage over open Inventions.

That profits are the advantage derived by the infringer over what he would have obtained by adopting some other available method, see *Shannon v. Brunner* (1888), 33 Fed. Rep. 871.

That in estimating profits the advantage of using the infringing device is to be compared with that of using devices previously employed for the same purpose, see *Coupe v. Weatherhead* (1888), 37 Fed. Rep. 16.

That the profits of the defendant are what he made or saved over what could have been saved or made by using means free to the public, see *McMurry v. Emerson* (1888), 36 Fed. Rep. 901; 47 O. G. 815.

That profits are to be measured by the advantage received by the defend-

ant over what he would have enjoyed by using other means then open to the public, and adequate to obtain an equally beneficial result, see *Webster Loom Co. v. Higgins* (1889), 39 Fed. Rep. 462; 48 O. G. 1119; *Tilghman v. Proctor* (1888), 125 U. S. 136; 43 O. G. 628.

That the defendant's profit may be measured by the amount charged by him when using the patented invention in excess of that charged when he does not use it, see *Vulcanite Paving Co. v. American Artificial Stone Pavement Co.* (1888), 36 Fed. Rep. 378; 45 O. G. 948.

From Use of Composition.

That when a patented composition is used in making a device and gives it its value, the patentee is entitled to the entire profit, see *Welling v. La Bau* (1888), 34 Fed. Rep. 40; 43 O. G. 117.

From Use of Design.

That the profits on a design are the difference between the profits of articles with it and without it, see *Tomkinson v. Willets Mfg. Co.* (1888), 34 Fed. Rep. 536.

Interest.

That generally interest is not to be allowed on profits before the date of the submission of the master's report, see *Tilghman v. Proctor* (1888), 125 U. S. 136; 43 O. G. 628.

Profits not proved, Nominal Damages awarded.

That where on an accounting it does not appear what definite profits were due to the invention, only nominal damages can be allowed, see *Roe-mer v. Simon* (1887), 24 Blatch. 396; *Everest v. Buffalo Lubricating Oil Co.* (1887), 24 Blatch. 463.

That where the profits cannot be computed, nominal damages may be awarded, see *Fischer v. Hayes* (1889), 39 Fed. Rep. 613.

Not recovered as Damages.

That profits made by the defendant, in excess of those of which the plaintiff was deprived, cannot be recovered as damages, see *Morss v. Union Form Co.* (1889), 39 Fed. Rep. 468.

Computation.

That a rule for computing profits adopted in one part of a case will be followed in the future proceedings in that case, see *Webster Loom Co. v. Higgins* (1889), 39 Fed. Rep. 462; 48 O. G. 1119.

REDUCTION TO PRACTICE.

That filing a caveat is not reduction to practice, see *Elges v. Miller* (1889), 46 O. G. 1514.

That a working model designed and intended as such is not reduction to practice, see *Green v. Hall* (1889), 47 O. G. 1631; *Green v. Hall* (1889), 46 O. G. 1515.

That drawings are not reduction though filed in the Patent Office, nor do they show a practical embodiment sufficient to save the rights of the first conceiver as against a later rival, see *Beach v. Fuller* (1889), 48 O. G. 821.

That the Patent Office has no means of determining whether or not an invention has been reduced to practice, see *Green v. Hall* (1889), 47 O. G. 1631.

RE-ISSUE

Scope.

For a review and interpretation of the cases concerning the scope of a re-issue, see *Parker & Whipple Co. v. Yale Clock Co.* (1887), 123 U. S. 87; 41 O. G. 811.

That a re-issue can cover only what an examination of the original in the light of the re-issue shows that the original was intended to embrace, see *Flower v. Detroit* (1888), 127 U. S. 563; 43 O. G. 1348; *Hoskin v. Fisher* (1888), 125 U. S. 217; 43 O. G. 509; *Parker & Whipple Co. v. Yale Clock Co.* (1887), 123 U. S. 87; 41 O. G. 811.

That a re-issue cannot cover matter which the original did not describe or claim, after intervening rights have arisen, see *Dunham v. Dennison Mfg. Co.* (1889), 40 Fed. Rep. 607.

That the introduction into a re-issue of an invention radically different from the original after long delay is fatal, see *Hubel v. Dick* (1886), 24 Blatch. 139; 28 Fed. Rep. 653; 37 O. G. 1467.

That an assignee cannot so re-issue as to broaden the invention, see *Ex parte Mahnkou* (1887), 41 O. G. 1269.

Of Combination Patent.

That the re-issue of a combination-patent within reasonable time may cover subcombinations and elements, see *Hubel v. Dick* (1886), 24 Blatch. 59; 28 Fed. Rep. 132; 36 O. G. 939.

Of Patent for an Art.

That a Claim for the process cannot be inserted into the re-issue of a patent for the apparatus or product, or *vice versa*, unless they are so related to each other as to constitute but one invention, see *Ex parte Tainter* (1889), 47 O. G. 135. See the opinion in this case for an extended discussion of the relations of processes, apparatus, and products toward each other.

Enlarging Claims.

That a re-issue cannot enlarge Claims unless there has been a clear mistake inadvertently committed in

wording them, see *Huber v. N. O. Nelson Mfg. Co.* (1889), 38 Fed. Rep. 830; 47 O. G. 1732.

That a re-issue cannot enlarge a Claim by omitting an element previously claimed as essential, see *Matthews v. Iron Clad Mfg. Co.* (1888), 124 U. S. 347; 42 O. G. 827.

That a re-issue with enlarged Claims to cover matter already in public use after unreasonable delay is void, see *Flower v. Detroit* (1888), 127 U. S. 563; 43 O. G. 1348.

That where the first re-issue enlarged the Claims a second re-issue may repeat the Claims of the original patent, see *Sawyer Spindle Co. v. Eureka Spindle Co.* (1888), 33 Fed. Rep. 886.

Cannot cover Matter intentionally Excluded.

That a Claim restricted by direction of the Patent Office in the first re-issue cannot be enlarged by subsequent re-issues, see *Yale Lock Co. v. James* (1888), 125 U. S. 447; 43 O. G. 881.

That a re-issue to restore a Claim rejected by the Patent Office with the acquiescence of the applicant is invalid though applied for within two years after the original was granted, see *Union Paper Bag Mach. Co. v. Waterbury* (1889), 39 Fed. Rep. 389.

That a re-issue may correct errors occasioned by mistaken ideas of the objections raised in the Patent Office, see *Hutchinson v. Everett* (1887), 33 Fed. Rep. 502.

Unreasonable Delay.

That laches in applying for a re-issue is fatal to the re-issued patent, and may be taken advantage of by a demurrer, see *Philadelphia Novelty Mfg. Co. v. Rouss* (1889), 39 Fed. Rep. 273; 48 O. G. 1664.

That the Commissioner has no jurisdiction over an application for a re-issue unless it is filed within a reasonable time, see *Hutchinson v. Everett* (1887), 33 Fed. Rep. 502.

That whether delay in applying for a re-issue is reasonable is a question of law for the court, and the decision of the Patent Office on that point is not conclusive, see *Hoskin v. Fisher* (1888), 125 U. S. 217; 43 O. G. 509.

That delay in re-issuing to expand the Claims, if unexplained, is fatal, see *Wollensak v. Sargent* (1888), 33 Fed. Rep. 840.

That the plaintiff must explain the delay in obtaining a re-issue, see *Hoskin v. Fisher* (1888), 125 U. S. 217; 43 O. G. 509.

Inadvertence, etc.

That inadvertence or mistake must exist in reference to the application, not the invention, and the re-issue must be confined to the invention inadvertently misdescribed or misclaimed in the original, see *Ex parte Mahuken* (1887), 41 O. G. 1269.

That a patentee taking his patent with full knowledge of the limitations imposed by the Patent Office and the consequent imperfection of his Claims, cannot set up inadvertence, &c., as a ground for a re-issue, see *Ex parte Page* (1888), 43 O. G. 1455.

That acquiescence in the rejection of a Claim by the Patent Office shows that the exclusion of the matter claimed was not inadvertent or accidental, see *Union Paper Bag Mach. Co. v. Waterbury* (1889), 39 Fed. Rep. 389.

That the decision of the Commissioner as to inadvertence, accident, or mistake, may be reviewed by the courts, see *Huber v. N. O. Nelson*

Mfg. Co. (1889), 38 Fed. Rep. 830; 47 O. G. 1732.

That the oath of the inventor to his inadvertence, etc., is not perfunctory, though he has assigned his interest, see *Ex parte Mahuken* (1887), 41 O. G. 1269.

Effect of Surrender.

That no action can be maintained on a patent after its surrender and pending an application for re-issue, see *Burrell v. Hackley* (1888), 35 Fed. Rep. 833; 44 O. G. 1400.

Evidence of Validity.

That on the question of the validity of a re-issue the original patent is admissible evidence, and such question is raised when the answer denies all the allegations of a bill averring that the original and re-issue were for the same invention, see *Oregon Improvement Co. v. Excelsior Coal Co.* (1889), 132 U. S. 215; 49 O. G. 1694.

REPEAL.

That the United States may sue in equity for the repeal of a patent obtained by fraud, see *United States v. American Bell Telephone Co.* (1888), 128 U. S. 315; 45 O. G. 1311. See the argument and opinion in this case for a full discussion of the subject.

That a bill in equity to repeal two patents to the same party and relating to the same subject is not multifarious, see *United States v. American Bell Telephone Co.* (1888), 128 U. S. 315; 45 O. G. 1311.

Secretary of the Interior.

That the Secretary has no appellate jurisdiction over the Commissioner as to the judicial or quasi-judicial duties imposed on him by law, but may direct him to perform the duties which the law devolves upon him, and may

be appealed to as to matters prescribed by the rules established by the Secretary himself for the direction of his department, see *Houston v. Barker* (1888), 44 O. G. 697.

That the decisions of the Commissioner as to the admissibility of evidence are not reviewable by the Secretary, see *Houston v. Barker* (1888), 44 O. G. 697.

STAMPING.

That an article covering new, valuable, unpatented matter as well as parts that are patented cannot be marked "patented" as a whole, see *Deverall v. Banker* (1888), 45 O. G. 591.

That the stamp "patented" means that the article is protected by a patent at the time of sale, and if the patent has expired the mark is false, and the intent to deceive will be inferred from the act of marking itself, see *New York Card Co. v. Union Card Co.* (1886), 39 Hun (N. Y.), 611.

That in marking "with intent to deceive" the intent to deceive is essential and must be proved, see *Deverall v. Banker* (1888), 45 O. G. 591.

That to mark an unpatented article with "Patent applied for" is not an offence, see *Schwebel v. Bothe* (1889), 40 Fed. Rep. 478; 49 O. G. 1696.

STATE POWERS.

That the right of an inventor to sell his invention is not derived from the Patent Law, and may be controlled by the State authorities, see *Herdie v. Roessler* (1888), 109 N. Y. 127.

That a State cannot tax the property in letters-patent, but may tax the proceeds thereof, see *Herdie v. Roessler* (1886), 39 Hun (N. Y.), 198.

That a statute requiring the vendor

of a patent-right to file a copy of the patent with the county clerk, and to swear that it is genuine, and that a note given for such a right shall state that it is so given, is valid; but such statute applies only to the patent-right, not to the article made under it, see *Hankoy v. Downey* (1888), 116 Ind. 118; *Pape v. Wright* (1889), 116 Ind. 502.

TERM OF PATENT.

Provable by Parol.

That the American patent need not declare its true term on its face, but the exact limit may be proved by parol, see *Bate Refrigerating Co. v. Hammond* (1889), 129 U. S. 151; 46 O. G. 689.

That the term of a patent, however it may be stated in the patent, may be inquired into as a matter of fact in view of foreign patents, see *Edison Electric Light Co. v. Westinghouse* (1889), 40 Fed. Rep. 666.

When limited by foreign Patents.

That an American patent may expire with the prior foreign patent when the American covers some improvements if the invention is substantially the same, see *Holmes Electric Protective Co. v. Metropolitan Burglar Alarm Co.* (1887), 33 Fed. Rep. 254; *Siemen's Administrator v. Sellers* (1887), 123 U. S. 276.

That a domestic patent expires with the foreign one, though the former includes other features which are not separable inventions, see *Clark v. Wilson* (1886), 24 Blatch. 39; 28 Fed. Rep. 95; 36 O. G. 456.

That the domestic patent will be limited by the term of the foreign if the foreign were first issued, though the domestic were first applied for, see *Edison Electric Light Co. v. U. S.*

Electric Lighting Co. (1888), 35 Fed. Rep. 134; 43 O. G. 1456.

That when an English patent is issued after the American, but is antedated to precede it, the term of the latter is not limited thereby, see *Sci-bert Cylinder Oil Co. v. William Powell Co.* (1888), 35 Fed. Rep. 591.

That the foreign patent will limit the term of the domestic whether it were granted to the same patentee or to some other person with his consent, see *Edison Electric Light Co. v. U. S. Electric Lighting Co.* (1888), 35 Fed. Rep. 134; 43 O. G. 1456.

Not enlarged by Extension of Foreign Patent.

That an American patent whose term is limited by that of a foreign patent expires when the foreign patent expires, see *Bate Refrigerating Co. v. Hammond* (1889), 129 U. S. 151; 46 O. G. 689.

That the extension of the term of a foreign patent by which that of the American patent is limited does not extend the latter, where the foreign extension is a matter of right, see *Bate Refrigerating Co. v. Hammond* (1889), 129 U. S. 151; 46 O. G. 689.

Effect of Forfeiture of Foreign Patent.

That the term of the domestic patent does not expire with the forfeiture of the foreign patent by failure to pay periodical taxes, see *Paillard v. Bruno* (1886), 24 Blatch. 177.

That an American patent cannot lawfully be granted after a foreign patent for the same invention has expired by forfeiture, see *Huber v. N. O. Nelson Mfg. Co.* (1889), 38 Fed. Rep. 830; 47 O. G. 1732.

That an American patent granted after the forfeiture of a foreign one is

of too doubtful validity to warrant an injunction, see *Huber v. Myers Sanitary Depot* (1887), 33 Fed. Rep. 48.

That the same reasons exist for terminating an American patent by the premature failure of the foreign patent as for not extending it when the foreign patent is extended, see *Huber v. N. O. Nelson Mfg. Co.* (1889), 38 Fed. Rep. 830; 47 O. G. 1732. The contrary is true. When a foreign patent is extended, it is extended because of some merit peculiar to the foreign patentee. When it is forfeited, it is forfeited because of some demerit peculiar to the foreign patentee. If the merit resulting in an extension does not enure to the benefit of the American patentee, the demerit resulting in a forfeiture should not work him an injury.

That the term of a patent limited by that of a foreign patent expires when the limiting patent expires, whether by lapse of time, forfeiture, or other causes, see *Huber v. N. O. Nelson Mfg. Co.* (1889), 38 Fed. Rep. 830; 47 O. G. 1732; *Pohl v. Anchor Brewing Co.* (1889), 39 Fed. Rep. 782; 49 O. G. 1695; departing from preceding cases in deference to their interpretation of *Refrigerating Co. v. Hammond* (1889), 129 U. S. 151; 46 O. G. 689. If this doctrine is sustained the American patentee will be at the mercy of any foreign patentee or assignee who may choose to destroy the domestic patent by the sacrifice of his own; and in most cases a due regard to his interests would thus compel the American inventor, whom our law is supposed to favor and protect, to refrain from patenting his invention altogether in a foreign country, at least until after his patent has issued

in the United States. Such a consequence is directly opposed to the true intent of this provision of our statutes.

UNPATENTED INVENTION.

That an infringer before application for patent is not liable in damages in a suit on the patent, though he knew the plaintiff was the true inventor, see *Lyon v. Donaldson* (1888), 34 Fed. Rep. 789.

That the unlawful use of an invention will not be enjoined before a patent has issued, though an application be pending in the Patent Office, see *Rein v. Clayton* (1889), 37 Fed. Rep. 354. In this opinion, and the cases cited to support it, the distinction between the property in the invention and the property in the monopoly is not preserved; and the former is treated as if it had no legal existence apart from the latter, which is incorrect in fact as well as upon principle and authority.

That an inventor has a property in his invention, independent of any patent, until he makes it public, and it will meanwhile be protected against piracy by unfair means by the State courts of equity, see *Tabor v. Hoffman* (1889), 118 N. Y. 30.

That the patent grants to the patentee only the right to exclude others from practising the invention, not the right to make, use, or sell it himself, see *Herdie v. Roessler* (1888), 109 N. Y. 127.

That there is no property right in an invention until the patent issues, see *Marsh v. Nichols* (1888), 128 U. S. 605; 46 O. G. 239.

That one who discovers the inventor's secret by dishonorable means, but without a breach of trust, may use the invention before patent without liability, see *Kortenhans v. American Watch Co.* (1884), 17 Phila. 134.

USES.

That the benefits of an invention belong to an inventor whether he has perceived them or not, see *Brown v. District of Columbia* (1889), 130 U. S. 87; 47 O. G. 398.

UTILITY.

That utility does not mean commercial success, see *Aulin v. Levinstein* (1887), L. R. 12 App. 710.

That an invention employed only for gambling is not useful or patentable, see *National Automatic Device Co. v. Lloyd* (1889), 40 Fed. Rep. 89.

That the efforts of others to accomplish a result may show that the means by which it is accomplished has utility, see *Shannon v. Brewer* (1887) 33 Fed. Rep. 289; 41 O. G. 697.

That one using an invention cannot deny its utility, see *La Rue v. Western Electric Co.* (1887), 24 Blatch. 392.

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(See also ACTION IN EQUITY, ACTION AT LAW, APPLICATION FOR PATENT, ASSIGNMENT, ASSIGNOR, ATTORNEYS, CLOUD ON TITLE, CO-GRANTEES, CONSIDERATION, CONTRACT, CO-OWNERS, DISCLAIMER, EMPLOYEE, EQUITABLE ESTOPPEL, EXTENSION, FORFEITURE, FRAUD, INFRINGEMENT, INJUNCTION, JUDGMENTS, LACHES, MONEY PAID, NOTES, PARTNERS, PURCHASE MONEY, RESCISSION, SPECIFIC PERFORMANCE, STATES OF THE UNION, TITLE, TRANSFER.)

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(See also AGGREGATION, ART, CLAIM, COMPOSITION, DESCRIPTION, DESIGN, DISCLAIMER, DOUBLE USE, ELEMENTS, EQUIVALENTS, IDENTITY, IMPROVEMENT, INFRINGEMENT, JOINDER OF INVENTIONS, MACHINE, MANUFACTURE, PATENT, PATENT OFFICE, RE-ISSUE, SUBCOMBINATIONS, SUB-PROCESS, UNITY OF INVENTIONS, USE.)

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